

# **Case Law**

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

**Eighth Edition  
July 2016**

**Legal Research Service  
of the Boards of Appeal**

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## Foreword to the eighth edition

The boards of appeal have developed a substantial body of case law over the past 37 years. They have settled more than 40 000 cases. In addition, more than 90 decisions or opinions of the Enlarged Board of Appeal have clarified legal points of fundamental importance in order to ensure uniform application of the law.

The eighth edition of the "Case Law of the Boards of Appeal of the European Patent Office" offers a comprehensive overview of the entire case law of the boards of appeal. More than 5 500 decisions are either summarised or cited in chapters which are arranged by topic. This edition incorporates decisions issued in writing by the end of 2015 and also takes account of a number of important decisions rendered at the beginning of 2016. While it follows the same overall structure as the seventh edition, some chapters have been re-organised to allow topics to be located more quickly or to take further developments in the case law into account. The book is complemented by the regular "Board of Appeal Case Law" supplementary publications of the EPO Official Journal, which provide updates on the boards' most recent case law.

This book will help anyone concerned with European patent law to identify the decisions they need. Nevertheless, no summary, however careful, can replace study of the actual decision. All of the decisions handed down since 1979 can be consulted in full and free of charge on the EPO website ([www.epo.org](http://www.epo.org)).

I would like to thank the members of our Legal Research Service, who updated, revised and harmonised the text of this edition. My thanks also go to the EPO Language Service, without whose co-operation the simultaneous publication in the three official languages would not have been possible. Lastly, I wish to thank all the other EPO staff who have helped produce the present publication.

Wim van der Eijk  
Chairman of the Enlarged Board of Appeal  
Vice-President Directorate-General 3



# TABLE OF CONTENTS

<b>FOREWORD TO THE EIGHTH EDITION</b>	<b>III</b>
<b>READER'S GUIDE</b>	<b>XV</b>
1. Abbreviations	XV
2. Citations	XVI
3. Case numbers	XVI
<b>I. PATENTABILITY</b>	<b>1</b>
<b>A. Patentable inventions</b>	<b>1</b>
1. Patent protection for technical inventions	2
2. Non-inventions under Article 52(2) and (3) EPC	10
<b>B. Exceptions to patentability</b>	<b>35</b>
1. Introduction	36
2. Breaches of "ordre public" or morality	37
3. Patentability of biological inventions	43
4. Medical methods	51
<b>C. Novelty</b>	<b>66</b>
1. General	69
2. State of the art	69
3. Availability to the public	78
4. Determining the content of the relevant prior art	101
5. Ascertaining differences	115
6. Chemical inventions and selection inventions	121
7. First and second medical use	134
8. Second (or further) non-medical use	148
<b>D. Inventive step</b>	<b>158</b>
1. Introduction	160
2. Problem and solution approach	161
3. Closest prior art	163
4. Technical problem	172
5. "Could-would approach"	183
6. Ex post facto analysis	184

---

7.	Expectation of success, especially in the field of genetic engineering and biotechnology	185
8.	Skilled person	188
9.	Assessment of inventive step	197
10.	Secondary indicia in the assessment of inventive step	243
<b>E.</b>	<b>The requirement of industrial application under Article 57 EPC</b>	<b>254</b>
1.	Notion of "industrial application"	254
2.	Reproducibility and sufficiency of disclosure	257
3.	Indication of a profitable use of the invention in industry	258
<b>II.</b>	<b>PATENT APPLICATION AND AMENDMENTS</b>	<b>261</b>
<b>A.</b>	<b>Claims</b>	<b>261</b>
1.	Basic principles	262
2.	Form, content and conciseness of claims	263
3.	Clarity of claims	270
4.	Disclaimers	283
5.	Claims supported by the description	284
6.	Interpretation of claims	287
7.	Product-by-process claims	296
8.	Claims fees	300
<b>B.</b>	<b>Unity of invention</b>	<b>302</b>
1.	Introduction	302
2.	Unity in the context of different types of claims	303
3.	Assessing lack of unity of invention	307
4.	Criteria for determining lack of unity	312
5.	The single general inventive concept	314
6.	Plurality of inventions and further search fees	321
<b>C.</b>	<b>Sufficiency of disclosure</b>	<b>327</b>
1.	Date of compliance	328
2.	Parts of the application relevant for assessing sufficiency of disclosure	329
3.	Knowledge of skilled person relevant for assessing sufficiency of disclosure	330
4.	Clarity and completeness of disclosure	333
5.	Reproducibility	338
6.	The requirement of sufficiency of disclosure in the biotechnology field	344
7.	The relationship between Article 83 and Article 84 EPC	356
8.	Evidence	362

---

<b>D.</b>	<b>Priority</b>	<b>366</b>
1.	Introduction	367
2.	Applications giving rise to a right of priority	368
3.	Identity of invention	372
4.	First application	387
5.	Partial and multiple priorities	391
<b>E.</b>	<b>Amendments</b>	<b>398</b>
1.	Article 123(2) EPC – added subject-matter	401
2.	Article 123(3) EPC – extension of the protection conferred	459
3.	Relationship between Article 123(2) and Article 123(3) EPC	475
4.	Correction of errors in the description, claims and drawings – Rule 139 EPC	481
5.	Evidence and standard of proof for allowing amendments and corrections	489
<b>F.</b>	<b>Divisional applications</b>	<b>491</b>
1.	Introduction	492
2.	Subject-matter of a divisional application	493
3.	Filing a divisional application	499
4.	Procedural questions	505
5.	Double patenting	508
<b>III.</b>	<b>RULES COMMON TO ALL PROCEEDINGS BEFORE THE EPO</b>	<b>513</b>
<b>A.</b>	<b>The principle of the protection of legitimate expectations</b>	<b>513</b>
1.	Applicability of the principle of the protection of legitimate expectations	514
2.	Information provided by EPO	518
3.	Obligation to draw attention to easily remediable deficiencies	521
4.	Obligation to enquire in case of unclear nature of request	526
5.	Legitimate expectation and case law	527
<b>B.</b>	<b>Right to be heard</b>	<b>530</b>
1.	Introduction	531
2.	The right to be heard under Article 113(1) EPC	532
3.	Text submitted or agreed by applicant (patent proprietor) - Article 113(2) EPC	553
<b>C.</b>	<b>Oral proceedings</b>	<b>556</b>
1.	Right to oral proceedings	558
2.	Request for oral proceedings	560

3.	Non-attendance at oral proceedings	566
4.	Preparation and conduct of oral proceedings	568
5.	Costs	589
<b>D.</b>	<b>Time limits, further processing and interruption of proceedings</b>	<b>591</b>
1.	Calculation, determination and extension of time limits	591
2.	Further processing under Article 121 EPC	595
3.	Interruption of proceedings under Rule 142 EPC	596
<b>E.</b>	<b>Re-establishment of rights</b>	<b>601</b>
1.	Introduction	602
2.	Right to file request for re-establishment of rights	603
3.	Non-observance of time limit directly causing a loss of right	604
4.	Admissibility of requests for re-establishment of rights	606
5.	Merit of request for re-establishment of rights	615
6.	Procedural treatment of requests for re-establishment	638
7.	Rights of use under Article 122(5) EPC	642
8.	Principle of proportionality	642
9.	Refund of the fee for re-establishment	644
<b>F.</b>	<b>Languages</b>	<b>646</b>
1.	Language of filing and date of filing of a European patent application	646
2.	Language of the proceedings	647
3.	Derogations from the language of the proceedings in written proceedings and in oral proceedings	647
4.	Language privilege	649
5.	Translations	649
6.	Language-related fee reductions	651
<b>G.</b>	<b>Law of evidence</b>	<b>653</b>
1.	Introduction	654
2.	Admissible evidence	656
3.	Taking of evidence	664
4.	Evaluation of evidence	674
5.	Burden of proof	693
<b>H.</b>	<b>Interpretation of the EPC</b>	<b>704</b>
1.	The Vienna Convention on the Law of Treaties	705
2.	Interpretation of the EPC affected by TRIPS Agreement	710
3.	The European Convention on Human Rights	711
4.	Impact of national decisions on the case law of the boards of appeal	711



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5.	Decisions of the Administrative Council: boards of appeal not formally bound	713
6.	Implementing Regulations	713
7.	Changes in relation to an established practice and interpretation	714
8.	Interpretation of the various language texts of the EPC (Article 177 EPC)	715
<b>I.</b>	<b>Main and auxiliary requests</b>	<b>716</b>
1.	Possibility of filing auxiliary requests	716
2.	Order of requests	716
3.	Admissibility of requests	717
4.	Obligation to give reasons for refusal of each request	718
5.	Examination procedure	719
6.	Interlocutory decision on allowable auxiliary request – distinction between examination proceedings and opposition proceedings	719
7.	Opposition procedure	720
8.	Appeal procedure	721
<b>J.</b>	<b>Suspected partiality</b>	<b>722</b>
1.	General principles	723
2.	Initiation of partiality proceedings and other procedural issues	727
3.	Admissibility	730
4.	Suspected partiality of members of the departments of first instance	732
5.	Suspected partiality of members of the boards of appeal	734
6.	Suspected partiality of members of the Enlarged Board of Appeal	737
7.	Legal restrictions for former board members	740
<b>K.</b>	<b>Formal aspects of decisions of EPO departments</b>	<b>741</b>
1.	Right to a decision after notification of loss of rights (Rule 112 EPC)	742
2.	Composition of the competent departments of first instance	744
3.	Date of decision	747
4.	Form of decisions	748
5.	Principles for the exercise of discretion	761
<b>L.</b>	<b>Correction of errors in decisions</b>	<b>763</b>
1.	General issues	763
2.	Errors in the printed version of the European patent specification	765
3.	Competence to correct a decision under Rule 140 EPC (former Rule 89 EPC 1973)	766
4.	Procedural status of third parties	767

<b>M.</b>	<b>Inspection of files, European Patent Register and stay of proceedings</b>	<b>768</b>
1.	Inspection of files	768
2.	European Patent Register	771
3.	Stay of proceedings under Rule 14(1) EPC	773
<b>N.</b>	<b>Observations by third parties</b>	<b>776</b>
1.	Introduction	776
2.	Formal requirements	777
3.	Third party's legal status	779
4.	Third-party observations in opposition proceedings	781
5.	Third-party observations filed at a late procedural stage	782
6.	Remittal following filing of observations	784
<b>O.</b>	<b>Notifications</b>	<b>785</b>
1.	Forms of notification	785
2.	Notification to representatives	787
3.	Notification to third parties	788
4.	Spheres of risk and apportioning the burden of proof	789
<b>P.</b>	<b>Applications by non-entitled persons</b>	<b>791</b>
<b>Q.</b>	<b>Rules relating to Fees</b>	<b>792</b>
1.	General	792
2.	Payment of fees	793
3.	Date of payment	795
4.	Insufficient payments - small amounts lacking	795
5.	Reduction of the examination fee	797
6.	Partial refund of the examination fee	797
<b>R.</b>	<b>Representation</b>	<b>798</b>
1.	Professional representatives	799
2.	Legal practitioners entitled to act as professional representative	803
3.	Appointment of a common representative (Rule 151 EPC)	806
4.	Authorisations for appointment of a representative	808
5.	Oral submissions by an accompanying person	815
6.	Distinction between presentation of facts and evidence and presentation of arguments	826
<b>S.</b>	<b>Guidelines for Examination in the European Patent Office</b>	<b>828</b>
1.	Guidelines not binding on boards	828

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2.	Guidelines binding (in principle) on departments of first instance	830
3.	The boards' application of the Guidelines in specific cases	832
<b>IV.</b>	<b>PROCEEDINGS BEFORE THE EPO</b>	<b>835</b>
<b>A.</b>	<b>Preliminary and formalities examination</b>	<b>835</b>
1.	Introduction	836
2.	Responsibility for formalities examination	836
3.	Where and how applications may be filed	837
4.	Persons entitled to file application	837
5.	Accordance of a date of filing	838
6.	Examination of formal requirements	848
7.	Designation of states	851
8.	Priority	855
9.	Deemed withdrawal of the application (Rule 100(3) EPC)	858
10.	Publication of the application	859
<b>B.</b>	<b>Examination procedure</b>	<b>860</b>
1.	Stage before substantive examination	862
2.	The first stage of substantive examination	865
3.	The grant stage in examination	887
4.	Additional searches during examination	913
5.	Amendments relating to unsearched subject-matter - Rule 137(5) EPC	918
<b>C.</b>	<b>Special features of opposition and appeal proceedings</b>	<b>928</b>
1.	Late submission	930
2.	Transfer of party status	958
3.	Intervention	967
4.	Continuation of the opposition proceedings by the EPO	973
5.	Limitation/revocation	979
6.	Apportionment of costs	981
<b>D.</b>	<b>Opposition procedure</b>	<b>1005</b>
1.	Legal character of opposition proceedings and applicable principles	1006
2.	Filing and admissibility requirements	1008
3.	Substantive examination of opposition	1027
4.	Amendments in opposition proceedings	1037
5.	Right to be heard in opposition proceedings	1050
6.	Acceleration of opposition proceedings in the case of pending infringement proceedings	1055
7.	Decisions of opposition division	1056

<b>E.</b>	<b>Appeal procedure</b>	<b>1059</b>
1.	Legal character of appeal procedure	1065
2.	Filing and admissibility of the appeal	1069
3.	Substantive examination of the appeal	1111
4.	Filing of amended claims in appeal proceedings	1127
5.	Parallel proceedings	1164
6.	Termination of appeal proceedings	1164
7.	Remittal to the department of first instance	1170
8.	Reimbursement of appeal fees	1187
<b>F.</b>	<b>Proceedings before the Enlarged Board of Appeal</b>	<b>1215</b>
1.	Introduction	1216
2.	Referral under Article 112 EPC	1217
3.	Petition for review under Article 112a EPC	1226
4.	Removal from office of a board member	1245
<b>V.</b>	<b>PROCEEDINGS BEFORE THE DISCIPLINARY BOARD OF APPEAL</b>	<b>1247</b>
1.	Introduction	1247
2.	European qualifying examination	1249
3.	Disciplinary matters	1260
4.	Code of Professional Conduct	1262
5.	Appeals against decisions of the Disciplinary Board of Appeal	1263
<b>VI.</b>	<b>THE EPO ACTING AS A PCT AUTHORITY - EURO-PCT APPLICATIONS</b>	<b>1265</b>
1.	Introduction	1265
2.	Jurisdiction of the boards of appeal	1265
3.	Competence of the EPO acting as designated or elected Office	1266
4.	Language of the proceedings	1268
<b>VII.</b>	<b>INSTITUTIONAL MATTERS</b>	<b>1269</b>
1.	Legal status of the EPO boards of appeal	1269
2.	Extension agreements and ordinances	1274
3.	Administrative agreements under Article 10(2)(a) EPC	1276

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<b>TABLE OF CASES</b>	<b>1279</b>
Decisions of the Disciplinary Board	1279
Decisions and opinions of the Enlarged Board of Appeal on referrals	1280
Decisions of the Legal Board of Appeal	1283
Decisions of the Enlarged Board of Appeal on petitions for review	1290
Decisions of the technical boards of appeal	1292
PCT Protests	1360
<b>INDEX OF CITED PROVISIONS</b>	<b>1363</b>
1. European Patent Convention	1363
2. Implementing Regulations to the EPC	1373
3. Rules relating to Fees	1381
4. Patent Cooperation Treaty (articles and rules)	1381
5. Regulation on the European qualifying examination for professional representatives	1382
6. Regulation on discipline for professional representatives	1382
7. Rules of procedure of the Enlarged Board of Appeal	1383
8. Rules of procedure of the Boards of Appeal	1383
<b>ANNEXES</b>	<b>1385</b>
1. Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office	1385
2. Rules of Procedure of the Boards of Appeal of the European Patent Office	1395
3. Transitional provisions	1405
4. Cross-reference list EPC 1973 - EPC 2000	1407
5. General Index	1413



## Reader's Guide

### 1. Abbreviations

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

RFees	Rules relating to Fees
SISA	Supplementary International Searching Authority
TRIPS	Agreement on Trade-related Aspects of Intellectual Property Rights
UPOV	International Union for the Protection of New Varieties of Plants
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization

## 2. Citations

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

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

(c) The Official Journal of the EPO is cited as OJ, followed by the year of publication and page number for publication prior to 2014 (eg OJ 2000, 322) and as OJ, followed by the year of publication and article for publication as of 2014 (eg OJ 2015, A102).

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

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

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

## 3. Case numbers

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

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

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



# I. PATENTABILITY

## A. Patentable inventions

1.	Patent protection for technical inventions	2
1.1.	Technical character of an invention	3
1.2.	Separate and independent patentability requirements	4
1.3.	Absolute and relative patentability requirements	4
1.4.	Verification of the presence of an invention under Article 52(1) EPC	4
1.4.1	Assessment of the invention independent of the prior art	5
	a) Earlier case law of the boards of appeal: the "contribution approach"	5
	b) Abandonment of the so-called "contribution approach"	5
	c) Some consequences of abandoning the contribution approach	6
1.4.2	Technical considerations and technical implementations	6
1.4.3	Methods involving technical means	7
1.4.4	Methods used in a technical process carried out on a physical entity	8
1.4.5	Apparatus constituting a physical entity or concrete product	9
2.	Non-inventions under Article 52(2) and (3) EPC	10
2.1.	Introduction	10
2.2.	Discoveries, scientific theories and mathematical methods	12
2.2.1	Discoveries and scientific theories	12
2.2.2	Mathematical methods	12
2.3.	Aesthetic creations	14
2.4.	Computer-implemented inventions	16
2.4.1	Introduction	16
2.4.2	Patentability of computer programs	17
2.4.3	Programs for computers and technical character	18
	a) Further effects of programs for computers	18
	b) Technical effect on a physical entity	19
	c) Technical considerations: programming a computer	19
	d) Technical considerations: implementation of a function on a computer system	21
	e) Methods performed by a computer	22
	f) Computer-implemented simulation methods	23
2.4.4	Claims on computer programs	25
	a) Computer program recorded on the medium	25
	b) Exclusion of computer programs under Article 52(2) and (3) EPC	26
2.5.	Schemes, rules and methods for performing mental acts, playing games or doing business	27
2.5.1	Methods for doing business	28
2.5.2	Methods for performing mental acts	29
2.5.3	Word-processing	30
2.6.	Presentations of information	32

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

### 1. Patent protection for technical inventions

Art. 52(1) EPC expresses the fundamental principle of a general entitlement to patent protection for any invention in all technical fields (see **G 5/83**, OJ 1985, 64, point 21 et seq. of the Reasons; **G 1/98**, OJ 2000, 111, point 3.9 of the Reasons; **G 1/03**, OJ 2004, 413, point 2.2.2 of the Reasons; **G 1/04**, OJ 2006, 334, point 6 of the Reasons; **T 154/04**; OJ 2008, 46, 62, point 6 of the Reasons). Any limitation to the general entitlement to patent protection is thus not a matter of administrative or judicial discretion, but must have a clear legal basis in the EPC (see **G 2/12**, of 25.03.2015, OJ 2016, A28; **T 154/04**).

The technical character as a legal requirement of invention was expressly confirmed by the Conference of the Contracting States to Revise the EPC of 20 to 29 November 2000.

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

Art. 52(2) EPC contains a non-exhaustive list of "**non-inventions**", that is, subject-matter or activities not to be regarded as inventions within the meaning of paragraph 1. The exclusion from patentability of the subject-matter or activities referred to applies only to the extent that a European patent application or European patent relates to such subject-matter or activities **as such** (Art. 52(3) EPC; see also OJ SE 4/2007). Art. 52(2) EPC covers subject-matter whose common feature is a substantial lack of technical character.

The application of Art. 52(1) EPC presents a problem of construction as there was no legal or commonly accepted definition of the term "invention" at the time of conclusion of the Convention in 1973. Moreover, the EPO has not developed any such explicit definition since. Art. 52(2) EPC is merely a negative, non-exhaustive list of what should not be regarded as an invention within the meaning of Art. 52(1) EPC. It was the clear intention of the contracting states that this list of "excluded" subject matter should not be given too broad a scope of application, as follows from the legislative history of Art. 52 (2) EPC. Art. 52(3) EPC is a bar to a broad interpretation of Art. 52(2) EPC (**T 154/04**, point 6 of the Reasons; see also **G 2/12**, OJ 2016, A28).

## 1.1. Technical character of an invention

It has been part of the European legal tradition that patent protection should be reserved for technical creations. It was indeed always common ground that creations in engineering and technology were entitled to patent protection under the EPC (see e. g. **T 22/85**, OJ 1990, 12; **T 154/04**, OJ 2008, 46). The use of the term "invention" in Art. 52(1) EPC 1973 in conjunction with the so-called "exclusion provisions" of Art. 52(2) and (3) EPC 1973 was interpreted by the boards of appeal as **implying** a requirement of technical character or technicality to be fulfilled by an invention as claimed in order to be patentable (**T 931/95**, **T 1173/97** and **T 935/97**). Thus an invention may be an invention within the meaning of Art. 52(1) EPC if, for example, a technical effect is achieved by the invention or if **technical considerations** are required to carry out the invention. In **T 1173/97** (OJ 1999, 609) and **T 935/97** the board stated that within the context of the application of the EPC the technical character of an invention was generally accepted as an essential requirement for its patentability. In **T 931/95** (OJ 2001, 441) the board held that technical character was an implicit requirement of the EPC to be met by an invention in order to be an invention within the meaning of Art. 52(1) EPC 1973 (see also **T 1543/06**).

In **T 154/04** (OJ 2008, 46) the board summarised the main principles underlying the relevant jurisprudence of the boards of appeal. The board held that "technical character" was an **implicit requisite** of an "invention" within the meaning of Art. 52(1) EPC 1973 (requirement of "technicality"). Art. 52(2) EPC 1973 did not exclude from patentability any subject matter or activity having a technical character, even if linked to items listed in this provision since these items were **only excluded "as such"** (Art. 52(3) EPC 1973). In examining the patentability of an invention in respect of a claim, the claim had to be construed to determine the **technical features** of the invention, i.e. the features which contributed to the technical character of the invention (see also **T 931/95**, OJ 2001, 441, **T 914/02** and **T 1543/06**). The board observed that the intention of Art. 52(3) EPC 1973 was clearly to ensure that anything which had previously been a patentable invention under conventional patentability criteria should remain patentable under the EPC.

In **T 619/02** (OJ 2007, 63) the board stated that, as had long been accepted, (see in this respect decisions **T 22/85**, OJ 1990, 12, **T 931/95**, OJ 2001, 441, and **T 258/03**, OJ 2004, 575), the technical character of an invention constituted a fundamental prerequisite inherent to Art. 52 EPC 1973 - and was formulated as an explicit requirement in Art. 52(1) EPC. Thus, technical character constituted a **conditio sine-qua-non** to be met by an invention susceptible of patent protection under the EPC. Additionally, the board noted that a technical invention is generally useful and practical within the generic meaning of these terms, but the reverse is not necessarily true, i.e. not every "practical art" and not every entity or activity that is practical or useful is necessarily technical in the patent law sense (see **T 388/04**, OJ 2007, 16). It was noted that in some national patent law systems, "useful" is the counterpart to the requirement of industrial applicability set out in Art. 57 EPC 1973 (see Note 5 to Art. 27(1) TRIPS); however, this special meaning of the term does not necessarily convey technical character either. Accordingly, considerations of usefulness and practicality are no substitute for, or criteria equivalent to the prerequisite of technical character inherent in

the EPC. The board observed that although industrial applicability and technical character of an invention are intimately related to each other (**T 854/90**), they are not synonymous and constitute two distinct, non-equivalent requirements under the EPC 1973 (**T 953/94**).

## **1.2. Separate and independent patentability requirements**

Art. 52(1) EPC 1973 in conjunction with Art. 52(2) and (3) EPC 1973 is generally interpreted as implying a requirement of technical character for a claimed invention to be patentable. Whereas technical character was previously assessed using the "contribution approach", recent case law has abandoned this approach in favour of one which recognises the requirement of technical character as separate and independent of the remaining requirements of Art. 52(1) EPC, in particular novelty and inventive step, and compliance with which can therefore be assessed without having recourse to the prior art (**T 1543/06**).

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

## **1.3. Absolute and relative patentability requirements**

In **T 154/04**, OJ 2008, 46, the board indicated that the examination of whether there was an invention within the meaning of Art. 52(1) to (3) EPC 1973 should be strictly separated from and not confused with the examination of the other three patentability requirements referred to in Art. 52(1) EPC 1973. It distinguished the concept of "invention" as a general and absolute requirement of patentability from the relative criteria, novelty and inventive step, (which, in an ordinary popular sense, were understood to be the attributes of any invention), and the requirement of industrial applicability. Decisive for the presence of a (potentially patentable) invention was the inherent character of the claimed subject-matter.

## **1.4. Verification of the presence of an invention under Article 52(1) EPC**

In **T 258/03**, OJ 2004, 575 (see also **T 154/04**, OJ 2008, 46), the board stated that the verification that claimed subject-matter is an invention within the meaning of Art. 52(1) EPC 1973 is, in principle, a **prerequisite** for the examination in respect of novelty, inventive step and industrial application, since these latter requirements were defined only for inventions (see Art. 54(1), 56, and 57 EPC 1973). The structure of the EPC therefore suggests that it should be possible to determine whether subject-

matter was excluded under Art. 52(2) EPC 1973 without any knowledge of the state of the art (including common general knowledge).

#### 1.4.1 Assessment of the invention independent of the prior art

##### a) Earlier case law of the boards of appeal: the "contribution approach"

In order to assess whether the claimed subject-matter was an invention within the meaning of Art. 52(1) EPC 1973, the boards of appeal applied, in their earlier case law, the so-called "contribution approach", according to which an invention had a technical character if it provided a technical contribution to the state of the art in a field not excluded from patentability under Art. 52(2) EPC 1973 (see **T 121/85**, **T 38/86**, OJ 1990, 384; **T 95/86**, **T 603/89**, OJ 1992, 230; **T 71/91**, **T 236/91**, **T 833/91**, **T 77/92**). The idea behind the so-called contribution approach applied by earlier jurisprudence of the boards of appeal was that the EPC 1973 only permitted patenting "in those cases in which the invention involves some contribution to the art in a field not excluded from patentability" (**T 38/86**, OJ 1990, 384). In other words, in order to assess the first requirement, i.e. the presence of an invention within the meaning of Art. 52(1) EPC 1973, a criterion was established which relied on meeting further requirements mentioned in that Article, in particular novelty and/or inventive step. Thus, some prior art was taken into account when determining whether subject-matter was excluded under Art. 52(2) and (3) EPC 1973 (**T 258/03**, OJ 2004, 575; see **T 769/92**, OJ 1995, 525).

##### b) Abandonment of the so-called "contribution approach"

In more recent decisions of the boards, any comparison with the prior art was found to be inappropriate for determining whether or not an invention was present.

In **T 1173/97** (OJ 1999, 609) the board held that determining the technical contribution an invention achieves with respect to the prior art is more appropriate for the purpose of examining novelty and inventive step than for deciding on possible exclusion under Art. 52(2) and (3) EPC 1973. In **T 931/95** (OJ 2001, 441) it was stated that there is no basis in the EPC for distinguishing between "new features" of an invention and features of that invention which are known from the prior art, when examining whether the invention concerned may be considered to be an invention within the meaning of Art. 52(1) EPC 1973. Thus there is no basis in the EPC for applying the so-called contribution approach for this purpose (see also; **T 1001/99**, **T 388/04**, OJ 2007, 16; **T 619/02**, OJ 2007, 63; **T 553/02**; **T 258/03**, OJ 2004, 575). By taking this position the board in **T 1173/97** consciously abandoned the so-called "contribution approach" which had been applied, somewhat inconsistently, in the earlier case law. This was clearly a deliberate development of the case law. No decision of the boards of appeal has since challenged this choice by the board. It therefore stands as the established case law (**G 3/08**, OJ 2011, 10).

c) Some consequences of abandoning the contribution approach

Over a series of decisions the boards of appeal (and in particular Board 3.5.01) explored the consequences of abandoning the contribution approach (see **G 3/08**, OJ 2011, 10).

In **T 931/95** (OJ 2001, 441), the board decided that an apparatus for carrying out an activity excluded as such from patentability by Art. 52(2) and (3) EPC 1973 was not itself excluded from patentability. In particular, a claim directed to a computer loaded with a program was not excluded from patentability by Art. 52(2) EPC 1973 even if the program itself would be, i.e. if the program caused no "further technical effect" when run. That decision did not however extend the logic to methods employing technical means (Headnote 2). With regard to methods, this decision was explicitly overturned by **T 258/03** (Headnote 1); **T 258/03** came to the conclusion that any claim involving technical means was not excluded from patentability by Art. 52(2) EPC 1973 (see points 3 and 4 of the Reasons). **T 424/03**, finally extended the reasoning applied in **T 258/03** to come to the conclusion that a claim to a program ("computer executable instructions" in the claim in question) on a computer-readable medium also necessarily avoids exclusion from patentability under Art. 52(2) EPC 1973 (see Catchword 2 and point 5.3 of the Reasons).

#### 1.4.2 Technical considerations and technical implementations

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

In **G 3/08** (OJ 2011, 10) the Enlarged Board of Appeal could not identify a divergence in the case law of the boards of appeal, but noted that there was at least the potential for confusion, arising from the assumption that **any technical considerations** are sufficient to confer technical character on claimed subject-matter, a position which was apparently adopted in some cases (e.g. **T 769/92**).

In **T 1173/97** the board noted that all computer programs have technical effects, since for example when different programs are executed they cause different electrical currents to circulate in the computer they run on. However such technical effects are not sufficient to confer "technical character" on the programs; they must cause **further technical effects**.

Thus, although it may be said that all computer programming involves technical considerations since it is concerned with defining a method which can be carried out by a machine, that in itself is not enough to demonstrate that the program which results from the programming has technical character; the programmer must have had technical considerations beyond "merely" finding a computer algorithm to carry out some procedure (**G 3/08**, point 13.5 of the Reasons; see also **T 1358/09**).

In **T 914/02** the involvement of technical considerations, however, was **not sufficient** for a method, which might exclusively be carried out mentally, to have technical character.

In fact, other non-inventions listed in Art. 52(2) EPC 1973, such as scientific theories, but also computer programs, typically involved technical considerations. Technical character could be provided through the technical implementation of the method, resulting in the method providing a **tangible, technical effect**, such as the provision of a physical entity as the resulting product, or a non-abstract activity, such as through the use of technical means. The board rejected a claim directed to an invention involving technical considerations and encompassing technical embodiments (point 3 of the Reasons) on the grounds that the invention as claimed could also be exclusively performed by purely mental acts excluded from patentability under Art. 52(2)(c) EPC 1973.

In **T 619/02** (OJ 2007, 63) the board stated that the prerequisite of technical character inherent to the EPC cannot be considered to be fulfilled by an invention, as claimed, which, although possibly encompassing technical embodiments, also encompasses ways of implementing it that do not qualify as technical. It followed that an invention is susceptible of patent protection within the meaning of Art. 52(1) EPC 1973 if, and only if the invention as claimed includes aspects that impart technical character to essentially all ways of performing the invention. An analogous condition applies in fact to the exclusions from patentability under Art. 52(2) EPC 1973, as illustrated by decision **T 914/02** in which the corresponding board rejected a claim directed to an invention involving technical considerations and encompassing technical embodiments on the grounds that the invention as claimed could also be exclusively performed by purely mental acts excluded from patentability under Art. 52(2)(c) EPC (see also **T 388/04**, OJ 2007, 16, point 3 of the Reasons).

In **T 306/04** the board pointed out that **the mere possibility** of serving a technical purpose or of solving a technical problem was not sufficient to avoid exclusion under Art. 52(2) and (3) EPC 1973 (see also **T 388/04**, OJ 2007, 16; **T 1410/07**).

In **T 471/05** the fact that the claimed method encompassed non-excluded implementations did not overcome the fact that the claimed method also encompassed excluded subject-matter (**T 453/91**, **T 914/02**, points 2 and 3 of the Reasons; **T 388/04**, OJ 2007, 16; **T 930/05**). Thus, as long as the claimed design method was not confined to physical, technical implementations, the claimed subject-matter encompassed embodiments excluded from patentability under Art. 52(1) to 52(3) EPC 1973 and was not entitled to patent protection under the EPC.

#### 1.4.3 Methods involving technical means

It is established case law of the boards of appeal that claimed subject-matter specifying at least one feature not falling within the ambit of Art. 52(2) EPC is not excluded from patentability by the provisions of Art. 52(2) and (3) EPC (**G 3/08**, OJ 2011, 10; **T 258/03**, **T 424/03**, **T 1658/06**, **T 313/10**).

According to **T 258/03** (OJ 2004, 575) technical character results either from the physical features of an entity or (for a method) from the use of technical means. **T 258/03** came to the conclusion that any claim involving technical means is not excluded from patentability by Art. 52(2) EPC, and since a claim directed to a method of operating a computer

involved a computer it could not be excluded from patentability by Art. 52(2) EPC (see also **G 3/08**). The board noted that previous decisions of the boards of appeal had held that the use of technical means for carrying out a method for performing mental acts, partly or entirely without human intervention, might, having regard to Art. 52(3) EPC 1973, render such a method a technical process or method and therefore an invention within the meaning of Art. 52(1) EPC 1973 (**T 38/86**, OJ 1990, 384; **T 769/92**). However, method steps consisting of modifications to a business scheme and aimed at circumventing a technical problem rather than solving it by technical means could not contribute to the technical character of the subject-matter claimed.

The board found that the technical character is determined by the presence or use of **technical means alone**, irrespective of purpose, even if that purpose is purely non-technical. This finding was irrespective of whether or not it can be associated with a technical effect or serves a technical purpose or function.

The board stated that what mattered, having regard to the concept of "invention" within the meaning of Art. 52(1) EPC 1973, was the presence of **technical character** which could be inferred from the physical features of an entity or the nature of an activity, or could be conferred on a non-technical activity by the use of technical means. In particular, the board held that the latter could not be considered to be a non-invention "as such" within the meaning of Art. 52(2) and (3) EPC 1973. Hence, in the board's view, activities falling within the concept of a non-invention "as such" would typically represent purely abstract concepts devoid of any technical implications. The board stated that its comparatively broad interpretation of the term "invention" in Art. 52(1) EPC 1973 would include activities which are so familiar that their technical character tends to be overlooked, such as the act of writing using pen and paper. However, this did not imply that all methods involving the use of technical means were patentable. They still have to be new, represent a non-obvious technical solution to a technical problem, and be susceptible of industrial application. The consequence was that, with regard to methods, **T 931/95** (OJ 2001, 441) was explicitly overturned by **T 258/03** (point 1 of the Headnote). In decision **T 931/95** the board had stated that **using technical means** for a purely non-technical purpose and/or for processing purely non-technical information **did not necessarily** confer technical character on any such individual steps of use or on the method as a whole. The mere occurrence of technical features in a claim did not turn the subject-matter of the claim into an invention within the meaning of Art. 52(1) EPC 1973.

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

#### 1.4.4 Methods used in a technical process carried out on a physical entity

In accordance with the established case law if a method which is not per se "technical" e.g. a mathematical method, is used in a technical process, and this process is carried out on a physical entity by some technical means implementing the method and provides



as its result a change in that entity, it contributes to the technical character of the invention as a whole (**T 1814/07**).

Any claimed subject-matter defining or using technical means is an invention within the meaning of Art. 52(1) EPC (see **T 424/03** and **T 258/03**, and confirmed in **G 3/08**). Therefore the mere inclusion of a computer, a computer network, a readable medium carrying a program, etc. in a claim lends technical character to the claimed subject-matter.

Features of the computer program itself (see **T 1173/97**) as well as the presence of a device defined in the claim may potentially lend technical character to the claimed subject-matter (see **T 769/92**, OJ 1995, 525; **T 424/03** and **T 258/03**).

#### 1.4.5 Apparatus constituting a physical entity or concrete product

An apparatus for carrying out an activity excluded as such from patentability by Art. 52(2) and (3) EPC is not itself excluded from patentability. In particular, a claim directed to a computer loaded with a program is not excluded from patentability by Art. 52(2) EPC even if the program itself would be, i.e. if the program causes no "further technical effect" when run (**T 931/95**, OJ 2001, 441; see also **G 3/08**, OJ 2011, 10).

In **T 931/95** (OJ 2001, 441) the board held that an apparatus constituting a physical entity or concrete product, suitable for performing or supporting an economic activity, was an invention within the meaning of Art. 52(1) EPC 1973. The board found that a computer system suitably programmed for use in a particular field, even if that was the field of business and economy, had the character of a concrete apparatus in the sense of a physical entity, man-made for a utilitarian purpose and was thus an invention within the meaning of Art. 52(1) EPC 1973. This distinction with regard to patentability between a method for doing business and an apparatus suited to perform such a method was justified in the light of the wording of Art. 52(2)(c) EPC 1973, according to which "schemes, rules and methods" were non-patentable categories in the field of economy and business, but the category of "apparatus" in the sense of "physical entity" or "product" was not mentioned in Art. 52(2) EPC 1973. This meant that, if a claim was directed to such an entity, the formal category of such a claim did in fact imply physical features of the claimed subject-matter which could qualify as technical features of the invention concerned and thus be relevant for its patentability. An apparatus constituting a physical entity or concrete product suitable for performing or supporting an economic activity, was an invention within the meaning of Art. 52(1) EPC 1973.

In **T 258/03** (OJ 2004, 575) the board was not convinced that the wording of Art. 52(2)(c) EPC 1973, according to which "schemes, rules and methods for performing mental acts, playing games or doing business" shall not be regarded as inventions within the meaning of Art. 52(1) EPC 1973, imposed a different treatment of claims directed to activities and claims directed to entities for carrying out these activities. What matters having regard to the concept of "invention" within the meaning of Art. 52(1) EPC 1973 is the presence of technical character which may be implied by the physical features of an entity or the nature of an activity, or may be conferred on a non-technical activity by the

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

In **T 2258/10** of 4 October 2011 the board found that any apparatus constituting a physical entity or concrete product has technical character. A cooking vessel clearly falls within this definition, and thus per se has technical character.

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

### 2.1. Introduction

"European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application." Art. 52(1) EPC expresses the fundamental maxim of the general entitlement to patent protection for any inventions in all technical fields. Any **limitation** to the general entitlement to patent protection is thus not a matter of judicial discretion, but must have a clear legal basis in the EPC (cf. **T 154/04**, OJ 2008, 46; see also **G 2/12**, OJ 2016, A28).

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

The term "invention" is to be construed as "subject-matter having technical character" (**T 931/95**, OJ 2001, 441; **T 619/02**, OJ 2007, 63; **T 258/03**, OJ 2004, 575). According to **T 930/05**, the mere fact that the list of items not to be regarded as inventions in accordance with Art. 52(2) EPC 1973 was non-exhaustive, ("in particular"), indicated that there was a common criterion for exclusion which these items shared and which could serve as the basis for possible additions to the list. The enumeration of typical non-inventions in Art. 52(2) EPC 1973 covered subjects whose common feature was a lack of technical character. The catalogue of exclusions under Art. 52(2) EPC 1973, with its reference to Art. 52(1) EPC 1973, was to be regarded as a negative definition of the concept of invention.

The verification that claimed subject-matter is an invention within the meaning of Art. 52(1) EPC 1973 is in principle a **prerequisite** for the examination with respect to novelty, inventive step and industrial application since these latter requirements are defined only for inventions (cf. Art. 54(1), 56, and 57 EPC 1973) (see **T 258/03**, OJ 2004, 575; see also **T 154/04**, OJ 2008, 46).

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

The case law clearly shows that this list of "excluded" subject-matter should not be given too broad a scope of application; Art. 52(3) EPC is a bar to a broad interpretation of Art. 52(2) EPC (**G 2/12** and **G 2/13**, OJ 2016, A28 and A29; **T 154/04**).

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

Further, the board held that "technical character" was an implicit requisite of an "invention" within the meaning of Art. 52(1) EPC 1973 (requirement of "technicality"). Art. 52(2) EPC 1973 **did not exclude from patentability** any subject matter or activity having technical character, even if linked to items listed in this provision since these items are **only excluded "as such"** (Art. 52(3) EPC 1973). In examining the patentability of an invention in respect of a claim, the claim had to be construed to determine the technical features of the invention, i.e. the features which contribute to the technical character of the invention. These principles had indeed a clear and consistent basis in the EPC and in the case law of the boards of appeal and the Enlarged Board of Appeal, in particular (see also **G 3/08**, OJ 2011, 10; **T 931/95**, OJ 2001, 441; **T 914/02**; **T 2383/10**).

For further information on the technical character of the invention, see in this chapter I.A.1.1 "Technical character of an invention".

The issue of inventions with technical and non-technical subject-matter of an invention (mixed inventions) is analysed in detail in sub-chapter "Treatment of technical and non-technical features", within the Chapter I.D.9 "Assessment of inventive step".

## 2.2. Discoveries, scientific theories and mathematical methods

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

### 2.2.1 Discoveries and scientific theories

If a new property of a known material or article is found out, that is mere discovery and unpatentable because discovery as such has no technical effect and is therefore not an invention within the meaning of Art. 52(1) EPC. If, however, that property is put to practical use, then this constitutes an invention which may be patentable. To find a previously unrecognised substance occurring in nature is also mere discovery and therefore unpatentable. However, if a substance found in nature can be shown to produce a technical effect, it may be patentable. In addition, if a microorganism is discovered to exist in nature and to produce an antibiotic, the microorganism itself may also be patentable as one aspect of the invention. Similarly, a gene which is discovered to exist in nature may be patentable if a technical effect is revealed, e.g. its use in making a certain polypeptide or in gene therapy (Guidelines G-II, 3.1 – November 2015 version).

It was recognised in **T 208/84** (OJ 1987, 14) that the fact that the idea or concept underlying the claimed subject-matter resides in a discovery does not necessarily mean that the claimed subject-matter is a discovery "as such" (**G 2/88**, OJ 1990, 93).

In **T 1538/05** the board noted that, speaking very generally, an invention must be of a technical character and must solve a technical problem with - at least partially - technical means. It found that the claims at issue related to the discovery of a scientific theory rather than a technical teaching. The appellant claimed to have discovered a magnetic force that was hitherto unknown, and as a consequence thereof, established that theories such as the Heisenberg uncertainty principle as well as Einstein's theory of relativity were wrong. These were scientific theories or discoveries of the laws of nature different from those established. The board was in no position to determine whether these physical theories and discoveries were correct or not. Neither the claims, nor the description gave any indication of a clear technical teaching. It was clear to the board that the subject-matter claimed by the appellant was not patentable, as the appellant had not demonstrated that they were of a technical nature and that the invention could be applied to processes or devices.

### 2.2.2 Mathematical methods

Purely abstract or intellectual methods are not patentable. For instance, a mathematical method for designing electrical filters is not patentable; nevertheless filters designed according to this method would not be excluded from patentability by Art. 52(2) and Art. 52(3) EPC. Furthermore, a method of encrypting/decrypting or signing electronic

communications may be regarded as a technical method, even if it is essentially based on a mathematical method (see **T 1326/06**) (Guidelines G-II, 3.3 – November 2015 version).

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" (**T 208/84**, OJ 1987, 14; **G 2/88**, OJ 1990, 93).

The case law of the boards of appeal has established that, if a method which is not per se "technical" e.g. a mathematical method, is used in a technical process, and this process is carried out on a physical entity by some technical means implementing the method and provides as its result a change in that entity, it contributes to the technical character of the invention as a whole. Thus this feature must be taken into account when assessing inventive step (**T 208/84**, OJ 1987, 14; **T 641/00**, **T 258/03**, **T 1814/07**, OJ 2003, 352).

In **T 208/84** (OJ 1987, 14) the method Claims 1-7 and 12 were directed to methods for digitally processing images. One basic issue to be decided was whether or not such a method was excluded from patentability under Art. 52(2) and (3) EPC 1973 on the ground that it was a mathematical method as such. The board noted that there could be little doubt that any processing operation on an electric signal can be described in mathematical terms. The characteristic of a filter, for example, can be expressed in terms of a mathematical formula. A basic difference between a mathematical method and a technical process can be seen, however, in the fact that a mathematical method or a mathematical algorithm is carried out on numbers (whatever these numbers may represent) and also provides a result also in numerical form, the mathematical method or algorithm being only an abstract concept prescribing how to operate on the numbers. No direct technical result is produced by the method as such. In contrast, if a mathematical method is used in a technical process, that process is carried out on a physical entity (which may be a material object but equally an image stored as an electric signal) by some technical means implementing the method and provides as its result a certain change in that entity. The technical means might include a computer comprising suitable hardware or an appropriately programmed general purpose computer. The board was, therefore, of the opinion that, even if the idea underlying an invention may be considered to reside in a mathematical method, a claim directed to a technical process in which the method is used does not seek protection for the mathematical method as such. In contrast, a "method for digitally filtering data" remains an abstract notion not distinguished from a mathematical method as long as it is not specified what physical entity was represented by the data and it forms the subject of a technical process, i.e. a process which is susceptible of industrial application (see also **T 1161/04**, **T 212/94**).

In **T 953/94**, claim 1 of the main request related to a method of generating with a digital computer a data analysis of the cyclical behaviour of a curve represented by a plurality of plots relating two parameters to one another (use of mathematical method in physical process). The board held that such a method could not be regarded as a patentable invention, because an analysis of the cyclical behaviour of a curve was clearly a

mathematical method excluded as such from patentability. The reference to a digital computer only had the effect of indicating that the claimed method was carried out with the aid of a computer, i.e. a programmable general-purpose computer, functioning under the control of a program excluded as such from patentability. The fact that the description disclosed examples in both non-technical and technical fields was confirmation that the problem solved by the claimed mathematical method was independent of any field of application and could thus lie, in the case at issue, only in the mathematical and not in a technical field.

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

In **T 1326/06** the board took the view that processes for encoding/decoding or signing electronic communications by RSA had to be regarded as technical processes, even if they were based essentially on mathematical processes (see also decisions **T 953/04**, point 3.3 of the Reasons and **T 27/97**, point 3 of the Reasons).

In **T 1784/06** (point 3.1.1 of the Reasons) the board stated that the algorithm is a mathematical (inter alia Boolean) method and mathematical methods as such are deemed to be non-inventions (Art. 52(2) and (3) EPC). A technical character of the algorithm could be recognised only if it served a technical purpose (see e.g. **T 1227/05**, point 3.1 of the Reasons, OJ 2007, 574) (see also **T 306/10**).

### 2.3. Aesthetic creations

An aesthetic creation relates by definition to an article (e.g. a painting or sculpture) having aspects which are other than technical and the appreciation of which is essentially subjective. The aesthetic effect itself is not patentable, neither in a product nor a process claim. Nevertheless, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not patentable, the means of obtaining it may be (Guidelines G-II, 3.4 - November 2015 version).

In **T 686/90** the board was called upon to decide whether the feature "work of art in the style of stained glass" meant that it was excluded from patentability under Art. 52(2)(b) EPC 1973. The board held that functional information referring to general aesthetic creations did not define an aesthetic creation as such, at least provided that and insofar as such information adequately identified technical features of the subject-matter of the claim. Since an aesthetic creation (not formally specified) as the stated purpose, together with the other features, adequately defined a technical subject-matter

in the claim, there was no aesthetic creation as such. For this reason there could be no objection to the claim under Art. 52(2)(b) EPC 1973 on the basis of Art. 52(3) EPC 1973.

In decision **T 119/88** (OJ 1990, 395) the subject-matter of the application in question related to a flexible disk jacket made of a plastic sheet presenting to the outside world a surface colour of a certain minimum light intensity. The board first of all stated that the feature of having a specific colour as such did not constitute a technical feature indicating that an object or device was entirely or partly covered by that colour; however, the board did not rule out the possibility that this did not hold in all circumstances. The feature taken by itself might not seem to reveal any technical aspect, but its technical or non-technical character could be decided by **the effect it brought about after being added to an object** which did not comprise the feature before (see e.g. **T 336/14**). In considering whether the subject-matter of a claim is excluded from patentability under Art. 52(2) and (3) EPC 1973, i.e. whether it is non-technical or technical, that claim has to be considered in its entirety. This is in line with decisions **T 38/86** and **T 65/86**, in which Art. 52(3) EPC 1973 was interpreted to mean that the subject-matter of a claim is not excluded from patentability under Art. 52(2)(c) EPC 1973 if the said subject-matter contributes anything to the prior art in a field that is not excluded from patentability. In these decisions this interpretation was only applied with regard to Art. 52(2)(c) EPC 1973. However, once applied to Art. 52(2)(c) EPC 1973 it must hold for all the paragraphs of Art. 52(2) EPC 1973, since Art. 52(3) EPC 1973 refers to all the items summed up in Art. 52(2) EPC 1973. The board stated that it had to be investigated whether the effects implied by the sole feature of possessing a specific colour, could make that feature into a feature not excluded from patentability the known object or device provided with that colour. The board concluded that the alleged resistance to fingerprints was a purely aesthetic effect which contributed nothing technical to the invention concerned (Art. 52(2)(b) EPC 1973) and the advantage of easy classification by colour represented a non-technical effect in the form of a presentation of information. As such it was excluded from patentability under Art. 52(2)(d) and (3) EPC 1973 (see also **T 962/91**).

In **T 617/11** the appellant I (opponent I) considered that there was no objective technical problem to be solved since the alleged obtained effects related to aesthetic effects. It argued that features could not be regarded as technical and justify patentability if their effects related to the subjective senses of the viewer (**T 119/88**, OJ 1990, 395) and concluded that, since all the features of claim 1 related to non-technical effects of colours and shapes, the claimed container could not be regarded as a patentable invention (Art. 52(2)(b) and (d) EPC). The board noted that the case law of the boards of appeal in relation to the technicality of inventions and the exclusions from patentability as provided in Art. 52(2) EPC was summarised in **T 154/04** (OJ 2008, 46) for inventions which have a mix of technical and non-technical features. The fact that the non-technical features provide the only contribution over the known prior art and thus lead to the conclusion of non-patentability under Art. 52(2) EPC, as held in **T 119/88** (supra), had clearly been overruled by the large body of jurisprudence on this issue, as summarised in **T 154/04** and established by the decisions citing **T 154/04** for this aspect. Hence, the board could not find fault with the reasoning and the findings of the opposition division.

For more information on the inventive-step analysis in connection with features relating to subject-matter excluded under Art. 52(2) EPC, see Chapter I.D.9.1.2 "Inventions having both technical and non-technical features".

## 2.4. Computer-implemented inventions

### 2.4.1 Introduction

Inventions involving programs for computers can be protected in different forms of a "computer-implemented invention", an expression intended to cover claims which involve computers, computer networks or other programmable apparatus whereby prima facie one or more of the features of the claimed invention are realised by means of a program or programs. Such claims directed at computer-implemented inventions may e.g. take the form of a method of operating said apparatus, the apparatus set up to execute the method, or, following **T 1173/97** (OJ 1999, 609), the computer program itself as well as the physical media carrying the program (see **T 424/03**), i.e. computer program product claims, such as "data carrier", "storage medium", "computer readable medium" or "signal" (Guidelines G-II, 3.6 – November 2015 version).

Art. 52(2)(c) EPC states that programs for computers shall not be regarded as inventions within the meaning of Art. 52(1) EPC and are therefore excluded from patentability.

Art. 52(3) EPC establishes an important limitation to the scope of this exclusion. According to this provision, the exclusion applies only to the extent to which a European patent application or a European patent relates to programs for computers "as such". In **T 935/97** the board stated that the combination of the two provisions (Art. 52(2) and (3) EPC 1973) demonstrates that the legislators did not want to exclude from patentability all programs for computers. In other words the fact that only patent applications relating to programs for computers as such are excluded from patentability means that patentability may be allowed for patent applications relating to programs for computers where the latter are not considered to be programs for computers as such.

According to the early case law of the boards of appeal, the view was taken on a number of occasions that exclusion under Art. 52(2)(c) and (3) EPC 1973 applied to all computer programs, independently of their contents, that is, independently of what the program could do or perform when loaded into an appropriate computer (see **T 1173/97**; OJ 1999, 609). To make a distinction between programs with a technical character and those with a non-technical character would not be allowed under such reasoning. Some examples of such reasoning could be found for instance in decisions **T 26/86** (OJ 1988, 19, point 3.1 of the Reasons), **T 110/90** (OJ 1994, 557, point 5 of the Reasons), and **T 204/93** (point 3.13 of the Reasons). For example, in **T 204/93**, the board held that computer programs as such, independent of their application, were not patentable irrespective of their content, even if that content happened to be such as to make it useful, when run, for controlling a technical process. The board ruled that, "similarly", a programmer's activity of programming was, "as a mental act", not patentable, irrespective of whether the resulting program could be used to control a technical process, and that automating that activity in a way which did not involve any unconventional means did not render that



programming method patentable either, independently of the content of the resulting program.

#### 2.4.2 Patentability of computer programs

In **T 1173/97** (OJ 1999, 609) (see also **T 935/97**) the board stated that within the context of the application of the EPC the technical character of an invention is generally accepted as an essential requirement for its patentability. This is illustrated, for instance, by R. 27 and 29 EPC 1973. The exclusion from patentability of programs for computers as such (Art. 52(2) and (3) EPC 1973) may be construed to mean that such programs are considered to be mere abstract creations, lacking in technical character. The use of the expression "shall not be regarded as inventions" seems to confirm this interpretation. This means that programs for computers must be considered as patentable inventions when they have a technical character.

Further, Art. 27(1) TRIPS provides that "patents shall be available for any inventions, whether **products or processes**, in all fields of technology". The board went on to state that it was the clear intention of TRIPS not to exclude from patentability any inventions, whatever field of technology they belong to, and therefore, in particular, not to exclude programs for computers as mentioned in and excluded under Art. 52(2)(c) EPC 1973. Thus, the board of appeal decided that the practice of the EPO under Art. 52(2) and (3) EPC 1973 should be changed in certain respects in relation to claims to computer programs. In these decisions it was held that the exclusion of computer programs "as such" did not encompass all programs for computers. The board held that a computer program product is not excluded from patentability under Art. 52(2) and (3) EPC 1973 if the program, when running on a computer or loaded into a computer, brings about, or is capable of bringing about, a technical effect which goes beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run.

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

result of not being considered programs for computers as such, were open to patentability.

#### 2.4.3 Programs for computers and technical character

##### a) Further effects of programs for computers

In **T 1173/97** (OJ 1999, 609) and **T 935/97** the board found that a computer program must be considered to be patentable when it has technical character. For the purpose of interpreting the exclusion from patentability of programs for computers under Art. 52(2) and (3) EPC 1973, the board assumed that **programs for computers** could not be considered as having a technical character for the very reason that they are programs for computers. This means that physical modifications of the hardware (causing, for instance, electrical currents) deriving from the execution of the instructions given by programs for computers cannot per se constitute the technical character required for avoiding the exclusion of those programs. Although such modifications may be considered to be technical, they are a common feature of all those programs for computers which have been made suitable for being run on a computer, and therefore cannot be used to distinguish programs for computers with a technical character from programs for computers as such. It was thus necessary to look elsewhere for technical character in the above sense: It could be found in the **further effects** deriving from the execution (by the hardware) of the instructions given by the computer program. The board stated that every computer program product produced an effect when the program concerned was made to run on a computer. The effect only showed in physical reality when the program was being run. Thus the computer program product itself did not directly disclose the said effect in physical reality. It only disclosed the effect when being run and consequently only possessed the "potential" to produce said effect. This effect might also be technical in the sense explained in reason 6 of the decision, in which case it constituted the "further technical effect" mentioned there. This meant that a computer program product might possess the potential to produce a "further" technical effect.

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

The board concluded that on condition they were able to produce a technical effect in the above sense, all computer programs had to be considered as inventions within the meaning of Art. 52(1) EPC 1973, and might be the subject-matter of a patent if the other requirements provided for by the EPC were satisfied.

## b) Technical effect on a physical entity

The President of the EPO referred the following point of law to the Enlarged Board of Appeal (**G 3/08**, OJ 2011, 10; Question 3(a) of the referral): must a claimed feature cause a **technical effect on a physical entity** in the real world in order to contribute to the technical character of the claim? It was noted in the referral that according to decisions **T 163/85** and **T 190/94**, a technical effect **on a physical entity** in the **real world** was required. This was, however, not the case in **T 125/01** and **T 424/03**. In these decisions the technical effects were essentially confined to the respective computer programs.

The Enlarged Board of Appeal stated in Opinion **G 3/08** (OJ 2011, 10) that the case law of the boards of appeal as a whole is consistent in considering all the features that are claimed. The boards have always avoided approaches which involve weighting of features or a decision which features define the "essence" of the invention. It is true that the COMVIK/Hitachi (**T 641/00**, **T 258/03**) approach to deciding whether there is an inventive step may involve ignoring some features, but the method starts with a consideration of all the features together to determine whether the claimed subject-matter has a technical character. Only once this determination has been made can the board turn to the question of which claimed features contribute to that technical character and therefore should be taken into account for the assessment of whether there is an inventive step (see also **T 528/07**).

The Enlarged Board of Appeal went on and stated that it is in fact a well-established principle that features which would, taken in isolation, belong to the matters excluded from patentability by Art. 52(2) EPC may nonetheless contribute to the technical character of a claimed invention, and therefore cannot be discarded in the consideration of the inventive step. This principle was already laid down, albeit in the context of the so-called "contribution approach", in one of the earliest decisions of the boards of appeal to deal with Art. 52(2) EPC, namely **T 208/84**.

The second problem with the alleged divergence was that the decisions **T 163/85** and **T 190/94** said in the referral to require a technical effect on a physical entity in the real world, simply did not do so. They merely accepted this as something sufficient for avoiding exclusion from patentability; they did not state that it was necessary. The referral did not identify any passages requiring such an effect and the Enlarged Board could not find any. Thus there was no divergence. The other two decisions cited considered that there were technical effects; whether the boards concerned considered that these technical effects were on a physical entity in the real world was irrelevant. This question was therefore found inadmissible.

## c) Technical considerations: programming a computer

It is not specified in the EPC whether, or under which circumstances, the activity associated with creating programs for computers, i.e. programming a computer, is a technical activity which is in principle patentable, or a non-technical activity which is as such excluded from patentability.

The President of the EPO referred to the Enlarged Board of Appeal the following point of law (see **G 3/08**, Question 4 of the referral): Does the activity of programming a computer necessarily involve technical considerations? The President of the EPO cited decision **T 1177/97**, where the board found that "implementing a function on a computer system always involves, at least implicitly, technical considerations". The reference to 'computer routines' made it clear that this implementation consisted of programming the computer (see also **T 172/03**). Contrary to these decisions **T 833/91**, **T 204/93** and **T 769/92** (OJ 1995, 525) considered programming to be a mental act of the programmer.

In Opinion **G 3/08** (OJ 2011, 10) the Enlarged Board of Appeal considered that the referral asserted correctly that **T 1177/97** considered that programming always involved technical considerations, at least implicitly, and that **T 172/03** assumed the same in that it considered the skilled person, who, it was emphasised, was a technical expert, to be a software project team, consisting of programmers. On the other hand, **T 833/91**, **T 769/92** (OJ 1995, 525) and **T 204/93**, were said to consider the programmer's activity, programming, to be a mental act, falling within the exclusions of Art. 52(2) EPC.

The Enlarged Board stated that there was no contradiction between these positions, as may be seen by considering the same case in a non-controversial field, for example bicycle design. Designing a bicycle clearly involves technical considerations (it may also involve non-technical, e.g. aesthetic, considerations), but it is a process which at least initially can take place in the designer's mind, i.e. it can be a mental act and to the extent that it is a mental act would be excluded from patentability (cf. also **T 833/91**, **T 769/92**, **T 204/93**, **T 914/02** and **T 471/05**). Hence the question did not satisfy the requirement for a divergence in the case law and was therefore inadmissible.

While the referral did not actually identify a divergence in the case law, the Enlarged Board of Appeal considered that there was at least the potential for confusion, arising from the assumption that **any technical considerations** were sufficient to confer technical character on claimed subject-matter, a position which was apparently adopted in some cases (e.g. **T 769/92**). **T 769/92** (OJ 1995, 525) was an example of an invention which concerned the internal functioning of a computer caused by the programs running on it. According to this decision the fact that technical considerations were required in order to arrive at the invention was considered to lend sufficient technical character to the invention as claimed for it to avoid exclusion from patentability under Art. 52(2)(c) and (3) EPC 1973, whereas no importance was attributed to the specific use of the system as a whole.

However, **T 1173/97** set the barrier higher in the case of computer programs. It argued that all computer programs have **technical effects**, since for example when different programs are executed they cause different electrical currents to circulate in the computer they run on. However such technical effects are **not sufficient to confer "technical character"** on the programs; they must cause **further technical effects**. In the same way, it seemed to this board, that although it may be said that all computer programming involves technical considerations since it is concerned with defining a method which can be carried out by a machine, that in itself is not enough to demonstrate that the program which results from the programming has technical

character; the programmer must have had technical considerations beyond "merely" finding a computer algorithm to carry out some procedure.

The board in **T 1173/97** concentrated on the effect of carrying out an algorithm on a computer, noting that there were always technical effects, which led the board, since it recognised the position held by the framers of the EPC, to formulate its requirement for a "further" technical effect. Only if a computer program, when run, produced **further technical effects**, was the program to be considered to have a technical character. In the same way, it would appear that the fact that fundamentally the formulation of every computer program requires technical considerations in the sense that the programmer has to construct a procedure that a machine can carry out, is not enough to guarantee that the program has a technical character (or that it constitutes "technical means" as that expression is used in e.g. **T 258/03**). By analogy one would say that this is only guaranteed if writing the program requires "further technical considerations".

In **T 598/14** the application related to a method for generating, from an input set of documents, a word replaceability matrix defining semantic similarity between words occurring in the input document set. The board considered that the translation, with the aim of enabling the linguistic analysis to be done automatically by a computer, could be seen as involving, at least implicitly, technical considerations. This was also in line with decision **T 1177/97** or opinion **G 3/08** (OJ 2011, 10). However, according to **G 3/08**, point 13.5 of the Reasons, this is not enough to guarantee the technical character of subject-matter otherwise excluded from patentability under Art. 52(2) and (3) EPC. The technical character would have to be established on the basis that those considerations constituted "further technical considerations". The board concluded that the subject-matter of independent claim 1 lacked an inventive step (Art. 52(1) EPC and 56 EPC).

d) Technical considerations: implementation of a function on a computer system

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

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

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

Decision **T 115/85** (OJ 1990, 30) concerned a method for displaying one of a set of predetermined messages comprising a phrase made up of a number of words, each message indicating a specific event which might occur in the input-output device of a word processing system which also included a keyboard, a display and a memory. The board observed that automatically giving visual indications of conditions prevailing in an apparatus or a system was basically a technical problem. The application proposed a solution to this technical problem involving the use of a computer program and certain tables stored in a memory. It adopted the principle laid down in decision **T 208/84**: an invention which would be patentable in accordance with conventional patentability criteria should not be excluded from protection by the mere fact that for its implementation modern technical means in the form of a computer program are used. However, it did not follow from this that conversely a computer program could under all circumstances be considered as constituting technical means. In the case in question the subject-matter of the claim, phrased in functional terms, was not barred from protection by Art. 52(2)(c) and (3) EPC 1973 (see also **T 790/92**).

e) Methods performed by a computer

In **T 258/03** (OJ 2004, 575) the board held that a method involving technical means is an invention within the meaning of Art. 52(1) EPC 1973 (as distinguished from decision **T 931/95**, OJ 2001, 441). Thus with regard to methods, decision **T 931/95** was explicitly overturned by **T 258/03**. If the claimed method requires the use of a computer, it has technical character and constituted an invention within the meaning of Art. 52(1) EPC (see **T 258/03**, **T 1351/04**, **T 313/10**). Since a claim directed to a method of operating a computer involved a computer it could not be excluded from patentability by Art. 52(2) EPC (**G 3/08**, OJ 2011, 10).

In **T 313/10** the examining division had argued, using their own criteria, that a method performed by a computer was excluded. The first issue in this case was whether the claimed method, performed by a computer, of matching items in a table is excluded from patentability (Art. 52(2) and (3) EPC). The board stated that it is the established case law

of the boards of appeal that claimed subject-matter specifying **at least one feature** not falling within the ambit of Art. 52(2) EPC is not excluded from patentability by the provisions of Art. 52(2) and (3) EPC (see **G 3/08**, OJ 2011, 10; **T 258/03** and **T 424/03**).

The board noted that the technical character might come from within, namely from the effect on the computer. This was the case, for example in **T 424/03** where the technical effect came from "functional data structures (clipboard formats) used independently of any cognitive content...in order to enhance the internal operation of a computer system". Such "functional data structures" were also considered to be present in the file search method that was the subject of **T 1351/04**.

f) Computer-implemented simulation methods

In **T 1227/05** (OJ 2007, 574) the application related to a computer-implemented method with mathematical steps for simulating the performance of a circuit subject to  $1/f$  noise. The board noted that while the invention may be preceded by a mental or mathematical act, the claimed result must not be equated with this act. The claims related to a simulation method that could not be performed by purely mental or mathematical means, not to the thought process that led to that simulation method. The board was persuaded that the claimed simulation of a circuit constituted neither a mathematical method as such nor a computer program as such, even if mathematical formulae and computer instructions were used to perform the simulation. The board noted that simulation performed technical functions typical of modern engineering work. It provided for realistic prediction of the performance of a designed circuit and thereby ideally allowed it to be developed so accurately that a prototype's chances of success could be assessed before it was built. The technical significance of this result increased with the speed of the simulation method, as this enabled a wide range of designs to be virtually tested and examined for suitability before the expensive circuit fabrication process started. Without technical support, advance testing of a complex circuit and/or qualified selection from many designs would not be possible, or at least not in reasonable time. Thus computer-implemented simulation methods for virtual trials were a practical and practice-oriented part of the electrical engineer's toolkit. What made them so important was that as a rule there was no purely mathematical, theoretical or mental method that would provide complete and/or fast prediction of circuit performance under noise influences.

As regards the potential exclusion of computer programs, the board stood by its earlier ruling that this exclusion did not apply to computer-implemented methods, see **T 424/03**. For the above reasons, in the board's view, all steps relevant to circuit simulation - and that included the mathematically expressed claim features - contributed to the technical character of the simulation method.

In this context the board noted that the above conclusion could not be drawn from the mere observation that a claimed method runs faster than a "conceivable" reference method. As it was always possible to conceive of a slower reference method, a mere speed comparison was not a suitable criterion for distinguishing between technical and non-technical procedural steps (see also **T 1954/08**). If, for example, a sequence of auction steps led to price determination more quickly than some other auction method,

that did not necessarily imply that the auction steps contribute to the technical character of the method (see **T 258/03**).

The board concluded that, as the method according to independent claim 1 or 2 was computer-implemented, it used technical means and by that very token had technical character (see **T 258/03**, OJ 2004, 575 and **T 914/02**). The board was persuaded that simulation of a circuit subject to 1/f noise constituted an adequately defined technical purpose for a computer-implemented method, provided that the method was **functionally limited** to that technical purpose. Specific technical applications for **computer-implemented simulation methods** were themselves to be regarded as modern technical methods which formed an essential part of the fabrication process and preceded actual production, mostly as an intermediate step. In that light, such simulation methods could not be denied a technical effect merely on the grounds that they did not yet incorporate the physical end product.

Finally, the computer program according to claim 4 (data medium holding a computer program) had the potential for a technical effect going beyond basic hardware/software interaction in a standard computer. Loaded onto a computer it provides for automatic simulation and evaluation of noise-affected circuits. The computer program thus does not come under the program exclusion (see **T 1173/97**, OJ 1999, 609, point 6.5 of the Reasons).

In **T 953/94**, the board found allowable a method of controlling a "physical" process using a mathematical model. However, a reference to an unspecified "physical process" might, according to more recent jurisprudence, be rejected as a "meta-specification" (see e.g. **T 1227/05**, OJ 2007, 574; **T 1147/05**; **T 1029/06**).

In **T 1265/09** the board noted that it followed from **T 1227/05** that steps relevant to a simulation of a technical item contribute to the technical character of the simulation method only if certain conditions, as cited above, are met. Leaving aside the question of whether these conditions were indeed sufficient to contribute to a technical character, the board noted that, in any case, these conditions were not met in the case at issue, since, in connection with the call handling simulation referred to in claim 1, the telephone call center and, in particular, its performance, were not further specified in the claim and, further, the claimed method did not define the further steps which actually resulted in the stated purpose, i.e. the call handling simulation.

In **T 531/09** the board noted that definition of technical processes seemed to exclude **simulations**, whose very purpose is to replace physical entities by virtual ones. In decision **T 208/84** the board had held (at point 5 of the Reasons) that a technical process is different from a mathematical method in that the technical process is carried out on a physical entity and provides, as its result, a certain change in that entity. **T 1227/05** went beyond the earlier decision in holding that the simulation of an adequately defined class of technical items could be a functional technical feature. In **T 1265/09**, referring to **T 1227/05**, the board left open the question whether it is a sufficient condition for a simulation to be patentable that the simulated items be technical, noting that the simulated system (in that case, call handling in a telephone call center) was not



technical, so that the condition did not hold. The present board found itself in a similar situation. It came to the conclusion that the condition was not fulfilled in the case at issue. Simulation of a checkpoint is not inherently technical. The board saw claim 1 according to the main request as defining a simulation, on a computer, of a non-technical process, which happens to include some technical devices, and considered that the only feature that made a contribution to inventive step was the fact that the simulation is performed on a computer.

#### 2.4.4 Claims on computer programs

##### a) Computer program recorded on the medium

After the abandonment of the contribution approach, the boards of appeal finally dealt with the question whether a claim to a program on a computer-readable medium avoided exclusion in **T 424/03**. **T 424/03** extended the reasoning applied in **T 258/03** to come to the conclusion that a claim to a program ("computer executable instructions" in the claim in question) on a computer-readable medium also necessarily avoids exclusion from patentability under Art. 52(2) EPC (see also **G 3/08**, point 10.7 of the Reasons).

**T 424/03** of 23.02.2006 concerned an application disclosing a method of providing expanded clipboard formats for transferring data between formats. The clipboard was a storage area used in the common computer commands "cut", "copy" and "paste". Claim 1 related to a method implemented in a computer system. A computer system including a memory (clipboard) was a technical means, and consequently the claimed method had technical character in accordance with established case law. Moreover, the board emphasised that **a method implemented in a computer system** represented a sequence of steps actually performed and achieving an effect, and not a sequence of computer-executable instructions (i.e. **a computer program**) which just had the potential of achieving such an effect when loaded into, and run on, a computer. The board held that the claim category of a computer-implemented method was **distinguished from** that of a computer program. Even though a method, in particular a method of operating a computer, might be put into practice with the help of a computer program, a claim relating to such a method did not claim a computer program in the category of a computer program. Hence, in the case at issue, claim 1 could not relate to a computer program as such.

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

In the same case claim 5 was directed to a computer-readable medium having "computer-executable instructions" (i.e. a computer program) on it to cause the computer

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

b) Exclusion of computer programs under Article 52(2) and (3) EPC

The President of the EPO, making use of her power under Art. 112(1)(b) EPC, made a referral to the Enlarged Board of Appeal on several points of law relating to the application of the exclusion of computer programs as such, and the limits of patentability in the field of computing. In particular, the President of the EPO referred to the Enlarged Board of Appeal the following point of law (see **G 3/08**, Question 1 of the referral), "Can a computer program only be excluded as a computer program as such if it is explicitly claimed as a computer program?"

In Opinion **G 3/08** (OJ 2011, 10), the Enlarged Board of Appeal held that a claim utilising a synonym for "computer program", such as "a sequence of computer-executable instructions" or "an executable software module" perhaps, would clearly not avoid exclusion from patentability if the equivalent claim to a computer program did not. It noted that the alleged divergence identified in the referral did not simply relate to the form of words chosen. The discussion also referred to "the function of the computer program (does the claimed program have technical character) rather than the manner in which it is claimed (e.g. as a computer program, a computer program product or a computer-implemented method)".

The Enlarged Board of Appeal noted that in **T 424/03** the board had arrived at a conclusion which clearly contradicted the position (or rather one of the positions) taken in **T 1173/97** (OJ 1999, 609). **T 1173/97** stated, "Furthermore, the board is of the opinion that with regard to the exclusions under Art. 52(2) and (3) EPC, it does not make any difference whether a computer program is claimed by itself or as a record on a carrier ...," (point 13 of the Reasons), whereas **T 424/03** stated, "The subject-matter of claim 5 has technical character since it relates to a computer-readable medium, i.e. a technical product involving a carrier" (see decision **T 258/03**, point 5.3 of the Reasons). Thus there was a difference between the positions taken in **T 1173/97** and **T 424/03** on this point. It was still however necessary to decide whether this difference constitutes a divergence allowing a question to be referred by the President on the point.

The Enlarged Board of Appeal pointed out that the referral did not identify, and they were not aware of, any decision whatsoever of one of the boards of appeal of the EPO which followed **T 1173/97** on this point (although **T 1173/97** was evidently considered decisive

in its definition of "further technical effect" and abandonment of the contribution approach to exclusion). Secondly, the conclusion arrived at in **T 424/03** had not been challenged in any later decisions; nor was it isolated but rather came as the last of a series of decisions, the logic of which was consistent and, at least to the knowledge of the members of the Enlarged Board, had also not been challenged in any later decision of a board of appeal of the EPO (national court decisions were another matter).

The Enlarged Board of Appeal came to the conclusion that the position taken in **T 424/03** that a claim to a program on a computer-readable storage medium was necessarily not excluded from patentability by the provisions of Art. 52(2) and (3) EPC 1973 was in fact a consequence of the principles laid out in **T 1173/97**. It stated that **T 424/03**, did deviate from a view expressed in **T 1173/97**, concerning whether a claim to a program on a computer-readable medium necessarily avoided exclusion from patentability under Art. 52(2) EPC 1973. However this was a legitimate development of the case law. Therefore, the Enlarged Board of Appeal decided that there was no divergence which would make the referral of this point to the Enlarged Board of Appeal by the President admissible (for further legal considerations which were taken into account in that regard, see points 5 to 7 of Opinion **G 3/08**).

In **G 3/08** (OJ 2011, 10) (Question 2 of the referral), the Enlarged Board of Appeal stated that a claim in the area of computer programs can avoid exclusion under Art. 52(2)(c) and (3) EPC merely by explicitly mentioning the use of a computer or a computer-readable storage medium. It noted however that no exposition of this position would be complete without the remark that it is also quite clear from the case law of the boards of appeal since **T 1173/97** that if a claim to program X falls under the exclusion of Art. 52(2) and (3) EPC, a claim which specifies no more than "Program X on a computer-readable storage medium," or "A method of operating a computer according to program X," will always still fail to be patentable for lack of an inventive step under Art. 52(1) and 56 EPC.

The Enlarged Board of Appeal also noted that in **T 424/03** (extending the reasoning applied in **T 258/03**) the board held that claim to a program ("computer executable instructions" in the claim in question) on a computer-readable medium also necessarily avoided exclusion from patentability under Art. 52(2) EPC. The decision in **T 424/03** went on to note that the particular program involved had the potential of achieving a **further technical effect** when run and thus also contributed to the technical character of the claimed subject-matter. The Enlarged Board of Appeal stated that this fact was, however, not necessary to the conclusion that the claimed subject-matter avoided exclusion, since according to the reasoning of **T 258/03 any technical means** claimed was **sufficient** to overcome the exclusion of Art. 52(2) EPC.

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

According to Art. 52(2)(c) EPC, schemes, rules and methods for performing mental acts, playing games or doing business are not to be regarded as inventions .

### 2.5.1 Methods for doing business

In accordance with Art. 52(2)(c) EPC, in particular methods for doing business shall not be regarded inventions within the meaning of Art. 52(1) EPC. According to Art. 52(3) EPC the patentability of such methods shall only be excluded to the extent that the application, and indeed the claimed subject-matter as this defines the matter for which protection is sought, relates to methods for doing business as such. However, where the claimed method involves technical means, it does not relate to a method for doing business as such and its patentability is therefore not excluded (see also **T 258/03**, OJ 2004, 575).

Pure business methods as such are not patentable (Art. 52(2) and (3) EPC 1973). Methods only involving economic concepts and practices of doing business are not inventions within the meaning of Art. 52(1) EPC 1973. A feature of a method which concerns the use of technical means for a purely non-technical purpose and/or for processing purely non-technical information does not necessarily confer a technical character on such a method (see e.g. **T 931/95**, OJ 2001, 441).

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

In **T 854/90** (OJ 1993, 669), a computer manufacturer applied to patent a method for operating an electronic self-service machine (e.g. cash dispenser) which could be accessed using any machine-readable card. A prospective user first had to insert such a card to enable its identification data to be stored; he then keyed in credit information about himself onto an "electronic application form", thereby permitting a decision to be taken on whether to authorise him as a user. Once authorised, he could access the system using that same card. The board ruled that this was not patentable - parts of the method claimed were merely instructions for using the machine, and although technical components were used, this did not alter the fact that what was being claimed was a method for doing business as such. The board held that a claim which, when taken as a whole, is essentially a business operation, does not have a technical character and is not a claim to a patentable invention within the meaning of Art. 52(1) EPC 1973, even though the claimed method includes steps which include a technical component. The true nature of the claimed subject-matter remains the same, even though some technical means are used to perform it.

A method of doing business is excluded from patentability even where it implies the possibility of making **use of unspecified technical means** or has practical utility (**T 388/04**).

In **T 388/04** (OJ 2007, 16) the board considered that transmitting information as specified in the claim, even if performing the transmission might involve the use of technical means, does not go beyond a business activity as such. If the contrary were true, no method for doing business that implicitly could make use of a functionality offered by technical means would be excluded from patentability, which, in the view of the board, could not be what is intended by Art. 52(2) and (3) EPC 1973. The board held that subject-matter or activities that are excluded from patentability under Art. 52(2) and (3) EPC 1973 remain so even where they imply the possibility of making use of **unspecified technical means**.

In **T 384/07** the method claimed included features corresponding to technical means for the technical implementation of the business scheme, such as a data processing terminal connected to a network of data processing terminals etc. The board held that the method did not constitute a method for doing business as such, and, therefore, was not excluded from patentability in accordance with Art. 52(2) and (3) EPC 1973.

#### 2.5.2 Methods for performing mental acts

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

In **T 471/05** the board pointed out that claim 1 merely formulated a series of mathematical and optical abstract concepts without properly requiring a physical, technical implementation. It followed that the subject-matter for which protection is sought was the mere "design" of an optical system and encompasses purely abstract and conceptual implementations excluded from patent protection pursuant to Art. 52(1), (2) and (3) EPC 1973. More particularly, the claimed method could be carried out as a purely mental act or as a purely mathematical design algorithm and, consequently, encompasses embodiments falling within the category of methods for performing mental acts as such and within the category of mathematical methods as such both expressly excluded from patent protection under Art. 52(2)(a) and (c) EPC 1973 in conjunction with Art. 52(3) EPC 1973.

The board stated that the criteria for technical character of a claimed invention discussed in decision **T 619/02** (OJ 2007, 63) implicitly presupposed that the claimed subject-matter defining the matter for which protection is sought related to a **physical entity or a physical activity**. It could not be denied that the method defined in claim 1 of the main request could be carried out using some physical means and that such implementations of the claimed method constitute physical, technical activities not excluded from patent protection (see for instance decisions **T 914/02**, and **T 258/03**, OJ 2004, 575).

Nonetheless, contrary to the appellant's contention, the claimed method **did not require the use of technical means** and the method was not restricted to physical, technical implementations, and the fact that the claimed method encompassed **non-excluded implementations** such as those mentioned above did not overcome the fact that the claimed method **also encompassed excluded subject-matter** (T 914/02, and T 388/04, OJ 2007, 16; see also T 453/91, T 930/05). Thus, as long as the claimed design method was not confined to physical, technical implementations, the claimed subject-matter encompassed embodiments excluded from patentability under Art. 52(1) to (3) EPC 1973 and was not entitled to patent protection under the EPC. The board also stated that the mere presence in the claim of such purely conceptual technical considerations did not overcome the conclusion above that the claim merely formulated a sequence of mathematical and optical concepts without properly requiring a technical or even a physical implementation. In particular, a purely mental implementation of the claimed method remains a mental act as such within the meaning of Art. 52(2) and (3) EPC 1973 even if the mental act involves conceptual technical considerations as already concluded in decision T 914/02 in which a method claim involving technical considerations and encompassing technical embodiments was refused on the grounds that the invention as claimed could still be exclusively performed by purely mental acts. In view of the above the subject-matter defined in claim 1 of the main request was excluded from patent protection under Art. 52(1), (2) and (3) EPC 1973.

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

### 2.5.3 Word-processing

In T 22/85 (OJ 1990, 12) the board had to decide on the patentability of a method for automatically abstracting and storing an input document in an information storage and retrieval system and a corresponding method for retrieving a document from the system. The board observed that the described method fell within the category of activities defined in Art. 52(2)(c) EPC 1973. It considered that the mere setting out of the sequence of steps necessary to perform the activity in terms of functions or functional means to be realised with the aid of conventional computer hardware elements did not import **any technical considerations** and could therefore neither lend a technical character to the activity nor to the claimed subject-matter considered as a whole, any more than solving a mathematical equation could be regarded as a technical activity when a conventional calculation machine is used (see also T 186/86, T 95/86).

In T 38/86 (OJ 1990, 384) the board first of all had to assess the patentability of a method for automatically detecting and replacing linguistic expressions which exceeded

a predetermined level of understanding in a list of linguistic expressions. The board was of the opinion that a person who wished to carry out such a task using his skills and judgment would perform purely mental acts within the meaning of Art. 52(2)(c) EPC 1973; the schemes, rules and methods used in performing such mental acts were not inventions within the meaning of Art. 52(1) EPC 1973. The board stated that the use of technical means for carrying out a method, partly or entirely without human intervention, which, if performed by a human being, would require him to perform mental acts, **might**, having regard to Art. 52(3) EPC 1973, render such a method a technical process or method and thus an invention within the meaning of Art. 52(1) EPC 1973. Since patentability was excluded only to the extent to which the patent application related to excluded subject-matter or activities as such, it appeared to be the intention of the EPC to permit patenting in those cases in which the invention involved a contribution to the art in a field not excluded from patentability. In the case in point this condition was not satisfied: once the **steps of the method for performing the mental acts** in question had been defined, the implementation of the technical means to be used in those steps involved no more than the straightforward application of conventional techniques and had therefore to be considered obvious to a person skilled in the art. If a claim for an apparatus (here, a word processing system) for carrying out a method did not specify any technical features beyond those already comprised in a claim pertaining to said method and furthermore did not define the apparatus in terms of its physical structure, but only in functional terms corresponding to the steps of that method, the board stated that the claimed apparatus did not contribute anything more to the art than the method, in spite of the fact that the claim was formulated in a different category. In such cases, if the method was excluded from patentability, so was the apparatus (see also **T 71/91**, **T 121/85**).

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

**T 95/86** related to an invention that involved text editing on a computer display. The board stated that the activity of editing a text is principally concerned with linguistic and layout features of a text. The method as such aims at solving a problem which is essentially of a non-technical nature. The board, therefore, found that the activity of text editing as such must be considered as falling within the category of schemes, rules and methods for performing mental acts and therefore as excluded from patentability under Art. 52(2)(c) and (3) EPC (following **T 186/86**).

## 2.6. Presentations of information

A feature relating to a presentation of information defined solely by the content of the information does not have a technical character. This applies whether the feature is claimed as a presentation of the information per se (e.g. by acoustical signals, spoken words, visual displays, books defined by their subject, gramophone records defined by the musical piece recorded, traffic signs defined by the warning thereon) or as relating to processes and apparatus for presenting information (e.g. features of indicators or recorders defined solely by the information indicated or recorded would not be technical features). A feature which relates to the manner in which cognitive content is conveyed to the user on a screen normally does not contribute to a technical solution to a technical problem. An exception would be if the arrangement or manner of presentation can be shown to have a credible technical effect (**T 1741/08**, **T 1143/06**) (Guidelines G-II, 3.7 – November 2015 version).

In **T 1194/97** (OJ 2000, 525) the board held that a record carrier characterised by having functional data recorded thereon is not a presentation of information as such and hence not excluded from patentability by Art. 52(2)(d) and (3) EPC 1973. In this context functional data includes a data structure defined in terms (here coded picture line synchronisations, line numbers, and addresses) which inherently comprise the technical features of the system (here read device plus record carrier) in which the record carrier is operative (extending **T 163/85**, OJ 1990, 379). In order to lend additional support to its view in relation to a data structure product, the board also referred to decision **T 1173/97** (OJ 1999, 609) and, in particular, to the observation made in that decision at point 9.4 of the reasons to the effect that the predetermined potential technical effect of a program recorded on a carrier could endow such a product with technical character sufficient to overcome the exclusions under Art. 52(2) and (3) EPC 1973 (see also **T 858/02**).

In **T 1749/06** the board agreed with the finding of **T 1194/97**. Presentation of information arises when "what is displayed" is claimed without specifying "how it is displayed". Claim 1 comprised the feature of an icon formed of dark and white stripes having thus a three-dimensional effect, but did not comprise the icon's cognitive content, i.e. its specific shape. The latter feature, i.e. the icon representing e.g. a butterfly, was a presentation of information, but not the former. The board found for these reasons that the features of the characterizing portion of claim 1 did not fall under the category of presentation of information within the meaning of Art. 52(2)(d) EPC.

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

In **T 599/93** a configuration for simultaneously displaying several images on one (computer) screen was claimed. The screen was divided into four sections, for example by means of one horizontal and one vertical demarcation line. The board was of the view that imparting information on events in a screen window by changing the colour of the relevant surface of the setting mark was not of a technical nature (no information was



given, for example, on the operating status of the claimed configuration), but merely drew the user's attention to particular contents of the relevant images and thus served to present information within the meaning of Art. 52(2)(d) EPC 1973 (**T 1704/06**).

In **T 1086/07** the board considered that, in general, the idea of displaying and placing an indicator at a position to identify a location has no technical character. It is a presentation of information, namely the results of the summarising process, and has no interaction with the possibly technical function of producing it. A similar conclusion was reached in decision **T 603/89** (OJ 1992, 230) in connection with a kind of template that displayed numbers on a card to represent notes on a keyboard instrument. The board noted that although the jurisprudence on Art. 52(2) EPC 1973 was somewhat different at the time, the judgment of technical character was essentially the same.

In **T 528/07** the appellant cited several decisions of the boards of appeal in order to demonstrate that the display of data can have technical character. The board found that **two different interpretations** of decision **T 115/85** existed in the jurisprudence: either the visual indications must concern technical conditions of the system in order to relate to a technical problem (**T 833/91**), or they may also concern non-technical conditions (**T 717/05**). The board in the case at issue followed the more restrictive approach according to which only technical conditions of a system can be taken into account. This line has also been taken in other decisions of the boards of appeal (see e.g. **T 790/92**; **T 953/94**; **T 1161/04**; **T 1567/05**; **T 756/06**). Moreover, the clear character of this approach as an exception appears to be more consistent with the exclusion of "presentations of information" pursuant to Art. 52(2)(d) EPC.

In **T 1073/06** the application related to generating a display of a **simulation model** including objects linked by relationships, for instance a proportional relationship. The appellant had argued that an objective technical problem could be seen in improving the ease with which a user can construct such a simulation model, the claimed solution avoiding the "drilling down" required in the prior art to understand the relationships between the objects in the simulation model.

The board judged, however, that an improvement in the comprehension of a model is a purely mental effect, so that the problem solved was not seen as being technical. Further, the solution was also not seen as having any technical implications beyond, possibly, routine implementation details, being simply a choice of where and in what form in a process of visualisation of a model to display certain information, i.e. an issue of "presentations of information", as mentioned in Art. 52(2)(d) EPC. On its broadest interpretation, the simulation model, of which the relationship conditions between objects were a part, could be of a wholly abstract nature and thus a system of equations which were merely a mathematical method and thus non-technical. The claimed "graphical link representations" related to the state of the simulation model, rather than to the state of the claimed simulation apparatus, and thus constituted presentations of information and were therefore also non-technical; see **T 528/07**.

In **T 163/85** (OJ 1990, 379), regarding a colour television signal characterised by technical features of the system in which it occurred, the board considered it appropriate

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

There is well-established case law which considers a graphical user interfaces layout (GUI) as such to be non-technical, being a "presentation of information" (Art. 52(2)(d) EPC) (see **T 1143/06**; **T 1741/08**).

In decision **T 1143/06** the board noted that a non-technical claim feature is a feature which does not interact with the technical features to produce a technical effect. According to the jurisprudence of the boards of appeal such a feature cannot establish novelty and inventive step (**T 154/04**, OJ 2008, 46, point 15 of the Reasons). Since the invention was concerned with the visualisation of data files Art. 52(2)(d) EPC was obviously relevant. If the new features of a claim concern the presentation of information itself (rather than its concrete implementation) a patent can only be granted if they also produce a technical effect. If they do not they cannot contribute to an inventive step. One example of such a case was **T 125/04** concerning a new kind of vector diagram. The deciding board stated that "i/n general, the task of designing diagrams is non-technical. This is so even if the diagrams arguably convey information in a way which a viewer may intuitively regard as particularly appealing, lucid or logical" (Catchword). Another example was decision **T 619/98**, in which it was held that an action performed by a user in response to a message in the form of questions or suggestions concerning the technical functioning of an apparatus did not render the form of the information technical.

The issues of GUI layout and presentation of information in the assessment of inventive step is analysed in detail in sub-chapter "Assesment of features relating to a presentation of information", within the Chapter I.D.9 "Assessment of inventive step".

## B. Exceptions to patentability

1.	Introduction	36
1.1.	Amendments made to Article 53 EPC as part of the EPC 2000 revision	36
1.2.	Basic principles	37
2.	Breaches of "ordre public" or morality	37
2.1.	Rule 28 EPC	38
2.1.1	Scope of exception under Rule 28(c) EPC	38
2.1.2	Scope of exception under Rule 28(d) EPC	39
2.1.3	Test date	40
2.2.	Article 53(a) EPC	40
2.2.1	Test date	40
2.2.2	Assessment of an objection according to Article 53(a) EPC	41
	a) Difference from test under Rule 28(d) EPC	41
	b) Concept of "morality" and "ordre public"	41
	c) Donor consent	42
3.	Patentability of biological inventions	43
3.1.	Plants and plant varieties	43
3.1.1	Definition of the term "plant varieties"	43
3.1.2	Limits to patentability	44
3.2.	Animals and animal varieties	45
3.3.	Essentially biological processes	45
3.3.1	Essentially biological processes for the production of animals	46
3.3.2	Essentially biological processes for the production of plants	46
	a) G 2/07 and G 1/08	46
	b) Patentable technical processes	47
3.3.3	Product claims for plants or plant material	48
3.4.	Microbiological processes and the products thereof	50
3.4.1	The concept of "microbiological processes"	50
3.4.2	Difference between microbiological and genetic-engineering processes	50
4.	Medical methods	51
4.1.	Introduction	51
4.2.	Methods for treatment by surgery or therapy and diagnostic methods	51
4.2.1	Distinction in the approach	51
4.2.2	Uniform approach: no need for practitioner involvement	52
4.3.	Surgical methods	52
4.3.1	One surgical step in a multi-step method	52
4.3.2	Treatment by surgery not limited to surgery for a therapeutic purpose	53
4.3.3	Towards a new concept of "treatment by surgery"	53
4.3.4	"Treatment by surgery" in the case law since G 1/07	54
	a) Surgical nature of a method step	54
	b) Surgical step part of claimed method?	55
	c) Apparatus claim – disguised method claim?	55
4.3.5	Avoiding the exclusion of methods of treatment by surgery from patent protection under Article 53(c) EPC	56
	a) Claim cannot be left to encompass surgical step	56

b)	Disclaimer	56
c)	Methods only concerning the operation of a device	56
4.3.6	Data obtained during surgery	57
4.4.	Therapeutic methods	57
4.4.1	The term "therapy"	57
a)	Definition of the term	57
b)	Application in the case law	58
4.4.2	Methods with both therapeutic and non-therapeutic indications	59
a)	Inevitable and inextricably linked therapeutic effect of the claimed method	59
b)	Therapeutic and non-therapeutic effects distinguishable	61
4.4.3	Avoiding the non-patentability under Article 53(c) EPC of methods with therapeutic effect	62
4.5.	Diagnostic methods	62
4.5.1	Opinion G 1/04 of the Enlarged Board of Appeal	62
a)	What constitutes "diagnostic methods"	62
b)	Involvement of practitioner	63
c)	The criterion "practised on the human or animal body"	63
d)	Clarity of a claim relating to diagnostic methods	64
e)	Intermediate findings of diagnostic relevance	64
4.5.2	Case law applying the principles developed in G 1/04	64

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## 1. Introduction

Art. 53 EPC defines three exceptions to patentability: (a) inventions the commercial exploitation of which would be contrary to 'ordre public' or morality; (b) plant varieties or animal species or essentially biological processes for the production of plants or animals; this does not apply to microbiological processes or the products thereof; (c) methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this does not apply to products, in particular substances or compositions, for use in any of these methods.

### 1.1. Amendments made to Article 53 EPC as part of the EPC 2000 revision

As part of the EPC 2000 revision, several amendments were made to Art. 53 EPC. However, these are unlikely to affect the EPO's practice (see OJ SE 4/2007): Art. 53(a) EPC was brought into line with Art. 27(2) TRIPS and Art. 6(1) of Directive 98/44/EC on the legal protection of biological inventions ("Biotech Directive"). In the German version, moreover, the term "Tierarten" in Art. 53(b) EPC 1973 was replaced by "Tierrassen" to bring it into line with the Biotech Directive and R. 23c(b) EPC 1973 (MR/2/00, 45).

In addition, the exclusion of medical methods which had previously been enshrined in Art. 52(4) EPC 1973 was transferred to Art. 53(c) EPC. These methods had formerly been excluded from patentability through the legal fiction that they were not susceptible

of industrial application. However, since medical methods are excluded from patentability mainly in the light of public health considerations, it appeared appropriate to include these inventions also under exceptions to patentability (MR/2/00, 45).

## 1.2. Basic principles

No general exclusion of inventions in the sphere of animate nature can be inferred from the EPC (**T 49/83**, OJ 1995, 545). It was held in **T 356/93** (OJ 1995, 545) that seeds and plants per se should not constitute an exception to patentability under Art. 53(a) EPC 1973 merely because they represented 'living' matter, or on the ground that plant genetic resources should remain the 'common heritage of mankind'.

The case law indicates that any exceptions to patentability must be narrowly construed. In respect of Art. 53(a) EPC, see **T 356/93** (OJ 1995, 545) and **T 866/01**, but also **T 1374/04** (OJ 2007, 313); in respect of Art. 53(b) EPC, see **T 320/87** (OJ 1990, 71), **T 19/90** (OJ 1990, 476) and **T 315/03** (OJ 2006, 15); regarding Art. 53(c) EPC (Art. 52(4) EPC 1973) see **T 144/83** (OJ 1986, 301), **T 385/86** (OJ 1988, 308) and **G 1/04** (OJ 2006, 334).

Given the ratio legis of the individual provisions, however, this narrow interpretation produces different results: a claim which embraces plant/animal varieties, but does not claim them individually, is not excluded from patentability under Art. 53(b) EPC (**G 1/98**, OJ 2000, 111; **T 19/90**, OJ 1990, 476; **T 315/03**, OJ 2006, 15). According to the established case law of the boards of appeal, a method claim falls under the prohibition of Art. 53(c) EPC if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy (see in this chapter I.B.4.2). By contrast, several method steps are required to define a diagnostic method within the meaning of Art. 53(c) EPC owing to the inherent and inescapable multi-step nature of such a method (**G 1/04**, OJ 2006, 334). In **T 19/90** it was also stated that the object and purpose of the law (ratio legis) was not merely a matter of the legislator's intention at the time when the law was adopted, but also of their presumed intention in the light of changes in circumstances which had taken place since then.

## 2. Breaches of "ordre public" or morality

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

Art. 53(a) EPC is supplemented by R. 28 EPC, which sets out four categories of biotechnological inventions excluded from patentability under that article. R. 28 EPC is part of the chapter on "Biotechnological inventions" inserted into Part II of the Implementing Regulations, and is identical to Art. 6(2) of the Biotech Directive. The Biotech Directive was thereby transposed into European patent law.

Where an invention falls under one of the categories set out in R. 28 EPC, it is by its very nature non-patentable and there is no need additionally to consider Art. 53(a) EPC.

However, if it does not fall under one of those categories, it must be examined more closely under Art. 53(a) EPC (**T 315/03**, OJ 2006, 15; see also **G 2/06**, OJ 2009, 306).

R. 29 EPC governs the patentability of the human body and its components. Under R. 29(2) EPC (R. 23e(2) EPC 1973), an element isolated from the human body or otherwise produced by a technical process, including the sequence or a partial sequence of a gene, may constitute a patentable invention, so that an invention falling under this category is not excluded from patentability pursuant to Art. 53(a) EPC (**T 272/95** of 23 October 2002; see also **T 1213/05**).

## 2.1. Rule 28 EPC

R. 28 EPC, which sets out four non-patentable categories, entered into force on 1 September 1999 as R. 23d EPC 1973. It applies equally to applications pending on, i.e. filed before, the date of its entry into force (**G 2/06**, **T 315/03**).

### 2.1.1 Scope of exception under Rule 28(c) EPC

Under R. 28(c) EPC (R. 23d(c) EPC 1973), European patents may not be granted in respect of biotechnological inventions which concern "uses of human embryos for industrial or commercial purposes". The expression "uses for industrial or commercial purposes" in R. 28(c) EPC covers the making of the claimed product, even where it was intended to use that product for further research (**G 2/06**).

In **G 2/06**, the Enlarged Board considered an invention concerning, inter alia, human embryonic stem cell cultures which at the filing date could only be prepared by a method which necessarily involved the destruction of the human embryos from which they were derived, that method not being part of the claims.

When interpreting R. 28(c) EPC, the Enlarged Board also looked at Art. 6(2) Biotech Directive because the aim of introducing R. 26 to 29 EPC was to align the EPC to that directive. It observed that neither the EU legislator nor the EPC legislator, unlike their German and UK counterparts, had chosen to define the term "embryo". It assumed that they had been aware of the definitions in national laws on regulating embryos and deliberately refrained from defining the term. Given the aim of protecting human dignity and preventing the commercialisation of embryos, it could only presume that "**embryo**" was not to be construed restrictively and therefore rejected the appellant's argument that "embryo" was to be given a very specific interpretation as meaning embryos of 14 days or older, in accordance with usage in the medical field.

The appellant had argued that, for the R. 28(c) EPC prohibition to apply, the use of human embryos had to be claimed. The Enlarged Board disagreed, observing that R. 28(c) EPC did not mention claims, but rather referred to "invention" in the context of its exploitation. What had to be looked at was not just the explicit wording of the claims but the technical teaching of the application as a whole as to how the invention is to be performed. The Enlarged Board thus answered the second point referred as follows: R. 28(c) EPC forbids the patenting of claims directed to products which – as described in

the application – at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos from which the said products are derived, even if the said method is not part of the claims.

In **T 522/04**, the contested claim was directed to a method of proliferating *in vitro* a clonal population of neural crest stem cells of mammalian origin. This clearly included cells of human origin. Since the only teaching of how to prepare human neural crest stem cell cultures was the use (involving their destruction) of human embryos, the board concluded that at the filing date human neural crest stem cells could be prepared exclusively by a method which necessarily involved the destruction of human embryos - with the inescapable result that the invention fell under the prohibition of Art. 53(a) EPC combined with R. 28(c) EPC.

In **T 2221/10** claims 1 and 2 of the appellant's sole request referred to methods of maintaining human embryonic stem cells (hES cells) in culture in an undifferentiated state, while claim 5 referred to a cell culture comprising hES cells. The appellant argued that methods using commercially or otherwise publicly available hES cell lines were not excluded from patentability because no *de novo* destruction of human embryos was necessary to perform them.

The board disagreed. It referred to **G 2/06** and noted that, according to that decision, all steps preceding the claimed use of hES cells which are a necessary precondition for carrying out the claimed invention have to be considered. In this respect the Enlarged Board of Appeal had neither made a distinction between steps which have been carried out by the inventor or by any other person, nor between steps which took place in direct preparation of the experiments leading to an invention and steps having taken place at a point in time further remote from those experiments. The board thus decided that inventions which make use of hES cells obtained by *de novo* destruction of human embryos or of publicly available hES cell lines which were initially derived by a process resulting in the destruction of the human embryos are excluded from patentability under the provisions of Art. 53(a) EPC in combination with R. 28(c) EPC. It noted that its decision was in line with ECJ judgment C-34/10.

In **T 1441/13** claim 1 of the main request was directed to a method for obtaining polypeptide-secreting cells. The method required the use of a culture of primate pluripotent stem cells (pPS) which, according to the description in the application, included human embryonic stem (hES) cells. The board considered that at the relevant date of the patent in suit, the known and practised method for achieving cultures of hES cells, i.e. the starting material of the method of claim 1, included preceding steps that involved the destruction of human embryos. Thus, the main request was not allowable under Art. 53(a) EPC and R. 28(c) EPC.

#### 2.1.2 Scope of exception under Rule 28(d) EPC

R. 28(d) EPC (R. 23d(d) EPC 1973) provides that European patents should not be granted in respect of processes for modifying the genetic identity of animals which were

likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

One of the most important cases dealing with interpretation not only of R. 23d EPC 1973, but also of Art. 53(a) EPC, concerned a patent relating to **transgenic animals having an increased probability of developing cancer**. The application resulted in two groundbreaking board decisions: **T 19/90** (OJ 1990, 476, see below), in which the matter was remitted to the department of first instance, and **T 315/03** (OJ 2006, 15), in which a patent was granted on the basis of new claims.

Having addressed the relationship between R. 23d EPC 1973 (R. 28 EPC) and Art. 53(a) EPC (see also in this chapter I.B.2), the board in **T 315/03** turned to the test under R. 23d(d) EPC 1973 (R. 28(d) EPC). This test required **only** three matters to be considered: animal suffering, medical benefit and the necessary correspondence between the two in terms of the animals in question. The board observed that the test was to be applied to ensure that a patent extended only to those animals whose suffering was balanced by a medical benefit. The level of proof was the same for both animal suffering and substantial medical benefit, namely likelihood (see also **T 1262/04** of 13 July 2012).

### 2.1.3 Test date

In **T 315/03**, the board observed that the relevant date for applying the test under R. 23d EPC 1973 (R. 28 EPC) was, as for all patentability criteria, the date of filing or priority. Nevertheless, evidence becoming available later could be taken into account, provided it related to the situation on that date.

In **G 2/06**, the Enlarged Board arrived at the same basic result. When assessing whether a claim contravenes R. 28(c) EPC, technical developments which became publicly available only after the filing date cannot be taken into consideration. Any other conclusion would lead to legal uncertainty, and risk being to the detriment of any third party who later provided an innocuous way to carry out the invention. The Enlarged Board thus concluded in the case before it that it is irrelevant that, after the filing date, the same products could be obtained without having recourse to a method necessarily involving the destruction of human embryos.

## 2.2. Article 53(a) EPC

If an invention is not excluded from patentability because it falls under one of the four categories in R. 28 EPC (see above), it must be then examined whether it is covered by the exception to patentability under Art. 53(a) EPC.

### 2.2.1 Test date

Assessment of an Art. 53(a) EPC objection was to be made as of the filing or priority date of the patent or application in suit. Evidence arising thereafter might be taken into account provided it was directed to the position at that date (**T 315/03**).



## 2.2.2 Assessment of an objection according to Article 53(a) EPC

In **T 19/90** (OJ 1990, 476), the board expressed the view that in cases, like the one before it, of genetic manipulation of animals by the insertion of an activated oncogene, there were compelling reasons to consider Art. 53(a) EPC 1973. As this had not been done at the level of the first instance, the board remitted the case to the examining division with the instruction to carry out a careful **weighing up** of the suffering of animals and possible risks to the environment on the one hand, and the invention's usefulness to mankind on the other, before deciding whether to grant or refuse the patent application (see also **T 1262/04** of 13 July 2012).

### a) Difference from test under Rule 28(d) EPC

In **T 315/03** (OJ 2006, 15) the board held that, in animal manipulation cases, the test in **T 19/90** (OJ 1990, 476) was appropriate. This differed in several respects from the test in R. 23d(d) EPC 1973 (R. 28(d) EPC), most importantly by allowing matters other than animal suffering and medical benefit to be taken into account. Whereas the R. 23d(d) EPC 1973 test only required a likelihood of animal suffering, however minor, and a likelihood of achieving a medical benefit, the test in **T 19/90** required a "careful weighing up" of the matters to be balanced. This clearly allowed an appraisal of animal suffering, of environmental risks and of the feasibility of using non-animal alternatives.

A wider range of benefits to mankind than the substantial medical benefit found in R. 23d(d) EPC 1973 could also be considered. Since the test in **T 19/90** was "mainly" the basis of assessment, further arguments as to the appropriate standard of morality or "ordre public" could additionally be considered, but all arguments had to be supported by evidence.

In **T 315/03** the board found that claims directed to rodents failed the R. 23d(d) EPC 1973 test and had therefore to be refused, as the patent disclosed a likelihood of animal suffering but not a likelihood of medical benefit when applying the invention to this generic class of animals. The same conclusion would have been reached under an Art. 53(a) EPC 1973 assessment. However, both tests were satisfied when the invention was restricted to mice.

### b) Concept of "morality" and "ordre public"

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

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

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

In **T 315/03** the board found that in the assessment of an Art. 53(a) EPC 1973 objection, no single definition of morality based on e.g. economic or religious principles represents an accepted standard in European culture. Opinion poll evidence was of very limited value for the reasons given in **T 356/93** (OJ 1995, 545), where many drawbacks were identified, ranging from the type and the number of questions posed within one poll, through the size and representative nature of the cross-section of the population polled, to the manner of interpretation of the results obtained.

In **T 356/93** the board defined the concept of "**ordre public**" as covering the protection of public security and the physical integrity of individuals as part of society. It also encompassed the protection of the environment. Accordingly, inventions the exploitation of which was likely to seriously prejudice the environment were to be excluded from patentability as being contrary to "ordre public". However, a decision in this respect presupposes that the threat to the environment be sufficiently substantiated at the time the decision is taken by the EPO.

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

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

c) Donor consent

The invention in **T 1213/05** related to the human BRCA1 gene isolated from the genome, mutant forms of that gene and its use in the diagnosis of predisposition to breast and ovarian cancer. Appellant II submitted that the lack of proof that the donors of the cells

had given previous informed consent to the commercial exploitation of the research results by patents as well as a benefit sharing agreement meant that the initial obtaining of these research results involved a violation of ordre public or morality as referred to in Art. 53(a) EPC.

The board disagreed. The EPC contained no provision establishing a requirement for applicants to submit evidence of previous informed consent of the donor of the cells or a benefit sharing agreement. That the legislator had not provided for a procedure of verifying such informed consent could also be deduced from the Biotech Directive, which had to be used as supplementary means of interpretation (R. 23b(1) EPC 1973, R. 26(1) EPC).

In addition, the board referred to ECJ judgment C-377/98 concerning the application for annulment of the Directive, where the Court had rejected the plea of the Kingdom of the Netherlands that the absence of a provision requiring verification of the consent of the donor or recipient of products obtained by biotechnological means undermined the right to self-determination. The Directive concerned only the grant of patents and therefore did not extend to activities before and after grant, whether they involved research or the use of the patented products.

### 3. Patentability of biological inventions

#### 3.1. Plants and plant varieties

According to Art. 53(b) EPC, a patent shall not be granted if the claimed subject-matter is directed to plant varieties. If a product claim does not specify any particular plant variety, but a **technical teaching which can be embodied in an unspecified number of plant varieties**, the subject-matter of the claimed invention does not relate to a plant variety or varieties within the meaning of Art. 53(b) EPC. Thus, a patent will not be granted for a single plant variety but can be granted if varieties may fall within the scope of the claims. If plant varieties are individually claimed, they are not patentable, irrespective of how they were made (**G 1/98**, OJ 2000, 111).

##### 3.1.1 Definition of the term "plant varieties"

**T 49/83** (OJ 1984, 112) first defined the term "plant varieties" as a multiplicity of plants which were largely the same in their characteristics and remained the same within specific tolerances after every propagation cycle. Following on from this, the board in **T 320/87** (OJ 1990, 71) concluded that **hybrid seed and plants**, lacking stability in some trait of the whole generation population, could not be classified as plant varieties within the meaning of Art. 53(b) EPC 1973. In this regard, see also **T 788/07**. In **T 356/93** (OJ 1995, 545) the board held that **plant cells** as such, which with modern technology can be cultured much like bacteria and yeasts, could not be considered to fall under the definition of a plant or of a plant variety. This was confirmed by **G 1/98**, which stated that plant cells should be treated like micro-organisms.

The term 'plant variety' is defined in R. 26(4) EPC in the same way as in Directive 98/44/EC on the legal protection of biotechnological inventions, namely as "any plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety are fully met, can be:

(a) defined by the expression of the characteristics that results from a given genotype or combination of genotypes,

(b) distinguished from any other plant grouping by the expression of at least one of the said characteristics, and

(c) considered as a unit with regard to its suitability for being propagated unchanged."

The words "the expression of the characteristics that results from a given genotype or combination of genotypes" used in R. 26(4)(a) EPC refer to the entire constitution of a plant or a set of genetic information. In contrast, a plant defined by single recombinant DNA sequences is not an individual plant grouping to which an entire constitution can be attributed within the above meaning. A plant defined in this way is not a concrete living being or grouping of concrete living beings but an abstract and open definition embracing an indefinite number of individual entities defined by a part of its genotype or by a property bestowed on it by that part (**G 1/98**, **T 189/09**, **T 1242/06** of 31 May 2012).

### 3.1.2 Limits to patentability

In **G 1/98**, the Enlarged Board concluded that, where specific plant varieties were not claimed individually, the claim was not excluded from patentability under Art. 53(b) EPC, even if it might potentially embrace plant varieties. The Enlarged Board took the view that Art. 53(b) EPC 1973 defined the borderline between patent protection and plant variety protection. The extent of the exclusion for patents was the obverse of the availability of plant variety rights. Since plant variety rights were only granted for specific plant varieties and not for technical teachings which could be implemented in an indefinite number of plant varieties, it was not sufficient for the exclusion from patent protection in Art. 53(b) EPC 1973 to apply that one or more plant varieties were embraced or might be embraced by the claims of the patent application (see also **T 475/01**).

The Enlarged Board further held that Art. 64(2) EPC 1973 should not be taken into consideration when a claim to a process for the production of a plant variety was examined, in conformity with the established case law according to which the protection conferred by a process patent is extended to the **products obtained directly by the process**, even if the products are not patentable per se (see Chapter II.A.7.1).

Finally, the Enlarged Board held that the exception to patentability in Art. 53(b), first part of sentence, EPC 1973, applied to plant varieties irrespective of the way in which they were produced. Therefore, plant varieties containing genes introduced into an ancestral plant by recombinant gene technology were excluded from patentability. The underlying reason for this was that the exclusion in Art. 53(b) EPC 1973 was designed to exclude

from patentability subject-matter which was eligible for protection under the plant breeders' rights system. It did not make any difference for the requirements under the UPOV Convention or under the Regulation on Plant Variety Rights, whether a variety was obtained by traditional breeding techniques or genetic engineering. The argument that the EPC legislator had not envisaged the possibility of **genetically modified plant varieties** and therefore could not have intended to exclude them from patentability could not be accepted - laws were not restricted in their application to situations known to the legislator.

### 3.2. Animals and animal varieties

In **T 19/90** (OJ 1990, 476) the board confirmed the general principle that the exception to patentability under Art. 53(b) EPC 1973 applies to certain categories of animals, but **not to animals as such**. In interpreting the term "animal varieties" the board emphasised the narrow interpretation to be given to the provisions of Art. 53(b) EPC 1973. It is not a bar to patentability for subject-matter which is not covered by any of the terms "animal varieties", "races animales" or "Tierarten".

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

The bar on patenting under Art. 53(b), first part of sentence, EPC 1973 did not extend to the products of a micro-biological process, which were patentable under Art. 53(b), second part of sentence, EPC 1973. Thus patents were held to be grantable for **animals produced by a microbiological process**. However, particularly in cases of genetic manipulation of animals involving, as in the case at issue, the insertion of an activated oncogene, there are compelling reasons to consider the provisions of Art. 53(a) EPC when assessing patentability (**T 19/90**).

In **T 315/03** the board did not agree with the assertion of some of the opponent appellants that the claimed transgenic mice were a new species because they inherited one particular characteristic, namely an increased probability of developing tumours. This was not enough to create a new species when the possible "starting material" might be any of a whole genus of animals, namely all mice. The board held that Art. 53(b) EPC 1973 did not exclude the patentability of the claims amended to encompass only mice and maintained the patent on that basis.

### 3.3. Essentially biological processes

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

### 3.3.1 Essentially biological processes for the production of animals

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

In **T 315/03** (OJ 2006, 15) the board held that the claimed process for producing transgenic mice, which included genetic manipulation, was not "an essentially biological process", the latter being defined in R. 23b(5) EPC 1973 (R. 26(5) EPC) as consisting "entirely of natural phenomena such as crossing or selection".

In **T 1199/08** appellant II argued that if the technical teaching of the patent as a whole was taken into account, it became obvious that the only purpose of the claimed method was the production of an animal. The board rejected the argument that the "whole contents approach" developed in **G 2/06** should be taken into consideration for a correct assessment of whether the claim in question would fall under the prohibition of Art. 53(b) EPC. It also decided that a claim to a method which allowed for the long-term preservation of sex-selected sperm did not qualify as an essentially biological process for the production of animals. Therefore, in line with the parallel reasoning developed in **G 2/07** regarding processes for the production of plants (see below), it did not fall under the prohibition of Art. 53(b) EPC.

### 3.3.2 Essentially biological processes for the production of plants

#### a) G 2/07 and G 1/08

The leading cases concerning the interpretation of the exclusion from patentability of essentially biological processes for the production of plants are the consolidated cases **G 2/07** (OJ 2012, 130) and **G 1/08** (OJ 2012, 206) ruling on the referral in **T 83/05** of 22 May 2007 (OJ 2007, 644) relating to a method of obtaining particular broccoli lines and on that in **T 1242/06** of 4 April 2008 (OJ 2008, 523) relating to a method of breeding tomato plants which produce tomatoes with reduced fruit water content.

The Enlarged Board of Appeal found, first of all, that the exception applying to "essentially biological processes for the production of plants" could not be read as limited to processes for the production of plant varieties, because such an interpretation would be contrary to the wording.

After rejecting a series of possible approaches to the interpretation of the exclusion, the Enlarged Board concluded that a non-microbiological process for the production of plants which contains or consists of the steps of sexually crossing the whole genomes and of

subsequently selecting plants is "essentially biological" within the meaning of Art. 53(b) EPC. Such a process does not escape the exception to patentability merely because it contains, as a further step or as part of any of the steps of crossing and selection, a step of a technical nature which serves to enable or assist performance of the steps of sexually crossing the whole genomes of plants or of subsequently selecting plants.

This outcome was largely based on the Enlarged Board's findings with regard to the legislative history of the Strasbourg Patent Convention and the EPC 1973. The legislator's intention, it found, had been to exclude from patentability those plant breeding processes which were the conventional methods of plant-variety breeding at the time. These conventional methods included, in particular, those based on the sexual crossing of plants (i.e. of their whole genomes) deemed suitable for the purpose pursued and on the subsequent selection of the plants having the desired trait(s). It could also be gathered from the legislative history that the mere use of a technical device in a breeding process was not to be considered sufficient to lend the process itself a technical character.

The Enlarged Board distinguished such processes from those which left the realm of plant breeding. It cited R. 27(c) EPC, which expressly provides that biotechnological inventions are also patentable if they concern a microbiological or other technical process, so that the excluded essentially biological processes are juxtaposed with the patentable technical processes. The exception to patentability under Art. 53(b) EPC does not exclude a process of sexual crossing and selection which includes within it an additional step of a technical nature, which step by itself introduces a trait into the genome or modifies a trait in the genome of the plant produced, so that the introduction or modification of that trait is not the result of the mixing of the genes of the plants chosen for sexual crossing. In the context of examining whether such a process is excluded from patentability as being "essentially biological" within the meaning of Art. 53(b) EPC, it is not relevant whether a step of a technical nature is a new or known measure, whether it is trivial or a fundamental alteration of a known process, whether it does or could occur in nature or whether the essence of the invention lies in it.

Ultimately, this means that, while the presence in a claim of one feature which could be characterised as biological does not necessarily result in exclusion of the claimed process as a whole under Art. 53(b) EPC, the same does not apply where the process includes sexual crossing and selection.

#### b) Patentable technical processes

In **T 1729/06** the invention was in the field of the production of watermelon fruit, in particular of seedless watermelons. The claimed use and methods concerned the pollination of the sterile female flowers of the triploid watermelon plant with pollen of the diploid polliniser plant. They did not concern sexually crossing two whole genomes of plants (implying meiosis and fertilisation) and the subsequent selection of plants. The board was therefore satisfied that the use and methods as subject-matter of the claims were not such methods which the Enlarged Board of Appeal in its decisions **G 2/07**

(OJ 2012, 130) and **G 1/08** (OJ 2012, 206) had considered to fall under the exclusion of "essentially biological processes for the production of plants".

The board noted that, in those decisions, the Enlarged Board had not given a comprehensive and exhaustive definition of the subject-matter to which the process exclusion in Art. 53(b) EPC applies in relation to plant inventions. Therefore, it still needed to be established whether the claimed uses and methods were excluded from patentability by virtue of the process exclusion in Art. 53(b) EPC for other reasons.

The board found that they were not. The legislator drafting Art. 53(b) EPC had not intended to exclude from patentability a whole class of inventions, i.e. horticultural or agricultural (agronomic) processes, under which the claimed use and methods undoubtedly fell. The EPC 1973 legislator (and the EPC 2000 legislator) had only wished to exclude from patentability the – then conventional – processes applied by plant breeders in connection with new plant varieties for which a special property right was available under the UPOV Convention, and processes which were fundamentally of this type.

Thus, rather than being excluded from patentability by virtue of Art. 53(b) EPC, the claimed uses and methods constituted a "technical process" and were therefore patentable pursuant to R. 27(c) EPC.

### 3.3.3 Product claims for plants or plant material

In the consolidated cases **G 2/12 and G 2/13** (OJ 2016, A28 and A29) the Enlarged Board was concerned with the question whether the exclusion of essentially biological processes for the production of plants in Art. 53(b) EPC had a negative effect on the allowability of product claims or product-by-process claims directed to plants or plant material (such as a fruit or plant parts) which are directly obtained and/or defined by an essentially biological process. It concluded that it did not.

The Enlarged Board applied the various methodical lines of interpretation set out in Art. 31 and 32 of the Vienna Convention on the Law of Treaties. None of these led the Enlarged Board to conclude that the term "essentially biological processes for the production of plants" extended beyond the processes to products defined or obtained by such processes. This result was confirmed when the preparatory work of the EPC was taken into account as a supplementary means of interpretation.

The Enlarged Board also examined whether considerations had arisen since the Convention was signed which might give reason to believe that a literal interpretation of the relevant provision would conflict with the legislator's aim. However, it could not see why the original intention of the legislator in drafting Art. 53(b) EPC was no longer justified, just because new plant breeding techniques were available today.

The Enlarged Board considered whether allowing patenting of a product claim or a product-by-process claim for a plant or plant material that is obtained by a means of an essentially biological process could be regarded as a circumvention of the process



exclusion. It found that it could not, referring to the clear wording of Art. 53(b) EPC. It warned that broadening the scope of the process exclusion to the extent that it included products obtained by essentially biological processes for the production of plants would introduce an inconsistency in the system of the EPC, as plants and plant material other than plant varieties were generally eligible for patent protection.

On the question whether it was of relevance that the protection conferred by the product claim encompassed the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Art. 53(b) EPC, the Enlarged Board highlighted the distinction between the requirements for patentability and the extent of protection. Whether a product claim or a product-by-process claim was patentable was to be examined irrespective of the extent of protection that is conferred by it after grant.

The Enlarged Board emphasised that its judicial decision-making powers did not extend to the ethical, social and economic aspects raised in the general debate, as it had no mandate to engage in legislative policy.

The questions of law referred to the Enlarged Board of Appeal were answered as follows:

1. The exclusion of essentially biological processes for the production of plants in Art. 53(b) EPC does not have a negative effect on the allowability of a product claim directed to plants or plant material such as a fruit (**G 2/12**) or plant parts (**G 2/13**).
2. The fact that the process features of a product-by-process claim directed to plants or plant material other than a plant variety define an essentially biological process for the production of plants does not render the claim unallowable (**G 2/13**). The fact that the only method available at the filing date for generating the claimed subject-matter is an essentially biological process for the production of plants disclosed in the patent application does not render a claim directed to plants or plant material other than a plant variety unallowable (**G 2/12**, **G 2/13**).
3. In the circumstances, it is of no relevance that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants excluded as such under Art. 53(b) EPC (**G 2/12**, **G 2/13**).

In its decision **T 83/05** of 10 September 2015 the board applied **G 2/13**. Claim 1 of the main request was directed to an edible Brassica plant produced according to a method of crossing and selecting. Claims 2 and 3 were directed to an edible portion and to the seed of a broccoli plant produced by a method defined in the same manner as in claim 1. Claims 4 and 5 were directed to a broccoli plant and a broccoli inflorescence. The board remitted the case to the department of first instance with an order to maintain the patent on the basis of claims 1 to 5 of the main request, a description yet to be adapted and figures 1 to 5 as granted.

### 3.4. Microbiological processes and the products thereof

The exception to patentability for plant or animal varieties or essentially biological processes for the production of plants or animals does not apply to microbiological processes or the products thereof (Art. 53(b), second part of sentence, EPC).

#### 3.4.1 The concept of "microbiological processes"

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

According to **T 356/93** (OJ 1995, 545), the concept of "microbiological processes" under Art. 53(b), second part of sentence, EPC refers to processes in which micro-organisms (or their parts) are used to make or to modify products or in which new micro-organisms are developed for specific uses. Consequently, the concept of "products thereof" under Art. 53(b), second part of sentence, EPC encompasses products which are made or modified by micro-organisms as well as new micro-organisms as such. 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, i.e. all generally unicellular organisms with dimensions not visible to the naked eye which can be propagated and manipulated in a laboratory, including plasmids and viruses.

Examining the patentability of the claimed plant grouping, the board in **T 356/93** also addressed the issue whether **multi-step processes** for producing plants which include at least one **microbiological process step** could be considered as a whole to represent "microbiological processes", and whether, consequently, the products of such processes (e.g. plants) might be regarded as being "the products thereof" for the purposes of this provision. The board held that "technical processes including a microbiological step" could not simply be equated with "microbiological processes". Nor could the resulting final products of such a process (e.g. plant varieties) be defined as "products of a microbiological process" within the meaning of the said provision.

#### 3.4.2 Difference between microbiological and genetic-engineering processes

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

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

## 4. Medical methods

### 4.1. Introduction

Art. 53(c) EPC states that European patents shall not be granted in respect of methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods. Thus, the exclusion of methods of treatment and diagnostic methods formerly referred to in Art. 52(4) EPC 1973 has been added to the two exceptions to patentability and reappears in the new Art. 53(c) EPC.

In three (almost) identical decisions **G 1/83**, **G 5/83** and **G 6/83** (OJ 1985, 60,64, 67), the Enlarged Board stated that the intention of Art. 52(4) EPC 1973 (now Art. 53(c) EPC) was only to prevent non-commercial and non-industrial medical and veterinary activities from being restrained by patent rights (see also **T 245/87**, OJ 1989, 171). In **G 1/04** (OJ 2006, 334) the Enlarged Board of Appeal stated, with reference to diagnostic methods, that their exclusion from patentability seemed actually to be based on socio-ethical and public health considerations. In **G 1/07** (OJ 2011, 134), a decision concerning treatment by surgery, the Enlarged Board noted that the exclusion under Art. 52(4) EPC 1973 (Art. 53(c) EPC) had been deliberately maintained by the legislator, thereby confirming the principle that medical and veterinary practitioners' freedom to use the best available treatments to the benefit of their patients, uninhibited by any worry that some treatment might be covered by a patent, should be protected by excluding these activities from patentability.

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

#### 4.2.1 Distinction in the approach

In the case law of the boards of appeal a distinction is made in the approach to methods for treatment by surgery or therapy on the one hand and diagnostic methods on the other. The leading cases are **G 1/04** (OJ 2006, 334) concerning diagnostic methods, and **G 1/07** (OJ 2011, 134) concerning treatment by surgery.

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

#### 4.2.2 Uniform approach: no need for practitioner involvement

In **G 1/04** (OJ 2006, 334), concerning diagnostic methods, the Enlarged Board held that whether or not a method is a diagnostic method may neither depend on the participation of a medical or veterinary practitioner nor on the fact that all method steps can also, or only, be practised by medical or technical support staff, the patient himself or herself, or an automated system. The Enlarged Board highlighted the difficulty, if not impossibility, of defining the persons that were considered to be such practitioners on a European level within the framework of the EPC. For reasons of legal certainty, the European patent grant procedure should not be rendered dependent on the involvement of such practitioners (see also in this chapter I.B.4.5.1 b)).

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

#### 4.3. Surgical methods

**G 1/07** (OJ 2011, 134) marked an important turning point in the boards' case law on the exclusion of surgical methods from patentability. Whilst the Enlarged Board endorsed the existing basic approach to multi-step methods (see in this chapter I.B.4.3.1), it rejected the practice followed by the EPO thus far of broadly construing interventions of a surgical nature. It did not redefine the term "treatment by surgery", but indicated the direction in which it expected future practice and case law to develop. According to **G 1/07**, the required new direction is that the exclusion from patentability should not be applied to methods in respect of which the interests of public health, of protection of patients and as a counterpart to that of the freedom of the medical profession to apply the treatment of choice to their patients does not call for their exclusion from patentability (see in this chapter I.B.4.3.3).

##### 4.3.1 One surgical step in a multi-step method

In **G 1/07** the Enlarged Board upheld the principle confirmed in opinion **G 1/04** (OJ 2006, 334) and underlying the whole body of practice and jurisprudence hitherto (see e.g. **T 820/92** (OJ 1995, 113)), that a method claim falls under the prohibition on patenting methods for treatment by therapy or surgery now under Art. 53(c) EPC if it comprises or encompasses **at least one** feature defining a physical activity or action that constitutes a method step for treatment of a human or animal body by surgery or therapy. The principle is not only formally justified by the fact that the exclusion under Art. 53(c) EPC does not contain any limitation as to the defined methods being excluded only when claimed as such. More importantly, it is also justified as to substance, i.e. it enables the legislative purpose served by the exclusion to be achieved (see in this chapter I.B.4.1).

#### 4.3.2 Treatment by surgery not limited to surgery for a therapeutic purpose

In **G 1/07** (OJ 2011, 134) the Enlarged Board of Appeal concluded that neither the legal history nor the object and purpose of the exclusions from patentability in Art. 53(c) EPC would justify a limitation of the term "treatment by surgery" to curative surgery (overruling **T 383/03**). Such a limitation would be contrary to the ordinary understanding of the word "surgery" as referring to the nature of the treatment rather than its purpose, and contrary to the fact that Art. 53(c) EPC defines three separate alternative exclusions thereby suggesting that these are not merely identical in scope. The Enlarged Board of Appeal observed in **G 1/07** that the comparison between **T 383/03** and **T 1172/03** showed how inconsistent the decisions to be made could become if the term "treatment by surgery" was seen as limited to therapeutic surgery only.

#### 4.3.3 Towards a new concept of "treatment by surgery"

The Enlarged Board disapproved of the broad construction of interventions of a surgical nature corresponding to the practice of the EPO, such as in decisions **T 182/90** and **T 35/99**, namely that all methods involving irreversible damage to or destruction of living cells or tissues of the living body were regarded as non-insignificant interventions and thus as surgical treatments, irrespective of the underlying mechanism of the intervention (e.g. mechanical, electrical, thermal, chemical). This view was overly broad when considering today's technical reality. Thus the definition given obiter dicta in **G 1/04** that "'any physical intervention" on the human or animal body..." is a method of surgery within the meaning of Art. 52(4) EPC 1973 appeared too broad.

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

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

However, the Enlarged Board indicated the direction it expected future practice and case law to take, finding that the exclusion from patentability should not be applied to methods in respect of which the interests of public health, of protection of patients and as a counterpart to that of the freedom of the medical profession to apply the treatment of choice to their patients does not call for their exclusion from patentability. It is for the departments of first instance and the boards to define the boundaries of a more narrowly construed concept of "treatment by surgery", based on the technical reality of the individual case under consideration.

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

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

#### 4.3.4 "Treatment by surgery" in the case law since G 1/07

##### a) Surgical nature of a method step

In **T 992/03** of 4 November 2010, <sup>129</sup>Xe gas was used as part of the claimed method. The board observed that it was known that <sup>129</sup>Xe could also be used as an anaesthetic, but found that this was irrelevant in assessing whether the claimed methods should be excluded from patentability under Art. 53(c) EPC. The Enlarged Board had clarified in **G 1/07** that "there is an exclusion from patentability as a surgical method only if the health risk is associated with the mode of administration and not solely with the agent as such" and any anaesthetic effect of the <sup>129</sup>Xe gas thus did not fall under the exclusion.

The question to be decided in **T 663/02** was whether the step of "injecting the magnetic resonance contrast agent into a vein remote from the artery" had a surgical character. Citing **G 1/07**, the board concluded that the fact that an intravenous injection of a magnetic resonance contrast agent could be delegated by a physician to a qualified paramedical professional indicated that such an injection may be considered as representing a minor routine intervention which did not imply a substantial health risk when carried out with the required care and skill. Such acts would be ruled out from the scope of the application of the exclusion clause pursuant to Art. 53(c) EPC following the narrow understanding advocated by the Enlarged Board of Appeal (**G 1/04** and **G 1/07**). A possible way of assessing health risks is to use a risk matrix permitting the levels of likelihood and health impact of a complication of a medical act with regard to a large number of patients to be combined, so as to obtain statistical health risk scores which may be used to decide what action should be taken.

In **T 1075/06** the board held that venipuncture of blood donors and the extraction of blood from a donor's body represent substantial physical interventions on the body which require professional medical expertise to be carried out and which entail a substantial health risk even when carried out with the required professional care and expertise. A

method claim comprising steps encompassing such procedures is a method for treatment of the human body by surgery. Similarly, in **T 1695/07** the board held that a blood manipulation process involving the continuous removal of blood from a patient, its subsequent flowing through a circulating line of an extracorporeal circuit and its re-delivery to the patient was a method of treatment of the human body by surgery.

b) Surgical step part of claimed method?

In a series of decisions, the boards have considered whether particular surgical steps form part of the claimed method or are simply preparatory measures which cannot be deemed such a part. They have arrived at different conclusions.

In **T 992/03** of 4 November 2010, methods were claimed for MR imaging the pulmonary and/or cardiac vasculature of a subject, using dissolved-phase polarised  $^{129}\text{Xe}$  gas. The board stated that whilst a skilled person would know that a MR imaging method was a rather complex procedure requiring inter alia preparatory steps like positioning of a subject in the MR system, delivering polarised  $^{129}\text{Xe}$  gas to the subject and initialising the MR system, these preparatory steps did not form part of the contribution of the invention to the art. The method claims thus did not comprise "an invasive step representing a substantial physical intervention on the body which requires professional medical expertise to be carried out and which entails a substantial health risk even when carried out with the required professional care" (**G 1/07**).

In **T 836/08**, claim 1 concerned a method for tracking the position of the distal end of a bone guide wire, using a medical optical tracking and navigation system. The board found that, while this meant that the reference apparatus had to be attached to, and the wire introduced into, the bone, these steps were not part of the claimed method. The fact that the method was performed after, or even during, a surgical intervention on the body did not mean that the claimed position-tracking method as such was a method of treatment by surgery.

Although the decision in **T 923/08** was concerned with circumstances similar to those in **T 836/08**, the board came to a very different result: where a method for determining measurements of the human or animal body necessarily entailed a surgical step consisting of fixing to the human or animal body a measuring device indispensable for performance of the method, that step had to be deemed an essential feature of the method which was covered by such a method, even if none of the claimed method features expressly related to this step. Such a method was excluded from patentability under Art. 53(c) EPC. Moreover, such a surgical step could not be removed from the scope of the claimed method by means of wording stating that the surgically placed measuring device was already fixed to the body before the start of the method, or by means of a disclaimer, as this would breach Art. 84 EPC (1973) (see also **T 2102/12**).

c) Apparatus claim – disguised method claim?

In **T 1798/08**, although all claims were directed to a visual prosthesis, i.e. an apparatus, they were objected to by the opponent under Art. 53(c) EPC as relating to a surgical

method. The features "suitable to be located on the body of the user outside a wall of the sclera and attached to the sclera" and "suitable to be located implanted in the eye behind the iris", the opponent argued, related to a method for treatment of the human or animal body by surgery and thus transformed the claim into a "disguised" method claim, even though it was notionally directed to a device.

The board dismissed this objection. It observed that Art. 53(c), second sentence, EPC specified that the provision did not apply to products. The claim category "products" included apparatus. Accordingly, the provisions of Art. 53(c) EPC did not normally apply to apparatus claims. The fact that some features of the claimed apparatus were functionally defined in relation to the body of the patient did not, in itself, transform the apparatus claim into a method claim (**T 712/93**, **T 1695/07**; see also **T 1407/08**).

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

##### a) Claim cannot be left to encompass surgical step

The Enlarged Board in **G 1/07** (OJ 2011, 134) confirmed the established case law of the boards of appeal, according to which a claim encompassing an embodiment which was excluded from patentability under Art. 53(c) EPC could not be left unamended. Contrary to what the appellant had argued, it found that this principle had been upheld in **G 1/98** (OJ 2000, 111).

##### b) Disclaimer

The Enlarged Board in **G 1/07** went on to say that the exclusion from patentability under Art. 53(c) EPC can be avoided by disclaiming an embodiment, it being understood that in order to be patentable the claim including the disclaimer must fulfil all the requirements of the EPC and, where applicable, the requirements for a disclaimer to be allowable as defined in decisions **G 1/03** (OJ 2004, 413) and **G 2/03** (OJ 2004, 448). Whether or not the wording of a claim can be amended so as to omit the surgical step without offending against the EPC must be assessed on the basis of the overall circumstances of the individual case under consideration (see **T 923/08**, in this chapter I.B.4.3.4 b)).

##### c) Methods only concerning the operation of a device

A typical class of cases in which the invention would be fully defined without requiring the presence of the potentially surgical step as a positive feature of the claim would be cases in which the invention only concerns the operating of a device. With respect to such inventions the boards of appeal have constantly held that a method which is only concerned with the operating of a device without any functional link between the claimed method and the effects produced by the device on the body does not qualify at all as a method for treatment within the meaning of Art. 52(4) EPC 1973 (Art. 53(c) EPC) (**T 245/87**, OJ 1989, 171, **T 789/96**, OJ 2002, 364). If, on the contrary, there is such a functional link the method is excluded from patentability (**T 82/93**, OJ 1996, 274).



#### 4.3.6 Data obtained during surgery

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

#### 4.4. Therapeutic methods

Therapeutic methods are subject to a rule, similar to that applicable to surgical methods, that they cannot be patented if they include at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by therapy (**G 1/04**, OJ 2006, 334; **G 1/07**, OJ 2011, 134).

##### 4.4.1 The term "therapy"

###### a) Definition of the term

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

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

The board in **T 774/89** distinguished "therapy" from "performance improvement", finding that the purpose of therapy was invariably to restore the organism from a pathological to its original condition, or to prevent pathology in the first place, whereas a non-therapeutic improvement of performance took as its starting point a normal state (to be defined) (see **T 385/09**).

Therapeutic methods must also be distinguished from cosmetic methods. In **G 1/07** (OJ 2011, 134) the Enlarged Board of Appeal pointed out that it was the express wording of Art. 53(c) EPC that only therapeutic methods were excluded from patentability (and thus cosmetic methods were not) and the exclusion could not be extended to treatments which were not therapeutic in character (see also **T 1172/03** making reference to **T 144/83**, OJ 1986, 301).

b) Application in the case law

In **T 81/84** (OJ 1988, 207) the question arose whether or not the character of menstrual discomfort manifesting itself for instance in intense headaches and other painful symptoms was such that its treatment should fall under the category of therapeutic treatment. The board found that the concept of therapy should not be construed narrowly. It would be impossible and undesirable to distinguish between basic and symptomatic therapy, i.e. healing or cure and mere relief. The board concluded that irrespective of the origin of pain, discomfort or incapacity, its relief, by the administration of an appropriate agent, was to be construed as therapy or therapeutic use within the meaning of Art. 52(4) EPC 1973.

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

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

In **T 74/93** (OJ 1995, 712) the claimed invention related to alicyclic compounds and their contraceptive use. The board took the view that a method of contraception was not excluded per se from patentability under the aspects of industrial application as stipulated in Art. 57 as well as in Art. 52(4), first sentence, EPC 1973 (now Art. 53(c) EPC). Pregnancy was not an illness and therefore its prevention was not in general therapy according to Art. 53(c) EPC (see also **T 820/92**, OJ 1995, 113; **T 1635/09**, OJ 2011, 542). Nevertheless, the method could not be patented. The board found that a method of contraception to be applied in the private and personal sphere of a human being could not be deemed susceptible of industrial application (see Chapter I.E.1.2.1).

In **T 241/95** (OJ 2001, 103) the board held that the selective occupation of a hormone receptor could not be considered as a therapeutic application; the discovery that a substance selectively binds the serotonin receptor, even if this represented an important piece of scientific knowledge, still had to find a practical application as a defined, real

treatment of a pathological condition in order to make a technical contribution to the art and to be considered as an invention eligible for patent protection.

In **T 1075/06** the board held that a method claim comprising the step of returning processed blood, depleted of some of its components and charged with an anticoagulant, to a donor is a method for treatment of the human body by therapy which is excluded from patentability under Art. 53(c) EPC.

According to the contested patent in case **T 611/09**, a lock solution was used for infusion into the lumen of an in-dwelling intravascular catheter, i.e. a catheter which was typically inserted into a vein or artery and therefore in intimate contact with the human or animal body. According to the board, this did not necessarily mean that the lock solution was also directly in contact with or even active within the human or animal body. The board concluded that the antibacterial activity only took place in the lumen, which was part of the catheter that was located outside of the human or animal body, which meant that it was not therapeutic.

#### 4.4.2 Methods with both therapeutic and non-therapeutic indications

Whether or not a claimed invention is excluded from patentability under Art. 53(c) EPC depends upon the wording of the claim in question (see **T 820/92**, OJ 1995, 113; **T 290/86**, OJ 1992, 414; **T 780/89**, OJ 1993, 440 and **T 1077/93**). As a general rule, it is irrelevant for the purposes of Art. 53(c) EPC whether there are other therapeutic effects in addition to the claimed non-therapeutic use if those additional therapeutic effects can be clearly distinguished from the non-therapeutic use and are not covered by the subject-matter of the claim. If, however, the scope defined by the wording of the claim encompasses a use comprising a non-therapeutic element which is inseparably associated with a therapeutic element and that latter element is an essential part of the claimed method, the method is non-patentable under Art. 53(c) EPC (**T 1635/09**, OJ 2011, 542; **T 290/86**, OJ 1992, 414).

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

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

According to **T 780/89** (OJ 1993, 440) the secondary effect of a therapeutic treatment did not render it patentable. The claim in question related to a method of general immunostimulation for animals. The applicant argued, inter alia, that this served to increase meat production and that the method was therefore not being used as a means

of therapy. However, the board regarded the effect of increasing meat production as a consequence of the improvement in the animals' health. Moreover, the general stimulation of the immune system was integrally linked to the specific prophylactic function of safeguarding against particular infections.

In **T 438/91** the patentee contended that the main purpose of the claimed process was to increase the weight of the animals which effect was separable from the effect of prevention or cure of scours. This latter was merely a beneficial side effect. It was necessary to decide whether or not a method for breeding domestic animals in claims 1 and 2 related to a therapeutic or prophylactic treatment. The board noted that two effects were observed as a result of the breeding method claimed: (a) the remedying of scours and, (b) a weight increase in the animals being bred. The board found that, in the light of the patent disclosure, the two effects were linked by the single action of feeding the animals, and that the intention was to obtain both effects at the same time in animals suffering from scours (treatment by therapy) and to prevent the latter complaint in those animals which did not already have it (treatment by prophylaxis). In conclusion, the board was of the opinion that the subject-matter of claims 1 and 2 related to a therapeutic or prophylactic treatment of domestic animals and thus fell within the prohibition on patentability set out in Art. 52(4) EPC 1973.

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

In **T 1077/93** claims 1 and 11 related to the use of the cupric complex of 3,5-Diisopropyl salicylic acid (referred to in the following as CuDIPS) as a cosmetic product or in a cosmetic composition, and to a cosmetic treatment process, based on the use of this complex, for the protection of the human epidermis. The purpose of the patented composition was to protect the human epidermis against ultraviolet radiation: notably, to reduce the intensity of erythema, recognised as the most spectacular form of damage to the skin by sunlight, and of skin-level cellular changes such as the formation of degenerated and necrotised keratinocytes, generally known by the term "sunburn cells (SBC)". In its ruling, the board cited the point, already explored in **T 820/92** (OJ 1995, 113), that the exclusion of therapeutic methods from patentability could not be avoided by a purely formal rewording of the claim to qualify the purpose of the process, in its indivisible entirety, as non-therapeutic. The board took the view that the examination as to patentability of claims 1 and 11 necessitated an examination of the

mechanism by which CuDIPS acted, and of the relationship between all its effects. The board concluded that at least part of the protective effect did not derive from a simple filtering at the level of the skin surface, but rather from an interaction with the cellular mechanisms in the epidermis, with the purpose of preventing a pathological state (erythema); therefore the process had a genuine therapeutic effect.

According to **T 1635/09** (OJ 2011, 542) use as an oral contraceptive of a composition in which the claimed concentrations of the hormone content are selected at such a low level as to prevent or reduce the likely pathological side-effects of such an oral contraceptive is a therapeutic method excluded from patentability under Art. 53(c) EPC. The board held that the prevention of side-effects - which was affirmed in claim 1 by the indication of the concentrations of active substance and which, in the light of the pathological nature of the secondary effects, clearly had to be classed as therapeutic - was inseparably associated with the per se non-therapeutic contraceptive process.

b) Therapeutic and non-therapeutic effects distinguishable

In **T 144/83** (OJ 1986, 301) the board accepted the patentability of a claim worded in such a way that it clearly sought protection for a method of treating the human body for cosmetic purposes but not for the therapeutic application which was also possible. The board pointed out that the language of the claim in question clearly covered a method of cosmetic use and was unrelated to the therapy of a human or animal body in the ordinary sense. 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.

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

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

#### 4.4.3 Avoiding the non-patentability under Article 53(c) EPC of methods with therapeutic effect

One way of escaping the exception to patentability is a disclaimer, but the claim featuring the disclaimer must then meet all the EPC requirements (see also in this chapter I.B.4.3.5). In **T 774/89** the board accepted the patentability of using a medication to increase milk production in cows, because it was evident that the success of the treatment did not depend on the animals' state of health, and the insertion in the claim of the term "non-therapeutic" served as a disclaimer, excluding the therapeutic effects of the medication.

According to **T 1635/09** (OJ 2011, 542), the following applies to claims encompassing both therapeutic and non-therapeutic uses: a disclaimer "non-therapeutic" allows for the exclusion of therapeutic uses from a claim encompassing both therapeutic and non-therapeutic uses in such a way that they are substantively separable, so that the remaining subject-matter is no longer covered by the exception to patentability under Art. 53(c) EPC. However, such a disclaimer cannot be employed to define as non-therapeutic a use which - like that at issue in this case - necessarily includes one or more therapeutic steps, since the question whether or not a claimed use is therapeutic can be decided only in the light of the activities carried out, or the effects achieved, in the course of that use.

### 4.5. Diagnostic methods

Under Art. 53(c) EPC diagnostic methods practised on the human or animal body are also excluded from patentability. However, the boards construe the exception applicable to diagnostic methods more narrowly than that applicable to surgical and therapeutic methods.

#### 4.5.1 Opinion G 1/04 of the Enlarged Board of Appeal

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

##### a) What constitutes "diagnostic methods"

One of the points referred concerned interpretation of "diagnostic methods". The Enlarged Board gave it a narrow interpretation: in order that the subject-matter of a claim relating to a diagnostic method practised on the human or animal body falls under the prohibition of Art. 52(4) EPC, the claim is to include the features relating to: (i) the diagnosis for curative purposes *stricto sensu* representing the deductive medical or veterinary decision phase as a purely intellectual exercise, (ii) the preceding steps which are constitutive for making that diagnosis, and (iii) the specific interactions with the

human or animal body which occur when carrying those out among these preceding steps which are of a technical nature.

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

b) Involvement of practitioner

The Enlarged Board of Appeal held that the classification of an activity as having a diagnostic character did not depend on who was involved. The wording of Art. 52(4) EPC 1973 (now Art. 53(c) EPC) was unequivocal in that the exclusion related only to the method, and not to the person carrying out the method. To allow the grant of a European patent to depend on the involvement of such a person would therefore introduce legal uncertainty into the patent granting procedure. Thus, whether or not a method was a diagnostic method should depend neither on the participation of a medical or veterinary practitioner, through being present or bearing the responsibility, nor on the fact that all method steps could also, or only, be practised by medical or non-medical support staff, the patient himself or herself or an automated system (see also **G 1/07**, OJ 2011, 134). Moreover, no distinction is to be made in this context between essential method steps having diagnostic character and non-essential method steps lacking it.

c) The criterion "practised on the human or animal body"

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

This criterion was to be considered only in respect of method steps of a technical nature. Thus, it did not apply to diagnosis for curative purposes *stricto sensu*, i.e. the deductive decision phase, which as a purely intellectual exercise could not be practised on the human or animal body.

Art. 52(4) EPC 1973 did not require a specific type and intensity of interaction with the human or animal body; a preceding step of a technical nature thus satisfied the criterion

"practised on the human or animal body" if its performance implied any interaction with the human or animal body, necessitating the presence of the latter.

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

d) Clarity of a claim relating to diagnostic methods

If diagnosis as the deductive medical or veterinary decision phase was a purely intellectual exercise, the feature pertaining to the diagnosis for curative purposes and the features relating to the preceding steps which were constitutive for making the diagnosis represented the essential features of a diagnostic method. Thus, in order to satisfy the requirements of Art. 84 EPC 1973, an independent claim relating to such a method had to include these features. If a non-technical feature was to be regarded as constitutive for defining the invention, it had likewise to be included as an essential feature in the independent claim.

e) Intermediate findings of diagnostic relevance

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

#### 4.5.2 Case law applying the principles developed in G 1/04

In **T 1197/02** the invention related to a method of assessing the presence of glaucomatous damage to the visual system of a subject. The board explained that since the criterion "practised on the human or animal body" in Art. 52(4) EPC 1973 was to be considered only in respect of method steps which are of a technical nature (**G 1/04**, OJ 2006, 334, points 6.4.1 and 6.4.4 of the Reasons), it neither applied to the deductive decision phase, nor to those steps which consisted in comparing the data collected in the examination phase with standard values and in finding a significant deviation resulting from the comparison. These activities were principally of a non-technical nature and normally not practised on the human or animal body. It followed that in most cases, only the step which referred to the examination phase and involved the collection of data



could actually be of a technical nature and, therefore, concerned with the criterion "practised on the human or animal body". Additional intermediate steps which concerned for example the adjustment or preparation of the apparatus with which the collection of data would be performed could be introduced into a method claim for completeness. However, since these additional features were not part of one of the steps necessary for making the diagnosis, they were to be ignored when assessing the diagnostic character of the method. The issue of whether or not these intermediate features were of a technical nature and practised on the human or animal body was, therefore, irrelevant for this question.

In **T 143/04** claim 1 at issue related to a method of diagnosing Alzheimer's disease in a living subject. The board noted that data processing using an automated apparatus was not actually part of the examination phase which involved the data collection phase, but it resulted from a subsequent, technical step, intermediate between the data collection and the comparison of these collected data with standard values. Such intermediate steps were not to be considered when assessing the diagnostic character of the method. The claim at issue included all the features of a diagnostic method practised on the human or animal body as defined in the opinion **G 1/04**. The patenting of such a method was prohibited by Art. 52(4) EPC 1973 (Art. 53(c) EPC).

**C. Novelty**

1.	General	69
2.	State of the art	69
2.1.	General	69
2.2.	Applications with same filing or priority date	70
2.3.	Relevant date of documents	70
2.4.	Prior rights – Article 54(3) EPC	70
2.4.1	European prior rights	70
2.4.2	Applicability of Article 54(3) EPC in cases of potentially colliding European parent and divisional applications	71
2.4.3	Excluded national prior rights	72
2.4.4	PCT applications as state of the art	72
2.5.	Non-prejudicial disclosures under Article 55 EPC	73
2.6.	In-house knowledge not published before the priority date	74
2.7.	Prior art acknowledged in a patent application	74
2.8.	Common general knowledge	75
2.8.1	Definition of "common general knowledge"	75
2.8.2	Patent specifications as common general knowledge	76
2.8.3	Specialist journals as common general knowledge	76
2.8.4	Databases as common general knowledge	76
2.8.5	Proof of common general knowledge	77
3.	Availability to the public	78
3.1.	General	78
3.2.	Ways of making information available to the public	78
3.2.1	Publications and other printed documents	78
	a) General	78
	b) Company papers	78
	c) Advertising brochure	79
	d) Report available in the specialist field	80
	e) Books	80
	f) Instruction manual	80
	g) Patent and utility models	80
	h) Abstracts of documents	81
3.2.2	Lectures and oral disclosure	81
3.2.3	Internet disclosures	83
	a) General	83
	b) Public availability of a document stored on the World Wide Web	83
	c) Publication date	84
3.2.4	Prior use	86
	a) General issues	86
	b) Public prior use occurred	86
	c) No public prior use	87
	d) Internal structure or composition of a product	88
3.2.5	Biological material	89
3.3.	The concept of "the public"	90
3.3.1	Sale to a single customer	90

---

3.3.2	Making available to a person not skilled in the art	90
3.3.3	A limited circle of people	91
3.3.4	Public library	91
3.4.	Obligation to maintain secrecy	92
3.4.1	General	92
3.4.2	Parts for serial production	93
3.4.3	Distribution of prospectuses, technical descriptions	93
3.4.4	Commercial inter-relationships and interests	93
3.4.5	Demonstrating products for presentation purposes	94
3.4.6	Presenting the product in writing	95
3.4.7	Making samples/products available for test purposes	96
3.4.8	Conferences	97
3.4.9	Joint venture and other commercial agreements	98
3.4.10	Paper submitted to obtain an academic degree	99
3.4.11	Medical field	99
3.4.12	Notary	99
3.5.	Issues of proof	99
3.5.1	Burden of proof	99
3.5.2	Standard of proof	100
	a) General	100
	b) Public prior use	100
	c) Internet – proof of the date of availability	100
4.	Determining the content of the relevant prior art	101
4.1.	General rules of interpretation	101
4.2.	Combinations within a prior art document	104
4.3.	Taking implicit features into account	105
4.4.	Taking intrinsic features into account	108
4.5.	Taking equivalents into account	108
4.6.	Taking drawings into account	109
4.7.	Taking examples into account	110
4.8.	Broad claims	110
4.9.	Deficiencies and mistakes in a disclosure	111
4.10.	Accidental disclosure	112
4.11.	Reproducibility of the content of the disclosure	113
5.	Ascertaining differences	115
5.1.	Comparing each individual item from the prior art	115
5.2.	Distinguishing features	116
5.2.1	Difference in wording	116
5.2.2	Differences in values	117
5.2.3	Difference in parameters	119
5.2.4	Difference in composition	119
5.2.5	Functional features	119
5.2.6	Generic disclosure	120
5.2.7	Product claim with process features	120
5.2.8	Non-technical distinguishing features	121
6.	Chemical inventions and selection inventions	121
6.1.	General	121

---

6.2.	Novelty of chemical compounds and groups of compounds	122
6.2.1	Anticipation of certain compounds	123
	a) Definition of a substance by its structural formula or other parameters	123
	b) Selection of starting substances from different lists	124
	c) Selection on the basis of a general formula	124
6.2.2	Novelty of groups of substances	125
6.2.3	Novelty of enantiomers	127
6.2.4	Achieving a higher degree of purity	127
6.3.	Selection of parameter ranges	129
6.3.1	Selection from a broad range	129
6.3.2	Overlapping ranges	131
6.3.3	Multiple selection	132
6.4.	Subject-matter group	134
7.	First and second medical use	134
7.1.	First medical use	134
7.1.1	Introduction	134
7.1.2	Scope of a purpose-related product claim	135
7.1.3	Protection of a preparation in the form of a "kit-of-parts"	136
7.1.4	Further technical information as compared with the state of the art	136
7.2.	Second (or further) medical use	137
7.2.1	Introduction	137
7.2.2	Transitional provisions	139
7.2.3	Purpose-limited product claims and Swiss-type claims – scope of protection	139
7.2.4	Novelty of the therapeutic application	141
	a) General	141
	b) New therapeutic application based on the group of subjects to be treated	141
	c) New technical effect	142
	d) Same illness	142
	e) New dosage regimen	143
	f) New therapy with a different mode of administration	144
	g) Interpretation of "substance or composition"	144
	h) Statement of purpose of surgical use for a known instrument	146
	i) Discovery of a previously unknown property of a compound underlying the known effect	146
	j) Whether there is a therapeutic method	147
8.	Second (or further) non-medical use	148
8.1.	Novelty criteria for use claims and process claims containing a purpose feature	148
8.1.1	General issues decided before the Enlarged Board of Appeal	148
8.1.2	Non-therapeutic treatment of animals	149
	a) Non-therapeutic application	150
8.1.3	Applicability of G 2/88 and G 6/88 to process claims	150
	a) General	150
	b) Different treatment of use and process claims	150

c)	Interpretation of process claims	152
d)	Use of a known process for a particular purpose	152
e)	Discovery of new properties/technical effects underlying the known use	154
f)	Use of a substance to achieve a technical effect only attained in special circumstances	156
8.1.4	Statement of purpose in non-medical use claims in view of Article 52(4) EPC 1973	156
8.1.5	Novelty criteria for product claims with purpose characteristics	156

## 1. General

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

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

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

## 2. State of the art

### 2.1. General

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

As a rule, there are no restrictions as to where, how or in what language the relevant information must have been made available to the public; nor is any limit stipulated as to how old the documents or other sources of the information may be (Guidelines G-IV, 1 – November 2015 version).

## **2.2. Applications with same filing or priority date**

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

## **2.3. Relevant date of documents**

For the purposes of determining novelty, a prior document should be read as it would have been read by a person skilled in the art on its "relevant date". The relevant date of a previously published document is its publication date, and that of a document within the meaning of Art. 54(3) EPC its date of filing (or, as the case may be, priority date) (Guidelines G-VI, 3 – November 2015 version).

According to the boards' established case law, for ascertaining the disclosure of a document forming part of the state of the art within the meaning of Art. 54(2) EPC, the relevant date is that of publication (see **T 205/91**, **T 737/00**, **T 1162/07**). For the purposes of examining novelty, a document is to be assessed from the perspective of the skilled person on the publication date, **T 305/94**. Interpreting a document using knowledge which only became available to the relevant experts between the publication date of the cited prior art and the filing or priority date of the application to be examined or the patent in dispute is an issue relating to inventive step, not novelty (see **T 205/91**).

## **2.4. Prior rights – Article 54(3) EPC**

### **2.4.1 European prior rights**

Pursuant to Art. 54(3) EPC the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in Art. 54(2) EPC and which were published on or after that date, shall be considered as comprised in the state of the art. However, such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step. The "date of filing" referred to in Art. 54(2) and (3) is thus to be interpreted as meaning the date of priority in appropriate cases (see also Guidelines G-IV, 5.1 – November 2015 version).

As part of the 2000 revision of the EPC, former Art. 54(4) EPC 1973 was deleted, so that any European application falling under Art. 54(3) EPC constitutes prior art with effect for all the EPC contracting states at the time of its publication. The revised Art. 54(3) EPC is applicable to European patent applications filed on or after the time the EPC 2000 entered into force. The deleted Art. 54(4) EPC 1973 is still applicable to European patents already granted and applications pending at the time the EPC 2000 entered into force.

In **T 1926/08**, in order to establish novelty with respect to document D1, the patent proprietors had filed two sets of claims for different contracting states. The patent at issue was granted before the date of entry into force of the EPC 2000. The point of dispute was whether or not R. 87 EPC 1973 was a rule implementing Art. 54(4) EPC 1973, or whether the situation was covered by Art. 123 and R. 138 EPC.

R. 87 EPC 1973 allowed different claims, description and drawings for different states both in the case of an earlier European patent application which was part of the state of the art under Art. 54(3) and (4) EPC 1973 and when a prior national right existed, while R. 138 EPC 2000 only provided for the latter case. The board held that R. 87 EPC 1973 applied to European patents granted before the entry into force of EPC 2000 because it is an implementing regulation to Art. 54(4) EPC 1973 and admitted a separate set of claims.

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

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

#### 2.4.2 Applicability of Article 54(3) EPC in cases of potentially colliding European parent and divisional applications

In **T 1496/11** the board found that the subject-matter of claim 1 of the parent application was only entitled to the filing date of 8 October 1997. The divisional application of the patent in suit disclosed an embodiment identical to that provided in the priority document. This embodiment of the divisional application was therefore entitled to the claimed priority date of 10 October 1996 and thereby anticipated the subject-matter of claim 1, which was only entitled to the filing date of 8 October 1997. Hence, the subject-matter of claim 1 of the parent application lacked novelty with respect to the divisional application under Art. 54(3) EPC.

In **T 557/13** several questions concerning partial priorities were referred to the Enlarged Board of Appeal, see in particular question 1 and 5: 1. Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document? 5. If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Art. 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic "OR"-claim of the said European patent application or of the patent granted thereon? See Chapter II.D.5.3 "Multiple priorities for one claim".

### 2.4.3 Excluded national prior rights

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

In **T 1698/09**, the board observed that, under Art. 54(3) EPC, the state of the art comprised the content of European patent applications filed before the priority date of the patent in suit and published after that date. It held that a German utility model was not a German or a European patent application. It made no difference that Germany had been designated in the patent in suit.

### 2.4.4 PCT applications as state of the art

Art. 153(5) EPC states that a Euro-PCT application shall be considered as comprised in the state of the art under Art. 54(3) EPC if the conditions laid down in Art. 153(3) or (4) EPC "and in the Implementing Regulations" are fulfilled.

Pursuant to R. 165 EPC a Euro-PCT application shall be considered as comprised in the state of the art under Art. 54(3) EPC if in addition to the conditions laid down in Art. 153(3) or (4) EPC (publication of the international application or its translation), the filing fee under R. 159(1)(c) EPC has been paid. Thus once the filing fee is paid for the conflicting application, it is considered to be an Art. 54(3) EPC application.

Under former Art. 158(2) EPC 1973, a Euro-PCT application was considered to be an Art. 54(3) EPC application if a translation was filed (where necessary) and the national fee paid.

In **T 404/93** the European patent application was limited to the contracting states Italy (IT), Netherlands (NL) and Sweden (SE) in view of an earlier international application, published after the filing date of the former. The board noted that the earlier PCT application had mentioned several EPC contracting states, including IT, NL and SE, as being designated for a European patent. However, when the earlier application had entered the European phase, no designation fees had been paid for IT, NL and SE. Accordingly, the board found that the earlier international application was not comprised in the state of the art under Art. 54(3) EPC 1973 for IT, NL and SE (see also **T 623/93**).

In **T 622/91** the respondent (patent proprietor) requested that the decision under appeal be set aside and the patent maintained for all designated contracting states. Two earlier international applications and the European patent had designated the contracting state France (FR). The board noted that the requirements of Art. 158(2) EPC 1973 (now



Art. 153(3) and (4) EPC and R. 159 EPC) were fulfilled, and considered the international applications as comprised in the state of the art relevant to the patent in suit in accordance with Art. 54(3) and Art. 158(1) EPC 1973 (now Art. 153(5) EPC). The board went on to examine claim 1 of the main request and found that the earlier application was novelty-destroying in so far as the same contracting state FR was designated.

In **T 1010/07** the board held that E4, a document cited in relation to inventive step which had been published before the priority date of the contested patent, was a publication under Art. 158(3) EPC 1973, i.e. the publication of a translation supplied to the EPO under Art. 158(2) EPC 1973 into an EPO official language (English) of an international application not published in an official language (Japanese). Although translations under Art. 158(2) EPC 1973 were not checked by the EPO, it was presumed that their content was identical to that of the published international application (see e.g. **T 605/93**). Only when there were reasonable grounds to doubt this presumption in a particular case was further investigation and, where necessary, the production of evidence required. Thus, as a translation of identical content, E4 was to be regarded as forming part of the prior art.

## 2.5. Non-prejudicial disclosures under Article 55 EPC

Art. 55 EPC specifies that a disclosure of the invention shall not be taken into consideration for the application of Art. 54 EPC, if it occurred no earlier than six months preceding the filing of the European patent application and 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 has displayed the invention at an official, or officially recognised, international exhibition.

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

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

In **T 585/92** (OJ 1996, 129) the board found that where a patent application was published early by a government agency as a result of an error, this was not of necessity an abuse in relation to the applicant within the meaning of Art. 55(1)(a) EPC 1973, however unfortunate and detrimental its consequences might turn out to be. In order to determine whether there was an abuse within the meaning of Art. 55(1)(a) EPC 1973, the state of mind of the "abuser" was of importance.

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

## **2.6. In-house knowledge not published before the priority date**

It is the consistent view of the boards of appeal that in-house knowledge or matter which cannot be identified as forming part of the state of the art within the meaning of Art. 54(2) EPC is irrelevant for substantive patentability (**T 1247/06**, see also **T 654/92**, **T 1001/98**, **T 671/08**, **T 2434/09**).

In **T 1001/98** the board did not consider it appropriate either for itself or for the examining division to base an assessment of substantive patentability (novelty and inventive step) upon subject-matter not identified as forming part of the state of the art within the meaning of Art. 54(2) EPC 1973. That was consistent with a number of previous decisions of the boards of appeal (such as **T 654/92**). In view of the appellant's declaration that the arrangement of figures 7(a) and 7(b) of the patent application was in-house knowledge not published before the priority date of the patent and given that the European search report did not reveal any corresponding document, the board reached the conclusion that the arrangement concerned could not be treated as being comprised in the state of the art within the meaning of Art. 54(2) EPC 1973 (see also **T 1247/06**).

## **2.7. Prior art acknowledged in a patent application**

According to the established case law of the boards of appeal (see **T 654/92**, **T 691/94**, **T 87/01**, **T 730/05**, **T 1449/05**, **T 211/06**), the prior art cited and acknowledged in a patent application for the purpose of formulating the technical problem may be used as the starting point for assessing novelty and inventive step (**T 628/07**).

In **T 654/92** the board stated that the expression "background art" in the English version of R. 27(1)(b) EPC 1973 was to be interpreted as referring to prior art within the meaning of Art. 54(2) EPC 1973. The practice of starting out from art known to the applicant but not public at the claimed priority date was inconsistent with the requirements of the EPC. Any such art had to be ignored in an assessment of inventive step.

On the question whether an applicant may resile from its indication of background art, either implicitly or explicitly, some boards have taken the view that, unless resiled from or clearly not prior art for other reasons, it may be relied upon as prior art (see **T 654/92**, **T 691/94**, **T 730/05**, **T 1449/05**, **T 1554/05**, **T 211/06** and **T 413/08**).

In **T 413/08** the board stated in the absence of any indication to the contrary, an acknowledgment of prior art by a patent proprietor might be accepted at face value. If a

patent proprietor resiled from an acknowledgment of prior art at a point in time which did not give rise to any procedural problems, the acknowledgement could no longer be relied upon.

## 2.8. Common general knowledge

### 2.8.1 Definition of "common general knowledge"

Determining what constitutes common general knowledge plays an important role in the assessment of novelty, inventive step and sufficiency of disclosure. In the assessment of inventive step and sufficiency of disclosure however, the skilled person's knowledge is taken to be one and the same, see Chapters I.D.8.3. (Skilled person – level of knowledge) and II.C.3. (Knowledge of skilled person relevant for assessing sufficiency of disclosure) for other decisions on common general knowledge.

According to established case law, common general knowledge is to be found in basic handbooks, monographs, encyclopaedias, textbooks and reference books. It is knowledge that an experienced person in the field in question is expected to have, or at least to be aware of, to the extent that he knows he could look it up in a book if he needed it. Statements in such works are often used as references to show what common knowledge is (T 766/91, T 234/93, T 590/94, T 671/94, T 438/97, T 1253/04, T 1641/11).

However, Art. 54(2) EPC 1973 does not limit the state of the art to written disclosure in specific documents only; rather it defines it as including "any other way" by which technical subject-matter is made available to the public. Therefore, the absence of a reference to a particular document does not mean that there is no state of the art, as this could reside solely in the relevant common general knowledge, which, again, might be in writing, i.e. in textbooks or the like, or be simply a part of the unwritten "mental furniture" of the notional "person skilled in the art" (T 939/92, OJ 1996, 309; T 329/04).

In T 766/91 the board stated that by its very nature common general knowledge could be inferred from a number of sources, and proof that something was general knowledge in a particular art did not depend on proof of any particular document being published at a particular date.

In T 786/00 the board stated that, according to established case law, when considering the question of novelty, a prior art document must 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 (cf. T 229/90, T 965/92).

In T 1117/14 the application was silent about how the claimed biodegradable implant was to be produced. The board stated that, according to established case law, the skilled person may use his common general knowledge to supplement the information contained in the application. It was convinced that the method formed part of the common general knowledge in the field. Although it had not yet made its way into

textbooks or monographs, it had been published in both the scientific and the patent literature and those skilled in the art relied on such articles and patent documents.

### 2.8.2 Patent specifications as common general knowledge

General common knowledge does not normally include patent literature and scientific articles (**T 206/83**, OJ 1987, 5; **T 171/84**, OJ 1986, 95; **T 307/11**, **T 1641/11**, **T 571/12**, **T 1000/12**). By way of exception, however, patent specifications and scientific publications may be considered to be common general knowledge (see **T 51/87**, OJ 1991, 177; **T 892/01**). In **T 412/09** the board stated that this is so in particular when a series of patent specifications provides a consistent picture that a particular technical procedure was generally known and belonged to the common general knowledge in the art at the relevant date (see also **T 151/05**, **T 452/05**, **T 1000/12**). Special conditions also prevail when a field of research is so new that the technical knowledge is not yet available in textbooks (see **T 51/87**, OJ 1991, 177; **T 772/89**, **T 892/01**, **T 890/02**, OJ 2005, 497). Going back as far as **T 206/83** (OJ 1987, 5) it was held that information which could only be obtained after a comprehensive search was not to be regarded as common general knowledge (see also **T 654/90**, **T 924/03**).

### 2.8.3 Specialist journals as common general knowledge

In **T 475/88**, the board's view was that the content of specialist journals, or "standard magazines", like the content of patent specifications did not usually belong to the common general knowledge of the average skilled person because it was not normally part of that person's active knowledge and had to be acquired through a comprehensive search. In **T 676/94** the board concluded that the question of whether the contents of a specialist journal formed part of the average knowledge of a skilled person depended on the facts of the case. In **T 595/90** (OJ 1994, 695), an article in a specialist journal reporting on the results of a classic test was regarded as common general knowledge.

Numerous publications in the specialist press over a fairly short time, reporting on meetings and research in a particularly active field of technology, could reflect common general knowledge in this field at that time (**T 537/90**).

### 2.8.4 Databases as common general knowledge

In **T 890/02** (OJ 2005, 497) the board pointed out that the skilled person did not necessarily have knowledge of the whole technology. Having regard to the case law, the board established three criteria for correctly assessing the common general knowledge of skilled persons. First, the skills of such a person included not only having basic general knowledge of the particular prior art, but also knowing where to find such information, be it in a collection of relevant studies (see **T 676/94**), a scientific publication or a patent specification (see **T 51/87** and **T 772/89**). Second, it could not be expected that, in order to identify this common general knowledge, the skilled person would carry out a comprehensive search of the literature covering virtually the whole state of the art. No undue effort in the way of such a search could be required of the skilled person (see **T 171/84**, OJ 1986, 95; **T 206/83**, OJ 1987, 5; **T 676/94**). Third, the information found

had to be unambiguous and usable in a direct and straightforward manner without doubts or further investigation (see **T 149/07**).

In **T 890/02** the board concluded that whilst not being *stricto sensu* encyclopaedias or handbooks, databases (a) which are known to the skilled person as an adequate source for obtaining the required information, (b) from which this information may be retrieved without undue burden and (c) which provide it in a straightforward and unambiguous manner without any need for supplementary searches represent the common general knowledge of the skilled person as defined in the case law, and can be taken into account as such in deciding whether the teaching of a document which *prima facie* destroys novelty is sufficient to be reproducible.

### 2.8.5 Proof of common general knowledge

Where an assertion that something is common general knowledge is challenged, the person making the assertion must provide proof that the subject-matter in question is in fact common general knowledge (**T 438/97**, **T 329/04**, **T 941/04**, **T 690/06**). In the case of any dispute as to the extent of the relevant common general knowledge this, like any other fact in contention, has to be proved, for instance by documentary or oral evidence (**T 939/92**, OJ 1996, 309, see also **T 766/91**, **T 1242/04**, OJ 2007, 421; **T 537/90**, **T 329/04** and **T 811/06**). The proof is regularly supplied in citing literature (**T 475/88**). According to **T 766/91** and **T 919/97**, evidence of general technical knowledge need be submitted only if the latter's existence is disputed.

In **T 1110/03** (OJ 2005, 302), the board stated that when evaluating evidence relating to the issues of novelty and inventive step it was necessary to distinguish between a document alleged to be part of the state of the art within the meaning of Art. 54(2) EPC 1973 - in the sense that the document itself was alleged to represent an instance of what had been made available to the public before the priority date of the opposed patent - and a document which was not itself part of the state of the art, but which was submitted as evidence of the state of the art or in substantiation of any other allegation of fact relevant to issues of novelty and inventive step. Only a document of the first kind could be disregarded on the sole ground that it was post-published; documents of the second kind did not stand or fall by their publication date even on issues of novelty and inventive step. Similarly a technical review article is by definition an account of the common general knowledge in the art prior to its own publication date – which could bear *inter alia* on the issue of enabling disclosure of a prepublished document and hence on the novelty of claimed subject-matter (**T 1625/06**, **T 608/07**, **T 777/08**).

In **T 608/07** the respondent tried to query the relevance of D6 because it was published after the priority date of the patent in suit. The board stated that D6 related to published course material of a university and to subject-matter well known in the art for many years. Hence, albeit published after the priority date of the patent in suit, D6 provided indirect evidence for common general knowledge.

### 3. Availability to the public

#### 3.1. General

Pursuant to Art. 54(2) EPC the state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

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

#### 3.2. Ways of making information available to the public

##### 3.2.1 Publications and other printed documents

###### a) General

For a written description to be regarded as having been made available to the public, it suffices that it was possible for the public to gain knowledge of its content without any obligation of confidentiality restricting the use or dissemination of such knowledge. As to whether written information contained in a document has been made publicly available, it is generally necessary to establish all the facts: where did the documents turn up; under what circumstances were the documents made accessible to the public, and who constituted the public in the case in question; was there any explicit or implicit confidentiality agreement; and when (date or period of time) were said documents publicly available (**T 526/12**).

###### b) Company papers

In **T 37/96** the board had to decide on the public availability of some prior-art documents. Two of them were **typical company papers**. The board held that unlike scientific or technical journals, such papers as prospectuses or product descriptions could not be assumed to have automatically made their way into the public domain. On the contrary, whether they had indeed been available to the public on a given date depended on the particular circumstances and the evidence available (see also **T 77/94**, **T 1017/01**). In **T 19/05** the board stated that the document was a company-generated technical paper and could thus not be assumed to have automatically made its way into the public domain.

In **T 278/09**, when examining whether a product data sheet had been available to the public, the board observed that such a sheet merely described the components and

features of newly developed or improved products, but as such contained no evidence in relation to marketing or any public availability. The decision whether and when to market a product could depend on other circumstances, such as the economic climate and the relevant firm's marketing policy. In any event, product data sheets did not necessarily become information destined for the public when it was decided to market the product they described, as customers to whom the sheet was distributed could be obliged to treat it as confidential. It was therefore insufficient in such a case to decide on the mere balance of probabilities that simple suppositions that an allegedly novelty-destroying product data sheet had been made available to the public were accurate (see also **T 738/04**). A product data sheet thus does not provide the same level of information as an advertising brochure (**T 184/11**, see below).

c) Advertising brochure

**T 804/05** concerned the public availability of an advertising brochure usually distributed amongst interested specialists and bearing a date on its cover. The board decided that, in the absence of any evidence to the contrary, it had to be assumed that this brochure had been made available to interested customers, without any obligation to keep it secret, in the months following the cover date.

In **T 743/89** the board held that it was in the respondent's own interest to ensure widespread distribution of the commercial pamphlet in order to inform as many potential customers as possible of this latest development in a highly competitive field. 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 (see also **T 1748/10**).

In **T 146/13**, the proprietor maintained that the opponent had not supplied proof that a commercial brochure (D6) had been distributed before the priority date of the patent in suit. The board noted that there was a gap of more than 24 months between the date of printing and the priority date and, citing the established case law (**T 287/86**, **T 743/89**, **T 804/05**, **T 1748/10**), held that this was sufficiently long to presume that D6 had been made available to the public. The board was also convinced that it was standard practice not to print a commercial brochure unless it was to be distributed to interested groups with a view to attracting the attention of potential clients. The publisher of D6 had likewise had it printed in an effort to present its products and their advantages to its target market (see also **T 184/11**).

In **T 77/94**, the argument that a publicity notice's date of issue was necessarily immediately after its date of printing (because such notices were only produced in order to be issued) was held to be merely a supposition which required confirmation; in reality, things were often different (see also **T 1440/04**).

d) Report available in the specialist field

In **T 611/95** a research institute known in the field was in possession of a **report** anticipating the invention, which anyone could view at the institute or order from it on request. Two papers published prior to the priority date referred to this report and indicated where it could be obtained. In the board's view, the report was therefore publicly available. As far as availability to the public was concerned, the institute was not to be equated with a library, but the information in the documents had indicated to experts in the field that anyone could inspect or order the report there.

e) Books

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. 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.

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

f) Instruction manual

**T 55/01** concerned the public availability of an instruction manual, bearing a publication date, for the satellite receiver of certain makes of television set. The board observed that televisions were mass-produced consumer products which were rapidly distributed to the market without any obligation of confidentiality. It held that no further evidence was necessary to prove that televisions were actually sold to specified customers and that the handbook accompanying them was made available to the public within a period of about four months between their established production date and the priority date of the patent in suit, thereby taking into account the fact that events on the mass market such as the appearance of new television products were readily accessible to everybody, in particular to competitors, who would normally observe the market carefully. Hence, the balance of probabilities was the applicable standard of proof in cases such as this, as distinct from **T 472/92**.

g) Patent and utility models

**T 877/98** raised the question whether a German patent had become publicly available upon notification of the grant decision if the application had not been published previously. The board took the view that the patent had not become available until publication of grant in the patent bulletin; only from that point on was the file open for inspection. It thus endorsed the view of the German Federal Patents Court (decision of 23.12.1994, 4W(pat)41/94, BIfPMZ 1995, 324).



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

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

#### h) Abstracts of documents

In **T 160/92** (OJ 1995, 35) 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 (**T 462/96**).

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

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

#### 3.2.2 Lectures and oral disclosure

In **T 877/90** an oral disclosure was regarded as having been made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of its content and there was no bar of confidentiality restricting their use or dissemination of such knowledge (see also **T 838/97**).

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

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

In **T 1212/97** the opponent had submitted that the invention had been made available to the public at a lecture given some days before the priority date to an audience of some 100 to 200 persons. The question to resolve was whether there was any safe and satisfactory evidence regarding the content of what had been made available to the public at the lecture. The board did not consider evidence from the lecturer alone to be satisfactory evidence as to what had been made available to the public at the lecture. Even an audio or video tape recording made of the lecture, unless publicly available, would have to be treated with caution, if several hearings or viewings were necessary to extract all the information. Information appearing in each of the contemporary written notes made at the lecture by at least two members of the audience could usually be regarded as sufficient, whereas information in the notes of a single member of the audience might be inadequate, as it reflected the thoughts of the listener rather than solely the content of the lecture. If the lecturer read his lecture from a typescript or manuscript, or the lecturer wrote up his lecture subsequently, and the lecture was subsequently published in that form as part of the proceedings, then the written version might be taken as some evidence of the contents of the lecture, though with some caution as there would be no guarantee that a script was completely and comprehensibly read, or that a write-up had not been amplified. Most useful would be a handout given to the public at the lecture, containing a summary of the most important parts of the lecture and copies of the slides shown. None of those types of evidence were available in this case (see also **T 1057/09**).

In **T 2003/08** the board observed that, in contrast to a written document the contents of which are fixed and can be read again and again, an oral presentation is ephemeral. Therefore, the standard of proof for ascertaining the contents of an oral disclosure is high. What has been said, or to use the terms of Art. 54(2) EPC, what has been "made available to the public" has to be put beyond reasonable doubt. The board noted that in case **T 1212/97** the board had expressed the view that "written notes made at the lecture by at least two members of the audience can usually be regarded as sufficient" for that purpose. A fact also indicated by the board was that the amount of evidence necessary to establish the content of an oral presentation beyond reasonable doubt was to be judged on a case-by-case basis, i.e. it depends on the quality of the evidence in each case. In the current board's view, decision **T 1212/97** could not be interpreted as setting an absolute standard for the amount of evidence necessary to prove the contents of an oral disclosure. The board considered that there may be circumstances where evidence from the lecturer and only one member of the audience is convincing enough to reach the standard of proof – i.e. beyond reasonable doubt. In the case at issue, however, evidence from the lecturer and a member of the audience, provided by them in the form of both affidavits and oral testimony, was not considered by the board to prove beyond reasonable doubt that the subject-matter of the claim was disclosed during the lecture.

With respect to oral presentations during a conference, the board in **T 667/01** stated that: a declaration of the presenter as to the content of his presentation would not usually be regarded as sufficient since he might have deviated during his presentation from what he intended to present and from what he later remembered as having presented, or he might have presented relevant issues in such a way that the audience was unable to take note of them. If the extent to which the audience understood the presented issues remained uncertain, the established standard of proof typically required a further, independent statement by a person having attended the presentation. Considerable doubt had to remain as to whether the presenter could after 12 years still remember what exactly was presented.

### 3.2.3 Internet disclosures

#### a) General

Disclosures on the internet are generally regarded as part of the state of the art within the meaning of Art. 54(2) EPC. Information disclosed on the internet or in online databases is considered to be publicly available as of the date it was publicly posted (see **T 2339/09** and, for full details, Guidelines G-IV, 7.5 – November 2015 version).

For more information on the standard of proof required for internet disclosures, see Chapter III.G.4.2.3 "Archives and internet publications".

#### b) Public availability of a document stored on the World Wide Web

Both **T 1553/06** and **T 2/09** dealt with the question of the public availability of documents saved on the World Wide Web.

In **T 1553/06** the board developed a test for assessing the public availability of a document stored on the World Wide Web which could be found via a public web search engine on the basis of keywords. In devising this test the board started from its finding that the mere theoretical possibility of having access to a means of disclosure did not make it become available to the public within the meaning of Art. 54(2) EPC 1973. What is required, rather, is a practical possibility of having access, i.e. "direct and unambiguous access" to the means of disclosure for at least one member of the public as set out in **G 1/92** (OJ 1993, 277) and **T 952/92** (OJ 1995, 755):

If, before the filing or priority date of the patent or patent application, a document stored on the World Wide Web and accessible via a specific URL (1) could be found with the help of a public web search engine by using one or more keywords all related to the essence of the content of that document and (2) remained accessible at that URL for a period of time long enough for a member of the public, i.e. someone under no obligation to keep the content of the document secret, to have direct and unambiguous access to the document, then the document was made available to the public within the meaning of Art. 54(2) EPC 1973.

In **T 2/09** the board had doubts as to whether e-mails transmitted over the Internet could be accessed and searched in a way comparable to that of webpages, independent of whether or not access to and disclosure of the content of the e-mail were lawful. The board was rather of the opinion that the differences between webpages and such e-mails make a strong prima facie case against public availability of the latter. The board decided that the content of an e-mail did not become available to the public within the meaning of Art. 54(2) EPC 1973 for the sole reason that the e-mail was transmitted via the internet before the filing date.

c) Publication date

In **T 1134/06** the board found that if an Internet disclosure was to be used as prior art, a strict standard of proof should be adopted. Thus, the fact that an Internet disclosure formed part of the state of the art under Art. 54(2) EPC 1973 should be proved "beyond any reasonable doubt". Concerning the latter question, it would in most cases be necessary to address the main concern of reliability surrounding the Internet, in particular so as to establish whether, and to what extent, a retrieved disclosure was true to the disclosure appearing at that date. The board went on to state that in certain cases, where a web site belonging to a reputable or trusted publisher published online electronic versions of paper publications, content and date could be taken at face value, and the need for supporting evidence could be dispensed with. Where a disclosure had been retrieved from a resource such as the Internet Archive, further evidence concerning the history of the disclosure, whether and how it had been modified since the date it originally appeared on a web site would be necessary. This could be in the form of an authoritative statement from the archivist. Alternatively, an appropriate statement as to the content, either from the owner or author of the archived web site which included the disclosure could suffice.

In **T 1875/06** the board fully agreed with this finding in decision **T 1134/06** and applied the strict standard of proof to document (3), retrieved from the internet by the examining division when establishing the supplementary European search report. Document (3) was a printout of a web page. At the date of the decision, the URL indicated in the supplementary European search report did not permit retrieval of document (3) or of any other document. Proof of the above assumption regarding the public availability of document (3) would depend on suitable further evidence.

In **T 286/10** the board did **not** share the conclusion reached in **T 1134/06** that the prior publication on the internet had to be proved beyond all reasonable doubt. It found no legal basis for a standard of proof other than that applying to prior-art disclosures in general. Internet publications presented a special problem compared to conventional publications, given the potential for making changes that were not easily traceable. Internet publications did not in principle call for a different standard of proof; any uncertainty linked to such disclosures had to be overcome in a way that ensured a sufficient degree of probability and established a presumption of availability that would convince the judge. In the case in point the board held that [www.jacksonville.com](http://www.jacksonville.com), operated by the "Times Union" newspaper, was prima facie a known and reliable source of information, and it concluded that this was enough for it to presume that A9 had been

published on 28 May 2000. Document A10 had apparently been archived by the internet archive at [www.archive.org](http://www.archive.org) on 9 July 2001. The board considered that the fact that a document had been archived by the internet archive on a certain date, naturally barring special circumstances that justified suspicion, usually sufficed by itself to warrant a presumption that the document had been normally accessible to the public on the day of its downloading and made available to the public via the internet archive itself shortly thereafter.

In **T 1961/13** the examining division was of the view that document D2 was made available to the public on or before 15 February 1999 through its publication on a website at the URL from which it had been retrieved. As evidence for this assertion, the examining division referred to document D7, which was a screenshot of search results returned by Google in response to a "quick search on Google cached pages" and which showed the URL to document D2 together with the date "15 Febr. 1999". According to the examining division, this showed that the URL to document D2 had been "snapshot" by Google on 15 February 1999. The examining division's reasoning based on the screenshot shown in document D7 was refuted by the board. Document D7 showed the result, filtered by a data range, of a regular Google search for internet documents with part of the title of document D2 used as a search criterion. The single result returned appeared to point to document D2 at the same URL from which it was retrieved. This did not mean that document D2 was cached (or "snapshot") by Google, but that Google at some point in time had found and indexed document D2 at this URL. The board concluded that a date reported by Google is inherently unsuitable to serve as evidence of the publication date of a document.

In **T 1469/10** the board pointed out that the ETSI 3GPP organisation, a reputable standardisation body, had clear and reliable rules for publishing any meeting contributions, in particular as to the documentation of the uploading to the public file server. Therefore, a publication date indicated on the 3GPP document lists ("timestamp") was of high probative value and might serve as prima facie evidence as to the date on which the document was available to the public. Accordingly, the board pointed out that the dates ("timestamps") indicated on the 3GPP document lists corresponded to the dates on which the respective documents were uploaded to the 3GPP file server.

In **T 2339/09**, according to the search report, D4 was an internet article dated 22 May 2006 and relating to a product catalogue of HBE GmbH, which had been found in an internet archive at [www.archive.org](http://www.archive.org) on 21 March. The date of the catalogue's online publication was therefore 22 May 2006, i.e. before 17 November 2006, which was the filing date of the application in question. Moreover, the catalogue bore an imprint with the date "11.10.04", which suggested that it had been published "offline" even earlier. In any event, the relevant dates were prior to the filing date and it therefore had to be found that D4 formed part of the state of the art. The board held that the applicant (appellant) bore the burden of presenting the case for and proving the contrary, i.e. that D4 had not been published before the filing date.

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

### 3.2.4 Prior use

#### a) General issues

The state of the art is held to comprise everything made available to the public by means of a written or oral description, **by use**, or in any other way, before the date of filing of the European patent application (Art. 54(2) EPC). Use can take the form of producing, offering or marketing or otherwise exploiting a product, offering or marketing a process or its application or applying the process. Marketing may be effected, for example, by sale or exchange. (see Guidelines G-IV, 7.1 – November 2015 version). Instances of public prior use or availability in any other way will typically be raised in opposition proceedings. Under established case law, the following has to be clarified to determine whether an invention has been made available to the public by prior use: (i) when the prior use occurred, (ii) what was made available to the public through that use and (iii) the circumstances of the use, i.e. where, how and by whom the subject-matter was made public through that use.

For the preconditions for claiming prior use, see Chapters IV.D.2.2.9 c) "Alleged public prior use" and III.G.4.3.2 "Public prior use".

#### b) Public prior use occurred

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

**T 1416/10** concerned the public prior use of a washing machine manufactured and sold by the patent proprietor under model number WD-R100C. The board noted that, although there was no proof on file that the specific washing machine had indeed been available to the public prior to the relevant date of the patent in suit, notwithstanding that it was highly unlikely that this specific machine had remained with the manufacturer for more than one month before being delivered for sale to a distributor, the evidence submitted by the opponent allowed the conclusion to be drawn beyond any reasonable doubt that washing machines with the model number WD-R100C had been publicly available to the distributors for public sale prior to the relevant date of the patent in suit.

In **T 1682/09** the appellant alleged public prior use of an assembly of a weighing system. The board observed that, according to the established case law, the sale of an apparatus is, in the absence of any special circumstance, sufficient to render it available to the public. In the case at issue, the assembly had only been leased; it was not owned by the company. The board however found that mounting the assembly at the company's premises and the subsequent conventional start-up, training and maintenance

procedures of the assembly at the same premises had rendered its features available to the company, which had constituted a member of the public at that time.

c) No public prior use

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

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 (cf. **G 6/88**).

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

In **T 901/95** the board decided that merely claiming that generating equipment was installed into ships at three different shipyards and thus available to the public was not enough to demonstrate its obvious prior use. Shipyards were normally considered restricted areas and thus not open to the general public. Nor could the possibility be excluded that shipyards' business partners might secure their common interests through explicit or tacit secrecy agreements, in the absence of other protection. In the case in point, it was also questionable whether the relevant process steps and the functional arrangement of the switching means were apparent from merely looking at built-in apparatus; nor was it certain when the generating installations had become operational. The board did not in these circumstances consider the alleged public prior use.

In **T 1410/14**, it was common ground between the parties that a vehicle ("City Runner") with the claimed features had been test driven on a route forming part of a town's public transport network on a particular date, but also that the coupling joint in question could have been seen only from above, namely from an overhead pedestrian bridge. For the board, it was not proven that this prior use would have enabled a skilled person to identify all the features of the invention. In particular, the appellant had failed adequately to show that a specific feature (a bracket forming part of the pivot bearing and held displaceably on the coach body) had been apparent to the skilled person during the test drives. Summing up, the board held that features of subject-matter that had been visible only briefly could be considered to have been made publicly available only if it could be shown beyond doubt that they had been clearly and directly apparent to the skilled person for that short time.

d) Internal structure or composition of a product

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 952/92**, OJ 1995, 755, the board stated that information as to the composition or internal structure of a prior sold product is made available to the public and becomes part of the state of the art if **direct and unambiguous access** to such information is possible by means of known analytical techniques which were available for use by a skilled person before the relevant filing date (see also **T 2/09**). The board also stated that the likelihood or otherwise of a skilled person analysing such a prior sold product, and the degree of burden (i.e. the amount of work and time involved in carrying out such an analysis), is in principle irrelevant to the determination of what constitutes the state of the art. The novelty of a claimed invention is destroyed by the prior disclosure (by any means) of an embodiment which falls within the claim. The possibility of a complete analysis of a prior sold product is not necessary. The novelty of a claim is destroyed if an analysis of a prior sold product is such as to inform the skilled person of an embodiment of the product which falls within the claim.

In **G 1/92** (OJ 1993, 277) the Enlarged Board of Appeal held 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. It also stated that "An essential purpose of any technical teaching is to enable the person skilled in the art to manufacture or use a given product by applying such teaching. Where such teaching results from a product put on the market, the person skilled in the art will have to rely on his general technical knowledge to gather all information enabling him to prepare the said product. 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 472/92** (OJ 1998, 161) the board referred to **G 1/92** and concluded that the printability characteristic of the material was not a property that became available to the public by their mere delivery, since this was clearly an extrinsic characteristic requiring interaction with specifically chosen outside conditions. Thus, such characteristic could not be considered as already having been made available to the public (see also **T 267/92**).

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



In **T 301/94** the board decided that the skilled person would have been able to reproduce the green glass without undue burden and that this was sufficient to meet the requirement of reproducibility set out in **G 1/92**. A skilled person must be able to prepare the product without undue burden on the basis of his general technical knowledge and knowing the composition or internal structure of the product, whatever the scale of production (laboratory, pilot or industrial scale). The board held that when a commercially available product could be analysed by the analytical methods known on the priority date and could also be reproduced, its chemical composition formed part of the state of the art even if a skilled person could not have recognised *a priori* (i.e. before performing an analysis), on the basis of the common general knowledge on the priority date that at least one component was present in the product, or was present in an "unusual small" amount (referring to **T 952/92**, OJ 1995, 755; **T 406/86** OJ 1989, 302; **T 390/88**; **G 1/92**; see also **T 370/02**).

In **T 947/99** the alleged public prior use concerned a visit to an ice-cream factory. Although it had not been established that a feature of the manufacturing process had been explicitly explained to the visitors, the board decided that information about the procedure had been publicly disclosed. The board observed that, in accordance with the principles set out in **G 1/92**, it was the fact that direct, unlimited and unambiguous access to any particular information regarding the manufacturing processes known per se was possible which made these processes available to the public within the meaning of Art. 54(2) EPC 1973, whether or not there was any reason to look or ask for such information.

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 **T 461/88** (OJ 1993, 295) the board ruled that a control program stored on a microchip had not been made available to the public if the analysis of the program would require an expenditure of effort on a scale which could only be reckoned in man-years and if, for economic reasons, it was highly improbable that the sole purchaser of the machine controlled by the program had carried out such an analysis (see obiter dictum ruling in **T 969/90**, see also **T 212/99**).

### 3.2.5 Biological material

In the field of microbiology, the board, in **T 576/91**, conceded that an unwritten rule may exist within the scientific community, whereby biological material referred to in a scientific publication can be freely exchanged. However, this does not amount to an obligation, so that any biological material which is the subject of a publication can be considered as being publicly available. The board further stated that if contractual obligations between parties resulted in access to biological material being deliberately restricted to a group of persons bound either by a research contract or a licence, it could not be concluded that this material had been made "available to the public" within the meaning of Art. 54(2) EPC 1973 (see also **T 351/98**). In **T 128/92** the board stated that, for a

complex biochemical to be made available to the public, the minimum that would seem to be required for publication was a notice to those in the field that samples of the biochemical could be obtained on request, and clear evidence of exactly what the biochemical was.

### **3.3. The concept of "the public"**

The boards considered the concept of "the public" in several decisions. According to their case law, information is generally to be regarded as having been made public if even just one single member of the public is in a position to gain access to it and understand it, and if there is no obligation to maintain secrecy (**T 1081/01**, **T 229/06**, **T 1510/06**, **T 1309/07**, **T 2/09**, **T 834/09**, **T 1168/09**).

In **T 1829/06** the board stated that, according to established jurisprudence, information was considered to be made available to the public even if only one member of the public had access to it and there was no bar of confidentiality restricting the use or dissemination of such information. The fact that this member of the public acted as a straw man or that the opponent itself could have had difficulties in obtaining the article was immaterial.

#### **3.3.1 Sale to a single customer**

According to the established legal practice a single sale was sufficient to render the article sold available to the public within the meaning of Art. 54(2) EPC 1973 provided the buyer was not bound by an obligation to maintain secrecy. It was not necessary to prove that others also had knowledge of the relevant article hatten (**T 482/89**, OJ 1992, 646, see also **T 327/91**, **T 462/91**, **T 301/94** and **T 783/12**).

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

If a product can be analysed, its composition also becomes public on its sale to a third party (**T 897/07**).

#### **3.3.2 Making available to a person not skilled in the art**

In **T 953/90** and **T 969/90** the boards pointed out that information has been made public even if the sale was made to a person not skilled in the art.

In **T 809/95** the patentee justified its position on non-disclosure essentially on the ground that the test persons were not skilled in the art. It cited **T 877/90**. The board noted that the latter decision dealt with information made public by oral disclosure at a lecture. Public disclosure was there linked to the condition that the audience had to include skilled persons capable of understanding the lecture. Such considerations seem appropriate to an oral disclosure but are not transferable to the case of information made public by making an article available for free use.

### 3.3.3 A limited circle of people

According to the case law of the boards of appeal the information is publicly available where it was made available to a limited circle of people (**T 877/90** - congress; **T 228/91** - course; **T 292/93** - demonstration for potential customers conducted on the premises of a company with close links to the opponent). Whether or not a member of the public has actually accessed the information is irrelevant (see **T 84/83**). In **T 877/90** an oral disclosure was regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the disclosure and there was no bar of confidentiality restricting the use or dissemination of such knowledge war (see also **T 300/86** on a written description and **T 443/09** on public prior use).

According to **T 165/96** which concerned the public availability of technical information drafted in Danish and disclosed in an insert in a minor small-ads newspaper (circulation: 24,000) distributed in the suburbs of Copenhagen, the "public" within the meaning of Art. 54(2) EPC 1973 did not presuppose a minimum number of people or specific language skills or educational qualifications. It followed that the residents of a Copenhagen suburb were held to represent the public.

In **T 1085/92** the board ruled that a company's own staff could not normally be equated with "the public" within the meaning of Art. 54(2) EPC 1973 (see also **T 1464/05**, **T 1057/09**).

In **T 1081/01** the board observed that if, at the time of receipt of the information, the recipient was in **some special relationship to the donor** of the information, he could not be treated as a member of the public, and the information could not be regarded as published for the purpose of Art. 54 EPC 1973. Even if this special relationship were later to cease, so that the recipient was now free to pass on the information, the mere cessation of the special relationship did not make the information available to anyone else (see also **T 1057/09**).

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 313/05** the respondents asserted that document D30 had been made available to the public at an international workshop. The board came to the conclusion that the public availability of document D30 before the priority date of the patent in suit could only be regarded as established if, in view of the evidence, it had no reasonable doubt in this respect. This requirement was not met (see also **T 1335/05**).

### 3.3.4 Public library

In **T 834/09** the board stated that the person in charge of the reception and date stamping of an incoming document at a public library is without any doubt a member of the public as this staff member is in no way bound by any obligation to maintain secrecy about the publications he/she handles and the content thereof, and after all, his/her very

function as a staff member of a public library is to make information available to the public. The board went on to state that in the case of a written disclosure it is irrelevant whether the staff member is a person skilled in the art or not, because the content of a written disclosure can be freely reproduced and distributed even without understanding it. Thus the board held that the reception and date stamping of an incoming document by a staff member of a public library makes the document available to the public.

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

In **T 1137/97** the board stated that the strength of the presumption in favour of the accuracy of a "Received" date marking appearing on the copy of a journal in a library as evidence of the actual date when the journal was made available to the public would depend on the library routine used. The board did not accept a handwritten date on the cover of a journal in view of other evidence.

In **T 729/91**, one relevant document was an issue of a periodical intended for hoteliers and caterers. In accordance with the evidence brought forward in the case, a copy of this periodical was received by a particular library, i.e. before the priority date of the patent in suit. The librarian stated that publications were "generally available to the public as of the date of receipt". In the present case, it was, in the board's view, likely that the publication was available as from the date of receipt.

### **3.4. Obligation to maintain secrecy**

#### **3.4.1 General**

If the person who was able to gain knowledge of the invention was under an obligation to maintain secrecy, the invention cannot be said to have been made available to the public, provided the person did not breach that obligation. 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. Whether a tacit secrecy agreement between parties exists, depends on the peculiar circumstances of the specific case (**T 1081/01**, **T 972/02**, **T 1511/06**), e.g. the commercial inter-relationship between and the commercial interests of the companies involved (**T 913/01**; see also **T 830/90**, OJ 1994, 713, **T 782/92**, **T 37/98**).

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

make the text available to the public, and not as actually making the text available to the public.

#### 3.4.2 Parts for serial production

In **T 1168/09**, two prior uses were alleged: the supply of 170 ESG 400 control units and the supply of 111 143 ESG 300/600 control units. No information had been submitted with regard to the conditions of supply and, in particular, as to whether or not confidentiality had been agreed. The board therefore investigated whether, in the light of the business relationship between the supplier and the customer, it had to be presumed that an obligation to maintain secrecy had been tacitly agreed. A tacit obligation to maintain secrecy could be presumed, for instance, where business partners had a shared interest in confidentiality. However, such an interest could only be presumed until the parts had been supplied for serial production because, from then on, the parts were destined to be fitted in cars for sale and so made available to the public. In other words, a shared interest in confidentiality could no longer be presumed once parts had been delivered for serial production (see **T 1512/06**). In the case at hand, the board found that the large number of control units supplied suggested that they had not been test units. It therefore held that they had been publicly available.

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

#### 3.4.3 Distribution of prospectuses, technical descriptions

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

#### 3.4.4 Commercial inter-relationships and interests

In the following cases, the boards found that there was an (implicit) obligation to maintain secrecy:

In **T 1085/92** the board took the view that, where contractual relations and development agreements existed, a secrecy agreement could be assumed to exist.

In **T 838/97** the board held that an agreement which ruled out availability to the public did not necessarily have to be a contract made in writing, as an implicit or implied agreement could also be taken into account (see e.g. **T 818/93**).

In **T 830/90** (OJ 1994, 713) the board, faced with the facts of the case, 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.

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

In **T 2/09** the board took the view that, where a party's own interest in secrecy could be established, then the situation would be analogous to that of a non-disclosure agreement between the parties involved.

In **T 274/12** the board concluded that there had been no implicit obligation to maintain secrecy. As evidence of public prior use, the appellants had cited documents they regarded as proof that a company had had talks with potential suppliers about developing a new product. The board shared the view taken by the German Federal Court of Justice (Bundesgerichtshof) in its decision X ZR 6/13 that an offer addressed not to the public but to a (potential) contractual partner could, in itself, be regarded as relevant prior art only if experience showed that the knowledge divulged in it to the recipient was likely to have been disseminated indiscriminately to third parties. According to the German Court of Justice, that could not readily be presumed where the offer related to the production of something yet to be developed, because both the party selected or wishing to develop it and the contractual partner wishing to benefit in some way from its development might have an interest in keeping the development project secret until the product went to market. An experience-based conclusion could be drawn only if at least one act of communicating knowledge as part of, for instance, an offer or delivery, was established which could then be assessed in the light of experience.

#### 3.4.5 Demonstrating products for presentation purposes

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

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

In **T 823/93**, according to the board, the development of a new apparatus is usually kept secret from competitors. In the case at issue, the development of the apparatus had to be regarded as the result of co-operation between the opponent and the client. The board therefore took the view that, on the basis of these facts, it could be assumed that none of the parties had an interest in disclosing any information about the apparatus and it was likely that the technical reports exchanged between the parties were tacitly required to be treated as confidential. The board also held that the general conditions of business, which had become the conditions of contract and required the plans, designs and other documents to be handled confidentially, also extended to verbal information and details given during the presentation of the apparatus.

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

#### 3.4.6 Presenting the product in writing

In **T 541/92** a sub-contractor had given sketches of a device to its client. In the board's view this constituted an obligation to maintain secrecy. It was standard practice for clients and their subcontractors to keep their projects secret, and allegations to the contrary required convincing proof. Likewise in **T 887/90** the obligation to maintain secrecy was derived from the circumstances.

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

In **T 818/93** several steps and approaches had been taken within the context of business relationships which were necessary to bring the project to a successful conclusion. The board held that such negotiations were confidential by nature, in view of the comparable interests of the parties involved, and implied a secrecy agreement.

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

### 3.4.7 Making samples/products available for test purposes

In the following cases, the boards found that there was an obligation to maintain secrecy:

A product made available for test purposes is to be treated as confidential. Sale of the product in a limited quantity is regarded as sale for test purposes, if the product is normally sold in large quantities (see **T 221/91**, **T 267/91** and **T 782/92**). In **T 221/91**, the board held that it was for the patent proprietors to prove the existence of an obligation to maintain secrecy when the opponents had proved that the invention had been made available to the public and the patent proprietors had claimed the existence of a secrecy agreement (see also **T 1407/09**).

In **T 37/98** a limited quantity of tape laminates had been delivered to three customers of the appellant. The delivered material had been used exclusively for test purposes, even after the priority date of the patent in suit. This was confirmed by the fact that such a laminate was usually delivered in large quantities. The board concluded that the delivered material had to be treated as confidential. In a case where only test specimens were sent to a customer, it had to be assumed in principle that at least an inherent secrecy agreement existed. If this should exceptionally not be true, the exception from the usual practice had to be proved. The mere statement that there was no secrecy agreement, as made in the present case, was not sufficient for this purpose.

There was no obligation to maintain secrecy in the following cases:

In **T 7/07** a third party had claimed inter alia that the main claims of the patent lacked novelty over a prior use, namely, the conduct of clinical trials with contraceptives containing the composition claimed in the patent. The participants had been informed of the ingredients but had not signed a confidentiality agreement, and not all unused drugs had been returned. The board came to the conclusion that the handing out of the drugs to the participants rendered them publicly available and that it was possible for the skilled person to discover the composition or the internal structure of the product used in the clinical trials and to reproduce it without undue burden.

In **T 945/09** the teaching according to claim 1 of the patent in suit was used by a patient while having "home parenteral nutrition" (HPN). The opposition division had concluded that all information concerning the use of taurolidine as a catheter lock available to the acting medical team, to the patent proprietor (supplier of taurolidine) and to the patient, was covered by an implicit obligation of confidentiality which stemmed from the specific circumstances of the case. The board held that there was no reason for the patient to treat that knowledge as a secret, because at that time the acting doctors simply tried to apply taurolidine of whatever provenance using a technique they derived freely and easily from the state of the art common to them at that time.

In **T 602/91**, in the board's view, there had been no tacit agreement, as the two parties had not concluded a development agreement or entered into any other contractual relations that would indicate either of them having had any particular interest in a secrecy agreement. Furthermore, a single case of co-operation between a manufacturer and a



potential end-user of the product was not sufficient to assume that a tacit confidentiality agreement had been entered into.

In case **T 809/95** the granted patent was, inter alia, for a plastic bottle, the special features of which related to its foldability. The prior use alleged by the opponents had occurred in connection with a "market test" performed by a market research company on behalf of the third party to gauge the market for such bottles. The patent proprietor claimed that both prior uses had been subject to confidentiality rules. The board held that the very fact that the third party had chosen a test variant allowing the test participants to take the bottles home indicated that it attached no particular value to confidentiality in the patent sense. Nor was there any circumstantial obligation to maintain secrecy since the market research institute did not employ or have a business relationship with the test persons.

In **T 1464/05** the board considered that the mere fact that a product has been delivered possibly for carrying out tests in what appears to be the result of an ordinary commercial transaction does not constitute by itself, in the absence of any other special circumstance or supporting evidence, a sufficient condition for concluding that the product was necessarily delivered under an implicit confidentiality agreement (see in this respect decisions **T 602/91**, **T 264/99**, **T 913/01**, **T 407/03**, and **T 1510/06**). There was no indication that any express secrecy agreement existed between the two companies, but also no indication that any particular or special relationship existed between the two companies other than the ordinary relationship between a seller and a buyer company. As held in decision **T 681/01**, "there must be something in the circumstances that suggests that a confidential relation existed before a delivery which appears to be the result of an ordinary commercial transaction can be disregarded as not making the delivered goods available to a member of the public".

In **T 1054/92** the opponent had alleged and proved that the claimed invention, an absorbent structure for diapers, had been tested in public tests carried out by several hundred members of the public at several places in the USA over several weeks. The board was convinced in the light of common experience that it was very unlikely that these tests had been kept confidential, particularly since some of the used diapers had not been returned to the appellants.

#### 3.4.8 Conferences

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

blanket contractual prohibition from communicating the information they obtained to third parties.

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

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

#### 3.4.9 Joint venture and other commercial agreements

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

In **T 633/97** the opponent had to prove that an alleged prior use had in fact been made public, i.e. there was no obligation to maintain secrecy between the respective contractors. The board stated that, depending on the nature of the business relations and the status of the companies involved, the existence of such an obligation might be assumed on a prima facie basis without the necessity of a written agreement. In the case at issue, LLNL was acting in the national interest of the United States of America in fields which had to be considered classified. The very nature of this project, i.e. uranium enrichment technology, led to the conclusion that all persons involved had to be bound to secrecy.

Similarly, in decision **T 1076/93**, the board considered a weapons manufacturer normally not to form part of the public but to be implicitly supposed by its contractors to behave as if an agreement of secrecy had been specified (see also **T 1619/06**).

In **T 163/03** the appellant (opponent) contended that the technical details of the apparatus as shown in the drawing D2 became state of the art when this drawing was given, without any confidentiality restriction, to BMW in May 1990, i.e. before the priority date of the patent in suit. The board held that where, as there, the terms and conditions of a technical cooperation, including related obligations of secrecy, had been explicitly specified and agreed upon by the partners of the cooperation by way of a written

contract, the contractual provisions prevailed and left no room for construing implicit obligations of the parties which differed from or were incompatible with anything which the partners, on proper interpretation of the contract, had fixed therein. The board found that there was no reason whatsoever to assume, in the absence of any explicit secrecy obligation, that BMW could nevertheless have been under an implicit obligation to keep secret the manufacturing technology disclosed to it by the opponent within the framework of the SE project.

#### 3.4.10 Paper submitted to obtain an academic degree

In **T 151/99** the board held that, in general, it appeared highly plausible that a paper submitted to obtain an academic degree (in this case a master's thesis) was not confidential, and that became a virtual certainty if the paper was referred to in published scientific work. If the reference was in a document published before the priority date of the patent in suit, it could be assumed that the paper had also been made available to the public before that date (see also **T 451/00**, **T 538/09**).

#### 3.4.11 Medical field

In **T 906/01** the alleged public prior use concerned the implantation of a correction device into a patient. There remained some doubt as to the I. Spinal System which was really implanted. The board considered that a device having an investigational status, being implanted and tested within the restricted area of a hospital, under the responsibility of a surgeon operating within the framework of an investigator's agreement which included a confidentiality clause, had to be regarded as a prototype device. Usually the development and test phases of such products or devices were necessarily surrounded by secrecy as long as said products or devices had not been approved and commercialised (see also **T 818/93**). The board followed the reasoning of **T 152/03** that, in this field, there was a prima facie assumption that any person involved in a medical process was obliged to maintain confidentiality, given the need for patient confidentiality and the need to protect the development and testing of prototype devices, and that any evidence proving the contrary was important and had to be produced as soon as possible.

#### 3.4.12 Notary

In **T 1553/06** the board stated that the notary was not a member of the public. As the board considered that the notary was not entitled to disclose the content of the document at issue, the question whether the notary had the technical knowledge to understand that content is of no relevance.

### 3.5. Issues of proof

#### 3.5.1 Burden of proof

Where lack of novelty is alleged, the burden of proof invariably lies with the party claiming that the information in question was made available to the public before the

relevant date (see, for example **T 193/84**, **T 73/86**, **T 162/87**, **T 293/87**, **T 381/87**, OJ 1990, 213; **T 245/88** and **T 82/90**). According to the boards' established case law, each of the parties to the proceedings bears the burden of proof for the facts it alleges. If a party, whose arguments rest on these alleged facts, does not discharge its burden of proof, this is to the detriment of that party, who may not shift the onus of proof onto the other party (see **T 270/90**, OJ 1993, 725; **T 355/97**; **T 836/02**; **T 176/04**; **T 175/09**; **T 443/09**).

### 3.5.2 Standard of proof

#### a) General

The boards of appeal have developed in their case law certain principles as to the standard of proof required to establish the facts on which a decision is to be based. In some decisions the boards of appeal have applied the standard of "the balance of probabilities", which means that in relation to, for example, the question of when a document was first made available to the public, the board must decide what is more likely than not to have happened (see **T 381/87**, OJ 1990, 213; **T 296/93**, OJ 1995, 627; and **T 729/91** of 21 November 1994). In other decisions the boards have taken the view that a fact has to be proved "beyond reasonable doubt" or "up to the hilt" (see **T 472/92**, OJ 1998, 161; **T 97/94**, OJ 1998, 467; **T 750/94**, OJ 1998, 32).

#### b) Public prior use

As far the standard of proof to be applied is concerned, the boards' established legal practice is to apply as a rule the same standard of proof to prior public use objections as to other objections under Art. 100 EPC: the balance of probability. It is the established practice of the boards of appeal to apply the criterion of "absolute conviction" and the "up-to-the-hilt" standard rather than the "balance of probabilities" in cases of prior public use for which the evidence lies entirely within the sphere of the opponent (see **T 472/92**, OJ 1998, 161 and Chapter III.G.4.3.2 "Public prior use").

#### c) Internet – proof of the date of availability

According to the Guidelines, when an internet document is cited against an application or patent, the same facts are to be established as for any other piece of evidence. This evaluation is made according to the principle of "free evaluation of evidence". That means that each piece of evidence is given an appropriate weight according to its probative value, which is evaluated in view of the particular circumstances of each case. The EPO standard of proof is generally the "balance of probabilities" (**J 20/85**, OJ 1987, 102).

However, especially in cases where only one party had access to information about an alleged public prior use, the case law has tended toward expecting that the public prior use be proved beyond any reasonable doubt or "up to the hilt" (**T 1553/06**, see also **T 55/01**, **T 472/92**, OJ 1998, 161). The same strict standard was required for Internet disclosures in the decision in case **T 1134/06** (affirmed in **T 1875/06**). In **T 286/10** the

board rejected the view taken in **T 1134/06** that the prior publication of an internet disclosure had to be proved beyond all reasonable doubt. In **T 2339/09** the board of appeal applied the "balance of probabilities". Similarly, it has been laid down in both the EPO Guidelines and the "Notice from the European Patent Office concerning Internet citations" that, in examination proceedings concerning Internet citations, the balance of probabilities will be used as the standard of proof for assessing the particular circumstances of a given case, and thus the probative value of the evidence in question. Proof beyond reasonable doubt ("up to the hilt") is not required (Guidelines G-IV, 7.5.2 – November 2015 version; see also "Notice from the European Patent Office concerning internet citations", OJ 8-9/2009, 456).

For further information, see in this chapter I.C.3.2.3 "Internet disclosures" and in Chapter III.G.4.2.3 "Archives and internet publications".

#### **4. Determining the content of the relevant prior art**

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

The consistent view in the case law is that for an invention to lack novelty, its subject-matter must be clearly and directly derivable from the prior art (see e.g. **T 465/92**, OJ 1996, 32; **T 511/92**) and all its features - not just the essential ones - must be known from the prior art (**T 411/98**). The disclosure of a publication is determined by what knowledge and understanding can and may be expected of the average skilled person in the technical field in question (**T 164/92**, OJ 1995, 305, Corr. 387; **T 582/93**).

##### **4.1. General rules of interpretation**

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

According to the boards' settled case law, the technical disclosure in a prior art document must be considered as a whole (see **T 56/87**, OJ 1990, 188). The individual sections of a document cannot be considered in isolation from the others but must be seen in their overall context (**T 312/94**, **T 452/05**, **T 456/10**). In **T 1321/04** the board found that the terms used in patent documents should be given their normal meaning in the relevant art, unless the description gave the terms a special meaning. The patent document might be its own dictionary (**T 523/00**, **T 311/93**). Thus, if a special meaning could be derived from the patent document, only this meaning was ultimately decisive.

In **T 312/94**, the board held that for the interpretation of any document, in particular a patent application or patent, in order to determine its true meaning and thus its content and disclosure, no part of such a document should be construed in isolation from the remainder of the document: on the contrary, each part of such a document had to be construed in the **context of the contents of the document as a whole**. Thus, even though a part of a document appeared to have a particular meaning when interpreted literally and in isolation from the remainder of the document, the true meaning of that part

of the document could be different having regard to the remainder of the document (see also **T 546/07**, **T 860/06**, **T 456/10**).

According to established case law, it is a prerequisite for the acceptance of lack of novelty that the claimed subject-matter is "directly and unambiguously derivable from the prior art". In other words, it has to be "beyond doubt - not merely probable - that the claimed subject-matter was directly and unambiguously disclosed in a patent document" (**T 450/89**, **T 677/91**, **T 988/95**, **T 1029/96**, **T 218/00**). This also means that the novelty of the claimed subject-matter over a prior art document cannot be opposed only on the basis of equivalents to the features directly and unambiguously disclosed in the cited document (**T 167/84**, OJ 1987, 369; **T 928/93**, **T 1387/06**).

In **T 2201/10**, the board found that the "photographic" approach to assessing novelty developed in the case law required that the prior art actually disclose the claimed features, be it explicitly or implicitly, in order for it to be found that the claimed subject-matter lacked novelty. The mere fact that information in the prior art did not rule out the feature in question was not enough to establish that it had already been disclosed. In other words, general information could not anticipate a more specific technical feature.

In **T 410/99** the board added that a prior art disclosure was novelty-destroying if it disclosed directly and unambiguously the subject-matter in question, account also being taken of a skilled person's common general knowledge at the publication date of the cited document in the case of prior art cited under Art. 54(2) EPC 1973, or at the priority date of the cited document in the case of an Art. 54(3) EPC 1973 document (see e.g. **T 511/92**, **T 412/91**).

In **T 412/91** the board decided that a prior art disclosure had to be read giving the information it contained the meaning that a skilled person would have given it at its publication date and disregarding information which would be understood by a skilled person to be wrong; however, any teaching which would not be recognised as wrong by a skilled person had to be accepted as state of the art.

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

In **T 1849/08** the board stated that what was decisive for the information content of a prior art document was what a person skilled in the art reading the document would understand from it. If a skilled reader of a prior art document containing an isolated statement that a diagram in a figure was "not to scale" could find nothing in the figure itself or in the rest of the document supporting this statement, he would consider the statement to be made in error and disregard it.

It is a well-established principle laid down by the boards' case law that a non-specific definition in a claim should be given its broadest technically sensible meaning (see **T 79/96**, **T 596/96**).

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

According to decision **T 158/96**, the information in a citation that a medicament was undergoing a clinical phase evaluation for a specific therapeutic application was not prejudicial to the novelty of a claim directed to the same therapeutic application of the same medicament, if such information was plausibly contradicted by the circumstances, and if the content of said citation did not allow any conclusion to be drawn with regard to the actual existence of a therapeutic effect or any pharmacological effect which directly and unambiguously underlay the claimed therapeutic application (see also **T 385/07**, **T 715/03**, **T 1859/08**).

In **T 1859/08** the board first observed that independent claims 1 and 10 were in the form of medical use claims, the novelty of which was derived from the intended medical use. As a consequence, all the technical features of the therapeutic indication specified in the claims had to be taken into account when considering whether or not the claimed subject-matter was novel. The board noted that prior art document D1 did not involve humans, whereas the claims before the board were directed to the treatment of breast cancer in a human patient. Further, D1 stated that the combination therapy disclosed in the study was "currently being explored". The board held that a mere statement that a combination therapy was being explored did not amount to a novelty-destroying disclosure. The "currently being explored" situation, where no clinical benefit was disclosed, fell within the rationale of decisions **T 158/96** and **T 715/03**. According to these decisions, if a prior art document disclosed clinical investigations such as phase I, II or III studies (or stated that these investigations were ongoing), but failed to disclose the final result of these studies, it was not novelty-destroying. The board concluded that there was no description in the prior art documents of the treatment of a human patient, nor any disclosure of the biological effect. Therefore, the claims satisfied the requirements of Art. 54 EPC.

In **T 943/93** the board held that a **hypothetical possibility** of operating within the claimed area was not per se sufficient in law to deprive this area of novelty, particularly if the skilled person had no technical motive and thus no practical necessity to work within this region (see also **T 892/05**).

Decisive for novelty in **T 464/94** was a citation disclosing a preliminary test to transform plant protoplasts with selective markers. The opposition division had considered it probable that this document anticipated the patent in dispute. In the board's view, it was not justifiable to decide whether a document was prejudicial to novelty on the basis of probability. When a patent was revoked for lack of novelty, the department concerned had to be sure, having taken all the facts and arguments put forward during the proceedings into consideration, that the revocation was justified (see also **T 892/05**).

In **T 233/90** the board took the view that in a case where a document comprised in the state of the art under Art. 54(3) EPC 1973 referred to "**a usual manner**" of preparing a

product, it was permissible to use documents of reference such as handbooks, encyclopaedias or dictionaries in order to determine what the skilled person would have understood by such a reference on the effective date of the prior document.

In **T 4/00** the board held that the points of a graph in a diagram in a prior art document did not represent a disclosure of the corresponding values read from the scales of the diagram, if the accuracy of the graph in the diagram could not be established.

#### **4.2. Combinations within a prior art document**

It is not permissible to combine separate items of prior art together. It is also not permissible to combine separate items belonging to different embodiments described in one and the same document, unless such combination has specifically been suggested (**T 305/87**). In **T 1988/07** the board emphasised that for the examination of novelty different passages in a document can only be combined if there is a clear teaching combining them.

A claimed subject-matter would lack novelty only if a "clear and unmistakable teaching" of a combination of the claimed features could be found in a prior art disclosure (**T 450/89**, **T 677/91**, **T 447/92** and **T 511/92**).

When contesting the novelty of a claim, the content of a document must not be treated as something in the nature of a reservoir from which features pertaining to separate embodiments may permissibly be drawn in order to create artificially a particular embodiment which would destroy novelty, unless the document itself suggests such a combination of features. This is confirmed by e.g. **T 450/89**, in which the board stated that "a conclusion of lack of novelty ought not to be reached unless the prior art document contains a clear and unmistakable disclosure of the subject-matter of the later invention" (see also **T 677/91**, **T 763/07**).

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. It was not permissible to combine **separate items belonging to different embodiments** described in one and the same document merely because they were disclosed in that one document, unless of course such combination had been specifically suggested there. In the case at issue, the two shears known from the catalogue were therefore definitely two separate entities forming two independent bases for comparison which ought to be considered in isolation when assessing novelty, and it was not admissible to piece together artificially a more relevant state of the art from features belonging to one or both of these entities, even if they were both disclosed in one and the same document (see **T 901/90**, **T 931/92** and **T 739/93**, **T 763/07**).

In **T 332/87** the board, after having recalled that the disclosure of a document normally had to be considered as a whole, held that, when examining novelty, different passages of one document might be combined, provided that there were no reasons which would prevent a skilled person from making such a combination. In general, the technical



teaching of examples might be combined with that disclosed elsewhere in the same document, e.g. in the description of a patent document, provided that the example concerned was indeed representative of, or in line with, the general technical teaching disclosed in the respective document (see also **T 1630/07**, **T 2188/08**, **T 1239/08**).

According to established case law, the disclosure of a patent document does not embrace the combination of individual features claimed in separate dependent claims if such combination is not supported by the description (cf. **T 525/99**, **T 496/96**, **T 42/92**).

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

In decision **T 610/95**, in view of the objection of lack of novelty, the question to be answered was whether or not the proposed solution in the patent was derivable directly and unambiguously from the disclosure of citation (2), which contained **cross-references** to the entire content of **three patent specifications** without giving priority to any of these references. Each of these references offered a plurality of different options for preparing pressure-sensitive layers of medical dressings. The board held that, under these circumstances, it could not be said that the use of the specific product acting as pressure-sensitive material in the claimed invention was directly and unambiguously derivable from the wholly general reference to the three different prior documents quoted in citation (2) and had therefore already been made available to the public.

### 4.3. Taking implicit features into account

According to the boards' established case law, a prior art document anticipates the novelty of claimed subject-matter if the latter is directly and unambiguously derivable from that document, including any features implicit to a person skilled in the art. However, an alleged disclosure can only be considered "implicit" if it is immediately apparent to the skilled person that nothing other than the alleged implicit feature forms part of the subject-matter disclosed (**T 95/97**, **T 51/10**). In other words, a prior art disclosure is novelty-destroying if the subject-matter claimed can be inferred directly and unequivocally from that disclosure, including features which for the skilled person are implicit in what is explicitly disclosed (see **T 677/91**, **T 465/92**, OJ 1996, 32; **T 511/92**).

The limitation to subject-matter "derivable directly and unambiguously" from the document is important. According to the boards' case law on assessing novelty, the teaching of a document, independent of its nature, is not to be interpreted as embracing equivalents not disclosed in that document (see also **T 167/84**, **T 517/90**, **T 536/95**). This is a matter of obviousness (see Guidelines G-VI, 2 – November 2015 version).

In **T 701/09**, the board found that direct and unambiguous disclosure was not limited to explicit or literal statements, but equally included implicitly disclosed information which a reader skilled in the art would unequivocally gather from the overall context of a cited document.

In **T 1523/07** the board observed that it is a generally applied principle that for concluding lack of novelty, there must be a direct and unambiguous disclosure, either explicit or implicit, in the state of the art which would inevitably lead the skilled person to subject-matter falling within the scope of what is claimed. In this context "implicit disclosure" means disclosure which any person skilled in the art would objectively consider as necessarily implied in the explicit content, e.g. in view of general scientific laws. In this respect, the term "implicit disclosure" should not be construed to mean matter that does not belong to the content of the technical information provided by a document but may be rendered obvious on the basis of that content. Whilst common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document, the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implied by the disclosure of that document. The implicit disclosure means no more than the clear and unambiguous consequence of what is explicitly mentioned (see **T 823/96**, **T 297/11**). Implicit disclosure means disclosure which any person skilled in the art would objectively consider as necessarily implied in the explicit content (**T 2522/10**).

In **T 51/10**, the board held, in summary, that, for a feature to be "implicit", it was essential that it could be unequivocally gathered from the overall context of a cited document (**T 701/09**) or necessarily followed from that context (**T 1523/07**). In particular, the skilled person had to be unable to conceive of any realistic alternative to the allegedly implicit feature.

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 666/89** (OJ 1993, 495) the board stated that 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 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 (**T 793/93**).

In **T 270/97**, the opposition division considered the claimed product to be anticipated by the agent produced and inevitably obtained by repeating examples 1 and 2 of a prior art document. The board noted that it was a well-established principle laid down in the case

law since **T 12/81** (OJ 1982, 296) that the product inevitably resulting from a process properly defined as to its starting substance and reaction conditions was considered to be disclosed even if it was not cited *expressis verbis* in the prior art document. The board, however, found that the method disclosed in the text of example 2 implied a way of acting not envisaged in the method according to the patent in suit. The parties' attempts to show that the particles obtained according to example 2 were, or were not, identical to the products of the patent in suit, produced highly contradictory results. Therefore, the board could only conclude that depending on experimental conditions not disclosed in example 2 different products might be obtained. Thus, the claimed product was not inevitably obtained by following the method of example 2.

In **T 583/01** the board, following **T 270/97**, stated that novelty was a question of inevitability and not a question of probability.

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

In **T 624/91** it was held that exact **disclosures for alloy compositions** in the state of the art had to be interpreted as average or nominal values within a small range in view of known fluctuations in reproducibility and in analytical results, unless there was evidence available to the contrary. The board pointed out that, whenever a metallurgist aimed at producing an alloy in accordance with a given nominal composition, the composition of the final product would deviate somewhat from this target or even be undefined within certain narrow limits. The metallurgical production process was not ideally reproducible and the actual composition of different batches aiming at the same nominal composition would be spread over a certain area around this target (see also **T 718/02**, **T 324/12**).

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

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

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

Likewise 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.

#### **4.4. Taking intrinsic features into account**

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

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

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

#### **4.5. Taking equivalents into account**

The case law of the boards of appeal is based on a narrow concept of novelty, i.e. the disclosure of a prior document does not include equivalents of the features which are explicitly or implicitly disclosed; equivalents can only be taken into account when it comes to considering inventive step (**T 517/90**). This narrow concept of novelty, which excludes equivalents, is of particular importance for the application of Art. 54(3) EPC. In **T 167/84** (OJ 1987, 369) the board commented that conflicting applications within the

meaning of Art. 54(3) EPC 1973 were included in the state of the art solely from the point of view of novelty, but were considered in the light of their "whole contents". In order to mitigate the harsh effects of the "whole contents approach", its application was confined to novelty. Further, in order to reduce the risk of "self-collision", it had always been considered justified to adopt a strict approach to novelty. For this reason, the Guidelines expressly stated that "when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the document; this is a matter of obviousness" (Guidelines G-VI, 2 – November 2015 version). According to the case law of the boards of appeal the "whole contents" of an earlier document did not also comprise features which were equivalents of features in the later document (see also **T 928/93**, **T 1387/06**).

In **T 652/01** the appellant was of the opinion that although the relevant prior-art document did not explicitly mention a particular feature, that feature could be derived from the document by applying the document's teaching *mutatis mutandis*. The appellant had referred to **T 952/92** (OJ 1995, 755), which, in its first headnote, stated that "availability" within the meaning of Art. 54(2) EPC 1973 involved not only availability of the disclosure but also availability of information accessible and derivable from the disclosure, which meant that "derivable equivalents" were included. However, the board held that, when reading the cited phrase from **T 952/92** in the context of the present decision, it was clear that the term "derivable" had been employed in the sense of "obtainable by chemical analysis of a sample" and that it was used with the same restriction as expressed in opinion **G 1/92** (OJ 1993, 277), namely that it had to be "directly and unambiguously derivable".

#### **4.6. Taking drawings into account**

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

In **T 204/83** (OJ 1985, 310) the board held that features shown solely in a drawing formed part of the state of the art when a person skilled in that art was able, in the absence of any other description, to derive a technical teaching from them. Dimensions obtained merely by measuring a diagrammatic representation in a document did not, however, form part of the disclosure (see **T 857/91**, **T 272/92**, **T 1488/10**).

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

In **T 56/87** (OJ 1990, 188) the board held that a technical feature which was derived from or based on dimensions obtained from a diagrammatic representation and which

technically contradicted the teaching of the description, did not form part of the disclosure of a document.

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

#### **4.7. Taking examples into account**

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

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

In **T 666/89** (OJ 1993, 495) the board stated it was necessary to consider the whole content of a citation when deciding the question of novelty. In applying this principle, the evaluation was therefore not to be confined merely to a comparison of the claimed subject-matter with the examples of a citation, but had to extend to all the information contained in the earlier document.

In **T 1049/99** the board noted that in the case of a "written description" open to public inspection, what is made available is all the information contained in that description. In some cases, the information contained in the written description, such as teaching on ways of carrying out a process, also provides access to other information necessarily resulting from the application of that teaching (**T 12/81**, OJ 1982, 296; **T 124/87**, OJ 1989, 491; **T 303/86**).

#### **4.8. Broad claims**

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

explanation but rather of examining an excessively broad request in relation to the state of the art.

#### **4.9. Deficiencies and mistakes in a disclosure**

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

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

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

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

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

In **T 230/01** the board noted that a document normally forms part of the state of the art, even if its disclosure is deficient, unless it can unequivocally be proven that the disclosure of the document is not enabling, or that the literal disclosure of the document

is manifestly erroneous and does not represent the intended technical reality. Such a non-enabling or erroneous disclosure should then not be considered part of the state of the art.

#### **4.10. Accidental disclosure**

An anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention. When an anticipation is taken as accidental, this means that it appears from the outset that the anticipation has nothing to do with the invention (**G 1/03** and **G 2/03**, OJ 2004, 413 and 448; **T 134/01**, **T 1911/08**).

In **G 1/03** and **G 2/03** (OJ 2004, 413 and 448), the Enlarged Board of Appeal observed that different definitions of accidental anticipation had been put forward (see referrals **T 507/99** and **T 451/99**). Often cited were decisions **T 608/96** and **T 1071/97**, which said in similar terms that a disclosure was accidentally novelty-destroying if it was disregarded by the skilled person faced with the problem underlying the application, either because it belonged to a remote technical field or because its subject-matter suggested it would not help to solve the problem. Thus, according to these decisions, the disclosure had to be completely irrelevant for assessing inventive step.

The Enlarged Board noted that the individual elements of these and other attempts to find an adequate definition could not be taken in isolation. The fact that the technical field was remote or non-related might be important but was not decisive because there were situations in which the skilled person would also consult documents in a remote field. Even less decisive, as an isolated element, was the lack of a common problem, since the more advanced a technology was, the more the problem might be formulated specifically for an invention in the field. Indeed, one and the same product might have to fulfil many requirements in order to have balanced properties making it an industrially interesting product. Correspondingly, many problems related to different properties of the product might be defined for its further development. When looking specifically at improving one property, the person skilled in the art could not ignore other well-known requirements. Therefore, a "different problem" might not yet be a problem in a different technical field. What counted was that from a technical point of view, the disclosure in question had to be so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention (to this effect, see **T 608/96**, cited in referral **T 507/99**). This should be ascertained without looking at the available further state of the art because a related document did not become an accidental anticipation merely because there were other disclosures which were even more closely related. In particular, the fact that a document was not considered to be the closest prior art was not sufficient to accept an accidental anticipation (see, however, **T 170/87**, OJ 1989, 441).

Accidental anticipation understood in the sense outlined above not only corresponds to the literal meaning of the term, but also limits disclaimers to situations in which there is a justification comparable to the case of conflicting applications for which the allowability of disclaimers has been accepted (see also Chapter II.E.1.5 "Disclaimers").



In **T 161/82** (OJ 1984, 551) the board found that the prior art document was concerned with the solution of a problem totally different from that stated in the application at issue and concluded that in cases where an anticipation was of a chance nature, in that what was disclosed in a prior document could accidentally fall within the wording of a claim to be examined for novelty without there being a common technical problem, a particularly careful comparison had to be made between what could fairly be considered to fall within the wording of the claim and what was effectively shown in the document (see also **T 986/91**).

#### **4.11. Reproducibility of the content of the disclosure**

According to the established case law a disclosure destroys novelty only if the teaching it contains is reproducible, i.e. can be carried out by the skilled person (**T 1437/07**, **T 1457/09**). Subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1) EPC, if the information given therein to the skilled person is sufficient to enable him, at the relevant date of the document, to practise the technical teaching which is the subject of the document, taking into account also the general knowledge at that time in the field to be expected of him (see **T 26/85**, **T 206/83**, **T 491/99**, **T 719/12** and Guidelines G-VI, 4 – November 2015 version).

In **T 206/83** (OJ 1987, 5), in particular, it was found that a document did not effectively disclose a chemical compound, even though it stated the structure and the steps by which it was produced, if the skilled person was unable to find out from the document or on the basis of his common general knowledge how to obtain the required starting materials or intermediates. Information which could only be obtained after a comprehensive search was not to be regarded as part of the common general knowledge. This need for an enabling disclosure was also in conformity with the principle expressed in Art. 83 EPC 1973 for patent applications which had, accordingly, to "disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art". The requirements as to the sufficiency of the disclosure were, therefore, identical in all these instances.

In **T 719/12** neither party contested that document (1) disclosed the compound methyl-2-( $\alpha$ -thenoyl)-ethylamine by name. The board held that document (1) alone did not make the compound available to the public, since the specific attempts to prepare it which were described in that document had failed. Therefore, the board concluded that it had not been made available to the public, as no method for its preparation had been available at the publication date of the prior art.

For selection inventions the requirement of a reproducible disclosure also plays a significant role. In **T 26/85** (OJ 1990, 22) the ranges of a certain parameter as defined in the claim fell within the broader ranges stated for the same parameter in a prior art document. The board considered that a realistic approach, when assessing the novelty of the invention under examination over the prior art in a case where overlapping ranges of a certain parameter existed, would be to consider whether the person skilled in the art would, in the light of the technical facts, seriously contemplate applying the technical

teachings of the prior art document in the range of overlap; if it could be fairly assumed that this would be the case, it had to be concluded that no novelty existed. Such was not the case in the matter under consideration, since there existed in the prior art a reasoned statement clearly dissuading the person skilled in the art from using the range under a certain value, and the range of overlaps was under this value; the claimed range was therefore considered novel (see also **T 255/91**).

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

In **T 310/88** the board of appeal had to consider a discrepancy between what actually happened in practice when carrying out a technical teaching in a prior document according to the letter of its description, and what this prior document said would happen. 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 (see **T 23/90**).

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

In **T 1437/07** the board pointed out that a disclosure in a prior art document is novelty-destroying only if the teaching it contains is reproducible. This need for an enabling disclosure is in conformity with the principle expressed in Art. 83 EPC. Thus, the requirements of sufficiency of disclosure are identical for a prior art document and a patent. The board followed the principles developed by the case law in the framework of the evaluation of the requirements of Art. 83 EPC in the case of a medical use, i.e. that the skilled person should not only be able to carry out the teaching of the prior art document, but it should also be credible that the effect at issue - here, relief of pain - has been achieved (see also **T 491/08**).

In **T 1457/09** claim 4 was drafted as a second medical use claim. In the decision under appeal the opposition division held that the subject-matter of the corresponding claim was anticipated by the intermediate document (D1). The opposition division considered that both documents (D1) and (D1a, the priority document of D1) disclosed pharmaceutical compositions comprising the peptide RMFPNAPYL and their use as a cancer vaccine. The board found that for the requirement of reproducibility to be

considered as fulfilled in relation to a medical use it is necessary that the disclosure in the prior-art document is such as to make it credible that the therapeutic effect on which the disclosed treatment relies can be achieved (**T 609/02**). The board held that in the case at issue a prior art document was novelty-destroying only if it disclosed not only the product referred to in the claim – here RMFPNAPYL – for the claimed therapeutic application – here treatment of cancer – but also that the claimed product was indeed suitable for the claimed therapeutic application. The board concluded that the experimental results disclosed in document (D1a) were not sufficient to make it credible that the RMFPNAPYL peptide was suitable for the treatment of cancer. Therefore document (D1) did not destroy the novelty of the subject-matter of claim 4.

## 5. Ascertaining differences

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

### 5.1. Comparing each individual item from the prior art

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

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

According to the boards' settled case law, a strict approach must be taken to assessing novelty and, in cases of ambiguity or doubt, the content of a prior publication must be interpreted narrowly (see **T 447/92**, **T 988/95**, **T 722/00**, **T 1517/11**).

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. Thus, the board concluded that if a citation gave detailed information about a further development of a prior art described only in very general terms without quoting a specific source, it was not permissible in examining for novelty to combine these general statements with the specific statements made solely in order to explain the said development, unless a person skilled in the art would have made the combination when reading the citation.

In **T 288/90** the board observed that, although for the purposes of assessing novelty it was not normally legitimate to read two documents together, nevertheless, when interpreting a single document, it was necessary to read it having the general technical knowledge in mind, and for this purpose to look at representative technical literature as an aid to the correct interpretation of any particular term of art encountered.

In decision **T 56/87** (OJ 1990, 188) the board emphasised that the technical disclosure in a document should be considered in its entirety, as it would be by a person skilled in the art, and that there could be no justification for arbitrarily isolating parts of the document in order to derive therefrom an item of technical information which would be distinct from or even contradict the integral teaching of the document. Thus, a technical feature which was derived from or based on dimensions obtained from a schematic illustration and which technically contradicted the teaching of the description did not form part of the disclosure of this document (see **T 332/87**, **T 441/91** and **T 657/92**).

## 5.2. Distinguishing features

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

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

### 5.2.1 Difference in wording

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

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

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

In **T 452/05** the board noted that, in principle, a specific term was not anticipated by a generic term. Nevertheless, in **T 870/95** an exception was made if it were proven that, in the light of common general knowledge, the generic term could only be understood in the meaning of the more specific term. Since this was not the case, the board concluded that the generic term ("water permeable membrane") did not anticipate the specific term ("filtering paper").

In **T 79/96**, an extract from a handbook (D1) disclosed all the features of claim 1 of the patent in issue apart from the use of a "countercurrent gas/gravity classifier". Thus, with respect to novelty it only had to be decided whether a vibrating fluidised bed with an upwards gas flow through the bed of particles as described in D1 should be regarded as a countercurrent gas/gravity classifier. The definition of a countercurrent gas/gravity classifier was given in an extract from another standard handbook on chemical technology (D3). The proprietor of the patent was of the opinion that the definition given in D3 was too broad and that a person skilled in the art would not consider a fluidised bed, being a rather inefficient classifier, as a countercurrent gas/gravity classifier. The board did not share this view. It held that, when assessing novelty of the claimed subject-matter, an expression in a claim should be given its **broadest technically sensible meaning**. On that basis, any gas/gravity classifier, including a fluidised bed, satisfied the classification requirements of the claim 1 of the patent at issue. The subject-matter therefore lacked novelty over D1 (see also **T 596/96**, **T 1126/05**, **T 452/11**, **T 2446/12**).

### 5.2.2 Differences in values

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

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

board in **T 1186/05** pointed out that rounding up was required, in order to enable two density values to be compared, each one reflecting a "true" density value having three (or more) decimal places, but expressed to a different degree of accuracy, i.e. one having three and the other one having only two decimal places. Thus, the rounding exercise put the claimed and the prior art density values on the same level by using the mathematical rule existing for that purpose. This exercise had no impact on the density value as disclosed in the prior art document (see also **T 708/05**).

In **T 234/09**, the board observed that the claims defined the fibre composition in terms of numerical ranges of its constituent parts' percentage by weight, the appellant patent proprietor having chosen to express most of those ranges' limits as whole numbers. It found that, in the context of the patent in suit, the skilled person would appreciate that the whole numbers defining the limits of the ranges in claim 1 were not to be understood as whole numbers in the mathematical sense, and that they were therefore to be seen as limits deliberately expressed in a less precise form than the decimal numbers set out in the patent specification. Consequently, they also included the decimal numbers from which they resulted on application of the rules on rounding up numbers. It noted that the boards had already taken a similar approach in comparable cases (see e.g. **T 1186/05**). Two of the decisions cited by the appellant had concerned situations in which, by contrast with the specific circumstances of the case in hand, there had been no particular reason to round up a figure disclosed only implicitly in the prior art (see **T 74/98**, **T 646/05**). The board concluded that the percentage in the prior art, as rounded up for the purpose of comparison, could not be distinguished from the upper limit in claim 1 and that, therefore, the subject-matter of that claim was not novel.

In **T 871/08** prior art document D9 related to a method for hydrogen peroxide production by an anthraquinone method. The respondent had argued that the claimed subject-matter was novel, because the value 2.996 was lower than the lower limit of 3:1 defined in claim 1 at issue. This argument was not accepted by the board. When comparing a value from the state of the art (the value "2.996") with those claimed (the range of values "from 3:1 to 9:1"), the state of the art value had to be given the same accuracy as the one claimed. In the case at issue, the values in the claims had been quoted without any digit after the comma, which meant that for comparison purposes, the value 2.996 had to be rounded up to 3, which thus fell into the range of the claimed values (see, in particular, **T 1186/05**, **T 708/05**).

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

construed to mean that the indicated lower limit corresponded to the value disclosed in the prior art. Claim 1 was then considered to lack novelty.

### 5.2.3 Difference in parameters

In **T 1764/06** the board noted that the only expressed distinction between the definition of the claimed photocatalyst and the photocatalyst of D1 relied on a parameter feature that was not usual, let alone common, for the skilled person. The onus of proof in that respect lay on the applicants, but no proven distinction had been shown. As regards the benefit of the doubt, which in the applicant's view was to be accorded to applicants in complex situations without direct disclosure, the position of the board was that in a situation where the applicants have used an unusual parameter feature to define their product, which unusual parameter feature represents the only distinction over otherwise identical known products, and the applicants have decided not to provide evidence that the parameter feature as such represents a difference in the claimed products from the known products, no benefit of the doubt could be accorded.

Following **T 1764/06** the board stated in **T 1920/09** that since the applicants had decided to formulate the definition of the invention by an unusual parameter, the onus was on them to convincingly establish novelty over the illustrated embodiments of D8. However, no evidence had been adduced by the applicants to discharge their burden of proof.

### 5.2.4 Difference in composition

In **T 80/96** (OJ 2000, 50), an aqueous solution of the claimed tartrate compound was described in the prior art. The board held that, in the case of an active agent which was known as such to be water-soluble, it was clear to a person skilled in the art that describing and claiming the active agent as a solution did not add to or change the definition of that active agent. Without further specification, the mere characterisation of a solvent or diluent as liquid or solid in a claim did not change the assessment of the novelty of the subject-matter of the claim. Analogously, in a claim directed to a preparation of a known structurally defined active agent with at least one auxiliary substance, in which the feature "with an auxiliary substance or auxiliary substances" meant that something was added to the active agent, the admixture of an unspecified auxiliary substance could not, in view of the unlimited number of substances which might enter into consideration, be deemed a substantive and distinctive addition to the active agent, unless this feature, which was necessary if novelty was to be acknowledged, was specified in such a way that a person skilled in the art could recognise what it was that should be added to the active agent. The claim was therefore not new.

### 5.2.5 Functional features

In **T 500/89** it could only be seen from the disclosure considered in its entirety that the prior art document did not deprive the claimed invention of novelty, because the method constituting the closest prior art differed from the claimed method in one functional characteristic. The disputed patent related to a method for the production of photographic material by the simultaneous application of several layers of fluid

photographic coating materials. Although the document cited in support of the opposition listed the numerical ranges for layer thickness, viscosity, coating speed, etc. used in the method claimed, the latter was nevertheless held to be new because the cited document described the choice of these numerical ranges as leading to intermixing between two particular layers. The contested patent was to be assessed according to a different criterion because it described the application of the layers as being "substantially free from intermixing". The "intermixing" described as an objective in the citation was not merely a stated purpose not constituting one of the technical features of the method described, but a functional feature - a criterion, in effect - forming an essential element of the teaching set out in this publication.

In **T 872/09** the board stated that the claimed sensor was defined by reference to characteristics of its response when used in a measurement set-up. Since none of the determining aspects of the measurement set-up was defined in claim 1, the technical features of the claimed sensor which were responsible for providing the measurement referred to in the claim remained obscure. Legal certainty required that a claimed subject-matter cannot be regarded as novel over the prior art on the basis of an ambiguous feature (see **T 1049/99**). Hence, defining a functional feature of the claimed electrochemical sensor under undefined operating conditions was not appropriate to provide any distinction of the claimed subject-matter over the prior-art electrochemical sensors. in the case at hand.

#### 5.2.6 Generic disclosure

It is established case law that a specific disclosure destroys the novelty of a generic feature in a claim but that a generic disclosure does not destroy the novelty of a specific feature (see **T 651/91**, **T 776/07**, **T 1174/05**, **T 6/04**, **T 776/07**). A generic disclosure does not normally deprive a claimed specific embodiment of novelty (**T 1786/09**, see also Guidelines G-VI, 5 – November 2015 version).

In **T 651/91** the board pointed out that a generic disclosure did not normally deprive any specific example falling within that disclosure of novelty. A disclosure could be generic even where it only left open the choice between two alternatives. In **T 508/91** the board held that, on the other hand, the prior disclosure of the subset "vegetables" deprived the wider set "fruits and plants" of novelty (see also **T 1204/00**).

#### 5.2.7 Product claim with process features

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



### 5.2.8 Non-technical distinguishing features

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

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

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

In **T 2050/07** the board confirmed the established case law according to which features that do not contribute to the technical character of an invention and do not interact with the technical subject-matter of the claim for solving a technical problem have to be ignored when assessing inventive step, such features should equally be ignored when assessing novelty. The board therefore examined whether or not the distinguishing features in the case before it made a technical contribution.

In **T 2191/13**, the board observed that novelty could not be established on the basis of a distinction **made only mentally**, i.e. derived solely from pre-existing knowledge and not reflected in the technical features of the claimed subject-matter. It cited the Enlarged Board's ruling in **G 2/88** that a claimed invention lacked novelty unless it included at least one essential technical feature distinguishing it from the prior art. It followed from that decision that a feature of a merely mental nature could not be a new technical feature for the purposes of Art. 54 EPC and, therefore, that a claim containing only already known technical features could not be considered novel. This approach was also taken in **T 959/98**, **T 553/02** and **T 154/04**.

## 6. Chemical inventions and selection inventions

### 6.1. General

The state of the art often includes documents containing technical teachings described in general terms; these teachings in turn subsume a number of more specialised technical teachings. In assessing the novelty of subject-matter that can be subsumed under a

general term in the state of the art, the question arises whether the general term makes the claimed matter fully or partially accessible to the public. In other words, it has to be established whether the general term used in the citation discloses the subject-matter defined by the special term in the claim. The prior-art disclosure needs to be identified particularly carefully in such cases. General terms of this kind occur particularly frequently in the chemical literature, which is why the relevant case law usually relates to this field. There are two types of case here:

(a) assessing the novelty of chemical substances and groups of substances in respect of general formulae (Markush formulae) under which they fall (see Chapter I.C.6.2 "Novelty of chemical compounds and groups of compounds"), and

(b) assessing the novelty of products or processes defined by parameter ranges as against known products or processes characterised by wider or overlapping parameter ranges (see Chapter I.C.6.3 "Selection of parameter ranges").

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

## 6.2. Novelty of chemical compounds and groups of compounds

According to the boards' case law, a specific combination of elements requiring the selection of elements from two known groups/lists cannot be regarded as disclosed in the art and so fulfils the novelty requirement (cf. **T 12/81**, OJ 1982, 296).

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

The applicant argued that the novelty of the claimed product was based on a selection. The board used the opportunity to comment on this argument and develop **criteria for selection inventions** that have frequently been adopted in later decisions: A substance selection can come about if an unmentioned compound or group of compounds having a

formula covered by the state of the art is found, in the absence of any information as to the starting substance or substances. The subject-matter in the case in question, however, did not involve a selection of that kind in an area which, although marked out by the state of the art, was nonetheless virgin territory. However, the disclosure by description in a cited document of the starting substance as well as the reaction process is always prejudicial to novelty because those data unalterably establish the end product. If, on the other hand, two classes of starting substances are required to prepare the end products, and examples of individual entities in each class are given in two lists of some length, then a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded for patent purposes as a selection and hence as new.

The board held that a combination of starting substances and process variants, however, was quite a different matter from a combination of two starting substances, and thus not comparable. At its simplest, if the starting substances were regarded as fragments of the end product, then every conceivable combination of a given starting substance in the first list with any starting substance in a separate second list of additionally required starting substances involved a true substantive modification of the first starting substance, since in every combination it was supplemented by a different fragment of the second starting substance to become a different end product. Each end product was thus the result of two variable parameters. However, combining a given starting substance from a list of such substances with one of the given methods of preparation did not result in a real substance alteration of the starting substance but only an "identical" alteration (see also **T 3/89, T 1841/09**).

#### 6.2.1 Anticipation of certain compounds

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

Following **T 12/81** (see above) the board in **T 352/93** decided that a claim for an ionic compound (salt) that was defined only by structural parameters, i.e. the structural formulae of the cation and anion of the compound, was not novel over prior art disclosing an aqueous solution that contained a base corresponding to the cation and an acid corresponding to the anion.

In **T 1336/04** the board stated that, according to case law, (see, inter alia, **T 767/95** and **T 90/03**), the preparation of an enzyme sufficiently pure to allow sequencing was novel over a preparation which was not in such a state of purity.

In **T 767/95** concerned the purification of interleukin-1Beta (IL-1Beta), a high molecular weight protein (17.5 kDa). The board found that a purified homogeneous preparation of IL-1Beta was novel over a semi-purified mixture of proteins containing IL-1Beta. A relevant consideration was the provision of IL-1Beta in a degree of purity that allowed the determination of its (partial) amino acid sequence, whereas "no analysis of the amino acid sequence of IL-1 that would provide definitive proof of the homogeneity of IL-1 preparations" was found in the prior art (see also **T 90/03, T 29/05**).

## b) Selection of starting substances from different lists

According to **T 12/81** (OJ 1982, 296), an end product resulting from the reaction of a specific pair of starting substances may be seen as a novel selection for patent purposes if its preparation requires using entities from two classes of starting substances given in two lists of some length. This criterion has been applied to mixtures of two substances, selected from two lists (**T 401/94**) and confirmed in subsequent decisions (**T 211/93**, **T 175/86**, **T 806/02**, **T 2436/10**).

In **T 401/94** the board again adopted one of the criteria for selection inventions laid down in decision **T 12/81** (OJ 1982, 296), namely, that if two classes of starting substances were required to prepare the end products, and examples of individual entities in each class were given in two lists of some length, the substance resulting from the reaction of a specific pair from the two lists could be regarded for patent purposes as a selection and, hence, as new. The board stated that, although **T 12/81** concerned the synthesis of a chemical product, and the case in question involved the preparation of a **mixture**, the claimed subject-matter was defined on the basis of two chemical entities, each of which had been selected from a list of compounds. Hence the criteria defined in **T 12/81** were applicable here too. By analogy, the board held that, in this case, the claimed composition had to be viewed as a selection, and therefore as novel, as it corresponded to a specific combination of constituents, each of which had been selected from a relatively long list.

In **T 366/96** the board held that if, when selecting two components of a composition from two known lists of possible ingredients, a skilled person had, as soon as one component was taken from the first list, no choice in selecting the second component from the second list in view of compelling technical necessities which made the particular second component mandatory, then this could not be considered to be a "twofold" selection which could render the resulting combination novel.

## c) Selection on the basis of a general formula

In **T 181/82** (OJ 1984, 401) the board confirmed that the products of processes which were the inevitable result of a prior description of the starting materials and the process applied thereto formed part of the state of the art. This was true even if one of the two reactants manifested itself as a chemical entity (C<sub>1</sub> alkyl bromide) from a group of generically defined compounds (C<sub>1</sub> - C<sub>4</sub> alkyl bromides). The board took the view that the description of the reaction of a certain starting material with C<sub>1</sub> to C<sub>4</sub> alkyl bromides disclosed only the C<sub>1</sub>-substituted product, and was not prepared to recognise the disclosure of a particular butyl substituent on the grounds that four isomeric butyl radicals existed.

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

the individual substituents had to be selected from two or more lists of some length, such as in the case in question.

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

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

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

#### 6.2.2 Novelty of groups of substances

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

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

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

As regards case (a) the board said: "That case is not comparable with the present one in which a distinction must be drawn between the novelty of a group of substances defined by a general formula and a second group of substances partially covering the first and defined by another general formula, because the **concept of individualisation** naturally only applies to the structural definition of a single compound, not a collection of compounds".

Case (b) was extensively discussed in **T 124/87** (OJ 1989, 491). This decision dealt with the problem of assessing the novelty of a class of compounds defined by parameters within numerical ranges. The patent in suit claimed a class of compounds defined by parameters within numerical ranges while the prior document disclosed a process by which a class of compounds could be prepared - comprising those claimed in the patent in suit - having the combination of parameters required by the main claim of the latter. In that particular case, the example specifically described in the prior document did not disclose the preparation of any particular compounds within the class defined in the claims of the disputed patent. However, it had been accepted by the patentee that a skilled man would have no difficulty in preparing such compounds within the class defined by the claims of the disputed patent using the process described in the said prior document, in combination with his common general knowledge, so that the disclosure of the prior document had to be regarded as not only limited to the particular compounds whose preparation was described in the examples, but also as comprising the general class of compounds made available to the skilled man in that technical teaching, even though only certain compounds within this class were described as having been prepared. Since the compounds as defined in the claims of the disputed patent formed a major part of this general class, they formed part of the state of the art and therefore lacked novelty.

In **T 133/92** the question to be answered in examining novelty was whether the selection of the alkyl group as defined in claim 1 of the disputed patent had been made available to the public with regard to the disclosure of a prior document. By citing **T 666/89** (OJ 1993, 495), the 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 Art. 52 and 54 EPC 1973, so that the proper approach was to consider availability in the light of a particular document. Thus the board found that a claimed group of compounds, essentially resulting from omitting those parts of a larger group of compounds which a skilled person would have immediately considered as being less interesting than the rest, could not be selectively novel. In addition, in the board's opinion, a skilled person would, having regard to these considerations, have seriously contemplated applying the technical teaching of this prior art document in the range of overlap.

### 6.2.3 Novelty of enantiomers

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

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

In **T 1046/97** it was decided that the term "optically-active forms" could not be equated to an individualised disclosure of a specific enantiomer (see also **T 833/11**).

### 6.2.4 Achieving a higher degree of purity

In **T 990/96** (OJ 1998, 489), it had to be examined whether the feature in dispute, which in fact represented a **specific degree of chemical purity** (in particular diastereomeric purity), constituted a "new element" imparting novelty to the claimed subject-matter. The board stated that it was common general knowledge that any chemical compound obtained by a chemical reaction would normally contain impurities for various reasons and that it was not possible for thermodynamical reasons to obtain a compound which was - in the strict sense - completely pure, i.e. totally free of any impurity. It was, therefore, common practice for a person skilled in the art of preparative organic chemistry to (further) purify a compound obtained in a particular chemical manufacturing process according to the prevailing needs and requirements. Conventional methods for the purification of low molecular organic reaction products, which could normally be successfully applied in purification steps, were within common general knowledge. It followed that, in general, a document disclosing a low molecular chemical compound and its manufacture made this compound available to the public within the meaning of Art. 54 EPC 1973 in all grades of purity as desired by a person skilled in the art (**T 392/06**).

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

found, however, that the applicant, who bore the burden of proving this allegation, had not provided the necessary evidence. Where the claimed purity level of a low molecular chemical compound (here a terfenadine derivative) turns out to be successfully achieved by applying a conventional purification method on a reaction mixture disclosed in the prior art, an exceptional situation such as addressed in decision **T 990/96** does not exist. This would have required evidence that conventional methods could not achieve that purity level. Therefore the general rule applies that the level of purity of that low molecular compound cannot entail novelty. That general rule is valid also in the case of a product-by-process claim where that purity level is the inevitable result of the preparation process indicated in the claim.

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

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

In **T 142/06** the board noted that it followed from the considerations made in decision **T 990/96**, according to which a document disclosing a low molecular compound and its manufacture normally makes this compound allowable in all desired grades of purity, that the purity level of an organic compound is as such not an essential feature for the definition of this organic compound. However, in the case at issue it was evident that the content of chlorine ion of the claimed latex was an essential feature of the claimed latex, since, according to the patent in suit, only the latexes having this low level of chlorine ions enabled the production of films having the desired properties in terms of oxygen barrier properties and boil blushing properties. This implied that the claimed degree of purity in terms of chlorine ion content could not be considered as an arbitrary degree of purity but that it amounted to a purposive selection. Thus, for this reason the considerations made in decision **T 990/96** and, by way of implication, in decision **T 803/01**, did not apply to the case before the board.



### 6.3. Selection of parameter ranges

#### 6.3.1 Selection from a broad range

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

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

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

With reference to the third criterion, the board in **T 198/84** was of the opinion that this view of novelty really entailed more than just a formal delimitation vis-à-vis the state of the art. There would be delimitation only in respect of the wording of the definition of the invention, but not in respect of its content, if the selection were arbitrary, i.e. if the selected range only had the same properties and capabilities as the whole range, so that what had been selected was only an arbitrary specimen from the prior art. This was not the case if the effect of the selection, e.g. a substantial improvement in yield, occurred in all probability only within the selected range, but not over the whole known range (purposive selection). To prevent misunderstanding, the board emphasised, following **T 12/81** (OJ 1982, 296), that a sub-range singled out of a larger range was new not by virtue of a newly discovered effect occurring within it, but had to be new per se. An effect of this kind was not therefore a prerequisite for novelty; in view of the technical disparity, however, it permitted the inference that what was involved was not an arbitrarily chosen specimen from the prior art, i.e. not a mere embodiment of the prior description, but another invention (purposive selection).

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

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

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

In **T 610/96** the patentee claimed a magnetoresistive material comprising magnetic and non-magnetic metallic thin film layers. The board found that the claimed ranges defining the composition of these layers must be considered as a narrow selection of the generic disclosure of prior art document D10, which did not overlap with the sub-ranges preferred in D10 and which further selected a specific non-magnetic layer among a group of possible layers. This selection was also sufficiently far removed from the specific examples of D10. Furthermore, the claimed material showed different characteristics of the magnetoresistance change, so that the specific sub-range was not simply an arbitrary part of the generic disclosure of D10, but was of a different nature and therefore novel. The criteria for selection inventions set out in **T 279/89** were thus satisfied. In **T 100/12** too, all three criteria were met.

In **T 230/07** the board noted that novelty and inventive step are two distinct requirements for the patentability of an invention and therefore different criteria should apply for their assessment. So, the presence or absence of a technical effect within a sub-range of numerical values was not to be taken into account in the assessment of novelty. To establish novelty of a sub-range of numerical values from a broader range, the selected sub-range should be narrow and sufficiently far removed from the known broader range illustrated by means of examples. A sub-range is not rendered novel by virtue of a newly discovered effect occurring within it.

In **T 1130/09**, the "selection invention" principle had been applied in the contested decision for the purpose of assessing novelty, regard being had to the three criteria developed in **T 198/84** (see OJ 1985, 209). The board observed that this principle was applicable where a narrow sub-range was selected from a broader range. The passage on page 9, lines 5 to 7, of document (2) disclosed that the dimensions of the structures were measured in nanometres or micrometres. Therefore, as had already been established in the contested decision, the range specifically claimed was a narrow selection which, in the absence of examples in document (2), had to be considered far removed from the central embodiments in that document. The board thus held that the first two of the criteria defined in **T 198/84** were met. The third - that a technical effect of

the narrower sub-range claimed had to be demonstrated - could not, however, be considered for the purpose assessing novelty, because novelty and inventive step were two distinct requirements for patentability. A technical effect within the more narrowly claimed range did not confer novelty on a numerical range which was already novel per se, but merely confirmed its already established novelty. Whether or not there was a technical effect nevertheless remained a matter of inventive step (see **T 1233/05**; **T 230/07**, **T 1948/10**).

In **T 40/11** the board stated that it may be questioned whether the third criteria mentioned in **T 198/84** (see above) has to be considered when assessing novelty.

### 6.3.2 Overlapping ranges

In decision **T 666/89** (OJ 1993, 495) the board gave a ruling on novelty assessment in cases of overlapping numerical ranges. The patent related in particular to a shampoo comprising 8-25% anionic surfactant and 0.001-0.1% cationic polymer. In an earlier patent application a shampoo composition had been disclosed containing 5-25% anionic surfactant and 0.1-5.0% cationic polymer. The board held that the composition was not new. In the board's view, there was no fundamental difference between examining novelty in situations of so-called "overlap" or "selection", and in doing so in other situations, although it might be helpful, in order to verify a preliminary conclusion of a novelty examination in cases of overlap, to investigate whether or not a particular technical effect was associated with the narrow range in question. It needed to be stressed, however, that such a particular effect was neither a prerequisite for novelty nor could it as such confer novelty; its existence could merely serve to confirm a finding of novelty already achieved. The term "available" in Art. 54(2) EPC 1973 clearly went beyond literal or diagrammatical description, and implied the communication, express or implicit, of technical information by other means as well. Thus it was clear that matter that was hidden, not in the sense of being deliberately concealed but rather in the sense of being reconditely submerged in a document, would not have been "made available" in the above sense. In the case of overlapping ranges of physical parameters between a claim and a prior art disclosure, what would often help to determine what was "hidden" as opposed to what had been made available was whether or not a skilled person would find it difficult to carry out the prior art teaching in the range of overlap. Provided the information in the prior art document, in combination with the skilled person's common general knowledge, was sufficient to enable him to practise the technical teaching, and if it could reasonably be assumed that he would do so, then the claim in question would lack novelty. Novelty was carefully analysed on the basis of comparable considerations in **T 366/90** and **T 565/90**.

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

**T 666/89** (OJ 1993, 495), **T 255/91** (OJ 1993, 318), **T 369/91** of 7.10.1992, **T 631/92** and **T 660/93**.

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

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

In **T 594/01** the board stated that it was common general knowledge that every experimental measurement in quantitative analytical chemistry as well as any result of any physical measurement could not be dissociated from the margin of uncertainty attached to the measurement. Normally, the uncertainty of a measured experimental value was irrelevant for the assessment of novelty. However, when a specific experimental value was disclosed in an example of prior art, seeking to distinguish the claimed subject-matter therefrom only in terms of an upper limit to be required to be "lower than" the experimental value must fail, as the claimed subject matter is still not distinguishable from the prior art within the margin of experimental error (see also **T 708/05**).

In **T 1115/09** D1 disclosed that the gas at the outlet of the catalytic bed contained no more than about 10 ppm oxygen, i.e. a range of oxygen concentrations ending with the upper value of "about 10 ppm". According to the boards' established case law (see **T 240/95**), the disclosure of a range was an explicit disclosure of the end values. In the case at issue, it followed by analogy that the end value "about 10 ppm" was explicitly disclosed in D1. The question to be answered was whether this end value fell within the range defined in claim 1 at issue, i.e. "more than 10 ppm oxygen and up to 250 ppm". In the board's view, in the absence of a clear definition in document D1 of the relative term "about", the expression "about 10 ppm of oxygen" was to be given its broadest meaning, namely "10 ± epsilon ppm of oxygen". As the value "10+epsilon" was synonymous with the value "more than 10", the choice of the latter as the lower end of the range defined in claim 1 thus boiled down to the selection of one discrete value within the list of three disclosed in D1: "10-epsilon", "10" and "10+epsilon". The board referred to **T 730/01**, according to which the selection of one item within one single list of equivalent alternative items did not confer novelty, concluded that the disclosure of document D1 inevitably led to subject-matter falling within the scope of protection of claim 1.

### 6.3.3 Multiple selection

In **T 245/91** the patent proprietors contended that the subject-matter of claim 1 amounted to the purposeful selection of a small area from the very broad disclosure in the document. The board observed that most of the ranges in claim 1 of the patent in suit

could be obtained by narrowing down the ranges according to the cited document by approximately 25 to 80% and restricting them to their central portion, and that in a situation like this, where several ranges of parameters were to be considered, a careful comparison had to be carried out in order to assess whether or not the subject-matter of the claimed invention was available to the skilled person. Any obviousness considerations were to be strictly avoided. Referring to **T 666/89** (OJ 1993, 495), the board emphasised that, under the Convention, novelty had to be decided by reference to the total information content of a cited prior art document. In the board's judgment, the combination of the relevant features would not have been seriously contemplated by the skilled reader and was not made available to him, because the said features were not prominent in the cited document and did not therefore lend themselves to an unambiguous, implicit disclosure. A further point to consider was the number of parameters used to define the claimed subject-matter, since each of the ethylene polymers was characterised by several parameters. The board held that, even if most of the ranges for these parameters corresponded to a more or less central portion of the range which limited the corresponding parameter in the composition according to the cited document, as a result of the number of parameters involved, which exceeded ten, the scope of the claimed blends was in reality quite narrow with regard to the breadth of the definition of the known composition. This was also the reason why the argument that there had been an implicit description of this narrow selection in the prior document was not accepted (see also **T 440/04**, **T 1196/05**).

In case **T 653/93**, the appellant argued that the process of claim 1 was novel as it referred to a combination of three process features with selected ranges and product features with specific limits, a combination not disclosed in the prior art document. The board of appeal emphasised that in such situations the question of novelty could not be answered by contemplating the ranges of the various parameters separately. This would, in the board's judgment, be an artificial and unjustified approach, since it was not the specified ranges of the three parameters or their agglomeration that formed the subject-matter of claim 1, but the group of processes defined by the combination of these ranges, which was rather small when compared with the group of processes disclosed in the prior art document. Thus the claimed group of processes, characterised by the combination of three specific process parameters, was not explicitly disclosed in the prior art document and therefore could be said to result from a "multiple (i.e. threefold) selection". The novelty of the technical teaching of claim 1 was corroborated by experimental evidence showing that the products resulting from the claimed processes could not have been obtained by processes which were close to but nevertheless outside the range of the processes claimed. It followed that the subject-matter of claim 1 was not considered as having been disclosed in the prior art document.

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

technical problem. In any case, one of the parameters was referred to in a quite separate section of the disclosure. Furthermore, closer examination of D2 showed that the parameters relating to the amount of rubber and the particle size of rubber, were merely disclosed as independent ranges without any indication as to how, or indeed whether, they might vary in relation to one another. Whilst it was conceded by the respondent at the oral proceedings that D2 disclosed ranges partly overlapping with those defined in the solution of the technical problem, the latter required the simultaneous fulfilment of three values of the same parameters. The board came to the conclusion that the claimed solution was not arbitrary since it solved a specific technical problem compared with the products according to D2. Hence, the claimed solution, to the extent that it overlapped at all with the general disclosure of D2, represented a narrow selection therefrom and fulfilled all the requirements of a true selection (see **T 198/84**, OJ 1985, 209).

#### **6.4. Subject-matter group**

**T 763/89** considered the issues raised by making a selection from a generically defined group of multilayer materials. The patent related to a reversal colour photographic material comprising three layers having differing colour sensitivity, each layer comprising a further three layers having the same colour sensitivity but differing photographic sensitivity. The closest prior art consisted of a reversal material with "at least two" layers. The opponent had argued that the multilayer materials disclosed by this prior art also included the three-layer material claimed, therefore causing lack of novelty. The board, however, held that it was new: although "at least two" was synonymous with a multilayer material and set the lower limit in the form of a double-layer material (the description related to any multilayer material without specifying an upper limit for the number of possible layers), the only theoretical examples given for such multilayer materials were double-layer materials. Nor did the documents cited in support of the opposition as much as hint at a three-layer material. It might appear logical for a three-layer material to form part of the group of multilayer materials in the cited documents, but this did not mean that it was thereby disclosed. On the contrary, it was a new material forming part of this group and selected from it. The board handed down this ruling in the context of previous case law on selection inventions involving chemical substances. This had provided that a technical teaching was prejudicial to novelty if it disclosed a substance in individualised form, i.e. one clearly distinguishable from structurally similar substances. This principle for assessing the novelty of individuals as distinct from a group could be applied to things such as the photographic material in question, which was clearly distinguishable from other things forming part of the same generically described group.

### **7. First and second medical use**

#### **7.1. First medical use**

##### **7.1.1 Introduction**

Under Art. 53(c) EPC methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body ("medical

methods") are excluded from patentability; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

Art. 54(4) EPC (former Art. 54(5) EPC 1973) provides that the general rules of law relating to novelty do not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Art. 53(c) EPC (former Art. 52(4) EPC 1973), provided that its use for any method referred to in that paragraph is not comprised in the state of the art. Thus in addition to the general concept of novelty, this article introduces, in respect of substances and compounds used in surgical and therapeutic treatment and in diagnostic processes carried out on humans and animals, a **special concept of novelty** unknown in other technical fields (**T 128/82**, OJ 1984, 164).

The new Art. 54(4) EPC, which corresponds to the former Art. 54(5) EPC 1973, was not intended to introduce any fundamental change. Both provisions relate to what is known as a "first medical indication of a per se already known substance or composition" (**G 2/08**, OJ 2010, 456). Either a product for use in a method under Art. 53(c) EPC is new per se and can be the subject-matter of a product claim under Art. 53(c), second sentence, EPC or a product (substance or composition) is already known per se but can nevertheless be patented under Art. 54(4) EPC, provided it has not yet been used in a method under Art. 53(c), first sentence, EPC. The first medical indication of a known substance or composition is generally the object of broad generic claims in the form of **use-related product claims**. 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.

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

### 7.1.2 Scope of a purpose-related product claim

In **T 128/82** (OJ 1984, 164) the board considered the question of a first medical indication with regard to the breadth of the purpose-related product claim. The examining division had refused the application on the grounds that it failed to fulfil the requirements of Art. 52(4) and 54(5) EPC 1973 (now Art. 53(c) and 54(4) EPC), as the claims were not limited to the specific therapeutic use of the known compounds as first discovered. The board had to consider whether the broad version of the claims was allowable having regard to Art. 54(5) EPC 1973 and, in particular, whether the EPC 1973 offered a basis for a limited statement of therapeutic purpose susceptible of narrow interpretation. In the opinion of the board the EPC 1973 neither prohibited nor required an unlimited statement of purpose. It held that Art. 54(5) EPC 1973 permitted a purpose-limited substance claim

stating a general therapeutic purpose and found that where a known compound was for the first time proposed and claimed for use in therapy, the fact that a specific use was disclosed in the specification did not in itself call for a restriction of the purpose-limited product claim to that use (see also **T 43/82** and **T 36/83**, OJ 1986, 295).

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

#### 7.1.3 Protection of a preparation in the form of a "kit-of-parts"

It is the boards' settled case law that a "kit-of-parts" described the juxtaposition of separate but functionally interacting individual components.

In **T 9/81** (OJ 1983, 372) the board held that combined preparations, the individual components of which represented known therapeutic agents, might be protected in a formulation corresponding to Art. 54(5) EPC 1973 (now Art. 54(4) EPC) even when claimed as a kit-of-parts, providing those components formed a functional unity (true combination through a purpose-directed application. Claim 1 referred to a combined preparation containing an oxazaphosphorin cytostatic agent and the sodium salt of 2-mercapto-ethane-sulphonic acid as therapeutic active ingredients. The first-mentioned component of the product was known, and the second was a known mucolytic agent. According to the documentary prior art available to the board, the two active ingredients had never been used together for a **new joint effect** and were **unknown as a composition**. The active ingredients which were administered preferably at the same time according to the invention did not therefore represent a mere aggregate of known agents, but a new combination with the surprising, valuable property that the severe side-effects to be expected when administering the cytostatic agents were absent as a result of the detoxifying effect of the sodium 2-mercapto-ethane-sulphonate.

#### 7.1.4 Further technical information as compared with the state of the art

In **T 1031/00** claim 1 was directed to the first medical use of (-) amlodipine, namely the treatment of hypertension. However, the prior art document already showed the ability of (-) amlodipine to inhibit calcium ion influx into rat aorta tissue in vitro as indicative of its effectiveness in the treatment of hypertension. It also disclosed that amlodipine was then undergoing phase III clinical trials for the treatment of hypertension. The board found that the description **provided no further evidence or data** showing the actual antihypertensive effect of the (-) isomer of amlodipine in humans or animals than did the prior art. The board concluded that the subject-matter of the patent application was anticipated by the disclosure in that document; in other words, document (3) disclosed the same medical use as the application at issue.



## 7.2. Second (or further) medical use

### 7.2.1 Introduction

A substance or composition for which a first medical use is already known may nevertheless be patentable under Art. 54(5) EPC for a second or further use in a method under Art. 53(c) EPC if that use is novel and inventive. According to **G 5/83** (OJ 1985, 64), a further medical use claim is a claim directed to the use of a substance or composition for the manufacture of a medicament for a specified therapeutic application. Such a claim is novel if the therapeutic application, i.e. the therapeutic effect obtained by the claimed use, is novel. The Enlarged Board explained the legal and historical background to the patentability of further medical uses in **G 2/08** (OJ 2010, 456).

Under the EPC 1973 a patent for a further medical application could, pursuant to a line of case law first set out in decision **G 5/83** (OJ 1985, 64), be granted for a claim directed to the use of a substance or composition for the manufacture of a medicament for a specified therapeutic application ("**Swiss-type claim**"). The novelty of the subject-matter of such a claim could be derived not only from the novelty of the substance or of the method of manufacture, but also from the new therapeutic application (**G 5/83**). This "special approach to the derivation of novelty" constituted a narrow exception to the general novelty requirement and was not to be applied in other fields of technology.

Under Art. 54(4) EPC (former Art. 54(5) EPC 1973), known substances or compositions are deemed to be new, provided they are used for the first time in such a medical method ("first use in a medical method"). In the early 1980s, the Enlarged Board of Appeal was asked to decide whether any further medical use could receive patent protection under the EPC in spite of the wording of Art. 54(5) EPC 1973 (now Art. 54(4) EPC) which seemed to limit patentability to the first medical use. The Enlarged Board extended the notional novelty provided for in former Art. 54(5) EPC 1973 to apply to each further medical use in the so-called "Swiss type claim", i.e. to a claim "directed to the use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application" (**G 5/83**, OJ 1985, 64; Legal Advice from the Swiss Federal Intellectual Property Office, OJ 1984, 581).

During the course of the revision of the EPC 2000, former Art. 54(5) EPC 1973 ("first use in a medical method") was renumbered to become Art. 54(4) EPC and a new Art. 54(5) EPC was introduced to provide protection for second medical uses. The new Art. 54(5) EPC eliminates any legal uncertainty on the patentability of further medical uses. It unambiguously permits purpose-related product protection for each further new medical use of a substance or composition already known as a medicine.

Claims to a second medical use would be drafted as product claims relating to a specific second or further medical use (see **T 1599/06**).

In **T 1314/05**, the board stated that decision **G 5/83** made it quite clear that its special approach to the derivation of novelty was applicable only to inventions or claims relating to the use of substances or compositions in a method of treatment referred to in

Art. 52(4) EPC 1973, where that method did not yet form part of the state of the art. The board decided that **G 5/83** did not imply that the special approach to novelty assessment which was associated with the Swiss-type claim for substances or compositions could be applied to the use of a device to produce an appliance intended for medical purposes. Extension of that special approach to the production of such appliances ran counter to the general legal principle that exceptions are to be construed narrowly. This was confirmed by the fact that the EPC 2000 legislator in Art. 54(5) EPC expressly restricted the exception concerning the second medical use to substances or compositions.

The board in **T 1099/09** found that it followed clearly and directly from the EPC that Art. 54(4) and (5) EPC applied only to products which were substances or compositions and that no other products were patentable under them. The therapeutic effect of a medicinal product usually resulted from at least one substance or composition used in it and generally known as its active ingredient.

In **T 1758/07** the board stated that **G 5/83** only applies to second (and further) medical indications. It followed from this that the legal fiction behind **G 5/83**, namely that the therapeutic treatment according to Art. 52(4) EPC 1973 was a limiting feature, was applicable only if a therapeutic treatment was indeed a second (or further) medical indication. If, however, the claimed subject-matter related to the first medical indication, **G 5/83** provided no legal basis for additionally claiming the same subject-matter as a second medical indication.

In **G 2/08** (OJ 2010, 456), the Enlarged Board of Appeal considered the consequences of the revised EPC for claims in the Swiss-type format. It decided that, where the subject-matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so-called Swiss-type claim as instituted by decision **G 5/83** (OJ 1985, 64). As Art. 54(5) EPC now permits purpose-related product protection for any further specific use of a known medicament in a method of therapy, the loophole existing in the provisions of the EPC 1973 is now closed - when the reason for the law ceases, the law itself ceases. In view of the fact that patents had been granted for claims of this (Swiss) type and many applications seeking such patent protection were still pending, the Enlarged Board considered that a transitional arrangement was necessary to ensure legal certainty and to protect the legitimate expectations of applicants. It therefore set a time limit of three months from publication of its decision in the Official Journal of the EPO for future applications to comply with the new situation. In this respect the relevant date for future applications was ordered to be their date of filing or, if priority had been claimed, their priority date.

**G 2/08** is discussed in further detail in this chapter I.C.7.2.4 e) "New dosage regimen".

For the "Formulation of claims under the EPC 1973", see "Case law of the Boards of Appeal of the EPO", 6th edition 2010.

## 7.2.2 Transitional provisions

According to Art. 1, No. 3 of the Decision of the Administrative Council of 28 June 2001 under Art. 7 of the Act revising the EPC of 29 November 2000, revised Art. 54(5) EPC is applicable to European patent applications pending at the time of the EPC 2000's entry into force, insofar as a decision on the grant of the patent has not yet been taken (see decision **T 1127/05**, **T 406/06**, **T 1599/06**; see also OJ SE 4/2007).

Art. 54(5) EPC was introduced into the Convention as part of the revision of the EPC. Under the transitional provisions for EPC 2000, Art. 54(5) EPC shall apply to pending applications in so far as a decision on grant has not been taken (**T 1599/06** and **T 1127/05**).

In **T 1599/06** the board considered it already necessary to take the new situation under the EPC 2000 into account when examining the claims at issue. Claim 1 was interpreted as a product claim for a second medical use in accordance with Art. 54(5) EPC (see also **T 385/07**, a case involving similar circumstances).

## 7.2.3 Purpose-limited product claims and Swiss-type claims – scope of protection

In **T 1780/12** the board examined in the context of the issue of double patenting whether the subject-matter of a claim directed to a new medical use of a known compound was the same, irrespective of whether the claim was in the "Swiss-type" format or in the format according to Art. 54(5) EPC. The decision related to a divisional application with a main claim in the form of a purpose-limited product claim under Art. 54(5) EPC. Claim 1 of the parent application was granted in the "Swiss-type" format. The examining division held that the claims of the parent and the divisional applications were directed towards the same subject-matter "in the sense that both these claims concern the same invention claimed in a different format." It refused the application on the basis that double patenting was prohibited. The board held that there was no double patenting. The decisive issue was whether the claims of the patent granted on the divisional and that granted on the parent had the same subject-matter. The category of a claim and its technical features constitute its subject-matter and determine the protection conferred (see **G 2/88**, OJ 1990, 93). The claims in question were of different categories: Swiss-type claims were purpose-limited process claims (use of X for the manufacture of a medicament for the treatment of Y) and claims formulated in accordance with Art. 54(5) EPC were purpose-limited product claims (X for use in the treatment of Y). As regards the technical features, the board concluded that both sets of claims defined the same compound and the same therapeutic use, but that the Swiss-type claims comprised in addition the feature of manufacturing a medicament whereas the claim in accordance with Art. 54(5) EPC did not. The claimed subject-matter was thus different. This outcome has been followed in decision **T 879/12**. As regards the scope of protection, the board considered that a purpose-limited process claim, such as a Swiss-type claim, also conferred less protection than a purpose-limited product claim, such as a claim in accordance with Art. 54(5) EPC (see also **T 13/14**; for further details with regard to the scope of protection, see Chapter II.F.5 "Double patenting").

In **T 1570/09** the set of claims of the main request contained two independent claims, claim 1 in Swiss-type form and claim 4 as a purpose-limited product claim under Art. 54(5) EPC. The claims aimed to seek protection for one and the same medical use of one and the same active drug. The purpose-limited product claim 4 sought protection for the same medical indication of the same substance as the Swiss-type claim 1, and the notional novelty of claim 1 was not derived from the "medicament" itself. The board stated that there was no longer an objective reason for justifying the simultaneous presence of both claims in the set of claims to be proposed for grant. Allowing such a set of claims would cause the contradictory legal situation that the old provisions in Art. 54 EPC 1973 together with Art. 52(4) EPC 1973, and the new provisions in Art. 54 EPC together with Art. 53(c) EPC, would apply simultaneously to one and the same set of claims. Art. 54(5) EPC applied to the case at issue and thus the purpose-limited product claim 4 of the main request was allowable in view of a new medical indication of a known substance. The Swiss-type form was conceived as an exception under the old law (EPC 1973). Therefore, in the board's view, there was no longer any legal reason for allowing Swiss-type claim 1 in the set of claims of the main request. Accordingly, the main request was not allowable.

In **T 1021/11** too, the main request comprised two independent claims for the same medical indication of the same substance, one claim drafted in the Swiss-type format and the other claim following the provisions in Art. 54(5) EPC. The application had been pending when decision **G 2/08** was issued and therefore belonged to the category of applications in which the Swiss-type format could, as a general rule, still be used. As both claim formats were available for the application and claims in both formats were present in the main request, the question arose whether both claim types could be present in a single set of claims. The board concurred with the conclusion reached in **T 1570/09** that decision **G 2/08** did not give applicants an absolute right to draft two independent claims in one single set of claims for one and the same medical indication of one and the same substance, one of those claims being in the Swiss-type format and the other in the format in accordance with Art. 54(5) EPC. However, it appeared to the board that no prohibition of the coexistence of such claims in one claim set could be deduced from **G 2/08** either, as it was silent in this respect. Having carefully examined the reasoning given in decision **T 1570/09**, the board found that several factors prevented it from objecting to the presence of claims in the two formats in one single set of claims in the case before it. Firstly, it noted that a single set of claims could be governed by provisions of the EPC 1973 and the revised EPC at the same time. Secondly, the continued existence of the Swiss-type format, in parallel to the provisions of Art. 54(5) EPC, was a direct consequence of the transitional arrangement provided for by the Enlarged Board in decision **G 2/08**. Thirdly, the board saw no reason to prevent an applicant from choosing both available formats during the interim period and considered it justified to do so in one set of claims. Even though the claims in both formats provided patent protection for the same medical indication, there was a difference in the subject-matter of the claims due to their category, in combination with their technical features (see above **T 1780/12**, **T 879/12**). Thus, by filing two patent applications having the same effective date (two parallel applications or parent/divisional or priority/subsequent application) it was possible for an applicant to obtain patent protection for the same second or further medical indication in both available claim

formats. The board therefore did not object to the presence of both formats in a single set of claims, as both formats were applicable to the present application. The board noted that no objections had been raised in similar previous cases (see **T 396/09** and **T 1869/11**), even if the issue had not been discussed in those decisions.

#### 7.2.4 Novelty of the therapeutic application

##### a) General

The cases decided following decision **G 5/83** throw some light on the categories of novel and inventive therapeutic use for which the manufacture of a known substance or compound may be considered patentable. Manufacture of a known composition has been considered patentable for use in a new therapy where the target group to be treated was different (seronegative pigs instead of seropositive pigs; **T 19/86**, OJ 1989, 25), and in the case of a new therapy with a different technical effect (prevention of tooth decay by means of a known substance, but by removing plaque instead of by reducing the solubility of tooth enamel; **T 290/86**, OJ 1992, 414) or a new therapy with a different mode of administration (subcutaneous instead of intramuscular injection; **T 51/93**).

##### b) New therapeutic application based on the group of subjects to be treated

According to the established case law of the boards of appeal, the use of the same compound in the treatment of the same disease for a particular group of subjects, can nevertheless constitute a novel therapeutic application, provided that it is carried out on a new group of subjects which is distinguished from the former by its physiological or pathological status (see **T 19/86**, OJ 1989, 24; **T 893/90**, **T 233/96**, **T 1399/04**, **T 734/12**).

In **T 19/86** (OJ 1989, 25) the board had to decide whether the application of a known medicament for the prophylactic treatment of the **same disease** in an **immunologically different** population of animals of the same species could be considered a new therapeutic application from which novelty for the claims could be derived. According to decision **T 19/86** the question of whether a new therapeutic use was in accordance with decision **G 5/83** should not be answered exclusively on the basis of the ailment to be cured but also on the basis of the subject (in the case in question, the new group of pigs) to be treated. A therapeutic application was incomplete if the subject to be treated was not identified; only a disclosure of both the disease **and** the subject to be treated represented a complete technical teaching. The proposal according to the application to protect animals which could not hitherto be protected from the disease in question, by intranasally administering to them a known serum, could not be considered disclosed in the prior art and therefore constituted a novel therapeutic application in accordance with **G 5/83**.

In **T 233/96** the board held that if the use of a compound was known in the treatment or diagnosis of a disease of a particular group of subjects, the treatment or diagnosis of the same disease with the same compound could nevertheless represent a novel therapeutic or diagnostic application, provided that it was carried out on a new group of subjects which was **distinguished** from the former **by its physiological or**

**pathological status (T 19/86, OJ 1989, 25; T 893/90)**. This did not apply, however if the group chosen overlapped with the group previously treated, or the choice of the novel group was arbitrary which meant that no functional relationship existed between the particular physiological or pathological status of this group of subjects (here humans who were unable to exercise adequately) and the therapeutic or pharmacological effect achieved.

c) New technical effect

In decision **T 290/86** (OJ 1992, 414) the board considered the claimed invention new. The grounds for its decision were as follows: "When a prior document and a claimed invention are both concerned with a similar treatment of the human body for the same therapeutic purpose, the claimed invention represents a further medical indication as compared to the prior document within the meaning of decision **G 5/83** if it is based upon a different technical effect which is both new and inventive over the disclosure of the prior document". In this case the technical effect considered new was the removal of dental plaque, whereas the prior art only disclosed the depression of enamel solubility in organic acids (see also **T 542/96** and **T 509/04**).

In **T 836/01** the board accepted that claims directed to the use of IL-6 to directly influence tumour growth and differentiation were novel over a prior art disclosure of the use of IL-6 to indirectly treat cancer by activating T cells, finding that a new technical effect resided in the medical indication of the treatment of cancer vs. enhancement of the immune system. Applying the principles of decision **G 5/83** (OJ 1985, 64), the board concluded that the technical effect relied upon in the claimed invention identified a **new clinical situation**. Since a new clinical situation was inseparable, as an abstract concept, from a patient suffering under it, it had to be concluded that this new clinical situation also identified a new sub-group of subjects being treated (**T 1642/06**).

In **T 1955/09**, the board needed to decide whether the use claimed represented a further and different therapeutic use from the disclosure in document (D1). It stated that the conclusion could not be drawn that the technical effect relied upon by the claimed invention, i.e. the antibiotic effect, was a mere explanation of how the compounds inhibited or neutralised toxins. Rather, this effect identified a new clinical situation, namely one in which it could be preferable to target the infection itself, not merely the toxins produced by the bacteria or fungi causing the infection. The board decided that this reasoning was based on the differentiation of a direct and indirect effect on claims relating to second or further medical uses of a known substance (see above **T 836/01** and **T 1642/06**). In view of the foregoing, the board was satisfied that the subject-matter of claim 1 at issue fulfilled the requirements of Art. 54(1) and (3) EPC vis-à-vis the disclosure in document D1.

d) Same illness

In **T 108/09** the claims were drafted in the second medical use format according to decision **G 5/83**. The board noted that according to decision **G 2/08** (OJ 2010, 456), Art. 54(5) EPC does not exclude a medicament already known to be used in the

treatment of an illness from being patented for use in a different treatment by therapy of the same illness. It considered it appropriate to evaluate whether the breast cancer of claim 1 as granted was identical to the breast cancer according to document D2. The board noted that the tumours of document D2, being only resistant to tamoxifen, could be distinguished from the tumours of claim 1 as granted, which were additionally resistant to an aromatase inhibitor. This distinction meant that in the case at issue two different diseases or two subsets of a disease (tumour) were concerned. As a consequence, in analogy to the findings in **T 893/90**, the board established novelty. The subject-matter of claim 1 as granted was therefore novel over D2.

e) New dosage regimen

Some boards of appeal have considered recognising specific therapeutic uses as patentable in principle to be problematic where they differ from the prior art merely in terms of the dosage regimen. In **G 2/08** (OJ 2010, 456), the Enlarged Board addressed this issue in detail.

With reference to the case law and the danger of a collision with Art. 52(4) EPC 1973, decision **T 584/97** denied patentability for a claim directed essentially to the administration of nicotine in increasing doses. In **T 317/95**, **T 56/97** and **T 4/98** (OJ 2002, 139) the issue was discussed, with answers tending towards the negative, but ultimately left undecided. In all of these cases, the grant of a patent would anyway have been refused on other grounds - i.e. lack of novelty or inventive step - so that the outcome of a decision on this issue was immaterial (see also **T 1319/04**, OJ 2009, 36)

In **T 1319/04** (OJ 2009, 36), the board referred to the Enlarged Board of Appeal the question whether medicaments for use in methods of treatment by therapy, where the only novel feature was a dosage regime, are patentable under Art. 53(c) and 54(5) EPC. The Enlarged Board answered in **G 2/08** (OJ 2010, 456) as follows:

1. Art. 54(5) EPC does not exclude a medicament which is already used in the treatment of an illness being patented for use in a different treatment by therapy of the same illness. Art. 53(c) EPC, which lists as an exception to patentability 'methods for treatment of the human body ... by therapy' is clear and unambiguous, and draws a borderline between unallowable method claims directed to a therapeutic treatment on the one hand and allowable claims to products for use in such methods on the other. The two concepts of a method of treatment by therapy and of a product to be used in such a method are so close to each other, that there is a considerable risk of confusion between them unless each is confined to its own domain as allocated to it by the law. Art. 53(c), second sentence, EPC, is not therefore to be interpreted narrowly; on the contrary, it is appropriate to give both provisions (Art. 54(5) and Art. 53(c) EPC) the same weight and conclude that, in respect of claims directed to therapy, method claims are absolutely forbidden in order to leave the physician free to act unfettered, whereas product claims are allowable, provided their subject-matter is new and inventive. By virtue of a legal fiction, Art. 54(4) and (5) EPC acknowledge the notional novelty of substances or compositions even when they are already comprised in the state of the art, provided they are claimed for a new use in a method which Art. 53(c) EPC excludes from patent

protection. The notional novelty, and thus, non-obviousness, if any, is not derived from the substance or composition as such, but from its intended therapeutic use. Art. 54(5) EPC refers to "any specific use" [emphasis added] and thus, in conjunction with the stated intention of the legislator to maintain the status quo of the protection evolved in the case law of the boards of appeal under **G 5/83** (OJ 1985, 64) in this respect, this use cannot be *ex officio* limited to a new indication *stricto sensu* (approving **T 1020/03**, OJ 2007, 204).

2. The Enlarged Board went on to hold that such patenting is also not excluded where a dosage regime is the only feature claimed which is not comprised in the state of the art. Given the answer to the first question, and, since Art. 54(5) EPC may be used in cases of the treatment of the same illness, the "specific use" in the sense of that provision may reside in something other than the treatment of a different illness, the Enlarged Board held that there is no reason to treat a feature consisting in a new dosage regime of a known medicament differently from the one given to any other specific use acknowledged in the case law. However, it stressed that the whole body of jurisprudence relating to the assessment of novelty and inventive step also applies. The jurisprudence on this continues to apply (see **T 290/86**; OJ 1992, 414; **T 1020/03**, OJ 2007, 204; **T 836/01**; **T 1074/06**).

In **T 1020/03** (OJ 2007, 204) a pure dosage regimen was for the first time recognised as not excluded from patentability. The claims were directed to the use of insulin-like growth factor-I in the preparation of a medicament for administering to a mammal in a specific discontinuous administration pattern. In the headnote, the board stated that any use to which Art. 52(4) EPC, first sentence, applies in circumstances where the composition has already been suggested for some therapeutic use, allows a second medical use claim to the preparation of the composition for that second medical use, irrespective of in what detail that use was specified, subject to the use being novel and inventive. For the purposes of novelty also under Art. 54(5) EPC this depends on whether use for therapy is novel, irrespective of the detail with which the therapy is stated in the claim.

f) New therapy with a different mode of administration

In **T 51/93** 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 board stated that a different mode of administration for a pharmaceutical could render a medical use claim drafted according to decision **G 5/83** novel. Patentability should be treated as depending only on whether this modification was in fact novel and inventive. Thus, it was possible to acknowledge novelty over D(4) (see **T 143/94**, OJ 1996, 430).

g) Interpretation of "substance or composition"

In **T 2003/08** the board allowed a claim directed to a new use of a compound for an extracorporeal treatment. The appellant (opponent) argued, relying on decisions **T 227/91** (OJ 1994, 491), **T 775/97** and **T 138/02**, in which the boards defined the term "medicament", that claim 1 did not fulfil one prerequisite to qualify as a second medical



use claim, namely that a "medicament" was used in the treatment. Indeed the means used in the treatment were a "column", which was not a "medicament", but a "device". In the board's view, it emerged from the whole reasoning of decision **G 5/83** (i) that the Enlarged Board intended to allow the special second medical use-form of protection only for those uses in the medical domain which concerned a "substance" or "composition", (ii) that it was the "substance" or "composition" which achieved the medical effect and (iii) that the terms "substance" or "composition" referred at least to products which were chemical entities or compositions of chemical entities. In the case at issue the medical effect on which the treatment according to claim 1 was based was the removal of immunoglobulin from the plasma of patients suffering from dilated cardiomyopathy. This effect was achieved by the "specific ligand for human immunoglobulin", which was undisputedly a chemical entity. The "column" only served as a carrier for the ligand and was not instrumental in achieving the therapeutic effect. Accordingly, the board held that the means used for the treatment in accordance with claim 1 was to be considered as a "substance" or "composition" within the meaning of decision **G 5/83**.

In **T 773/10** claim 1 was directed to a new use of a dialysis membrane for the treatment of multiple myeloma. It was undisputed that document D1 disclosed all the structural features of the dialysis membrane. Art. 54(5) EPC states that Art. 54(2) EPC does not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Art. 53(c) EPC, provided that its use for any such method is not comprised in the state of the art. The board stated that these provisions introduced a special assessment of novelty for purpose-related features. According to the appellant's submissions, the specific use of the dialysis membrane claimed in claim 1 for the treatment of multiple myeloma, i.e. a method of treatment by therapy of the human body, was not comprised in the state of the art. Therefore, it was crucial to determine whether the special assessment of novelty set out in Art. 54(5) EPC might apply to such a membrane and whether the claimed membrane should be considered a "substance or composition" within the meaning of Art. 54(5) EPC. Referring to the "travaux préparatoires" for the EPC 2000 the board had no doubt that decision **G 5/83**, had focused on new uses of compounds or "substances", i.e. products of the pharmaceutical industry generally referred to as "medicaments" or "drugs". However, showing that the legislative history did not include discussions on new uses of medical products other than compounds or "substances", i.e. products of the pharmaceutical industry generally referred to as "medicaments" or "drugs", could not establish that the legislator had intended to include any such products within the meaning of "substance or composition". The board came to the conclusion that the scope of the term "substance or composition" in Art. 54(5) EPC did not extend to all products for a specific use in a method referred to in Art. 53(c) EPC. The board referred to **T 2003/08** (see above), which allowed a claim directed to a new use of a column for an extracorporeal treatment. However, in that decision it was not the column as such which had been regarded as the "substance or composition" the new use of which could confer novelty according to Art. 54(5) EPC. Rather, the column contained a ligand constituting the "active" ingredient responsible for the "therapeutic effect". In the board's view, the case before it was different. The claimed dialysis membrane did not contain any further substance or composition which might constitute an "active" ingredient within the meaning of decision

**T 2003/08.** It followed that for the claimed dialysis membrane the exceptional novelty assessment as set forth in Art. 54(5) EPC did not apply. The application was refused.

In **T 2369/10** the independent claim was formulated as a use-related product claim, in particular for a device for use in a method of treatment of the human or animal body by therapy. The main issue to be resolved was whether a second (or further) medical use could confer novelty on a known device. The board held that, having regard to the wording of Art. 54(4) and (5) EPC, the ordinary meaning of those provisions could not be extended so as to include something which was not explicitly provided for. It consequently considered that there was no basis on which to contemplate that novelty might be conferred on products other than substances and compositions by virtue of the provisions of Art. 54(4) and (5) EPC.

h) Statement of purpose of surgical use for a known instrument

In **T 227/91** (OJ 1994, 491) the board held that the purpose of a surgical use alone could not render novel the subject-matter of a claim relating to the use of the components of a known instrument for its manufacture, i.e. assembly. The claim under consideration related to the "use" of intercepting of a laser beam of substrate means and coating means in the manufacture of a laser surgical instrument (the use). The indication of the purpose, i.e. intercepting the laser beam, was a characteristic of the surgical use of the instrument and did not affect the structure or composition of the entity itself. This kind of functional reference could not normally impart novelty to an otherwise known article unless the function implied a necessary modification of the article itself. The surgical use of an instrument was not analogous to a therapeutic use, since the instrument was not consumed in the application and could be used repeatedly for the same or even for other purposes (**T 138/02**, **T 1099/09**).

i) Discovery of a previously unknown property of a compound underlying the known effect

In **T 254/93** (OJ 1998, 285) an application relating to the use of a retinoid compound in association with the use of corticosteroids in the prevention of skin atrophy was refused by the examining division. The board noted that it was a basic consideration in **G 2/88** (OJ 1990, 93) that the recognition or discovery of a previously unknown property of a compound, such property providing a new technical effect, could involve a valuable and inventive contribution to the art. The board stated that it had no difficulty in accepting that the prevention of skin atrophy had to be regarded as a pharmaceutical feature and, following the conclusions of the Enlarged Board of Appeal, that the effect underlying this feature was not made available to the public in written form by any of the cited literature. Nevertheless, the question arose whether, in the case at issue, this effect was a technical effect within the meaning of decisions **G 2/88** and **G 6/88** (OJ 1990, 114), which was necessary to establish novelty, under Art. 54(1) EPC 1973, of the claimed subject-matter over the prior art. Although it concerned a specific aspect of the known use, the use specified in claim 1 (prevention of skin atrophy) was not actually different from the known use (treatment of dermatoses). The board observed that when a second medical indication was claimed in relation to the use of a constituent in the preparation of

a known composition and the final effect was apparent in **using the known composition for the known purpose**, a technical problem could be seen neither in the obtaining of the final effect nor in the preparation of the composition. The only remaining question could be the explanation of the phenomenon underlying the treatment according to the known process. However, the **mere explanation of an effect** obtained when using a compound in a known composition, even if the explanation related to a pharmaceutical effect which was not known to be due to that compound in the known composition, could not confer novelty on a known process if the skilled person was already aware of the occurrence of the desired effect when applying the known process (see also **T 669/01**, **T 605/09**, improvement of activity in a pet is not a new technical effect in terms of **G 2/88**; **T 433/11**).

Similarly, in **T 486/01** the physiological effects highlighted by the patent proprietor were only regarded as additional items of knowledge about a further mechanism of action underlying the known therapeutic application.

In **T 385/07** claim 1 was drafted in the form of a second/further medical use of apidine for making a medicament for the treatment of a mammal affected by pancreatic cancer. The relevant issue was whether or not this use related to a novel medical use within the meaning of decision **G 5/83** (OJ 1985, 64). The board found that, following decision **T 158/96**, the information in a citation that a medicament was undergoing a clinical phase evaluation for a specific therapeutic application was not prejudicial to the novelty of a claim directed to the same therapeutic application of the same medicament if the content of said citation did not allow any conclusion to be drawn with regard to the actual existence of a therapeutic effect or any pharmacological effect which directly and unambiguously underlay the claimed therapeutic application. It was true that the present application related to *in vivo* results in mice, not humans. However, it was an accepted principle of the case law that, for the purpose of patent protection of a medical application of a substance, a pharmacological effect or any other effect such as an effect observed on animal models was considered to provide sufficient evidence of a therapeutic application if, for the skilled person, this observed effect directly and unambiguously reflected such a therapeutic application (see e.g. **T 241/95**, OJ 2001, 103). Applying this principle, the board accepted in the case at issue that, in the absence of any data on human patients, the *in vivo* experiment was sufficiently predictive of the *in vivo* anti-tumour activity in humans.

j) Whether there is a therapeutic method

In **T 454/08** the board confirmed that if a claim formulated as a Swiss-type claim was not directed to the use of any therapeutic method or was *de facto* directed to a non-therapeutic use, the feature defining the use was purely illustrative and could not be used to establish novelty over the prior art. In effect, this specific novelty approach applied only to claims directed to the use of a substance or composition intended for use in a method referred to in Art. 52(4) EPC 1973 (now Art. 53(c) EPC). Claim 1 of the main request was based on the model proposed by **G 5/83**, namely the application of a substance to produce a composition for a particular use. However, nothing in the wording of claim 1 implied use in any of the therapeutic methods within the meaning of

Art. 53(c) EPC. The specific novelty approach created by **G 5/83** thus did not apply to claim 1 of the main request, the subject-matter of which amounted to a process claim. The step of administering the tablet had to be seen as an illustrative feature of the tablet and not as a limiting feature for a specific mode of administration.

In **T 1278/12** the board had to decide whether the main claim constituted a second medical use claim (Swiss-type claim). The appellant argued that the reference to "an infant delivered via caesarean section" implicitly indicated a therapeutic effect. The board stated that an enteral administration to an infant delivered via caesarean only specified the mode of delivery to the patient, but did not relate to any therapeutic effect obtained thereby. The appellant argued that, according to **T 1020/03**, the therapeutic effect did not need to be specified in a claim for it to qualify as a further medical use claim. The board did not share the appellant's view and observed that the board in **T 1020/03** had explicitly stated that the further medical indication had to be specified in the claim with some degree of specificity. Since claim 1 of the main request did not specify any therapeutic effect at all, it represented a non-medical use claim. Therefore the wording "for enteral administration to an infant delivered via caesarean section" limited claim 1 only in so far as the composition had to be suitable for the enteral administration to caesarean section infants. Since this suitability was given in some documents, these were novelty-destroying for the subject-matter of claim 1.

## **8. Second (or further) non-medical use**

### **8.1. Novelty criteria for use claims and process claims containing a purpose feature**

#### **8.1.1 General issues decided before the Enlarged Board of Appeal**

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

The Enlarged Board dealt in detail with the novelty of second non-medical uses in **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114). The questions referred to it concerned use claims, i.e. claims defining a "use of compound X for a particular purpose", or similar wording, where the only novel feature was the purpose of that use. They were not about medical inventions but were of a general nature and primarily concerned interpretation of Art. 54(1) and (2) EPC 1973. The patentability of a second non-medical use of a product had already been recognised in principle in **G 5/83** (OJ 1985, 64), which concerned the second medical use of a substance.

In the non-medical field use claims are admissible and not subject to special conditions.

In **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114), the Enlarged Board had to decide whether a claim for the use of a compound for a particular non-medical purpose was

novel under Art. 54 EPC 1973, having regard to a prior publication which disclosed the use of that compound for a different non-medical purpose, so that the only novel feature in the claims was the purpose for which the compound was used. The specific problem in these cases was that the previously disclosed use of the substance, although specifically stated to be for another purpose, would **inherently** comprise the use as claimed in the new application (**T 59/87**, OJ 1988, 347; **T 208/88** of 20.7.1988).

The Enlarged Board cited **T 231/85** (OJ 1989, 74), a case concerning an application for use as a fungicide of a compound already disclosed in the prior art as a growth regulator. The use according to the claimed invention and the use disclosed in the prior art were both carried out in the same way (i.e. the means of realisation was the same, namely the spraying of useful plants). The board had nevertheless concluded that the claimed invention was novel because the technical teaching in the application differed from that in the citation, and that, even if means of realisation was the same, the use was not yet known.

In **G 2/88** and **G 6/88**, therefore, it was pointed out that a claimed invention lacked novelty unless it included **at least one essential technical feature** which distinguished it from the state of the art. A basic initial consideration, when deciding upon the novelty of a claim, was therefore to analyse it in order to determine its technical features. The Enlarged Board took the view that the proper interpretation of a claim whose wording clearly defined a new use of a known compound would normally be such that the attaining of a new technical effect on which the new use was based was a technical feature of the claimed invention. Thus, where the particular technical effect underlying such use was described in the patent, the proper interpretation of that claim would require a **functional feature** to be implicitly contained in the claim as a technical feature - e.g. the compound actually achieved the particular effect.

The Enlarged Board thus concluded that, with respect to a claim to a new use of a known compound, such new use might reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a **functional technical feature** of the claim (e.g. the achievement in a particular context of that technical effect). Had that technical feature not previously been made available to the public by any of the means set out in Art. 54(2) EPC 1973, then the claimed invention was novel, even though such technical effect might have inherently taken place in the course of carrying out what had previously been made available to the public. The final decisions in cases **T 59/87** (OJ 1991, 561) and **T 208/88** (OJ 1992, 22) both held that the claimed use inventions were novel and inventive.

### 8.1.2 Non-therapeutic treatment of animals

In decision **T 582/88** the board applied the principles set out in decision **G 2/88** in slightly different circumstances. The invention's subject-matter was a method of non-therapeutic treatment of animals for the purpose of improving their milk production and comprising oral administration of a propionate-increasing amount of glycopeptide antibiotics. In the board's view the technical effect produced by the invention - in this case an improvement in milk production - was new and had to be construed as a new technical feature

sufficient to make the invention novel. The claim's subject-matter was a method of non-therapeutic treatment of animals, not - as in decision **G 2/88** - use of a known product to achieve a new effect (see also **T 848/93**).

a) Non-therapeutic application

In **T 469/94**, the set of claims had been worded as a second non-medical use of a product (choline or a choline derivative) to alleviate muscle fatigue. The examining division had considered that the known treatment with choline of muscle diseases and hardness was equivalent to, or even a synonym for, the treatment for reducing muscle fatigue which was claimed in the application in suit. The board concluded that the ability of choline to reduce the perception of fatigue had not been made available to the public. The first use of choline, in the therapeutic field, was known from two prior art documents. The board held that an independent invention could be based on the newly discovered effect, if such an effect led to a new technical application which was clearly distinguishable from the previous known application. The prior art documents did indeed describe the use of choline on groups of patients having manifest diseases: either epilepsy or muscle diseases and injuries. The board observed that fatigue arising from major exercise was not of a pathological nature, and that the performance itself of major exercise appeared to be quite incompatible with the situations envisaged in the prior art documents, specifically that of muscle injuries. The non-therapeutic use of choline according to the invention was therefore independent of, and distinguishable from, the known therapeutic use, because it was **directed to a distinct group of persons**. The subject-matter of the claim at issue was therefore found to be novel.

8.1.3 Applicability of G 2/88 and G 6/88 to process claims

a) General

In several decisions, the boards have taken the view that the criteria set out by the Enlarged Board in **G 2/88** and **G 6/88** (OJ 1990, 93 und 114) cannot readily be applied to process claims. Particularly in the more recent case law, they have found that those criteria can be applied only to claims directed to the use of a substance for achieving an effect and cannot be extended to claims directed to a process for producing a product characterised by process steps wherein the purpose of carrying out said process steps is indicated in the claim (**T 1049/99**, **T 1343/04**, **T 1179/07**, **T 304/08**, **T 2215/08**, **T 1039/09**, **T 1140/09**). The case law has constantly interpreted **G 2/88** in a restrictive manner, i.e. to mean that only claims relating to the use of a known compound for a particular purpose, based on a technical effect described in the patent, should be interpreted as including that technical effect as a functional technical feature, provided that such technical feature has not previously been made available to the public (**T 1822/12**).

b) Different treatment of use and process claims

In **T 1049/99** the board took the view that the criteria set out in decisions **G 2/88** and **G 6/88** (OJ 1990, 93 and 114) could not simply be transferred to process claims. The

board pointed out that, according to those decisions, a new purpose related to a new technical effect could render novel the claimed use of a product already known, even though the means of realisation making it possible to achieve the new purpose was identical to the known means of realisation, given that a use claim in reality defined the use of a particular physical entity to achieve an effect. The board distinguished this situation from that of a process claim which defined the use of a particular physical entity to achieve a product and, therefore, fell within the scope of Art. 64(2) EPC 1973. An extension of the criteria set out in the decisions of the Enlarged Board referred to above would result in protection of a product obtained by a process already known on the basis of the new effect discovered in the process itself, even though that process was identical to that already known (see also **T 910/98**).

In **T 1179/07** the board found that the central findings in **G 2/88** und **G 6/88** concerned a claim to the use of a known compound for a previously unknown purpose. No findings were made in those decisions with respect to process claims for a specific use. Although the "use of a compound" could be regarded as a process including the compound use as a procedural step, a use claim could not normally be treated as equivalent to a process claim because Art. 64(2) EPC was not, as a rule, applicable to use claims. According to the Enlarged Board in **G 2/88**, Art. 64(2) EPC was generally not directed to patents whose claimed subject-matter was the use of a process to achieve an effect (this normally being the subject of a use claim) but rather to European patents whose claimed technical subject-matter was a process of manufacture of a product. Despite the indicated purpose, the process claimed in this case was clearly aimed at manufacturing a product: a procedural treatment of the source product resulted in an end product differing from the source product. Were the board to extend the findings made in **G 2/88** and **G 6/88** to the granted process claim, this would confer fresh protection under Art. 64(2) EPC on the product resulting from granted process claim 1 even though that product was already known from D1 and obtained by precisely the same process as that described in D1. It could not, however, be in keeping with the object and purpose of Art. 64(2) EPC to extend its protection to a product obtained by a known process. It was, in particular, this difference in the treatment of process and use claims in the context of Art. 64(2) EPC which, in the board's view, left it no scope to extend the principles laid down by the Enlarged Board in **G 2/88** and **G 6/88** with regard to the use of a known compound for a previously unknown purpose to process claims (see also **T 684/02**, **T 910/98** and **T 1049/99**).

In **T 304/08** the board noted that **G 6/88** and **G 2/88** (OJ 1990, 93) contained no finding concerning claims to a method (or process, these two terms being used synonymously in this decision) wherein the purpose of carrying out the method was defined in the claim. However, **G 2/88** stated that there were basically two different types of claim, namely a claim to a physical entity (e.g. product, apparatus) and a claim to a physical activity (e.g. method, process, use) and that the technical features of a claim to an activity were the physical steps which defined such activity. Decision **G 2/88** further distinguished, in the context of defining the extent of protection conferred under Art. 64(2) EPC, between claims which defined the use of a particular physical entity to achieve an "effect" and the use to produce a "product" and concluded that, providing that the use claim in reality defined the use of a substance to achieve an effect and did not define such a use to

produce a product, the use claim was not a process claim within the meaning of Art. 64(2) EPC. Thus, the criteria set out by the Enlarged Board of Appeal in the aforementioned decisions could only be applied to claims directed exclusively to the use of a substance for achieving an effect.

In **T 1092/01** the board held that the rationale of decision **G 2/88** was applicable to a claim directed to a known process by which a previously unknown technical effect (conversion of lutein to its isomeric form zeaxanthin) was achieved. It considered that the relevant question to be answered was whether the skilled person would use the claimed process for a purpose different from that for which the processes in the prior art had been used. In the board's judgment, in view of its starting material and its procedural steps, the claimed process could only serve the same final purpose of production of pigments for food industry. The disclosure of the purpose did not open the way to a new activity and occurred inherently when carrying out the process in the prior art. Hence the board concluded that the statement of such an effect could not confer novelty on the claimed process (see **T 1039/09**). Observing that the board in **T 1092/01** had not given any detailed reasons for the above-mentioned finding (in point 17 of the decision) that the rationale of **G 2/88** could also be applied to a process claim, the board in **T 1179/07** likewise held that stating the purpose in the process claim could not establish novelty.

#### c) Interpretation of process claims

Where a process claim begins with wording such as "method for remelting galvanic layers", the part "for remelting" is not to be understood as meaning that the process is merely suitable for remelting such layers, but rather as a functional feature concerning the remelting of galvanic layers and, hence, defining one of the steps in the claimed process (see **T 848/93** below). Such a case has to be distinguished, however, from those where the claim is directed to a process aimed at a particular purpose and comprises physical steps resulting in the production of a product (i.e. the claim is in fact directed towards the production of a product; Guidelines F-IV, 4.13 – November 2015 version).

In **T 848/93** the application claimed a process which differed from the prior art only in its use (remelting instead of vapour phase soldering). The board considered the process feature "remelting galvanic layers" to be a functional technical feature which established novelty. If a claim concerned e.g. an apparatus which differed from a known apparatus only as regards the use indicated, then the use was not an apparatus feature. This meant that the two pieces of apparatus were identical in terms of structure. If the known apparatus was suitable for the claimed use, the application lacked novelty. If the claim was directed to an object, a substance or a composition, the same applied. If however the claim was for a process, the situation was not comparable. In such a case, the use feature was a functional process feature comparable in category with the other features (steps) of the process.

#### d) Use of a known process for a particular purpose

The board in **T 461/07** observed that it was settled case law that there was no basis for regarding the purpose of carrying out a process as having the effect of a functional



technical feature distinguishing the process from others carried out using identical features but for a different purpose (**T 210/93** and **T 1343/04**).

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 (confirmed in **T 684/02** and **T 2215/08**).

In **T 684/02** the board noted that claim 1 was directed to the use of the fluorination reaction process in order to remove the unstable end groups from the starting polymer. The effect of this process manifested itself in its result, i.e. in the product together with all its internal characteristics and the consequences of its particular history of origin (see **T 119/82**; OJ 1984, 217) but not in an effect observed in a particular use of the product. Moreover, in the board's view, a claim to the use of a process or to the process itself addressed the producer of a product, irrespective of any conceivable later applications, methods of further processing or uses of the product, whilst a claim to the use of a product clearly addressed the customer/user of that product. In other words, the asserted advantage or purpose could not be taken into account as a functional technical feature in claim 1 because of the jurisprudence of the boards of appeal as well as for technical reasons, because the asserted advantage or purpose was related only to the product (manufactured in some process or other) when used in certain circumstances and marginal conditions.

In **T 1039/09** the physical steps of the claimed method were the same as in the prior art. However it was submitted that the purpose of the method, namely producing bovine milk having a reduced level of saturated fatty acids relative to the level of unsaturated fatty acids, was also a technical feature to be taken into account in the assessment of the novelty of claim 1. The board stated that the claim at issue related to a known method for a particular purpose, namely the production of a product, wherein the product is the necessary result of the known method and indistinguishable from the product obtained in the prior art. The question arose whether the purpose could be considered a functional technical feature of a claim directed to a process for producing a product characterised by process steps wherein the purpose of carrying out said process steps was indicated in the claim. In the board's judgment the skilled person would not in the present case use the process for any purpose other than the production of its inevitable product, namely milk containing only beta-casein having a proline at position 67 and therefore also having

a reduced level of saturated fatty acids relative to the level of unsaturated fatty acids. The board concluded that the relevant technical features for the purpose of assessment of the novelty of the method of claim 1 were its physical steps and that document (D3), which disclosed these physical steps, anticipated the subject-matter of claim 1 of the main request.

In **T 1822/12** the appellant submitted that the prior art did not disclose the purpose of the method steps, which was defined in claim 1 as "a method for reducing acrylamide formation in thermally processed foods", or the step of "cooking said food to form a cooked food with a reduced concentration of acrylamide". According to the appellant, the above purpose and step were features limiting the scope of claim 1 and distinguishing it from the disclosures in the prior art. With regard to the above purpose, the appellant submitted that the principles established by **G 2/88** and **G 6/88** concerning limiting functional features of a claim should apply equally to the method claim in question. The board, however, stated that **G 2/88** related only to a use claim, namely to a claim for the new use of a known compound. It concluded that claim 1 of the main request relating to the known method of thermally processing foods for the unknown purpose of reducing acrylamide formation could not be construed to include that purpose as a distinguishing functional technical feature.

e) Discovery of new properties/technical effects underlying the known use

In **T 958/90** the board mentioned that a known effect could not be novel for the sole reason that the patent provided the information that it was present to a hitherto unknown extent.

In **T 279/93** a claim directed to the use of a first compound in a process for preparing a second compound was revoked by the opposition division for lack of novelty. In particular, the claims were directed to the use of the alkanolamines for reducing the formation of isomelamine impurities. According to the appellant, this purpose, even if it might have been inherently attained by following the teaching of a prior art document, should have rendered the subject matter of the claims novel, since, in application of the reasoning in decision **G 2/88** (OJ 1990, 93), inherency did not destroy the novelty of the new use, which had to be regarded as a functional technical feature of the claims. In the board's judgment, the use of a compound in a process for preparing another compound in order to reduce the formation of impurities was not necessarily a functional technical feature within the meaning of decision **G 2/88**, and did not therefore in all circumstances confer novelty on the subject matter of a claim containing it. The facts of the case at issue differed significantly from those underlying decision **G 2/88**, since the claim did not appear to contain any new technical effect or technical purpose in the sense required by that decision. In the board's view, noticing that an old product had the property of containing fewer isomelamine impurities was a mere discovery. To convert this into a patentable invention, and to show the characteristics of a new technical effect, the use referred to in the claim would have to be some **new use of the product** which exploited the discovery that the isomelamine impurities were low for some new technical purpose.

In **T 1855/06**, the board held that novelty of a use of a known compound for the known production of a known product could not be deduced from a new property of that product. In such a case, the use of a compound to produce a product had to be interpreted as a process for producing the product with the compound and could be regarded as novel only if the production process as such was novel. Similarly, where its stated purpose was merely to improve an already known property of the product to be produced, the use could not be regarded as a new technical activity within the meaning of **G 2/88** and **G 6/88**, unless the claim required that the improvement be exploited in some form. In line with **T 279/93**, the board held that a finding that a known product had a particular property was a mere discovery and could not establish novelty of a use claim.

In **T 892/94** (OJ 2000, 1) the board noted that according to **G 2/88**, novelty within the meaning of Art. 54(1) EPC 1973 could be acknowledged for a claim directed to the use of a known substance for a hitherto unknown, i.e. new, non-medical purpose reflecting a newly discovered technical effect. However, a newly discovered technical effect did not confer novelty on a claim directed to the use of a known substance for a known non-medical purpose if the newly discovered technical effect **already underlay the known use of the known substance**. The disclosure in citation (1) was, in the board's judgment, prejudicial to the novelty of the claim in question. It was immaterial for the purposes of prejudice to novelty that the actual technical effect exhibited by "aromatic esters" in deodorising compositions was not described in the cited document. The *ex post facto* discovery that the deodorising effect of "aromatic esters" when used as an active ingredient in deodorising products could result from their capability of inhibiting esterase-producing micro-organisms might possibly be regarded as a (potentially surprising) piece of knowledge about the known use or application of such esters but could not confer novelty on a claim, since the latter would require that the newly discovered effect did indeed result in either a new technical application or use of the "aromatic esters", which was not necessarily correlated with the known application or use and could be clearly distinguished therefrom.

In **T 706/95** the board held that the discovery that the **same known means** led to an additional effect when they are used for the **same known purpose** (i.e. known use) of reducing the concentration of nitrogen oxides in the same effluent could not confer novelty on this known use (see also **T 934/04**).

In **T 189/95** the board ruled that a new property of a substance, i.e. a new technical effect, did not necessarily signal or give rise to a new use for that substance. For example, the new property might **merely explain the mechanism behind the use already described in the prior art**, as in **T 892/94** (OJ 2000, 1). Here again the board ruled that discovering a new property or activity did not in itself render novel a claim for the use of a known substance for a known non-medical use, if the discovery only showed what formed the basis of the known use of the known substance.

On the issue of the discovery of a previously unknown property of a compound underlying a known use, see further **T 1073/96**, referring to **T 254/93** (OJ 1998, 285). By contrast, it was found that there was a new use, e.g. in **T 319/98**, **T 952/99**, **T 966/00**, **T 326/02** and **T 1090/02**.

- f) Use of a substance to achieve a technical effect only attained in special circumstances

In **T 977/02** the claim in suit was directed not to a device per se but to use of a specific component (an electric machine carcasse) to attain a technical effect (to facilitate the recycling of the electric machine). Applying **G 2/88** and **G 6/88** (OJ 1990, 93 and 114), the board held that a claim to the use of a component having a specific property (material that can be crushed into fragments) for a specific purpose (to facilitate the recycling of an electric machine) stated in the said claim and based on a technical effect described in the patent (flow of the material that can be crushed into fragments through the turns of the winding during recycling) should be interpreted as comprising a functional technical feature by virtue of that technical effect. According to the board, this was still valid when, as in the case before it, the technical effect was attained only in special circumstances (when the electric machine was recycled). The board also held that the choice of the specific material for manufacture of the carcasse covered by the use defined by the claim in suit constituted a novel selection.

#### 8.1.4 Statement of purpose in non-medical use claims in view of Article 52(4) EPC 1973

In **T 36/83** (OJ 1986, 295) the board stated that having discovered for the first time the surprising properties of a chemical product already known in the state of the art and having shown those properties in various uses, the applicant had the right to have those uses protected. In the particular case the uses were presented in the description as two methods; a method of medical treatment and a method of non-medical treatment. Under Art. 52(4) EPC 1973 a method of medical treatment was not patentable but a product for use in that method certainly was. Claims 1 to 7 had been worded accordingly. The method of non-medical treatment was one falling within the general field of patentable inventions. There could be no objection to the patentability of either use or method claims in general (see **G 5/83**, OJ 1985, 64). The applicants had chosen the phrase "**use as a cosmetic product of thenoyl peroxide**". The board considered that this form of claim was **acceptable** in the case in suit. The board noted that when considering the exclusions from patentability under Art. 52(4) EPC 1973 the wording of the claim was important. In reaching this conclusion the board held the use of the word "cosmetic" in the context of that application to be sufficiently precise to exclude therapeutic uses, without the need for a specific disclaimer of such uses.

#### 8.1.5 Novelty criteria for product claims with purpose characteristics

It is long standing office practice that a formulation such as "apparatus for" is to be interpreted as meaning an apparatus which is suitable for the stated use, see for example Guidelines F-IV, 4.13 – November 2015 version; **T 1389/10**). As explained in the Guidelines, as e.g. in the case of a mould for molten steel, the stated use may imply certain physical limitations (size, material) without which the apparatus could not be used for that purpose. Any prior art apparatus which, in addition to features expressly mentioned in the claim also possesses these implicit physical features and can thus reasonably be used for the stated purpose will then take away novelty of the claimed apparatus. This is irrespective of whether or not the prior art mentions the stated use or

purpose or whether the stated use is obvious or not. This is because the claim is directed at the apparatus, not its use. Nor can stating a use that is new and not-obvious render an apparatus which is already known novel and inventive.

In **T 215/84** the board held that the discovery that the known equipment might be used in a new manner could not render the entity itself novel.

In **T 523/89** a particular prior art document disclosed a container having all the structural features defined in claim 1 of the contested patent. Hence, the only outstanding issue was the fact that D1 nowhere indicated that the container disclosed therein was intended to be used for ice-cream. The board noted that the question of anticipation of a claim to an article for a particular use was dealt with in the Guidelines (Guidelines F-IV, 4.13 – version 2012), from which it was clear that, with the exception of medical uses of known substances, the indication of intended use was only to be seen as **limiting to the extent that the article had to be suitable for that use**. In other words, disclosure of an equivalent article without an indication of the particular use claimed - although the article was nevertheless suitable for it - would cause lack of novelty of a claim to the article for that particular use. The board saw no reason to disagree with this general principle of interpretation laid down in the Guidelines.

In **T 15/91** the board ruled that, according to the case law of the boards of appeal, the discovery that known apparatus could be used in a manner not hitherto described did not substantiate the novelty of that apparatus, if the hitherto unknown use did not require any modification to the technical design of the known apparatus (see **T 523/89**).

In decisions **T 303/90** and **T 401/90** the main claims related to a contraceptive composition comprising known pharmaceutical compounds. The board was of the opinion that the composition as claimed could not be considered novel and the added word "contraceptive" did not change the product claim into a use claim. **Only in the case of first medical use** could the addition of a purpose characteristic render a product claim new, if the product as such was known in other technical fields (see also **T 1200/03**).

In **T 637/92** the board held that, according to established case law, the statement of purpose of a claimed device (or product) was to be interpreted as meaning that the device was **suitable for the stated purpose** and that a known device that served another purpose but otherwise possessed all the features listed in the patent claim was not prejudicial to the novelty of the subject-matter of the claim if the known device was unsuitable for the purpose referred to in the claim (see also **T 287/86**). In the case in question, however, these conditions had not been met since the device known from the citation did not possess one of the features of claim 1.

## D. Inventive step

1.	Introduction	160
2.	Problem and solution approach	161
3.	Closest prior art	163
3.1.	Determination of closest prior art in general	163
3.2.	Same purpose or effect	164
3.3.	Similarity of the technical problem	165
3.4.	Selection of most promising starting point	167
3.4.1	General	167
3.4.2	Most promising springboard	168
3.4.3	Chosen type of starting point	168
3.4.4	Defective disclosure	169
3.4.5	Confidential prior art	170
3.4.6	Speculative character of closest prior art	170
3.5.	Improvement of a production process for a known product	170
3.6.	Old prior art documents as closest prior art	171
4.	Technical problem	172
4.1.	Determination of the technical problem	172
4.2.	Alleged advantages	175
4.3.	Formulation of the technical problem	175
4.3.1	No pointer to the solution	176
4.3.2	Problem formulated in the patent application as starting point	176
4.3.3	Formulation of partial problems - lack of unity	177
4.4.	Reformulation of the technical problem	177
4.4.1	General	177
4.4.2	Subsequently invoked technical effect	179
4.5.	Alternative solution to a known problem	181
4.6.	Solving a technical problem - post-published documents	181
5.	"Could-would approach"	183
6.	Ex post facto analysis	184
7.	Expectation of success, especially in the field of genetic engineering and biotechnology	185
7.1.	Reasonable expectation of success	185
7.2.	Try and see situation	187
8.	Skilled person	188
8.1.	Definition of the skilled person	188
8.1.1	Definition	188
8.1.2	Competent skilled person - group of people as "skilled person"	190
8.1.3	Definition of the person skilled in the art in the field of biotechnology	191
8.1.4	Identification of the skilled person in the case of computer-implemented inventions	192
8.2.	Neighbouring field	193
8.3.	Skilled person - level of knowledge	195
8.4.	Everyday items from a different technical field	196
9.	Assessment of inventive step	197
9.1.	Treatment of technical and non-technical features	197

---

9.1.1	Technical character of the invention	198
9.1.2	Inventions having both technical and non-technical features	199
9.1.3	Problem and solution approach when applied to "mixed" inventions	201
	a) General issues	201
	b) The Comvik approach	201
	c) Non-technical features and technical contribution	203
	d) Non-technical features and interaction with technical subject matter	205
	e) Technical implementation of excluded subject-matter	205
9.1.4	The aim to be achieved in the formulation of the technical problem	207
9.1.5	Credible technical effects	209
9.1.6	Assesment of features relating to a presentation of information	210
	a) Mental activities based on data visualisation	211
	b) Display of data and user preferences	219
9.1.7	Assesment of features relating to meta methods for software production	221
9.1.8	Assesment of features relating to mathematical algorithms	222
9.2.	Combination invention	223
9.2.1	Existence of a combination invention	223
9.2.2	Partial problems	224
9.3.	Combination of teachings	226
9.4.	Technical disclosure in a prior art document	226
9.5.	Features not contributing to the solution of the problem	227
9.6.	Substitution of materials - analogous use	227
9.7.	Combination of documents	228
9.8.	Chemical inventions	229
9.8.1	Problem and solution approach in chemical inventions	229
9.8.2	Structural similarity	230
9.8.3	Broad claims	231
9.8.4	Intermediate products	232
9.8.5	Predictable improvements resulting from amorphous forms as compared to crystalline forms	233
9.8.6	Synergistic effects	233
9.9.	Equivalents	233
9.10.	Problem inventions	234
9.11.	New use of a known measure	235
9.12.	Obvious new use	236
9.13.	Need to improve properties	236
9.14.	Disclaimer	237
9.15.	Optimisation of parameters	237
9.16.	Small improvement in commercially used process	238
9.17.	Analogy process - envisageable product	238
9.18.	Examples of lack of inventive step	239
9.18.1	Foreseeable disadvantageous or technically non-functional modifications	239
9.18.2	Reversal of procedural steps	240
9.18.3	Purposive selection	240
9.18.4	Automation	240
9.18.5	Enhanced effect	240
9.18.6	Simplification of complicated technology	241

9.18.7	Choice of one of several obvious solutions	241
9.18.8	Several obvious steps	242
9.18.9	Selection from obvious alternatives	242
9.18.10	Putting the closest prior art device into practice	242
9.18.11	Animal testing and human clinical trials	243
10.	Secondary indicia in the assessment of inventive step	243
10.1.	General issues	243
10.2.	Technical prejudice	244
10.3.	Age of documents - time factor	246
10.4.	Satisfaction of a long-felt need	247
10.5.	Commercial success	247
10.6.	Market competitors	248
10.7.	Simple solution	249
10.8.	Surprising effect - bonus effect	250
10.9.	Comparative tests	251

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## 1. Introduction

An invention shall be considered as involving an **inventive step** if, having regard to the **state of the art**, it is not **obvious** to a **person skilled in the art** (Art. 56, first sentence EPC). The "state of the art" for the purposes of considering inventive step is as defined in Art. 54(2) EPC. It does not include later published European applications referred to in Art. 54(3) EPC. Such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step (for full details see Guidelines G-IV, 5.1 and G-VII, 2 – November 2015 version).

Technical progress is not a requirement for patentability under the EPC. Therefore, technical progress shown in comparison with marketed products as an alleged support for inventive step cannot be a substitute for the demonstration of inventive step with regard to the relevant closest state of the art (see **T 181/82**, OJ 1984, 401; **T 164/83**, OJ 1987, 149; **T 317/88**, **T 385/94**, **T 850/02**).

The extent of the monopoly conferred by a patent should correspond to and be justified by the technical contribution to the art. This general principle of law, applied in **T 409/91** (OJ 1994, 653) and **T 435/91** (OJ 1995, 188) (albeit to determine the scope of protection justified under Art. 83 and Art. 84 EPC 1973), also applies to decisions under Art. 56 EPC 1973, because everything covered by a legally valid claim has to be inventive. Otherwise the claim has to be amended, by deleting anything obvious to ensure that the monopoly is justified (**T 939/92**, OJ 1996, 309; **T 930/94**, **T 795/93**, **T 714/97**).



## 2. Problem and solution approach

The "problem and solution approach" is regularly applied by the departments of the EPO in the course of deciding whether or not claimed subject-matter fulfils the requirements of Art. 56 EPC. This consists essentially of

- (a) identifying the "closest prior art",
- (b) assessing the technical results (or effects) achieved by the claimed invention when compared with the "closest state of the art" established,
- (c) defining the technical problem to be solved as the object of the invention to achieve these results, and
- (d) examining whether or not a skilled person, having regard to the closest state of the art within the meaning of Art. 54(2) EPC, would have suggested the claimed technical features in order to obtain the results achieved by the claimed invention (see e.g. **T 939/92**, OJ 1996, 309; **T 15/93**, **T 433/95**, **T 917/96**, **T 631/00**, **T 423/01**, **T 215/04**, **T 1621/06**, **T 1183/06**, **T 824/07**, Guidelines G-VII, 5 – November 2015 version).

On application of the problem and solution approach to claims comprising technical and non-technical aspects (especially in the case of computer-implemented inventions), see in this chapter I.D.9.1, and for its application to claims directed to chemical inventions, see in this chapter I.D.9.8.1.

The boards frequently cite R. 42(1)(c) EPC as the basis for the problem and solution approach. R. 42(1)(c) EPC requires that the invention be disclosed in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood. Problem and solution are thus component parts of any technical invention. The problem and solution approach was primarily developed to ensure objective assessment of inventive step and avoid ex post facto analysis of the prior art.

A solution claimed as non-obvious is patentable **only if** it actually has the alleged effect. According to **T 2001/12**, a doubt that the invention as claimed is capable of solving the problem defined in the application may have the following consequences: a) If the question arises because the claim fails to specify those features which are disclosed in the application as providing the solution to the problem, then the description and claims are inconsistent in relation to the definition of the invention, and an objection under Art. 84 EPC 1973 may properly arise that the claims do not contain all the essential features necessary to specify the invention. b) If this is not the case, but, having regard to the prior art, and irrespective of what may be asserted in the description, it does not appear credible that the invention as claimed would actually be capable of solving the problem, then an objection under Art. 56 EPC 1973 may be raised, possibly requiring a reformulation of the problem. This decision was later cited by **T 862/11** which also dealt with the distinction between the requirements of sufficiency of disclosure (Art. 83 EPC), clarity of the claims (Art. 84 EPC), and inventive step (Art. 56 EPC).

According to board of appeal case law (see **T 1/80**, OJ 1981, 206; **T 20/81**, OJ 1982, 217; **T 24/81**, OJ 1983, 133; **T 248/85**, OJ 1986, 261), the assessment of inventive step has to be based on the objective, not subjective, achievement of the inventor. By starting out from the objectively prevailing state of the art, the technical problem is to be determined on the basis of objective criteria and consideration given to whether or not the disclosed solution is obvious to the skilled person. Although the problem and solution approach is not mandatory, its correct application facilitates the objective assessment of inventive step. The correct use of the problem and solution approach rules out an **ex post facto analysis** which inadmissibly makes use of knowledge of the invention (**T 564/89**, **T 645/92**, **T 795/93**, **T 730/96** and **T 631/00**). In principle, therefore, the problem and solution approach is to be used; however, if exceptionally some other method is adopted, the reasons for departing from this generally approved approach should be stated.

In **T 967/97** the board stated that the problem and solution approach was essentially based on actual knowledge of technical problems and ways to solve them technically that the skilled person would, at the priority date, be expected to possess objectively, i.e. without being aware of the patent application and the invention that it concerned. If the skilled person had a choice of several workable solutions that might suggest the invention, the rationale of the problem and solution approach required that the invention be assessed relative to all these possible solutions before any decision **confirming** inventive step was taken. To **deny** inventive step, no special grounds had to be given for a pre-selection of prior-art citations, even if several workable solutions were available to the skilled person; the statement of grounds merely served to show that the invention was obvious to the skilled person from the prior art in relation to (at least) one of these solutions (see also **T 558/00**, **T 970/00**, **T 172/03**, **T 323/03**, **T 21/08**, **T 308/09**, **T 1289/09**).

Instructive summaries of the case law on the problem and solution approach can be found in a number of decisions; for recent examples, see **R 9/14**, point 2.1.1 of the Reasons; **T 519/07**, point 7 of the Reasons; and **T 698/10**.

The problem-solution approach does not require that the application specify what feature is responsible for producing precisely what advantage or technical effect (see e.g. **T 818/93**, point 5.2 of the Reasons). All that is required for inventive step is that the claimed subject-matter is not obvious to the skilled person in the light of the prior art (Art. 56 EPC). It is common practice to take features from dependent claims or the description and insert them into an independent claim with a view to rendering the subject-matter patentable and to cite the effects and advantages associated with those features as a basis for (re-)formulating the technical problem (see e.g. **T 39/93**, OJ 1997, 134, point 5 of the Reasons). To determine the objective technical problem, the technical results and effects achieved by the claimed invention as compared with the closest prior art **must** be assessed (**T 270/11**, points 5.1 and 5.3 of the Reasons).

In **T 188/09** the board noted first that whatever approach was applied as an auxiliary means for the evaluation of inventive step of claimed subject-matter, in a given evidential situation it had to provide the same result, be it either in favour of or against inventive

step. Therefore, even if the "problem and solution approach" was applied, the decision on inventiveness should be the same as if it had not been used. Citing **T 465/92** (OJ 1996, 32), the board observed: "if an invention breaks new ground it may suffice to say that there is no close prior art rather than constructing a problem based on what is tenuously regarded as the closest prior art."

In **T 465/92** (OJ 1996, 32) the board did not take the problem and solution approach when assessing inventive step, and said this was merely one possible approach, with advantages and drawbacks. It took the view that all of the seven relevant citations came equally close to the invention.

The board in **T 1437/09** considered that both D1 and D4 constituted a suitable starting point for the consideration of inventive step. In particular, both D1 and D4 belonged to the same technical field as the invention at issue and disclosed the same type of devices. If there are several different prior art documents, each of which might plausibly be taken as a starting point for the assessment of inventive step, it is established case law that inventive step be assessed relative **to all these pieces of prior art** before any decision confirming inventive step is taken (see **T 967/97**, point 3.2 of the Reasons; **T 308/09**, point 1.4.1 of the Reasons).

In case **R 5/13** (as well as **R 9/13**, **R 10/13**, **R 11/13**, **R 12/13** and **R 13/13** which were all directed against **T 1760/11**), the petitioners argued that they should have been allowed to discuss all the issues of inventive step of any stage of the problem-solution approach in respect of **all possible starting points** that they wished to rely on, despite the fact that the board had structured the discussion by first establishing which document or documents constituted the most promising starting point. The Enlarged Board in **R 5/13** held that the board had not only followed the sequence for the debate announced in its communication annexed to the summons to oral proceedings, but by doing so it had also systematically applied the standard method of the problem and solution approach. The Enlarged Board stated that the examination whether or not the subject-matter of a patent claim involved an inventive step according to the well-established problem-solution approach was a **matter of substantive law**. That was equally true for the determination of the closest prior art as the first step in the multi-stage method of the problem-solution approach, whether one document alone or a plurality of documents was taken as the starting point or most promising springboard aiming at the invention. The petition for review was not a means to review the correct application of substantive law (consistent case law).

### 3. Closest prior art

#### 3.1. Determination of closest prior art in general

In accordance with the problem and solution approach, the boards have developed certain criteria for identifying the closest prior art to be treated as a starting point.

The boards have repeatedly pointed out that the closest prior art for assessing inventive step is normally a prior art document disclosing subject-matter conceived for the same

purpose or aiming at the same objective as the claimed invention and having the most relevant technical features in common, i.e. requiring the minimum of structural modifications (see in this chapter I.D.3.2). A further criterion for the selection of the most promising starting point is the similarity of technical problem (see in this chapter I.D.3.3). In a number of decisions, the boards have explained how to ascertain the closest prior art constituting the easiest route for the skilled person to arrive at the claimed solution or the most promising starting point for an obvious development leading to the claimed invention (see in this chapter I.D.3.4).

The determination of the closest prior art is therefore an objective and not a subjective exercise. It is made on the basis of the notional skilled man's **objective comparison** of the subject-matter, objectives and features of the various items of prior art leading to the identification of one such item as the closest (**T 1212/01**).

In **T 698/10**, the board summarised the jurisprudence regarding the determination of the closest prior art. In particular, the board explained that the expression "closest prior art" did not mean that this prior art disclosure had to be sufficiently close to the claimed invention on an absolute basis, but only that it had to be closer to the claimed invention than the other prior art disclosures. In other words, there always had to be a closest prior art, even if it was not particularly close to the claimed invention.

After the relevant prior art has been identified, careful consideration must be given to the question whether, in the case concerned, the skilled person, taking into account all the available information on the technical context of the claimed invention, would have had good reason to take this prior art as the starting point for further development. The term "state of the art" in Art. 54 EPC 1973 should be understood as "state of technology", and "everything" in Art. 54(2) EPC 1973 is to be understood as concerning the information which is relevant to a field of technology (**T 172/03**).

In **T 1464/05** the board considered the features rendered available to the public by a public prior use as the closest state of the art.

The closest prior art must be assessed from the skilled person's point of view on the day before the filing or priority date valid for the claimed invention (**T 24/81**, OJ 1983, 133; **T 772/94**, **T 971/95**, Guidelines G-VII, 5.1 – November 2015 version).

Unidentified "prior art" cited in the patent does not form part of the state of the art within the meaning of Art. 54(2) EPC 1973 and cannot be used for basing an assessment of inventive step (**T 671/08**).

### **3.2. Same purpose or effect**

According to established case law, in selecting the closest prior art, a central consideration is that it must be directed to the same purpose or effect as the invention, otherwise it cannot lead the skilled person in an obvious way to the claimed invention.

According to **T 606/89** the closest prior art for the purpose of objectively assessing inventive step was generally that which corresponded to a **similar use** requiring the minimum of structural and functional modifications (see **T 574/88**, **T 606/89**, **T 686/91**, **T 834/91**, **T 482/92**, **T 298/93**, **T 59/96**, **T 730/96**, **T 650/01**). In **T 273/92** the board of appeal confirmed the established case law of the boards, according to which a document could not qualify as the closest prior art to an invention **merely because of similarity** in the composition of the products; its suitability for the desired use of the invention also had to be described (see also **T 327/92**). According to **T 506/95**, the closest prior art was therefore that most suitable for the purpose claimed by the invention, not that superficially showing structural similarities with the solution as claimed. Ideally, that purpose or objective should be something already mentioned in the prior art document as a goal worth achieving (**T 298/93**, **T 859/03**). The aim was that the assessment process should start from a situation as close as possible in reality to that encountered by the inventor. The real-world circumstances had to be taken into account. If it was not clear from this criterion what the closest prior art was, the problem and solution approach should be repeated taking possible alternative starting points (**T 710/97**, **T 903/04**).

In **T 176/89** the board concluded that the closest prior art comprised two documents in combination with each other. It found that, **exceptionally**, the two documents had to be read in conjunction; they had the same patentee, largely the same inventors, and clearly related to the same set of tests. As a rule, however, when assessing inventive step, two documents should not be combined if, in the circumstances, their teaching is clearly contradictory (see also **T 487/95**).

In **T 2255/10** citing **T 482/92** (point 4.1 of the Reasons), the board stated that in establishing the closest prior art, the determination of the purpose of the invention is not to be made on the basis of a subjective selection from among statements of purpose which may be set out in the description of the application, without any reference to the invention as defined in the claims. On the contrary, the question to be asked is, what, in the light of the application as a whole, would be achieved by the invention as claimed. For this reason, statements of purpose must be read in conjunction with the claims. Merely inserting such a statement into the description does not entitle an applicant effectively to "veto" any inventive step objection based on a document which is unrelated to this purpose, if it is not plausible that the invention as claimed would actually achieve the stated purpose. Art. 113(2) EPC guarantees that the manner in which the invention is defined in the claims of a European patent application is entirely in the hands of the applicant.

### 3.3. Similarity of the technical problem

A document serving as the starting point for evaluating the inventive merits of an invention should relate to the same or a similar technical problem or, at least, to the same or a closely related technical field as the patent in suit (**T 495/91**, **T 570/91**, **T 989/93**, **T 1203/97**, **T 263/99**, **T 1634/06**).

In **T 439/92** (dividing wall for a corner or circular shower) the board pointed out that although there was freedom in the choice of the starting point on which an objection of

lack of inventive step was based, there were certain criteria that should be adhered to if the prior art chosen was to be the closest. One such criterion was the problem already stated in the patent. Clearly in many cases it was reasonable for there to be a link between this problem and the prior art chosen as being closest (**T 495/91**, **T 570/91**).

In **T 325/93** the application related to an epoxy resin dispersion which provided a cured resin with improved impact resistance. The board stated that the problem addressed by the application was neither derivable nor indeed recognisable from the disclosure of D2 relating to compositions having a low coefficient of friction and which, according to the department of first instance and the appellant, represented the closest prior art. As early as **T 686/91**, another board had observed that a document not mentioning a technical problem which is at least related to that derivable from the patent specification does not normally qualify as the closest prior art for inventive step purposes, however many technical features it may have in common with the subject-matter of the patent concerned (see also **T 410/93**, **T 708/96**, **T 59/96**, **T 827/00**, **T 979/00** and **T 496/02**). In **T 644/97** the board concluded that a technical problem arising from a "closest prior art" disclosure which was irrelevant to the claimed subject-matter (in the sense that it did not mention a problem that was at least related to that derivable from the patent specification) had a form such that its solution could practically never be obvious, because any attempt by the skilled person to establish a chain of considerations leading in an obvious way to the claimed subject-matter was bound to fail. It followed that the respective claimed subject-matter was non-obvious in the light of such art (see also **T 792/97** and **T 599/03**).

In **T 835/00** D1, which the opposition division considered the closest prior art, did not mention any of the problem aspects addressed by the claimed invention. As a consequence, a technical problem was created which was unrelated to the actual disclosure of D1 but whose solution was then found to be obvious in the light of the disclosure of D2. The board referred to **T 686/91** and stated that it was a fatal defect that a prior art disclosure from which no relevant technical problem could be formulated without inappropriate hindsight had been chosen as a starting point for the application of the problem and solution approach, because without such hindsight any attempt to establish a logical chain of considerations which might lead to the claimed invention inevitably ran into difficulties at the start, for want of a relevant identifiable goal or object. If the relevant problem was not derivable from the alleged closest prior art, the measures for its solution were a fortiori not derivable. In other words, the invention was not obvious in the light of such art (see also **T 548/03**, **T 1898/07**).

In decision **T 698/10**, the board held that the closest prior art did not have to disclose all the problems solved by the claimed invention, in particular it did not have to disclose the objective technical problem, which was only determined in the second step of the problem and solution approach based on the technical effect(s) provided by those features distinguishing the invention as claimed from the closest prior art.

In **T 25/13**, citation D4 related to tumble dryers and so came under domestic appliances, a field neither the same nor even closely related to that of the invention, namely automotive technology. For that simple reason, it could not be "the closest prior art". The

board, however, held that opponents were essentially free to choose the starting point for assessment and that their choice then had implications for the technical knowledge of the relevant skilled person.

### 3.4. Selection of most promising starting point

#### 3.4.1 General

The boards have consistently held that, where more than one document is cited as the closest prior art, the one which must be deemed the closest is that which provides the skilled person with the most promising springboard to the invention, i.e. the one starting from which the subject-matter of the invention is rendered most obvious (**T 656/90**, **T 824/05**, **T 1755/07**, **T 698/10**).

The starting point for the assessment of inventive step should be one which is at least "promising", in the sense that there was some probability of a skilled person arriving at the claimed invention. However, when applying these principles, care must be taken to avoid an ex-post-facto-approach. A skilled person endeavouring to arrive at a simple construction is unlikely to begin by using prior art relating to an exceptional embodiment with a complex mechanism, and then to omit this mechanism from the invention (**T 871/94**).

In **T 1841/11** the board stated that the closest prior art should relate to the same or at least a similar purpose (or objective) as the claimed invention. Even if prior art relating to the same purpose is available, it is not excluded that a document relating to a similar purpose might be considered to represent a better - or at least an equally plausible - choice of closest prior art, provided that it would be immediately apparent to the skilled person that what is disclosed in the document could be adapted to the purpose of the claimed invention in a straightforward manner, using no more than common general knowledge (point 2.6 of the Reasons). If, despite the availability of prior art relating to the same purpose as the claimed invention (here: manufacturing a semiconductor substrate comprising a silicon-germanium film), it is nevertheless considered appropriate to select as closest prior art a disclosure relating to a similar purpose (here: manufacturing a semiconductor substrate comprising a germanium film), at least one claimed feature corresponding to the purpose of the invention will generally appear as a difference over the closest prior art (here: silicon-germanium). However, this difference is not one which can legitimately be invoked in support of inventive step. The problem-solution approach presupposes that the skilled person has a purpose in mind from the very beginning of the inventive process, which in this case is the manufacture of a known type of semiconductor substrate comprising a silicon-germanium film. Within this conceptual framework, it cannot be logically argued that the skilled person would find no motivation to incorporate silicon-germanium. Moreover, an argument that it would not be straightforward to incorporate this difference into the teaching of the document considered to be closest prior art, or that this would require more than common general knowledge, would not, in such a case, constitute an argument in favour of inventive step, but rather an argument that this document is not in fact a promising starting point (point 4.1 of the Reasons).

### 3.4.2 Most promising springboard

**T 254/86** (OJ 1989, 115) described the objectively closest prior art as the "most promising springboard" towards the invention which was available to the skilled person (see also **T 282/90**, **T 70/95**, **T 644/97**).

According to **T 870/96**, when trying to evaluate a skilled person's capabilities and behaviour in the problem and solution approach, as closest prior art a "bridgehead" position should be selected, which said skilled person would have **realistically** taken under the "circumstances" of the claimed invention insofar as these circumstances can be retrieved in one item of the prior art. Consequently, among these "circumstances", aspects such as the designation of the subject matter of the invention, the formulation of the original problem and the intended use and the effects to be obtained should generally be given more weight than the maximum number of identical technical features (see also **T 66/97**).

In **T 824/05** the board was faced with the situation of two alternative starting points equally suitable for the assessment of inventive step, whereby one starting point, i.e. D11, lead to the conclusion that the claimed subject-matter was obvious and the other starting point, i.e. D1, gave exactly the opposite result. The board held that in this situation D1 did not qualify as the closest state of the art because it did not represent the most promising springboard towards the invention.

In **T 53/08**, the board found that the disclosure in each of the two documents (1) and (10) differed from the patent in suit in respect of just a single feature. In deciding whether document (1) or document (10) had to be regarded as the closest prior art, it considered the patent's objective, which was to develop the highly effective herbicidal ingredient of formula (A1) in such a way that it did not significantly damage crops when used in a concentration with herbicidal effect. The natural starting point for the invention was therefore the document disclosing the active ingredient of formula (A1).

### 3.4.3 Chosen type of starting point

In **T 570/91** the board emphasised that although a person skilled in the art was completely free in choosing a starting point, he would of course be bound afterwards by that choice. If, for instance, the skilled person preferred and decided to start from a specific compressor piston, he could further develop that piston but at the end of that development the normal result would still be a compressor piston and not an internal combustion engine piston. In **T 439/92** it was explained that a conscious choice of starting point, made in the knowledge of the respective benefits and drawbacks of the various types concerned, not only determined the subject-matter serving as a starting point but also defined the framework for further development, i.e. a further development within this particular type. A change of type during the further development of the consciously chosen type, to another type, which was previously known but had not been chosen, could then only be seen as the result of an ex-post-facto analysis (see also **T 1040/93**, **T 35/95**, **T 739/95**, **T 255/03**). It is unlikely, and normally not obvious, for the invention type originally chosen to be changed during development (**T 817/94**, recently



cited in **T 749/11** and **T 535/10**). A generically different document cannot normally be considered as a realistic starting point for the assessment of inventive step (**T 870/96**, **T 1105/92**, **T 464/98**).

Following **T 439/92** the board stated in **T 1228/08**, that although D1 disclosed the use of hierarchical coding, which was a major aspect of the present invention, the board considered that this document did not represent a realistic starting point for an attack on inventive step. A conscious choice of a starting point not only determines the subject-matter serving as a starting point but also defines the framework for further development. Thus, using D1 as a starting point would mean that any further development would be carried out in the context of multicasting: it is unrealistic to suggest that, starting from this disclosure, the skilled person would go outside this framework - indeed take a technical step back - to develop a non-multicasting system.

In **T 487/95** the board chose a military protective helmet as the closest prior art, pointing out, however, that this did not mean that documents describing protective helmets of a different kind (such as workers' safety helmets) could not be said to form part of the knowledge of a person skilled in the art. In this case, adopting the problem and solution approach, the information contained in the patent which related to a known military protective helmet (D9) represented the **primary** source of information, i.e. the most promising point of departure, from which the skilled person would attempt to arrive at the claimed subject-matter. The other documents could, however, represent important **secondary** sources of information (in this case: workers' safety helmets) from which the skilled practitioner could obtain indications and suggestions with regard to the problem being addressed (see also **T 149/00**).

The invention in **T 25/13** related to a device for fastening an actuator and a housing, for use in a motor vehicle. D4, the only document cited by the opponent, which bore the burden of proof for lack of inventive step, described a fastening device for a tumble dryer. Opponents were essentially free to choose the starting point for assessment, but their choice then had implications for the technical knowledge of the relevant skilled person.

#### 3.4.4 Defective disclosure

In **T 211/01** the board stated that, quite apart from the fact that a skilled person would normally not consider an obviously defective disclosure at all, it would in particular be artificial to select a defective disclosure as a starting point for evaluating inventive step, when there exists other prior art which is not doubted with regard to its disclosure, but is also directed to the same purpose or effect as the patent in suit. Thus, a document which is so obviously defective as to be readily recognised as such by those skilled in the art when trying to reproduce its disclosure cannot be taken as the most promising and appropriate starting point for the assessment of inventive step.

### 3.4.5 Confidential prior art

In **T 211/06** the original application was a PCT application. The examining division used as a starting point for the assessment of inventive step background art indicated in the application, which according to the applicant comprised confidential information. The board stated that such background art meant publicly available art at the priority date, and not some internal prior art known only within the company employing the inventors. Disclosure in the application as filed which turns out on the available evidence not to be prior art under Art. 54(2) EPC 1973 cannot be used as a starting point for assessing inventive step, nor can subjective "laboratory practice" put forward by the examining division without any objective evidence that this was knowledge available to the public be used as a starting point for assessing inventive step.

### 3.4.6 Speculative character of closest prior art

In **T 184/10** the respondent argued that document (14) did not qualify as closest prior art because of its speculative character. The board stated that the author of document (14) gave an outlook into future trends, which were of course not yet verified by experimental evidence. In view of the fact that this outlook was based on the data available at the time, the skilled person would not dismiss it as pure speculation. Instead, he would regard it as a serious attempt to interpret the existing state of the art. As a consequence, the content of document (14) qualified as closest prior art.

In **T 1764/09** the board noted that D1 was no more than a speculative review of what might be potentially feasible in the future. No concrete realisation of a fully adapted lens for a contact or intraocular lens was described in D1. Therefore, for this reason alone, D1, the document selected by the examining division, could not objectively be considered as a realistic starting point or the most promising springboard towards the claimed invention.

## 3.5. Improvement of a production process for a known product

With a prior art not directed to the same purpose as starting point, any attempt to establish a logical chain of thought which could lead to the claimed invention, inevitably gets stuck from the outset. In particular, where the background to the invention lies in difficulties encountered in known processes for preparing known compounds (see above under point 3.3 "Similarity of the technical problem"). Where the invention concerned improving a process to manufacture a known chemical compound, then the closest prior art was confined to documents describing that compound and its manufacture. Comparison with these alone would show whether an improvement had been achieved which could thus be taken into account in formulating the problem the invention sought to solve (**T 641/89**, **T 961/96**, **T 713/97**, **T 948/01**, **T 833/02**, **T 339/03**). In the case of inventions concerning a special process for use with a particular chemical substance having necessarily specific characteristics, determining the closest prior art must involve, above all, considering only those documents which describe a generically corresponding process for using precisely this particular chemical substance with its specific characteristics (**T 1285/01**, **T 354/03**, **T 1652/08**). This accurately and objectively reflects

the actual situation in which the skilled person found himself on the priority date of the contested patent (**T 793/97**).

The above considerations regarding the closest prior art also apply to production processes for subject-matter other than a chemical compound. In **T 325/97** the patent related to a method for manufacturing a device for controlled delivery of nicotine from an adhesive reservoir. In **T 373/94** the board also applied the principles and conclusions laid down in **T 641/89** where the invention related to the improvement of a manufacturing process for prefilled plastic syringes.

### 3.6. Old prior art documents as closest prior art

Some decisions concerned determining the closest art by taking old prior publications as a realistic starting point for identifying the technical problem to be solved. In principle, any document that is state of the art under Art. 54(2) EPC may be a candidate for the closest prior art. The jurisprudence acknowledges, however, some cases where a document may not be a realistic starting point because it either relates to outdated technology, and/or is associated with such well known disadvantages that the skilled person would not even consider trying to improve on it. However, a document's age as such is not a ground for excluding it as closest prior art and as a starting point for the assessment of inventive step (**T 1408/04**).

In **T 1019/99** the board did not judge that a document, published only five years before the priority date of the patent, in any way represented outdated technology, even in a fast moving area such as digital image processing.

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, did not represent the closest state of the art and could not therefore be used to define a realistic technical problem. However, in **T 964/92**, filed as a divisional application to **T 334/92**, the board held that the same document could be considered as a realistic starting point for the determination of the relevant technical problem. The board stated that in **T 334/92** the technical problem that was solved should be seen as the provision of further chemical compounds which were more active in the treatment of angina pectoris than the known compounds and less toxic. In contrast, in **T 964/92** the skilled person set out to seek no more than alternatives to known compounds described as medicaments for treating angina pectoris. Therefore, the board held that the skilled person would consider any compound or group of compounds belonging to the state of the art, and known to have the desired activity, as a suitable starting point. In such a case the length of time for which this document had been available to the public was irrelevant.

In **T 1000/92** the board did not agree to the selection of document (1) as the closest state of the art because the disadvantages of the process described in document (1), which had been published about 30 years before the priority date of the application, were so evident and well-known that a skilled person would not have tried to improve and

develop such an old process (see also **T 616/93**). In **T 823/03** the board stated that the skilled person had good reasons not to select D2 content as a basis for further development since too many uncertainties existed.

In the further decision **T 479/00** the board did not regard a 65-year-old document as a realistic starting point for the evaluation of inventive step. It was unrealistic to assume that, without hindsight, somebody of average skill in the art of colouring ceramic articles in 1994 would have had the intention to improve a technique which had not received any attention during the previous 65 years. Furthermore, the teaching of this document, published in 1929, had never been put into practice on a commercial scale.

In **T 153/97** it was stated that there was no plausible reason why the skilled person should have disregarded a document only because the publication date lay 30 years in the past.

**T 69/94** also pointed out that Art. 54(2) EPC 1973 defined the state of the art as comprising everything made available to the public, clearly without any time restriction. Thus a document which related to an antiquated technology no longer used in industry comprising a teaching disapproved by those skilled in the art at the filing date of the patent in suit could not simply be disregarded as the closest prior art only because of its publication date about 20 years before the filing date of the application documents. In **T 113/00** the board pointed out that resurrecting very old teaching (in the present case 31 years old) with an obvious modification did not make known subject-matter inventive. In **T 1397/07** the board added that as a consequence, there is no legal basis in the EPC to preclude a particular state of the art from being taken into account when assessing inventive step, merely because of being published some years earlier than another one.

The board in **T 2579/11** ruled that there was no justification for disregarding a priority application and choosing a subsequent application as the closest prior art simply because the description in the subsequent application was by and large more detailed.

## **4. Technical problem**

### **4.1. Determination of the technical problem**

R. 42(1)(c) EPC (former R. 27(1)(c) EPC 1973) stipulates that an application's description must "disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effect of the invention with reference to the background art". As long ago as **T 26/81** (OJ 1982, 211), R. 27(1)(c) EPC 1973 was recognised as clearly binding. The boards' case law, and correct application of the problem and solution approach (see **T 1/80**, OJ 1981, 206; **T 24/81**, OJ 1983, 133), show that objective criteria must be used to determine the technical problem, i.e. the problem which can be seen to have been actually solved in the light of the closest prior art which may be different from the prior art which was at the disposal of the inventor (**T 576/95**). These objective criteria may be specifically defined by assessing the technical progress made in the subject-matter of the application against the closest prior art (**T 20/81**, OJ 1982, 217; **T 910/90**).

A comparison of the problem indicated in the application with that indicated in a prior document must avoid an unduly abstract approach far removed from the practical thinking of the person skilled in the art (**T 5/81**, OJ 1982, 249).

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

For the purpose of the problem and solution approach, the problem must be a technical one that a skilled person in the particular technical field might be asked to solve at the priority date. The technical problem may be formulated using an aim which is to be achieved in a **non-technical field**, and which is thus not part of the technical contribution provided by the invention to the prior art (**T 641/00**, OJ 2003, 352; **T 154/04**, OJ 2008, 46); see also in this chapter I.D.9.1 "Treatment of technical and non-technical features".

In **T 1639/07** the board held that the objective technical problem must be derived from physical, chemical etc. effects directly and causally related to the technical features of the claimed invention. An effect could not be validly used in the formulation of the technical problem if the effect required additional information not at the disposal of the skilled person even after taking into account the content of the application in question.

In **T 632/10** the board considered that an objective technical problem solved by the invention was to implement a digital signature system according to D1 suitable for long-term authenticity proof compliant with the requirements of Section 17 of the German Signature Law (SigV). The appellant (applicant) argued that the SigV might not be relevant for a European patent application, for which states other than Germany could be designated. The board was unconvinced by this argument. Even if an invention happened to be obvious only for skilled persons of German nationality or residence, it would still lack an inventive step within the meaning of Art. 56 EPC 1973. The fact that the SigV was valid only within Germany thus had no bearing on its status as prior art or its relevance for the assessment of inventive step outside Germany.

In **T 1422/12** claim 1 related to crystalline forms of tigecycline. The board referred to the established case law that the technical problem has to be determined on the basis of objectively established facts, since for the determination of the objective technical problem, only the effect actually achieved vis-à-vis the closest prior art should be taken into account (**T 13/84**, OJ 1986, 253 and **T 39/93**, OJ 1997, 134). In this connection, any effects may be taken into account, so long as they concern the same field of use and do not change the character of the invention (**T 440/91**). The formulation of the technical problem to be solved fell well within the framework of the invention as disclosed in the application in suit. That the more specific problem of improved stability with respect to epimerisation was not mentioned in the application as originally filed was irrelevant (**T 39/93**), since improvement of stability by avoidance of epimerisation, and, as a

consequence, improved biological activity was clearly recognisable by the skilled person as a desirable effect for a tetracycline antibiotic.

In **T 519/07**, the board held that, where **comparative tests** were chosen to establish inventive step on the basis of an effect produced over the claimed area, the comparison with the closest prior art had to show convincingly that the effect was attributable to the feature distinguishing the invention. The aim of such comparison was to demonstrate that the technical effect had its **exclusive origin** in the feature characterising the invention in the claims. That had not been shown in the case in point. It could not be concluded from the comparisons that the technical problem defined by the respondent (patent proprietor) had actually been solved by the claimed processes. The technical problem therefore had to be reformulated (see also **T 479/06**, a case concerning a cosmetic or dermatological emulsion, in which the board observed that the claimed emulsions had been tested using a different test protocol from that applied when testing one of the emulsions disclosed in the closest prior art).

In **T 2579/11**, the board considered the probative value of comparative tests carried out by the proprietor to show that the claimed invention actually solved the problem of improving biodegradability. The proprietor had not divulged the details of the test protocol applied, citing commercial reasons. The board ultimately found that the test results were neither verifiable nor plausible and therefore insufficient to establish that the problem had been solved successfully.

In **T 943/13** the board came to the conclusion that the causal relationship between the substance or composition on the one hand and the therapeutic effect achieved on the other hand was decisive for the assessment of inventive step of **further-medical-use claims**. Indeed the board considered that the objective technical problem was the provision of the claimed therapeutic effect by a different/alternative means. The opponent argued that the objective technical problem was the provision of an alternative composition. The board acknowledged that the objective technical problem might indeed be the provision of an alternative composition if claim 1 was a "normal" product claim directed to a substance or composition. However, claim 1 was formulated as a further medical use claim directed to a substance or composition for use in a therapeutic application.

In **T 87/08** the board stated that Art. 56 EPC requires that the assessment of inventive step is made "**having regard to the state of the art**". Accordingly, a decision is not sufficiently reasoned in the sense of R. 68(2) EPC 1973 (R. 111(2) EPC 2000) if the chain of reasoning to justify the finding of lack of inventive step merely states that a purported effect has not been achieved, i.e. this technical problem had not been solved, without reformulating the problem in a less ambitious way and without assessing obviousness of the claimed solution to that reformulated problem in the light of the cited prior art (**T 1079/08**, **T 306/09**, **T 2375/10**).

## 4.2. Alleged advantages

According to the case law of the boards of appeal, alleged advantages to which the patent proprietor/ applicant merely refers, without offering sufficient evidence to support the comparison with the closest prior art, cannot be taken into consideration in determining the problem underlying the invention and therefore in assessing inventive step (see **T 20/81**, OJ 1982, 217; **T 181/82**, OJ 1984, 401; **T 124/84**, **T 152/93**, **T 912/94**, **T 284/96**, **T 325/97**, **T 1051/97**). In **T 1027/08**, the board added that there was no reason to deviate from this case law as it was based on the understandable rule that a patent can only properly be granted for a solution claimed as non-obvious **if** it actually has the alleged effect (see also in this chapter I.D.4.6).

In view of the absence of any data confirming the alleged improvement, such an effect could not be taken into account in the formulation of the technical problem (**T 2044/09**).

Some beneficial effects or advantageous properties, if appropriately demonstrated by means of truly comparable results, can in certain circumstances properly form a basis for the definition of the problem that the claimed invention sets out to solve and can, in principle, be regarded as an indication of inventive step. The only comparative tests suitable for this are, however, those which are concerned with the structurally closest state of the art to the invention, because it is only here that the factor of unexpectedness is to be sought (**T 181/82**, OJ 1984, 401; **T 998/04**, **T 955/96**, **T 234/04**, **T 378/03**, **T 1761/07**; see also in this chapter I.D.10.9).

In **T 355/97** the patent related to an improved hydrogenation process for preparing 4-aminophenol. The technical problem as indicated in the patent in suit consisted of improving the performance index of the preparation process without loss of selectivity. The patent proprietor, however, did not demonstrate properly that the purported advantages, i.e. improvement of the performance index without loss of selectivity, of the claimed invention had successfully been achieved. The board referred to the above mentioned jurisprudence and held that, since the alleged advantages lacked the required adequate support, the technical problem needed reformulation. Therefore, the objective problem could only be seen as merely providing a further method for preparing 4-aminophenol (see also **T 1213/03**). If the proprietor of the patent alleges the fact that the claimed invention improves a technical effect, then the burden of proof for that fact rests upon him (see also **T 1213/03**, **T 1097/09**, **T 2418/10**).

## 4.3. Formulation of the technical problem

It must be examined whether the problem defined by reference to the closest prior art has indeed been solved the claimed invention. If not, the problem must be reformulated.

When defining the objective technical problem an effect cannot be retained if it is not credible that the promised result is attainable throughout the entire range covered by a claim (**T 741/91**, **T 626/90**, **T 939/92**, OJ 1996,309, **T 583/93**, OJ 1996, 496).

If the inventive step of a claimed invention is based on a given technical effect, the latter should, in principle, be achievable over the whole area claimed (**T 939/92**, OJ 1996, 309; **T 694/92**, OJ 1997, 408; **T 583/93**, OJ 1996, 496).

#### 4.3.1 No pointer to the solution

According to decisions **T 229/85** (OJ 1987, 237) and **T 99/85** (OJ 1987, 413) the technical problem addressed by an invention had to be formulated in such a way that it did not contain pointers to the solution or partially anticipate the solution, since including part of a solution offered by an invention in the statement of the problem necessarily had to result in an ex post facto view being taken of inventive step when the state of the art was assessed in terms of that problem (**T 322/86**, **T 184/89**, **T 289/91**, OJ 1994, 649; **T 957/92**, **T 422/93**, OJ 1997, 24; **T 986/96**, **T 313/97**, **T 799/02**).

In **T 1019/99** the board stated that the correct procedure for formulating the problem is to choose a problem based on the technical effect of exactly those features distinguishing the claim from the prior art that is as specific as possible without containing elements or pointers to the solution (**T 1557/07**, **T 1192/09**).

In **T 910/90** the board stated that, when assessing the objective problem, the closest prior art and any technical advance achieved by the characterising features of the invention had to be taken into account. In so doing, it was not important whether this problem had already been mentioned in the closest prior art; what mattered was what the skilled person objectively recognised as the problem when comparing the closest prior art with the invention (**T 214/01**).

#### 4.3.2 Problem formulated in the patent application as starting point

Furthermore it had to be considered that an objective definition of the problem to be solved by the invention should normally start from the problem described in the contested patent. Only if examination showed that the problem disclosed had not been solved or if inappropriate prior art were used to define the problem, was it necessary to investigate which other problem objectively existed. The definition of **artificial and technically unrealistic problems** was to be avoided (see **T 246/91**, **T 495/91**, **T 731/91**, **T 741/91**, **T 334/92**, **T 881/92**, **T 380/93**, **T 813/93**, **T 68/95**, **T 644/97**, **T 747/97** and **T 946/00**). This legal principle is also applicable to ex parte proceedings (**T 881/92**, **T 882/92**, **T 884/92**). In **T 419/93** it was added that, when determining the problem, the statements relating thereto in the application should be examined for **correctness** with regard to the prior art and for their **de facto relevance** to the claimed features of the solution. Only if the problem described in the application did not meet prior art requirements and/or was not solved in accordance with the features of the invention, should it be adapted to the prior art and/or actual technical success. In this connection, **T 800/91** emphasised that in any event the formulated problem should be one which the skilled person knowing only the prior art would wish to solve. It should not be tendentiously formulated in a way that unfairly directed development towards the claimed solution. In **T 400/98**, the technical problem set out in the patent at issue had to be reformulated because it had **not been credibly solved**.



In **T 1263/11**, the board observed that there was no disclosure of the terms "microscopic surface properties" and "macroscopic surface properties" in the patent in suit. It was not shown that those terms had well-defined, unambiguous definitions in the art. Consequently, they could not be used to formulate the problem to be solved.

#### 4.3.3 Formulation of partial problems - lack of unity

In **T 314/99** the three different embodiments which were covered by claim 1 did not belong to the same single general inventive concept (Art. 82 EPC 1973). According to **G 1/91** (OJ 1992, 253) lack of unity is not an issue in opposition (or opposition appeal) proceedings. In the case in point the board stated that the consequence of this conceptual lack of unity is that different aspects of the problem apply to the three embodiments and that where conceptual non-unity arises between different embodiments covered by a claim, this may necessitate the formulation of corresponding partial problems, the respective solutions of which must be assessed separately for inventive step. With respect to the requirements of Art. 56 EPC 1973 the inventiveness of the subject-matter of a claim must be denied as a whole in the event that only one of its embodiments is obvious.

### 4.4. Reformulation of the technical problem

#### 4.4.1 General

The technical problem arising may have to be reformulated, in particular in less ambitious terms, if it appears in view of experimental evidence that the combination of features in the claim does not solve this problem over the whole area defined in the claim (**T 20/81**, OJ 1982, 217; **T 39/93**, OJ 1997, 134).

**T 2001/12** clarified the distinction between the requirements of sufficiency of disclosure (Art. 83 EPC), clarity of the claims (Art. 84 EPC), and inventive step (Art. 56 EPC). The board dealt with the consequences when there is a doubt that the invention as claimed is capable of solving the problem defined in the application; inter alia requiring a reformulation of the problem.

It belongs to the well-established jurisprudence of the boards of appeal that where a specific problem is identified in the description, the applicant or patentee may be allowed to put forward a modified version of the problem particularly if the issue of inventiveness has to be considered on an objective basis against a new prior art which comes closer to the invention than that considered in the original patent application or granted patent specification (**T 184/82**, OJ 1984, 261; **T 386/89**). Applying the problem-solution approach, when the original technical problem defined in the application as filed has to be modified to take account of the closest prior art, the objective, more restrictive, problem is determined by the underlying remaining features of the claim (**T 39/93**, OJ 1997, 134). However, reformulation of the problem is only allowable, if the new problem can be deduced from the application as filed (**T 13/84**, OJ 1986, 253), i.e. within the limit of the original description (**T 162/86**, OJ 1988, 452). As a matter of principle, any effect provided by the invention may be used as a basis for reformulating the technical

problem, as long as that effect is derivable from the application as filed (**T 386/89**, see Guidelines G-VII, 5.2 – November 2015 version). A reformulation of the problem also may be appropriate if an alleged effect of a described feature could be deduced by the skilled person from the application in the light of the prior art or if new effects submitted subsequently during the proceedings were implied by or related to the technical problem initially suggested. In relation to new effects it was not permissible to change the nature of the invention (**T 344/89**, **T 2233/08**).

In **T 184/82** (OJ 1984, 261) the board said that "regarding the effect of the invention" reformulation of the problem could be allowed "provided the skilled man could recognise the same as implied or related to the problem initially suggested". The problem may thus be restated to meet a less ambitious objective (see also **T 106/91**, **T 339/96**, **T 767/02**). It was also ruled in **T 13/84** (OJ 1986, 253) that a reformulation of the problem was not precluded by Art. 123(2) EPC 1973 if the problem could be deduced by the skilled person from the application as filed when considered in the light of the closest prior art (**T 469/90**, **T 530/90**, **T 547/90**, **T 375/93**, **T 687/94**, **T 845/02**). In **T 818/93** the board added that it sufficed if the reformulated problem could be deduced later by comparing the application with the closest art. Since features from the drawings might be incorporated into the claims, and also into the description in support of the claims (**T 169/83**, OJ 1985, 193), those features' effects and advantages might also be used as a basis for reformulating the problem, provided this problem could clearly be deduced from the above comparison. **T 162/86** (OJ 1988, 452) added that it should still be possible in appeal proceedings to define the original problem more precisely, within the limits of the original description.

According to **T 39/93** (OJ 1997, 134), the technical problem as originally presented in the application or patent in suit, which was to be regarded as the "subjective" technical problem, might require reformulation on the basis of objectively more relevant elements originally not taken into account by the applicant or patentee. This reformulation defined the "objective" technical problem. The latter represented the problem ultimately remaining, i.e. the technical effect achieved by the subject-matter (features) as defined in the claim.

Following on from this case law, the board in **T 1397/08** confirmed that, in accordance with the problem/solution approach for assessing inventive step in chemistry, the technical problem could be reformulated, and in certain circumstances actually had to be, since the only factor of importance in determining the problem objectively was the result actually achieved in relation to the closest state of the art. There was nothing to prevent the problem as first formulated from being modified, even at the appeal stage, as long as the spirit of the original disclosure of the invention was respected.

In **T 716/07** with regard to the reformulation of the problem the board considered whether the examples in the closest prior art document and the patent in suit were comparable to the extent that the alleged effect was convincingly shown to have its origin in the distinguishing feature of the invention (**T 197/86**, OJ 1989, 371, **T 1835/07**). Then the board determined whether it was probable that this effect had been achieved over the whole range of the claims of the patent in suit (see **T 1188/00**), and finally whether the

effect was related to the problem to be solved as disclosed in the application as filed. In this case the comparison between the examples in the prior art and those in the patent showed an unexpected effect.

In **T 143/13**, the board observed that, according to the problem-solution approach, it is the problem described in the patent application that is normally used as the starting point for assessing inventive step. In the decision under appeal, the step of assessing whether the problem defined in the application had been solved had been omitted. Nevertheless, the problem had been reformulated in terms that had not been invoked by the appellant (applicant). The justification provided for the reformulation of the problem was that the originally defined problem was artificial. However, the board could not see why. The reformulation of the problem in the decision under appeal was not considered to be appropriate.

In **T 564/89** the appellant submitted that any amendment of the technical problem had to be in line with Art. 123(2) EPC 1973. The board stated that this article was not concerned with the issue of whether or not an objectively reformulated technical problem could be used in the course of the so-called problem-solution approach. Art. 123(2) EPC 1973 would only come into play if an amended technical problem were incorporated into the description itself (**T 276/06**).

In **T 732/89** the respondent submitted that the "hot/wet" performance of the claimed composites, although admittedly better than that of the control composition, corresponded to a completely new effect which could not be incorporated into the technical problem without contravening Art. 123(2) EPC 1973. The board did not agree with this line of argumentation and referred to **T 184/82** (OJ 1984, 261) where a redefinition of the problem regarding the effect of an invention was allowed provided that the skilled person could recognise the same as implied or related to the problem initially suggested. In the case in point the board took the demonstrated effect into account in the formulation of the technical problem and stated that in determining which effect was crucial and which was merely accidental (the so-called "bonus effect"), a realistic approach had to be taken, considering the relative technical and practical importance of those effects in the circumstances of a given case (see also **T 227/89**).

#### 4.4.2 Subsequently invoked technical effect

In **T 440/91** the board pointed out that R. 27 EPC 1973 did not rule out the possibility of additional advantages - not themselves mentioned in the application as filed but relating to a mentioned field of use - being furnished subsequently in support of patentability for the purposes of Art. 52(1) EPC 1973, as such advantages did not alter the character of the invention. Thus, the character of the invention was not altered if the technical problem specified in the application as filed was supplemented by such advantages, since the skilled person might consider them on account of their close technical relationship to the original problem (see also **T 1062/93**). The board made a distinction with regard to the situation in **T 386/89** and **T 344/89**, where there was no such technical relationship. In **T 386/89** the board had found that the solution to the technical problem derivable from the application as filed was in no way associated with a technical effect

subsequently invoked. This additional effect had thus not been taken into consideration. The alleged effect of a described feature could not be taken into account when determining the problem underlying the invention for the purpose of assessing inventive step, if it could not be deduced by the skilled person from the application as filed considered in relation to the closest prior art. Similarly in **T 344/89**, the board had refused to take account of a subsequently invoked technical effect on the grounds that to do so would have altered the character of the invention (**T 532/00**, **T 845/02**, **T 2179/08**).

In **T 235/04** the comparative test report did not allow any conclusion as to whether the technical benefits of the claimed composition vis à vis the closest prior art were achieved within the whole scope of claim 1. The board did not accept the formulation of the technical problem since the purported improvement had not been demonstrated to arise within the whole area that was claimed. When defining the technical problem, an effect cannot be retained if the promised result is not attainable throughout the entire range covered by the claimed subject matter. Therefore, the technical problem needed to be redefined in a less ambitious way (**T 626/90**, **T 1057/04**, **T 824/07**).

In **T 259/05** too the board held the claimed improvement to be unproven; it had not been substantiated by tests or plausibly shown in any other way. The ambitious problem formulated could therefore not be considered successfully solved. So the invention as defined in claim 1 was not a successful solution to that technical problem. As a result, the claimed improvement in the method's efficiency could not be taken into account for assessing the objective problem which the patent in suit sought to solve, or the inventiveness involved. The technical problem therefore had to be reformulated less ambitiously.

In **T 1188/00** the board found that a reformulation relating to an effect first alleged in appeal proceedings (a more ambitious problem) could not be used to substantiate inventive step unless it was plausibly demonstrated that the alleged effect could be achieved across the whole scope of the claim. The burden of proof for this lay with the proprietor (see also **T 134/00**).

In **T 357/02** the technical problem had to be reformulated in a less ambitious manner. In the board's view it followed from the minimalist character of the technical problem objectively arising from the closest prior art, which can only be formulated as a modification of that state of the art, regardless of a success or failure of the measures applied, that almost any modification of the latter process might be regarded as a feasible alternative by the person skilled in the relevant art, and therefore obvious, since each corresponding solution would be equally useful (or useless).

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

**T 115/89**). The board in case **T 2245/10** recalled that the definition of a technical problem which was in contradiction to the original teaching was not allowable.

#### **4.5. Alternative solution to a known problem**

In **T 92/92** the board noted that Art. 56 EPC 1973 did not require that the problem to be solved should be novel in itself. The fact that the underlying problem of the patent had already been solved by the prior art did not necessarily require redefinition of the problem for the assessment of inventive step, if the subject-matter of the patent represented an alternative solution to this problem. In this context the board referred in particular to decision **T 495/91**. In this case too, the problem stated in the patent specification had already been solved. The problem to be objectively solved was the provision of an alternative process and of apparatus which made it possible to produce a floor covering with specific properties by simple and low-cost means (see also **T 780/94**, **T 1074/93**, **T 323/03**, **T 824/05**).

According to **T 588/93**, for an inventive step to be present, it was not necessary to show improvement - substantial or gradual - over the prior art. Thus an earlier solution to a given technical problem did not preclude later attempts to solve the same problem in another, non-obvious way (**T 1791/08**).

#### **4.6. Solving a technical problem - post-published documents**

According to the established jurisprudence of the boards of appeal the assessment of inventive step is to be made at the effective date of the patent on the basis of the information in the patent together with the common general knowledge then available to the skilled person (**T 609/02**, **T 1329/04**, **T 1545/08**). Moreover, there can only be an invention if the application makes it at least plausible that its teaching indeed solves the problem it purports to solve. The boards have regularly considered in the context of the evaluation of inventive step whether or not "the problem is solved" (**T 939/92**, OJ 1996, 309) and have in cases where they were not satisfied that this was so, i.e. that what was claimed was de facto a solution to the problem, denied an inventive step (**T 210/02**, **T 1329/04**) or required a reformulation of the problem (**T 939/92**, **T 87/08**). According to decision **T 1329/04**, the verification of whether or not the claimed solution actually solves the problem, i.e. whether the claimed subject-matter actually provides the desired effect, must be based on the data in the application. Post-published evidence to support that the claimed subject-matter solves the problem to be solved is taken into account if it is already credible from the disclosure in the patent that the problem is indeed solved. In other words, supplementary post-published evidence may not serve as the sole basis to establish that the problem is solved (**T 1329/04**, **T 415/11**). Common general knowledge at the priority date may be used to interpret the teaching in an application or a patent. Post-published evidence can only be used to back up the teaching derivable from the application (**T 716/08**, see also **T 578/06**).

In **T 716/08** the board stated that as to the quality of the evidence, "absolute proof" of the achievement of an effect is not required for the effect to be "plausible".

In **T 578/06** the board stated that the EPC requires no experimental proof for patentability and considered that the disclosure of experimental data or results in the application as filed and/or post-published evidence is not always required to establish that the claimed subject-matter solves the objective technical problem. This is in particular true in the absence of any formulated substantiated doubt. The board re-emphasised in this context however that this case law considers the establishment of plausibility only relevant when examining inventive step if the case at hand allows the substantiation of doubts about the suitability of the claimed invention to solve the technical problem addressed and when it is thus far from straightforward that the claimed invention solves the formulated problem. This is all the more clear from decisions where an inventive step was in fact denied because the **formulated problem** was **not** considered to have been solved. By way of example the board referred to **T 893/02** and **T 1329/04**.

In **T 433/05** the board referred to decisions **T 1329/04** and **T 1336/04** when deciding whether the technical problem had indeed been solved by the subject matter of claim 1 at the relevant date (see also **T 1306/04**, **T 710/05**, **T 1396/06**).

In **T 1329/04** it was stated that the definition of an invention as being a contribution to the art, i.e. as solving a technical problem and not merely putting one forward, required that it was at least made plausible by the disclosure in the application that its teaching indeed solved the problem it purported to solve. Therefore, even if supplementary post-published evidence might, where appropriate, also be taken into consideration, it could not serve as the sole basis for establishing that the application did indeed solve the problem it purported to solve. In the case before it, the board decided that the post-published evidence could not be regarded as supportive of evidence which would have been given in the application as filed since there was none. Since the post-published evidence was considered to be the first disclosure going beyond speculation, it was not taken into consideration.

The same Board 3.3.08, confronted with a different technical situation, namely one where the quality of evidence provided in the patent at issue was such that the claimed invention was considered to be a bona fide solution to the problem to be solved, accepted the solution of the problem by also taking into consideration the disclosure in a post-published document (**T 1336/04**).

Considering decisions **T 1329/04** and **T 1336/04**, the board was convinced in **T 433/05** that the current circumstances were appropriate to take into account a supplementary post-published document when establishing whether the application indeed solved the problem it purported to solve. In the light of the disclosure in the patent in suit, which was supported by a post published document, the board was satisfied that the problem was solved by the subject-matter of the claims.

In **T 778/08** the post-published documents were taken into account because they simply provided a confirmation that the general concept of the method of the invention was sound. In reaching this conclusion, the board did not deviate from **T 1329/04**. In the present case, the experimental data provided in the application as filed rendered the

alleged effect and its solution plausible, the post-published documents could not be regarded as the first disclosure going beyond speculation, but rather additionally confirmed that the general concept of the claimed invention worked.

## 5. "Could-would approach"

To determine whether the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person, the boards apply the "**could-would approach**" (see also Guidelines G-VII, 5.3 – November 2015 version). This means asking not whether the skilled person **could** have carried out the invention, but whether he **would have done** so in the hope of solving the underlying technical problem or in the expectation of some improvement or advantage (**T 2/83**, OJ 1984, 265; **T 90/84**, **T 7/86**, OJ 1988, 381; **T 200/94**, **T 885/97**). When considering whether or not claimed subject-matter constitutes an obvious solution to an objective technical problem, the question to be answered is whether or not the skilled person, in the expectation of solving the problem, would have modified the teaching in the closest prior art document in the light of other teachings in the prior art so as to arrive at the claimed invention (**T 1014/07**). So the point is not whether the skilled person could have arrived at the invention by modifying the prior art, but rather whether, in expectation of the advantages actually achieved (i.e. in the light of the technical problem addressed), he would have done so because of promptings in the prior art (**T 219/87**, **T 455/94**, **T 414/98**).

In **T 1014/07** the board stated that since this question involves determining whether or not the skilled person would - and not could - have made a particular modification, it is necessary for answering the question to identify conclusive reasons on the basis of tangible evidence that would have prompted the skilled person to act in one way or the other.

It has been held that once an invention existed, it could often be shown that the skilled person could have made it by combining different elements in the prior art, but such arguments had to be disregarded as the product of ex post facto analysis (**T 564/89**).

According to **T 939/92** (OJ 1996, 309), the answer to the question what a skilled person would have done depended in large measure on the technical result he had set out to achieve. In other words, the notional "person skilled in the art" was assumed to act not out of idle curiosity but rather with a specific technical purpose in mind.

In **T 1126/09** the board pointed out that, in accordance with the "could-would" approach, the assessment of inventive step must involve establishing, in each individual case, to what extent the skilled person had good reason, in the light of the closest state of the art or the objective problem derivable from it, to adduce further prior art and apply its teaching to the process/apparatus of the closest prior art - or, in other words, whether any factor is discernible which points towards a combination of the teachings of the citations addressed.

**Technical feasibility** and the absence of obstacles were only necessary requirements for reproducibility but were not sufficient to render obvious **what was actually achievable** for the skilled person (T 61/90). The fact that the inherent properties of a technical means were known to the skilled person, so that he had the intellectual possibility to apply this means in a conventional device, merely established the **possibility** of using such technical means in such a manner, i.e. that the skilled person **could** have used it. However, if it was to be established that such intellectual possibility was also a technical measure which it was obvious for the skilled person to use, it was necessary to show that there was a recognisable pointer in the state of the art to combine the known means and conventional device for achieving the intended technical aim, i.e. that the skilled person **would** have made such a combination. The existence of such a technical reason was dependent on the known properties not only of the means but also of those of the device (T 203/93, T 280/95). That it was theoretically possible for the skilled person to arrive at the invention simply means that he could have used the requisite technical means. If, however, it is to be established that he would actually have used them, it must be possible to ascertain a pointer in the prior art which would have prompted him to do so (T 1317/08).

## 6. Ex post facto analysis

Many decisions of the boards of appeal warn against an ex post facto approach when assessing inventive step (see also the Guidelines G-VII, 8 – November 2015 version). This applies especially to inventions which at first sight seem obvious, to combination inventions and where the proposed solution is supposedly "simple". Correct application of the problem and solution approach avoids this inadmissible ex post facto analysis which draws on knowledge of the invention (T 24/81, OJ 1983, 133; T 564/89, T 645/92, T 795/93).

When assessing inventive step, an interpretation of the prior art documents as influenced by the problem solved by the invention, where the problem was neither mentioned or even suggested in those documents, must be avoided, such an approach being merely the result of an a posteriori analysis (T 5/81, OJ 1982, 249; T 63/97, T 170/97, T 414/98).

In T 970/00 the board stated that any ex post facto analysis, and in particular any conclusion going beyond what the skilled person would have objectively inferred from the prior art, without the benefit of hindsight knowledge of the invention, is of necessity at variance with a proper application of the problem-solution approach. Any attempt to interpret the disclosure of the closest prior art so as to distort or misrepresent, based on hindsight knowledge of the invention, the proper technical teaching of the disclosure in such a way that it artificially meets specific features recited in the claim under consideration must fail, especially as this would risk unfairly and tendentiously concealing the technical contribution of the invention and prejudice the subsequent objective determination of the technical problem solved by the claimed invention (see also T 266/07).

In T 2201/10, the board found that the examining division had taken an ex-post-facto approach to analysing the facts. Even assuming that the proposed solution could be



derived from common general knowledge, it went against the very essence of the teaching in the closest prior art and, therefore, would not realistically have been chosen. The problem and solution approach required that documents not relating to the technical field of the invention be disregarded, and it also precluded any analysis according to which the skilled person would have modified the closest prior art in a manner contrary to its very purpose. In other words, a finding that a claimed invention deviated from what was, in light of the aim pursued, the essence of a prior-art disclosure was enough by itself to conclude that it was inventive over that prior art.

## **7. Expectation of success, especially in the field of genetic engineering and biotechnology**

### **7.1. Reasonable expectation of success**

In accordance with the case law of the boards of appeal, a course of action can be considered obvious within the meaning of Art. 56 EPC 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 is not only at hand when the results are clearly predictable but also when there is a reasonable expectation of success (**T 149/93**). It is not necessary to establish that the success of an envisaged solution of a technical problem was predictable with certainty. In order to render a solution obvious it is sufficient to establish that the skilled person would have followed the teaching of the prior art with a reasonable expectation of success (**T 249/88**, **T 1053/93**, **T 318/02**, **T 1877/08**).

In some decisions, especially in the field of biotechnology, the boards have asked whether in the cases in point it was obvious for the skilled person to try a suggested approach, route or method with a **reasonable expectation of success** (**T 60/89**, OJ 1992, 268). For more about biotechnological inventions and the definition of the skilled person, see also point I.D.8.1.3 below.

In the more recent case **T 2168/11**, the board observed that, according to the jurisprudence of the boards of appeal, as set out in several decisions, absolute certainty is not required for a reasonable expectation of success (cf. **T 192/06**, point 11 of the Reasons; **T 278/03**, point 13 of the Reasons; **T 918/01**, point 9.1 of the Reasons). It regarded a specific reference in a document as a hint to the skilled person to try the claimed subject-matter to solve the technical problem. According to a further approach developed by the boards of appeal which was relevant for the case in point, the skilled person "would have had either some expectations of success or, at worst, no particular expectations of any sort, but a 'try and see' attitude, which ... does not equate with an absence of a reasonable expectation of success" (cf. **T 1127/06**, point 13 of the Reasons). It had also been decided that the expectation of success depended on the complexity of the technical problem to be solved. While for very ambitious problems requiring the consideration of all the features relied on by the respondents but not contained in claim 1, important difficulties might be expected a priori, less ambitious problems might normally be associated with higher expectation of success (see, among others, **T 192/06**, point 11 of the Reasons and **T 782/07** point 35 of the Reasons). The board decided that the main request did not fulfil the requirements of Art. 56 EPC.

In line with **T 918/01**, the board in **T 1577/11** concluded that, given the superior efficacy of anastrozole, as compared with tamoxifen, in treating advanced breast cancer, there was a reasonable expectation it would also improve the treatment of early breast cancer, as compared with that achieved with tamoxifen.

In **T 296/93** the board held that, in relation to inventive step, the fact that other persons or teams were working contemporaneously on the same project might suggest that it was "obvious to try" or that it was an interesting area to explore, but it did not necessarily imply that there was a "reasonable expectation of success". **A reasonable expectation of success should not be confused with the understandable "hope to succeed"**; it implied the ability of the skilled person to predict rationally, on the basis of the knowledge existing before a research project was started, the successful conclusion of the said project within acceptable time limits. The more unexplored a technical field of research was, the more difficult it was to make predictions about its successful conclusion and, consequently, the lower the expectation of success (**T 694/92**, OJ 1997, 408). According to **T 207/94** (OJ 1999, 273), the "hope to succeed" was merely the expression of a wish, whereas a "reasonable expectation of success" presupposed scientific appraisal of available facts.

In **T 187/93** it was stated that even if it was obvious for the skilled person to try an experiment, it was not necessarily true that this person would have any reasonable expectation of success when embarking on it.

In **T 223/92** the board said that in 1981, given the state of the art at that time, the skilled person would have opted for DNA-recombination technology only if relying, e.g., on his own good luck and inventiveness to overcome the known (and as yet unknown) problems involved, which would have caused the average skilled person to expect to fail.

In **T 923/92** (OJ 1996, 564) the board had to decide whether the skilled person would have attempted, with reasonable expectation of success, to produce cDNA coding for human t-PA, or whether in this instance he would have known from his technical knowledge, before even embarking on the research, that he would be able to complete his project within an acceptable time. The board bore in mind that, as stated in **T 816/90**, "even when it is possible to theoretically conceive a straightforward approach to solve a specific technical problem, the skilled person might be confronted with unexpected difficulties when trying to put the conceived strategy into practice". The board stated that, although hoping to succeed, the skilled person embarking on this project would have known that its successful conclusion depended not only on technical skill in putting into practice the sequence of precise steps of the theoretical experimental protocol, but to a large extent also on the ability to take the right decisions along the way whenever a difficult experimental situation so required. Under these circumstances, it could not be said that the skilled person had a reasonable expectation of success.

In **T 386/94** (OJ 1996, 658), again citing **T 816/90**, the board ruled that, in gene technology, inventive step could not be acknowledged if, at the priority date, a skilled person could expect to perform the cloning and expression of a gene in a fairly

straightforward manner, and the cloning, although requiring much work, did not pose such problems as to prove that the expectation of success was ill-founded.

Where the expression of a cloned DNA in a chosen foreign host constituted the subject-matter of the claimed invention, the question whether a reasonable expectation of success existed or not could be evaluated only by taking into account real difficulties relating to that step. Thus, in order to be considered, any allegation that features jeopardised a reasonable expectation of success had to be based on technical facts (**T 207/94**, OJ 1999, 273).

In **T 737/96** the board was of the opinion that it was not appropriate to attempt to evaluate the expectation of success of a random technique such as mutagenesis where results depended on chance events. This was because the skilled person knew that, unless a specific selection method could be developed, which was not the case in the patent in suit, perseverance and chance played a key role in achieving success, as no form of control could be exerted over the mutation events. Under these circumstances, as in a lottery game, the expectation of success always ranged irrationally from nil to high, so it could not be evaluated in a rational manner based on technical facts (see also **T 694/92**, OJ 1997, 408).

## 7.2. Try and see situation

In a few cases, the board stated that there have been cases where inventive step was denied by the boards of appeal because the skilled person was in a "try and see" situation. Such a situation was considered to have occurred if the skilled person, in view of the teaching in the prior art, had already clearly envisaged a group of compounds or a compound and then determined by routine tests whether such compound/s had the desired effect (**T 889/02**, **T 542/03**, **T 1241/03**, **T 1599/06**, **T 1364/08**).

In **T 1396/06** the board stated that a skilled person, even when applying routine methods with the aim of solving a closely related technical problem, would not have the absolute certainty of succeeding. However, certainty of success is not required according to the jurisprudence of the boards of appeal, which makes a clear distinction between reasonable expectation of success and certainty of success (**T 918/01**). Rather, in spite of the understandable uncertainties which always characterise biological experiments, the skilled person would have had no reason to adopt a sceptical attitude. He would have had either some expectations of success or, at worst, no particular expectations of any sort, but only a "try and see" attitude, which does not equate with an absence of a reasonable expectation of success (see also **T 759/03**).

In **T 293/07** the board stated that the testing of humans could not be considered to represent known routine tests and accordingly the skilled person was not in a "try and see" situation. In **T 847/07** the board considered it questionable whether the skilled person would adopt a "try and see" attitude at all in cases where human testing would be necessary in order to determine whether or not a compound has a certain property (see also **T 1545/08**).

In **T 1545/08** the appellant asserted that the skilled person would have at least adopted a "try and see" attitude towards the use of interferon and ribavirin for treating naïve patients having an HCV 1 genotype infection, a viral load of greater than 2 million copies per ml of serum for a period of 40 to 50 weeks and hence an inventive step was not present. The board, however, stated that neither cell culture nor animal models of HCV were available one year before the priority date of the patent. In fact document (OD2) stated that "[u]nfortunately, cell culture systems and animal models of HCV replication were yet to be developed and the lack of simple in vitro and in vivo systems for evaluating antiviral agents for effects on HCV replication made it necessary to investigate agents of promise in humans with this disease." No evidence was before the board that at the priority date this situation had changed. It followed that the effect of the combination had to be tested in humans. In line with established case law the board concluded that the skilled person was not in a "try and see" situation.

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

Decisions **T 455/91**, **T 412/93**, **T 915/93**, **T 63/94**, **T 856/94**, **T 91/98**, **T 111/00** and **T 948/01** also consider this topic.

## 8. Skilled person

### 8.1. Definition of the skilled person

#### 8.1.1 Definition

According to the case law of the boards of appeal, **the person skilled in the art** should be presumed to be an experienced practitioner who has average knowledge and abilities and is aware of what was common general knowledge in the relevant art concerned at a particular time (average skilled person). He should also be presumed to have had access to everything in the **state of the art**, in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation (Guidelines G-VII, 3 – November 2015 version). The skilled person will be an expert in a **technical field** (**T 641/00**, OJ 2003, 352). **T 39/93** (OJ 1997, 134) explained that, whilst generally accepted definitions of the notional "person skilled in the art" did not always use identical language to define the qualities of such a person, they had one thing in common, namely that none of them suggested he

was possessed of any inventive capability. It was the presence of such capability in the inventor which set him apart from the notional skilled person.

With regard to the definition of the skilled person, the board in **T 26/98** summarised the following principles which are generally applied by the boards of appeal: if the problem prompts the skilled person to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability" (see crucial decision **T 32/81**, OJ 1982, 225; **T 141/87**, **T 604/89**, **T 321/92**). The skilled person can be expected to look for suggestions in neighbouring fields if the same or similar problems arise in such fields. The skilled person can be expected to look for suggestions in a general technical field if he is aware of such fields. In advanced technical fields the competent "skilled person" could be taken to be a team of experts from the relevant technical branches. Solutions to general technical problems in non-specific (general) fields are considered to form part of the general technical knowledge.

In **T 1464/05** the board considered the features made available to the public by the public prior use as the closest state of the art. The board stated that, according to established doctrine, the notional person skilled in the art referred to in Art. 56 EPC 1973 was assumed to be aware of the totality of the prior art pertinent to the relevant area of technology and in particular of everything made available to the public within the meaning of Art. 54(2) EPC 1973. The different means by which the state of the art was made available to the public ranked equally with each other. The notional skilled person was supposed to be aware of all the features of the prior use in suit that had been made available to the public. Thus, although it would be unrealistic to assume that all skilled members of the interested public would have been aware of the features made available to the public by the prior use, the notion of the skilled person under Art. 56 EPC 1973 ensured that any obvious development or application of the features of the public prior use by any particular skilled member of the interested public who had gained information on the features made available to the public by the prior use was treated under Art. 56 EPC 1973 as such, i.e. as obvious with regard to the state of the art, irrespective of whether or not other members of the interested public had actually become aware of the features of the prior use.

In **T 1030/06** the application related to a system and method for securely buffering content. The board considered that the skilled person was a person of ordinary skill in the art which meant not only having access to the state of the art and common general knowledge in the field, but also the capability to perform routine work and experimentation. Thus, the skilled person could be expected to seek out solutions and make choices to try to solve design problems that crop up.

According to **T 422/93** (OJ 1997, 25), when examining for inventive step using the "problem and solution approach", the starting point for defining the appropriate skilled person was the technical problem to be solved on the basis of what the prior art disclosed, irrespective of any other definition of the skilled person suggested in the contested patent. Since the technical problem addressed by an invention had to be so

formulated as not to anticipate the solution, the skilled person to be considered could not be the appropriate expert in the technical field to which the proposed solution belonged if this technical field was different to the one considered when formulating the technical problem. Nor did the appropriate skilled person's basic knowledge include that of a specialist in the different technical field to which the proposed solution belonged, if the closest prior art gave no indication that the solution was to be sought in this other technical field.

In **T 25/13** the board stated that opponents were essentially free to choose the starting point for assessment (here D4), but their choice then had implications for the technical knowledge of the relevant skilled person. The board concluded that there were two options: either to take the skilled person in the field of the invention (motor vehicle) – who would never have consulted D4 (tumble dryers) because it was from a totally different field – or to take D4 as the starting point, in which case the skilled person's field would be domestic appliances and the solution would not be obvious to him.

#### 8.1.2 Competent skilled person - group of people as "skilled person"

Sometimes the "skilled person" may be a group of people, such as a research or production team. For the purposes of Art. 56 EPC 1973, the person skilled in the art was normally not assumed to be aware of patent or technical literature in a remote technical field. In appropriate circumstances, however, the knowledge of a team consisting of persons having different areas of expertise could be taken into account (**T 141/87**, **T 99/89**). This would be the case in particular if an expert in one particular field was appropriate for solving one part of the problem, while for another part one would need to look to another expert in a different area (**T 986/96**).

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

In **T 164/92** (OJ 1995, 305, Corr. 387) it was observed that sometimes the average skilled person in electronics, particularly if he did not have an adequate knowledge of programming languages himself, might be expected to consult a computer programmer if a publication contained sufficient indications that further details of the facts described therein were to be found in a program listing attached as an annex thereto.

In **T 147/02**, the board observed that the skilled person in the field of drainage systems for tunnels, flood barriers, dams and hydro-electric installations, was typically an engineer or architect in the civil engineering sector who drew up plans and supervised the building work, frequently working in a team with other specialists (**T 460/87**, **T 99/89**).

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

respectively), **T 141/87**, **T 295/88**, **T 825/93**, **T 2/94**, **T 402/95** and **T 986/96** (team consisting of a first expert in the field of mail processing and a second expert acquainted with information in the field of weighing) and **T 2192/10** (team comprising a machine designer and an actuator technician).

### 8.1.3 Definition of the person skilled in the art in the field of biotechnology

The person skilled in the art in the field of biotechnology is well defined by the case law of the boards of appeal. His attitude is considered to be conservative. He would never go against an established prejudice, nor try to enter unpredictable areas nor take incalculable risks. The notional skilled person would perform a transfer of technology from a neighbouring field to his specific field of interest, if this transfer involved routine experimental work comprising only routine trials (**T 455/91**, OJ 1995, 684; **T 500/91**, **T 387/94**, **T 441/93**, **T 1102/00**).

In **T 60/89** (OJ 1992, 268) the board took the view that the skilled person in genetic engineering in 1978 could not be defined as a Nobel prize winner, even if a number of scientists working in this field at that time actually were awarded that prize. Rather he should be assumed to be a scientist (or team of scientists) working as a teacher or researcher in the laboratories which made the transition from molecular genetics to genetic engineering at that time.

This case law was confirmed in **T 500/91** - "BIOGEN II". The board ruled that the average skilled person - who might also be a team of specialists in the relevant field - operated at a practical level, and the technical development which might normally be expected of him did not include solving technical problems through scientific research.

From the notional skilled person nothing more can be expected than the carrying out of experimental work by routine means within the framework of the normal practice of filling gaps in knowledge by the application of existing knowledge (**T 886/91**, **T 223/92**, **T 530/95**, **T 791/96**).

It had to be assumed that the average skilled person would not engage in creative thinking (**T 500/91**). Yet he or she could be expected to react in a way common to all skilled persons at any time, namely that an assumption or hypothesis about a possible obstacle to the successful realisation of a project must always be based on facts. Thus, in the board's view, an absence of evidence that a given feature might be an obstacle to carrying out an invention would not be taken as an indication that this invention could not be achieved, nor that it could (**T 207/94**, OJ 1999, 273).

In **T 223/92** the board had to consider the knowledge and capabilities of the notional skilled person in the field of genetic engineering as at October 1981, more than one year later than was the case in **T 500/91**. By this time, a considerably greater number of genes had been made the subject of cloning and expressing methods, and skills and experience in this technical field were developing rapidly. The knowledge of the notional person skilled in the art had to be considered as that of a team of appropriate specialists who knew all the difficulties still to be expected when considering the cloning of a new

gene. However, the skilled person had to be assumed to lack the inventive imagination to solve problems for which routine methods of solution did not already exist.

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

In **T 455/91** (OJ 1995, 684) the board set out considerations on the skilled person's likely attitude to possible changes, modifications or adjustments to known products (e.g. a plasmid) or procedures (e.g. an experimental protocol). Its aim was to answer, objectively and avoiding any ex post facto analysis, the question whether it would be obvious to the skilled person to make given changes in a structure or procedure. The skilled person in this field was well aware that even a small structural change in a product (e.g. a vector, protein, or DNA sequence) or procedure (e.g. a purification process) could produce dramatic functional changes. He would therefore adopt a conservative attitude. For example, he would neither go against an established prejudice, nor venture into "sacrosanct" or unpredictable areas, nor take incalculable risks. However, within the normal design procedures, he would readily seek appropriate, manifest changes, modifications or adjustments involving little trouble or work and no or only calculable risks, especially to obtain a handier or more convenient product or simplify a procedure.

If, on the other hand, he would expect to have to perform scientific research rather than routine work in order to transfer a technology previously set up in one field of research (method of transforming *Saccharomyces cerevisiae* whole cells) to a neighbouring field (method of transforming *Kluyveromyces* whole cells), then inventive step could be acknowledged (**T 441/93**).

In **T 493/01** the invention related to a protective antigen potentially useful in a vaccine against whooping cough. In **T 455/91** (OJ 1995, 684) the skilled person in the field of biotechnology had already been defined as being cautious and conservative. The board said this did not mean he would refrain from considering information because it did not concern the mainstream of research in his field of specialisation or because it applied only to some parts of the world. His skill and knowledge were not geographically limited; in fact he would have a global point of view. Thus if, as in the case in point, a pathogen constituted a known threat in some restricted parts of the world, the skilled person would not refrain from taking prior knowledge about that pathogen into consideration or from using it as a basis for his activities.

#### 8.1.4 Identification of the skilled person in the case of computer-implemented inventions

In **T 641/00** (OJ 2003, 352) the board stated that the identification of the skilled person needs careful consideration. He will be an expert in a **technical** field. If the technical



problem concerns a computer implementation of a business, actuarial or accountancy system, he will be someone skilled in data processing, and not merely a businessman, actuary or accountant (**T 172/03**).

In **T 531/03** the board stated that, in the assessment of inventive step, features relating to a non-invention within the meaning of Art. 52(2) EPC 1973 ("non-technical features") could not support the presence of inventive step. The patentee submitted that the invention at issue required a combination of a technical and a non-technical inventive step, and that the skilled persons would therefore consist of a team of a "non-technical person" plus a technical person. The board rejected this approach and stated that an attempt to take into account the contribution of non-technical and technical aspects on an equal footing in the assessment of inventive step would be inconsistent with the Convention, since the presence of inventive step would, in such an approach, be attributed to features which were defined in the Convention as not being an invention.

The board in **T 407/11** held that the relevant skilled person in the context of providing computer-system users with operating assistance via a user interface (e.g. error messages or warnings) was an expert in software ergonomics concerned with the user-friendliness of human-machine interfaces rather than an expert in software programming or in computer technology in the strict sense.

## 8.2. Neighbouring field

Two landmark decisions, **T 176/84** (OJ 1986, 50) and **T 195/84** (OJ 1986, 121) addressed in detail the problem of the relevant technical field, i.e. the question of the extent to which neighbouring areas beyond the specific field of the application might be taken into consideration when assessing inventive step. According to **T 176/84**, when examining for inventive step, a skilled person would, as well as considering the state of the art in the specific technical field of the application, look for suggestions in neighbouring fields or a broader general technical field if the same or similar problems arose, and if he could be expected to be aware of such general fields. **T 195/84** added that the state of the art also had to include prior art in a non-specific (general) field dealing with the solution of any general technical problem which the application solved in its specific field. Such solutions of general technical problems in non-specific (general) fields had to be viewed as forming part of the general technical knowledge which a priori was to be attributed to those skilled persons versed in any specific technical field. These principles were applied in a large number of decisions.

In **T 560/89** (OJ 1992, 725) the board took the view that the skilled person would also draw on prior art in other fields which were neither neighbouring nor broader general fields, if prompted to do so because the materials used were related or because of public debate about a technical problem common to both fields. Expanding on this, **T 955/90** added that, in practice, the person skilled in a broader general field would also draw on the narrower, more specialised field of the known main application of the general technology in search of a solution to a problem lying outside the special application of that technology (**T 379/96**).

According to **T 454/87** a skilled person specialising in a particular technical field (gas 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).

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.

According to the board in **T 1910/11**, whether the prior art and the claimed invention belonged to neighbouring technical fields within the meaning of **T 176/84** was less a question of whether the relevant implementation parameters were identical than a question of the degree of similarity between the respective problems, boundary conditions and functional concepts. Applying this to the case in hand, it observed that automotive electronics and avionics were traditionally considered to be neighbouring technical fields because they involved similar problems (e.g. interference resistance, robustness and reliability), boundary conditions (e.g. mobility) and functional concepts (e.g. physical/logical separation of the communications systems for safety and maintenance data in the vehicle) (point 2.1.6 of the Reasons).

In **T 767/89**, regarding carpets, the board ruled that wigs were neither a neighbouring technical field nor a broader general one which included the former field. So wigs were not a related technical field in which the person skilled in carpets would have been prompted to seek solutions. The two inventions addressed different problems; the user requirements were not comparable.

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

Further comments on the concept of relevant field are to be found in several other decisions, including the following: **T 277/90** (in dentistry, moulding technology and prosthodontics are neighbouring technical fields), **T 358/90** (discharging the content of a portable toilet did not lead the skilled person to the field of filling a tank of a chain saw by means of a special kind of container), **T 1037/92** (a person skilled in the art of making fuse links for programmable ROMs would also have consulted the documentation in the field of ultraminiaturised integrated switches), **T 838/95** (the pharmaceutical and cosmetic fields were immediate neighbours), **T 26/98** (the board did not consider the field of electrochemical generators to be a neighbouring field of iontophoresis because, though both fields relied on electrochemical processes, such processes had substantially different purposes and applications and, consequently, had to satisfy different requirements), **T 1202/02** (the manufacture of mineral fibres and that of glass fibres were two closely related technical fields irrespective of differences between the raw materials respectively used) **T 365/87**, **T 443/90**, **T 47/91**, **T 244/91**, **T 189/92**, **T 861/00**.

On a different aspect, with regard to the applicant's reference to a remote state of the art, the board gave the following ruling in **T 28/87** (OJ 1989, 383); if reference is made in the introduction to the description of an application or a patent to a state of the art which cannot objectively be classified as a relevant field, that state of the art cannot in the course of examination for patentability be applied to the applicant's or proprietor's disadvantage as a neighbouring field merely on account of that reference.

### 8.3. Skilled person - level of knowledge

The same level of skill has to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step have to be considered (**T 60/89**, OJ 1992, 268; **T 373/94**). **T 694/92** (OJ 1997, 408) added that, although the same level of skill is applied for both Art. 56 and Art. 83 EPC 1973, the two starting points differ; for inventive step purposes, the skilled man knows only the prior art; for sufficiency of disclosure, he knows the prior art **and** the disclosed invention.

According to **T 426/88** (OJ 1992, 427) a book providing general teaching in a general technical field covering the invention's specific technical field was part of the general knowledge of a specialist in that specific technical field. When books, representing common general knowledge, described a basic general technical theory or methodology and exemplified the same with specific applications in certain technical fields only, these did not limit the general scope and relevance of such disclosures so as to exclude possible applications in other fields. The appellant had argued that the book, written in German, was not a general reference book consulted by experts in that field in Great Britain. The board, however, adhered to the definition of the state of the art given in Art. 54 EPC 1973, according to which no account was taken of the location at which the skilled person exercised his profession.

In **T 1688/08** the board stated that the language of a patent document alone cannot be decisive for the question of whether or not the skilled person considers the technical content of that document. Otherwise, there would be a differentiation between skilled persons according to the language(s) they speak. This would be against the objective assessment of the inventive step (see, by analogy, **T 426/88**, OJ 1992, 427).

In **T 766/91** the board summarised the normally accepted view that common general knowledge was represented by basic handbooks and textbooks on the subject in question. It was knowledge that an experienced person in this field was expected to have, or at least to be aware of, to the extent that he knew he could look it up in a handbook if he needed it. Statements in such works were used as convenient references to show what was common knowledge. The information as such did not as a rule become such knowledge through publication in a given handbook or textbook; rather by the time it appeared in such works it was already generally known. For this reason, publication in an encyclopaedia, say, could normally be taken as proof that the information was not only known but was common general knowledge. The assertion that something was part of the common general knowledge therefore needed only to be substantiated if challenged by another party or the EPO (**T 234/93**, **T 590/94**, **T 671/94**, **T 438/97**, **T 1253/04**, **T 1641/11**). Where an assertion that something was part of the

common general knowledge is challenged, the person making the assertion must provide proof that the alleged subject-matter indeed forms part of the common general knowledge (**T 438/97**, **T 329/04**, **T 941/04**, **T 690/06**).

In **T 378/93** the board confirmed this case law, adding that the same applied to articles in scientific periodicals addressed primarily to qualified professionals and enjoying worldwide repute.

In **T 939/92** (OJ 1996, 309) it was explained that the state of the art could also perfectly well reside solely in the relevant common general knowledge, which, in turn, need not necessarily be in writing, i.e. in textbooks or the like, but might simply be a part of the unwritten "mental furniture" of the average skilled person. In the case of any dispute, however, the extent of the relevant common general knowledge had to be proven, e.g. by documentary or oral evidence.

Numerous publications in the specialist press over a fairly short time, reporting on meetings and research in a particularly active field of technology, could reflect common general knowledge in this field at that time (**T 537/90**).

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

#### **8.4. Everyday items from a different technical field**

In **T 1043/98** the patent concerned an inflatable gas-bag for a vehicle restraint system, one part being club-shaped and the other generally butterfly-shaped. According to the appellant, the skilled person would immediately arrive at the claimed gas-bag from his knowledge of tennis-ball or baseball construction. This raised the issue of the application of features or solutions drawn from another technical field but which could be considered "everyday items".

In **T 397/87** the board had already pointed out that there was no obvious reason why a skilled person trying to solve a non-trivial problem should have been led to the claimed process by simple examples from everyday life which were unrelated to the problem in question. In **T 349/96**, too, the board was unable to see why the fact that different transport containers were used for beer bottles in an everyday context should prompt a skilled person to invent a spinning/winding machine combination with an integrated transport system even if the many citations from the relevant technical field were unable to do this (see also **T 234/91**).

In **T 234/96**, however, the board concurred with the examining division's view that the skilled person dealing with the practicalities of motorising a dispenser drawer for washing powder had in mind as a model the disc tray of a CD player with push-button electromotor operation, which, at the time of filing the application, was familiar to anyone and which therefore suggested the subject-matter of claim 1. In the board's view, the fact

that washing machines and CD players were intrinsically different items serving different purposes did not suffice to prevent the skilled person concerned with the construction of washing machines from taking into consideration the basic principle of automatic tray operation in CD players when designing a dispenser drawer for washing powder.

From a comparison of the above-mentioned decisions, the board in **T 1043/98** concluded that the relevance of such items for inventive step depended very much on the circumstances of the individual case. It agreed that persons skilled in developing the gas-bags in question would include tennis or baseball players. It could not, however, share the appellant's view that to solve the problem addressed by the invention the skilled person would draw on what he might know about tennis-ball or baseball construction. The main reason was that the gas-bag was not intended to be spherical in shape. It was therefore unlikely that the skilled person would take as his starting point an object which was the epitome of a sphere (see **T 477/96**, where the board also concluded that everyday experience was not relevant to the technical field of the invention).

## **9. Assessment of inventive step**

### **9.1. Treatment of technical and non-technical features**

The boards of appeal have been concerned with the assessment of inventive step in cases where the invention consisted of a mix of technical and non-technical features. Decision **T 154/04** (OJ 2008, 46) analysed the case law relating to the patentability of inventions and summarised the main principles concerning mixed inventions as follows: for examining patentability of an invention in respect of a claim, the claim must be construed to determine the technical features of the invention, i.e. the features which contribute to the technical character of the invention. It is legitimate to have a mix of technical and "non-technical" features appearing in a claim, in which the non-technical features may even form a dominating part of the claimed subject matter. Novelty and inventive step, however, can be based only on technical features, which thus have to be clearly defined in the claim. Non-technical features, to the extent that they do not interact with the technical subject matter of the claim for solving a technical problem, i.e. non-technical features "as such", do not provide a technical contribution to the prior art and are thus ignored in assessing novelty and inventive step. Finally, for the purpose of the problem-and-solution approach, the problem must be a technical problem which the skilled person in the particular technical field might be asked to solve at the relevant priority date. The technical problem may be formulated using an aim to be achieved in a non-technical field, and which is thus not part of the technical contribution provided by the invention to the prior art. This may be done in particular to define a constraint that has to be met (even if the aim stems from an a posteriori knowledge of the invention).

These principles have indeed a clear and consistent basis in the EPC and in the case law of the boards of appeal and the Enlarged Board of Appeal, in particular. In this connection, the Enlarged Board of Appeal noted in **G 3/08** (OJ 2011, 10) that it was not aware of any divergence in this case law, suggesting that the boards were in general quite comfortable with it, and concluded that it would appear that the case law had

created a practicable system for delimiting the innovations for which a patent may be granted (see also **T 116/06**, **T 1769/10**).

### 9.1.1 Technical character of the invention

In order to be patentable, the subject-matter claimed must therefore have a "technical character" or to be more precise - involve a "technical teaching", ie an instruction addressed to a skilled person as to how to solve a particular technical problem using particular technical means (**T 154/04**, OJ 2008, 46). Having technical character is an implicit requisite of an "invention" within the meaning of Art. 52(1) EPC 1973 (requirement of "technicality"). Art. 52(2) EPC 1973 does not exclude from patentability any subject matter or activity having technical character, even if it is related to the items listed in this provision since these items are only excluded "as such" (Art. 52(3) EPC 1973) (**T 154/04**, OJ 2008, 46). Technical character results either from the physical features of an entity or (for a method) from the use of technical means. While an invention as a whole may possess technical character, it may nevertheless legitimately include both technical and non-technical features (**T 641/00**, OJ 2003, 352, **T 1543/06**). Decisive for the presence of a (potentially patentable) invention is the inherent character of the claimed subject-matter (**T 154/04**).

The case law identifies the requirement of technical character as **separate to and independent** of the remaining requirements of Art. 52(1) EPC 1973, in particular novelty and inventive step, compliance with which can therefore be assessed without having recourse to the prior art (**T 154/04**). The legal definition of Art. 56 EPC is to be put into context with the remaining patentability requirements of Art. 52 to 57 EPC these articles implying the general principles that patents shall be available for inventions in all fields of technology and that technical character is a sine qua non for an invention within the meaning of the EPC (**T 931/95**, OJ 2001, 441; **T 935/97**, **T 1173/97**, OJ 1999, 609; **T 641/00**, OJ 2003, 352; **T 914/02**, **T 154/04**, OJ 2008, 46, **T 1227/05**, OJ 2007, 574). According to **T 208/84** (OJ 1987, 14), one indication of technical character is that the method has an overall technical effect, such as controlling some physical process (see also **T 313/10**). Thus, following **T 258/03**, an invention claiming technical aspects possesses overall technical character, even if it is "mixed" (with both technical and non-technical aspects) (**T 859/07**, **T 188/11**, **T 414/12**, **T 1331/12**).

In **T 914/02** the board held that the involvement of technical considerations is not sufficient for a method which may exclusively be carried out mentally to have technical character. Technical character may be provided through the technical implementation of the method, resulting in the method providing a tangible, technical effect, such as the provision of a physical entity as the resulting product or a non-abstract activity, such as through the use of technical means. The board rejected a claim directed to an invention involving technical considerations and encompassing technical embodiments on the grounds that the invention as claimed could also be exclusively performed by purely mental acts excluded from patentability under Art. 52(2)(c) EPC (see **T 619/02**, OJ 2007, 63; **T 388/04**, OJ 2007, 16).

In **T 388/04** (OJ 2007, 016) the board took the view that subject-matter or activities that are excluded from patentability under Art. 52(2) and (3) EPC 1973 remain so even where they imply the possibility of making use of unspecified technical means.

The issue of technical character is analysed in detail in Chapter I.A.1.1 "Technical character of an invention".

### 9.1.2 Inventions having both technical and non-technical features

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

It is legitimate to have a mix of technical and "non-technical" features appearing in a claim, in which the non-technical features may even form a **dominating part** of the claimed subject matter (**T 26/86**, OJ 1988, 19; **T 769/92**, OJ 1995, 525; **T 641/00**, OJ 2003, 352; **T 531/03**; **T 154/04**, OJ 2008, 46; **T 1784/06**).

When assessing the inventive step of such a mixed-type invention, all those features which contribute to the technical character of the invention are taken into account. These also include the features which, when taken in isolation, are non-technical, but do, in the context of the invention, contribute to producing a technical effect serving a technical purpose, thereby contributing to the technical character of the invention. However, features which do not contribute to the technical character of the invention cannot support the presence of an inventive step (**T 641/00**). Such a situation may arise, for instance, if a feature contributes only to the solution of a non-technical problem, e.g. a problem in a field excluded from patentability (Guidelines G-VII, 5.4 – November 2015 version).

In **T 26/86** (OJ 1988, 19) 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 ask that a patentable invention be exclusively or largely of a technical nature; in other words, it does not prohibit the patenting of inventions consisting of a mix of technical and non-technical elements even if the technical part is not the dominating part of the invention. The board, although allowing a mix of technical and non-technical features to be claimed, considered the technical part of the invention as the basis for assessing inventive step (see **T 641/00**, OJ 2003, 352, point 4 of the Reasons; see also **T 209/91**).

The inventive step requirement of Art. 52(1) and 56 EPC 1973 is assessed using the well-established problem-solution approach, which is fundamentally technical in nature (**T 172/03**). This requires analysis of the invention in terms of a technical solution to a technical problem. When applied to "mixed" inventions, such an approach must necessarily differentiate between an invention's technical and non-technical features.

According to the established case law, features of an invention that do not have a technical effect or do not interact with the remaining features of the invention so as to result in a technical functional contribution cannot be considered to contribute to an inventive step within the meaning of Art. 56 EPC. This is not only the case when the features themselves do not contribute to the technical character of the invention (**T 641/00**, OJ 2003, 352; **T 258/03**, OJ 2004, 575; and **T 531/03**; see also **T 456/90**, **T 931/95**, **T 27/97**, **T 258/97**, **T 1121/02** and **T 1784/06**), but also when the features may in principle be qualified as being of a technical nature but do not have any technical function in the context of the claimed invention (**T 619/02**, OJ 2007, 63) (see for instance **T 72/95**, **T 157/97**, **T 158/97**, **T 176/97**). In addition, this is so regardless of whether the features are themselves obvious or not (see **T 72/95**, **T 157/97**, **T 158/97** and **T 176/97**).

In **T 641/00** (OJ 2003, 352), the board had already held that features of the invention which did not form part of the technical solution to the technical problem had to be disregarded in the assessment of inventive step (**T 931/95**, OJ 2001, 441); **T 1121/02**, **T 1543/06**, **T 336/07**, **T 859/07**, **T 859/07**). In **T 531/03** the board confirmed the principles set out in **T 641/00** and stated that, in the assessment of inventive step, features relating to a non-invention within the meaning of Art. 52(2) EPC 1973 (so-called "non-technical features") could not support the presence of an inventive step (see also **T 1543/06**). In **T 258/03** (OJ 2004, 575), the board held that the invention was to be assessed by taking account only of those features which contributed to a technical character. The features that made a technical contribution therefore needed to be determined. In **T 1543/06** the board stated that the principle as expressed in **T 641/00** (OJ 2003, 352) could be also reformulated as follows: an invention which **as a whole** falls outside the exclusion zone of Art. 52(2) EPC 1973 (i.e. is technical in character) cannot rely on excluded subject matter alone, even if novel and non-obvious (in the colloquial sense of the word), for it to be considered to meet the requirement of inventive step (see also **T 336/07**).

The presence of an inventive step can only be established on the basis of the technical aspects of both the distinguishing features of, and the effects achieved by the claimed invention over the closest state of the art (**T 641/00**, OJ 2003, 352) (see also **T 619/02**, OJ 2007, 63). The presence of an inventive step cannot rely on excluded (non-technical) subject matter alone, however original it may be (see also **T 336/07**).

It is the established case law of the boards of appeal (see **G 3/08**, OJ 2011, 10; **T 258/03**, and **T 424/03**, **T 313/10**) that claimed subject-matter specifying at least one feature not falling within the ambit of Art. 52(2) EPC is not excluded from patentability by the provisions of Art. 52(2) and (3) EPC. Features which would, taken in isolation, belong to the matters excluded from patentability by Art. 52(2) EPC may nonetheless contribute to the technical character of a claimed invention, and therefore cannot be discarded in the consideration of the inventive step. This principle was already laid down, albeit in the context of the so-called "contribution approach", in one of the earliest decisions of the boards of appeal to deal with Art. 52(2) EPC, namely **T 208/84** (point 4 ff. of the Reasons) (see also **T 1784/06**).

In **T 258/03** (OJ 2004, 575) the board noted that, taking into account both the fact that a mix of technical and non-technical features may be regarded as an invention within the



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

The methodology applied by the boards of appeal of the EPO in dealing with "mixed" inventions has been summarised in **T 1543/06** (see also **T 859/07**).

### 9.1.3 Problem and solution approach when applied to "mixed" inventions

#### a) General issues

The boards of appeal use the problem and solution approach to determine whether an inventive step is involved. This requires analysis of the invention in terms of a technical solution to a technical problem. Since both the solution and the problem solved by an invention have to be of a technical nature, the problem and solution approach might raise questions when the invention comprises non-technical aspects or elements. Such difficulties are to be resolved by taking due care to define the **technical field** to which the invention belongs, the scope of technical expertise and skills expected to be applied by the technical person in that particular technical field, and the correct formulation of the technical problem actually solved (**T 1177/97**). Such an approach must necessarily differentiate between technical and non-technical features when applied to "mixed" or hybrid inventions (**T 1543/06**).

#### b) The Comvik approach

The Comvik approach was applied in **T 641/00** (OJ 2003, 352). It is a conventional application of the problem and solution approach where the differences with respect to the closest prior art are determined and only those that contribute to the technical character are considered for inventive step.

The Comvik approach may be more appropriate where the technical part is more substantial and/or relevant prior art exists. It has the advantage that any non-technical feature known from this prior art will not appear as a difference and does not need to be considered in the subsequent steps, thus not requiring the step of judging whether it makes a technical contribution. Furthermore, this approach is less abstract since the claimed features can be analysed against concrete prior art (see **T 756/06** and **T 928/03**). Thus, when assessing the inventive step of the subject-matter of such a

claim, all features of a technical character are taken into account, whereas features which do not form part of a technical solution to a technical problem have to be disregarded in this assessment (**T 641/00**, OJ 2003, 352; **T 1344/09**, **T 1543/06**). The board stated that "... where a feature cannot be considered as contributing to the solution of any technical problem by providing a technical effect it has no significance for the purpose of assessing inventive step."

In **T 1461/12** the board noted that the appellant had taken issue with the fact that the assessment of inventive step based on **T 641/00** involved referring to Art. 52(2) and (3) EPC - and thereby allegedly mixed the requirements of Art. 52 and 56 EPC in an inappropriate manner. In this respect, the board pointed out that the "contribution approach" is typically understood as a test determining whether the difference between the claimed invention and the prior art lies exclusively in a field excluded from patentability under Art. 52(2) EPC and, if so, finding that claimed invention as a whole does not comply with Art. 52(2) and (3) EPC. That is, according to the contribution approach, compliance of an invention with Art. 52(2) and (3) EPC is determined only in view of its contribution over the prior art. This approach was abandoned in **T 1173/97** (OJ 1999, 609, point 8 of the Reasons; see also **G 3/08**, OJ 2010, 10, point 10.6 of the Reasons), which found that compliance with Art. 52(2) and (3) EPC can be established by features already known in the art. The approach based on **T 641/00** (the Comvik approach) relates to the assessment of whether an invention comprising technical and non-technical features involves an inventive step over the prior art. Evidently, an inventive step vis-à-vis the prior art depends on the "contribution" that the claimed invention makes over the prior art. Establishing this contribution is necessary in any method of assessing inventive step, **T 641/00** included, but is not equivalent to the "contribution approach".

The board specified that an inventive step can only be acknowledged for an invention which makes a technical contribution to the art (see, inter alia, **T 38/86**, OJ 1990, 384; **T 1173/97**; **T 1784/06**), i.e. **a contribution in a technical field**. Furthermore, the jurisprudence of the boards of appeal has developed the understanding that the subject-matter excluded from patentability by way of example in Art. 52(2) and (3) EPC concerns fields considered to be non-technical (see **T 931/95**, OJ 2001, 441; and **T 1173/97**). It is true, therefore, that the established way of assessing inventive step under Art. 56 EPC makes reference to Art. 52 EPC. However, this does not mean that the assessment of both requirements is "mixed" (see on this point **T 1784/06**, point 2.2 of the Reasons). Contrary to the appellant's argument, the **assessment** of the requirements of Art. 52 and 56 EPC **remains separate**.

In **T 528/07** the invention, a computer system, consisted of a mixture of technical and non-technical features. The board stated that in order to examine this type of subject-matter the board would normally apply the "Comvik approach" (see **T 641/00**). The appellant had, however, argued that since Art. 52(1) EPC had been brought into line with Art. 27(1) TRIPS, it had to be interpreted in the light of the object and purpose of TRIPS and that would require a modification of the Comvik approach. The board held that under Art. 27(1) TRIPS a patent shall only be granted if it is new and involves an inventive step. TRIPS however does not stipulate how these requirements are to be applied. The TRIPS

member states are free to adopt different standards for each patentability requirement, such as inventive step. The Comvik approach is one facet of the standard applied by the EPO.

In **T 531/03** the board stated that an attempt to take into account the contribution of non-technical and technical aspects on an equal footing in the assessment of inventive step would not be in conformity with the EPC, since the presence of inventive step would in such an approach be attributed to features which are defined in the EPC as not being an invention.

In **T 912/05** the board noted that, according to the principles set out in decision **T 641/00** (OJ 2003, 352) and confirmed in **T 258/03** (OJ 2004, 575), an invention within the meaning of Art. 52(1) EPC is to be assessed with respect to inventive step by taking account of only those features which contribute to its technical character, whereas features making no such contribution cannot support the presence of inventive step. Although the board agreed with the case law referred to above, it found that in the case at issue it was not necessary to seek to separate features that were essentially business-related, and thus not relevant for the solution of a technical problem, from those features that, as essentially technical, should be taken into account when assessing inventive step. It concluded that the assessment of the inventive step of a business-related method might be possible without a preliminary clear-cut separation between business-related features and technical features.

In **T 756/06** the board noted that another approach is also generally followed by the boards of appeal (see also **T 1344/09**). In the approach followed in **T 931/95** (OJ 2001, 441), there is an initial analysis of the technical character of the features of the claim and then a consideration of the inventive step of only those features. This approach is typically used for inventions that are essentially business methods running on more or less notoriously known computer hardware.

### c) Non-technical features and technical contribution

Art. 56 EPC requires a non-obvious technical contribution.

In **T 1784/06** the board confirmed the Comvik approach that only features contributing to the technical character of claimed subject-matter enter into the examination for inventive step (**T 641/00**, OJ 2003, 352; **T 1834/10**). As patents can be granted only for technical subject-matter, the consequence is that a (non-obvious) contribution which justifies the grant of a patent has to have a technical character. It would appear paradoxical to recognise an inventive step on the basis of a non-technical innovation (such as an organisational, administrative, commercial or mathematical algorithm) having no technical implication other than the (obvious) desire for its implementation on a general-purpose computer. Where an intrinsically non-technical solution (here: a mathematical algorithm) seeks to derive a technical character from the problem solved, the problem must be technical. Otherwise, the solution remains non-technical and does not enter into the examination for an inventive step (**T 566/11**). The board agreed with the statement that a non-technical problem can have a technical solution. However, where an

intrinsically non-technical solution (mathematical algorithm) seeks to derive a technical character from the problem solved, the problem must be technical. According to the appellant, claimed subject-matter as a whole should be examined for the presence of an inventive step once the subject-matter as a whole has been found to meet the technology criterion of Art. 52(1), (2) and (3) EPC. The appellant argued that Art. 56 EPC 1973 should be applied independently of Art. 52(1), (2) and (3) EPC because Art. 52(2) EPC has to be applied independently of Art. 56 EPC. The board pointed out that Art. 52(1) EPC has always been understood as referring to technical inventions. It also noted that Opinion **G 3/08** (OJ 2011, 10) of the Enlarged Board of Appeal backed the Comvik approach rather than raising any objection to it (points 10.13.1 and 10.13.2 of the Reasons).

In **T 336/14** the question which arose first was whether the distinguishing features of constituted presentations of information as such within the meaning of Art. 52(2)(d) and (3) EPC and thus were non-technical features which do not contribute to the technical character of claim 1. The board was aware of decisions proposing the concept of "technical novelty" (see **G 2/88**, OJ 1990, 93; **T 154/04**, OJ 2008, 46; **T 619/98**). The board, however, followed the well-established approach of treating potentially non-technical features under the umbrella of inventive step (see e.g. **T 641/00**, OJ 2003, 352).

The board noted that features relating to subject-matter excluded under Art. 52(2) EPC may only contribute to an inventive step if they bring about an overall technical effect, i.e. if they contribute to the technical character of the claim by interacting with its technical features to solve a technical problem. Otherwise, they are to be disregarded in the assessment of inventiveness (see e.g. **T 641/00**; **T 154/04**; **T 1143/06**). This is, in principle, also applied in prominent national decisions of the German Federal Court of Justice (BGH) concerned with the matter of "presentations of information" (see e.g. BGH, X ZR 3/12, GRUR 2013, 275 - Routenplanung; BGH, X ZR 27/12, GRUR 2013, 909 - Fahrzeugnavigationsystem) and the Court of Appeal of England and Wales dealing with "programs for computers" (see Court of Appeal decision of 8 October 2008 - Symbian Ltd v. Comptroller General of Patents [2008] EWCA Civ 1066). The board stated that, in the assessment of whether a feature provides a technical contribution, the feature is not to be taken by itself, but its technical character is to be decided by the effect it brings about after being added to an object which did not comprise that feature before (**T 119/88**, OJ 1990, 395, point 4.1 of the Reasons). Therefore, the board had to determine whether the distinguishing features of claim bring about a credible technical effect and hence solve a technical problem.

In **T 1121/02** the board referred to **T 931/95** (OJ 2001, 441) and **T 641/00** (OJ 2003, 352) and confirmed that features making no contribution to technical character could not support the presence of an inventive step. In **T 258/03** (OJ 2004, 575), the board held that the invention was to be assessed by taking account only of those features which contributed to a technical character (see eg. **T 784/06**, **T 2050/07**). The features that made a technical contribution therefore needed to be determined.

## d) Non-technical features and interaction with technical subject matter

In **T 154/04** the board stated that a non-technical feature may interact with technical elements so as to produce a technical effect, e.g. by its application in the technical solution of a technical problem. Non-technical features, to the extent that they do not interact with the technical subject matter of the claim for solving a technical problem, i.e. non-technical features "as such", do not provide a **technical contribution** to the prior art and are thus ignored in assessing novelty and inventive step. This is the approach used by board in **T 154/04** (OJ 2008, 46) to determine the technical features in a claim if technical and non-technical aspects are tightly intermingled in a mixed type claim, as is typically the case with computer-implemented inventions (see, for example, decisions **T 619/02** and **T 172/03**) (see also **T 641/00**, OJ 2003, 352; **T 1505/05**, **T 477/08**, **T 1358/09**).

In **T 603/89** (OJ 1992, 230) the board pointed out that the subject-matter of a "mix" claim is not excluded from patentability under Art. 52(2) and (3) EPC 1973 when, but only when, the non-technical elements interacted with the known technical elements in order to produce a technical effect (see **T 26/86**, OJ 1988, 19). In the absence of such an interaction - when the technical elements were only a support for the non-technical elements but did not otherwise co-operate therewith - the invention did not make use of technical means and could not therefore be granted (see **T 158/88**, OJ 1991, 566; **T 1670/07**).

## e) Technical implementation of excluded subject-matter

In **T 336/07** the board held that the mere fact that subject-matter (here rules for playing games), which is excluded per se under Art. 52(2)(c) EPC 1973, is technically implemented could not form the basis for inventive step. Inventive step can be based only on the particular manner of implementation of such subject matter. To this end it is therefore necessary to ask how the per se excluded subject matter was implemented. A consideration of the particular manner of implementation has to focus on **any further technical advantages** or effects associated with the specific features of implementation over and above the effects and advantages inherent in the excluded subject-matter (see also **T 1543/06**). The board concluded that the subject-matter of the claims did not involve an inventive step (on the technical implementation of game rules, see also **T 1782/09** and **T 1225/10**). In these two decisions the board stated that "game rules" form part of "the regulatory framework agreed between [or with] players concerning conduct, conventions and conditions that are meaningful only in a gaming context. They govern the conduct and actions of the players during game play.

In **T 1543/06** the board stated that it could not have been the legislator's purpose and intent on the one hand to exclude from patent protection excluded subject matter, while on the other hand awarding protection to a technical implementation thereof, where the only identifiable contribution of the claimed technical implementation to the state of the art is the excluded subject-matter itself. It was noted that here the term "contribution" encompasses both **means** (i.e. tangible features of the implementation) and **effects** resulting from the implementation. In that case, Art. 52(2) EPC would be reduced to a

mere requirement as to form, easily circumvented. The board believed it was intended as substantive in nature, whatever considerations may have been the source of this exclusion at the time of its adoption. It followed that **the mere technical implementation** of excluded subject-matter per se could not form the basis for inventive step (see also **T 1793/07**). The board concluded that inventive step could be based only on the particular manner of implementation. To this end it was therefore necessary to ask how the per se excluded subject-matter (e.g. a game or business method) is implemented (**T 859/07, T 414/12**).

In the context of the problem-solution approach this can be rephrased as a fictional technical problem in which the per se excluded subject matter appears as an aim to be achieved, see **T 641/00** (Headnote II). Where such excluded subject matter is novel such a formulation of the problem seemingly implies that such matter may be regarded as a given in the assessment of inventive step, which thus appears to depart from what is in fact a hidden starting point. The board viewed this fiction as an artefact of the systematic use of the problem-solution approach for assessing inventive step and the need to differentiate between excluded and non-excluded matter. This should not detract from the basic tenet that excluded subject-matter cannot form the sole basis for a patentable invention. A consideration of the particular manner of implementation must focus on **any further technical advantages** or effects associated with the specific features of implementation over and above the effects and advantages inherent in the excluded subject-matter (**T 336/07**). The latter are at best to be regarded as incidental to that implementation.

The board went on to state that the explicit requirement of a **"further" technical effect** was first formulated for computer-related inventions in decisions **T 1173/97** (OJ 1999, 609) (see also **T 935/97**), but the same principle holds also for other categories of excluded subject-matter which may inherently possess some "technical" effect. In fact, inherent and arguably technical effects may be easily identified for practically all excluded subject-matter, for example such a simple one as reducing time when using or performing it. This is why it needs to be stressed that the **"further" technical effect** can not be the same one which is **inherent** in the excluded subject-matter itself (**T 2449/10, T 1225/10, T 1547/09, T 1782/09, T 2127/09, T 1331/12**). This consideration of the specific implementation must, moreover, be from the point of view of the relevant skilled person under Art. 56 EPC, who may be identified on the basis of the invention's technical character. This was analogous to the approach of **T 928/03** (point 3.2 of the Reasons), which considered the actual contribution of each feature to the technical character by, for each feature, stripping away its non-technical content. Thus, "the extent to which the characterizing features contribute to the technical character ... in relation to the effects achieved by those features" had to be determined (**T 1023/06, T 336/07 and T 859/07**). The approach in **T 1543/06** was based foremost on **T 641/00** (OJ 2003, 352) (**T 1331/12**).

In **T 1173/97** (OJ 1999, 609) the board held that a computer program product is not excluded from patentability under Art. 52(2) and (3) EPC 1973 if, when it is run on a computer, it produces a **further technical effect** which goes beyond the "normal" physical interactions between program (software) and computer (hardware)" (see point

9.4 of the Reasons). The board also held that, for the purpose of determining the extent of the exclusion under Art. 52(2) and (3) EPC 1973, the "further" technical effect could, in its opinion, be known in the prior art. Determining the technical contribution which an invention achieves with respect to the prior art is therefore more appropriate for the purpose of examining novelty and inventive step than for deciding on possible exclusion under Art. 52(2) and (3) EPC (see also **T 1461/12**).

In **T 1755/10** the board noted that in the light of Art. 52(1), (2) and (3) EPC, Art. 56 EPC 1973 requires a **non-obvious** technical contribution (see e.g. **T 641/00**, OJ 2003, 352; **T 1784/06**). However, non-technical aspects cannot meet that requirement. In the case at issue, as the overall goal of the claimed method (determining commissions) was not technical, the software concept could not derive any (further) technical character from that goal. In fact, the board judged that no "further" technical effect was present at all. The board made it clear that, in the absence of any other potential "further" technical effect, the mere use of a specific software solution did not amount to a technical implementation (which would have to be considered in the inventive step examination). It held that the frequent general argument that modified software causes a modified behaviour of the computer and should for that very reason (*eo ipso*) be considered as a technical implementation means was insufficient. Hence, a **"software implementation fallacy"** might be added to a pertinent gallery established recently by the board (see **T 1670/07**). The board also held that even a more specific program structure within the data model did not constitute a technical implementation by itself as the alleged technical effect was limited to the general observation that modified software results in a modified operation of the computer. This was just another way of saying that software interacts with hardware and thus was not sufficient to establish a "further" technical effect. Consequently, even the more specific programming structure did not enter into the examination for an inventive step.

In **T 928/03** the application related to an interactive video game in which a user controls at least one player character displayed on a screen. The board stated that in applying the Comvik approach **in a fair manner**, its purpose must be borne in mind: on the one hand, the approach is to make sure that non-technical aspects do not support a finding of inventiveness; on the other hand, actual contributions to the technical character by any feature of an invention must be taken into account when assessing inventive step. In this context, a game rule constraint has to be distinguished carefully from its technical implementation (**T 1461/12**).

In **T 1834/10** the board held that the combination of two types of non-inventions (presentation of information, computer program) is not enough to define a technical contribution (**T 1755/10**, "software implementation fallacy").

#### 9.1.4 The aim to be achieved in the formulation of the technical problem

For the purpose of the problem-and-solution approach developed as a test for whether an invention meets the requirement of inventive step, the problem must be a technical one (**T 641/00**). The definition of the technical problem is difficult if the actual novel and creative concept making up the core of the claimed invention resides in the realm outside

any technological field, as is frequently the case with computer-implemented inventions. Defining the problem without referring to this non-technical part of the invention, if at all possible, would generally result either in an unintelligible vestigial definition, or in a contrived statement that does not adequately reflect the real **technical contribution** provided to the prior art (**T 154/04**, OJ 2008, 46).

In **T 641/00** (OJ 2003, 352) the board considered the formulation of the technical problem. Although the technical problem to be solved should not be formulated to contain pointers to the solution or partially anticipate it, merely because some feature appeared in the claim did not mean it was automatically excluded from appearing in the formulation of the problem (see point 7 to the Reasons). In particular where the claim referred to an aim to be achieved in a non-technical field, this aim might legitimately appear in the formulation of the problem as part of the framework of the technical problem which was to be solved in order to avoid taking into account a non-technical contribution when assessing inventive step. The board referred to its decision **T 1053/98**, where it had considered it necessary to formulate the technical problem in such a way that "there was no possibility of an inventive step being involved by purely non-technical features". Such a formulation of the problem could refer to the non-technical aspect of the invention as a given framework within which the technical problem was posed. Thus, the board allowed an **aim to be achieved** in a non-technical field to appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that is to be met (see e.g. **T 2063/09**). Such a formulation had the additional, desirable effect that the non-technical aspects of the claimed invention, which generally relate to non-patentable desiderata, ideas, and concepts and belong to the phase preceding any invention, are automatically cut out of the assessment of inventive step and cannot be mistaken for technical features positively contributing to inventive step. Since only technical features and aspects of the claimed invention should be taken into account in assessing inventive step, i.e. the innovation must be on the technical side, not in a non-patentable field (see also decisions **T 531/03** and **T 619/02**), it was irrelevant whether such a non-technical aim was known before the priority date of the application, or not (see **T 154/04**). In the case at issue, the object of the invention as stated in the patent specification was to eliminate inconveniences caused by distributing costs for service and private calls or among different users. That object had to be reformulated to arrive at the technical problem of implementing the GSM system **in** such a way as to allow user-selectable discrimination between calls for different purposes or by different users (see also in this respect **T 509/07**).

The board noted that this approach, although not made explicit before the Comvik decision **T 641/00**, was in line with the case law of the boards of appeal as shown, for example, from the analysis of some earlier decisions in decision **T 764/02**. In **T 1769/10** the board stated that the case law, as summarised in **T 154/04**, had created a practicable system for delimiting the innovations for which a patent may be granted (**G 3/08**, OJ 2011, 10).

In **T 1284/04** the board held that the Comvik approach does not consider the non-technical constraints as belonging to the prior art, but rather as belonging to the conception or **motivation phase** normally preceding an invention, since they may lead



to a technical problem without contributing to its solution. Such aspects have never been taken into account in assessing inventive step, irrespective of whether or not they were known from the prior art (see e.g. **T 958/03** and **T 506/06**).

In **T 1952/12** the board stated that since an inventive step can only be acknowledged for an invention which makes a technical contribution to the art (see e.g., **T 1461/12**, point 15.1 of the Reasons), even a new business method alone will be insufficient to establish an inventive step. Therefore, as far as the assessment of the inventive merit of an invention is concerned, it is immaterial whether the business method features referred to in the objective technical problem as "the aim to be achieved in the non-technical field" (see **T 641/00**, OJ 2003, 352; headnote 2) are known or not (see also **T 154/04**, OJ 2008, 46, point 16 of the Reasons).

#### 9.1.5 Credible technical effects

The assessment of inventive step can only be based on those elements and aspects of the invention in respect of which a technical effect can be established. Whether an invention causes a technical effect is essentially a question of fact (**T 1461/12**).

In **T 1958/13** board was not satisfied that they could be regarded as objectively credible technical effects for the purpose of formulating the objective problem to be solved (with reference to **T 1567/05**, **T 1841/06** and **T 407/11**; see also **T 336/14**). While the EPO has a duty to determine such facts in examination proceedings, the onus is upon the applicant to cooperate in said determination, in particular in the event of doubt (**T 258/97**, point 7 of the Reasons; see also **T 27/97**, **T 953/04** and **T 1044/07**).

Claim 1 was directed to a terminal made up of a touch-screen display and a controller **configured for detecting gestures** on that device. The appellant argued that the so-called "single-drag gesture" according to claimed feature had the effect of making text editing more convenient or simpler for the user and thus better compared to the solution of D2. The board regarded such gesture definition - whether deemed to be technical or non-technical - as a preliminarily obtained precondition, i.e. a user-specific fact, to be taken into account in the user interface design as belonging to the conception or motivation phase normally preceding an invention (see e.g. **T 482/02**, **T 1284/04**). Although the board deemed those effects, in principle, to be technical effects, since in the end they **aim at providing tools** which serve or assist user activities (see e.g. **T 643/00**), the question whether they were actually achieved depended exclusively on **subjective user skills or preferences**. Therefore, the board was not satisfied that they could be regarded as objectively credible technical effects for the purpose of formulating the objective problem to be solved (see also **T 1567/05**, **T 1841/06** and **T 407/11**; see also **T 77/14** on gesture-based functions).

In **T 953/04** the board followed decision **T 258/97** and noted that it is incumbent on the appellant to cooperate in the determination of the relevant technical features of an invention in the event of doubt. If not, these features are to be ignored in assessing inventive step if the doubts regarding their technical character cannot be resolved (see also decision **T 27/97**). Against the background of continuing doubts regarding the

technical content of the invention and **lacking cooperation** of the appellant in clarifying the issue, the board considered itself barred from arriving at a positive judgment on inventive step so that the appeal could not be allowed.

In **T 823/07** the board, following decision **T 1143/06**, stated that the manner how cognitive content is presented to the user may only contribute to the technical solution of a technical problem if the manner of presentation (exceptionally) shows a **credible technical effect** (see also **T 1575/07**, **T 1741/08**, **T 1562/11**). Non-technical features and aspects of an invention should not be given any weight in assessing inventive step. If they belong to the general framework in which the invention evolves, they may be used in formulating the relevant technical problem (see decision **T 641/00**, OJ 2003, 352; see also **T 77/14**). In the present case, however, there was no proof of any such technical effect of the concept of presenting information, beyond the alleged advantages which concern the mental and cognitive activities of the user. The only credible technical effects result from the computer implementation of this concept. This circumstance distinguishes the case from the decisions cited by the appellant in support of its arguments (**T 643/00**, **T 928/03** and **T 333/95**). In all these decisions, the board concluded on the existence of a technical contribution over the prior art. The technical contribution resulted from overcoming physical limitations of the size and resolution of computer screens (**T 643/00**, **T 928/03**) and from the functions of a "new input device" conferring technical character (**T 333/95**). None of the decisions derives the technical character of a feature or activity from the mental effort required or any similar effect; these are only secondary considerations. Moreover, the board noted that in the context of inventive step, caution is required in applying old decisions concerning non-technical subject-matter like decision **T 333/95** since the relevant case law has experienced some important development as explained in decision **T 154/04**. In the case at issue, the only relevant technical aspects of the invention were standard programming features for implementing the idea of displaying search results in connection with supplier logos on a computer system. The programming and implementation of this idea was obvious in the light of the prior art. For these reasons, the invention did not meet the requirement of inventive step.

In **T 258/97** the invention related to an image communication apparatus. The board referred to **T 27/97**, where it was stated that an abstract algorithm was relevant to inventive step only if a technical effect could be established which was causally linked to the algorithm, such that the technical effect provided a contribution to the solution of a technical problem and thereby conferred a "technical character" on the algorithm. Therefore, the board ruled that an assessment of inventive step could only be based on those elements and aspects of the invention in respect of which a technical effect could be established. Whether an invention caused a technical effect was essentially a question of fact.

#### 9.1.6 Assessment of features relating to a presentation of information

When deciding if a feature relating to the presentation of information is technical or not, what has to be considered is whether or not it contributes to solving a technical problem. The fact that mental activities are involved does not on its own render the subject-matter

non-technical (**T 643/00**, **T 336/14**). However, a feature that solely addresses a user's **subjective preferences** does not solve a technical problem (**T 1567/05**).

For further information on the technical character of features relating to the presentation of information and display of data, see Chapter I.A.2.3 "Aesthetic creations" and I.A.2.6 "Presentation of information".

a) Mental activities based on data visualisation

The jurisprudence of the boards of appeal provides little support for the idea that screen representations inherently address technical problems (**T 1143/06**, **T 95/86**). A feature which relates to the manner in which cognitive content is conveyed to the user on a screen normally does not contribute to a technical solution to a technical problem. An exception would be if the manner of presentation can be shown to have a **credible technical effect** (**T 1143/06**, **T 1575/07**, **T 1741/08** and **T 1562/11**). Features aimed exclusively at **improvements regarding the way information is perceived or processed** by the human mind are regarded as non-technical (see e.g. **T 1567/05**, **T 125/04**, **T 579/11**). A **GUI layout** (Graphical User Interface) as such is considered to be non-technical, being a "presentation of information" (Art. 52(2)(d) EPC (**T 1741/08** citing **T 1143/06**) (see also **T 1214/09**).

Features concerning the graphic design of user interfaces do not have a technical effect, because their design is not based on technical considerations, but on general intellectual considerations as to which design is particularly appealing to a user (Guidelines G-II, 3.7.1, November 2015 version). For example, the colour (see **T 1567/05**, **T 726/07**, **T 1734/11**), shape (**T 677/09**), size (**T 823/07**, **T 1237/07**), layout (**T 756/06**, **T 1741/08**, **T 1214/09**), arrangement of items on the screen (**T 643/00**, **T 1237/10**) or the information content of a message displayed is usually not a technical aspect of a graphical user interface. An exception would be if these features contribute to achieving a particular technical effect (**T 1741/08**, **T 1143/06**).

In **T 244/00** the board stated that the graphic design of menus was, as a rule, not a technical aspect of a menu-driven control system. Nor was the practical use of such menus genuinely a problem with which the skilled person, in his function as a technical expert, was confronted. For the purpose of the problem and solution approach, the problem had to be a technical problem which the skilled person in the particular technical field might have been asked to solve at the priority date. The board therefore concluded that, in the case at issue, the technical problem had to be formulated in a more limited way than on the basis of the alleged advantages of moving a cursor diagonally over the TV screen (see **T 154/04**, OJ 2008, 46; **T 125/04**, **T 1143/06**).

In **T 1237/10** the board pointed out that the displayed arrangement of images as defined by claim 1, including its temporal changes (a calendar-type layout), constituted a presentation of information, which is excluded "as such" from patentability under Art. 52(2)(d) EPC. Such a presentation of information contributes to inventive step only to the extent to which it interacts with the technical subject-matter of the claim for solving a technical problem (see **T 154/04**, OJ 2008, 46, and **T 1214/09**). The claimed

presentation of images was aimed at showing the images to the user essentially for informational purposes and not, for example, at enabling a new mechanism for inputting an image selection.

The board considered that, in the context of the claimed invention, the idea of sequentially replacing the images shown in a display region by other images classified into the same time slot was not technical. Dealing with limited available space is part and parcel of the design of presentations of information for human viewing and is therefore per se not an indication of technicality (cf. decision **T 1562/11**). Although the issues of image size and resolution might play a role in the idea's implementation, the idea itself was independent of such issues. The objective technical problem solved by the claimed selection means was therefore that of implementing this idea. The board came to the conclusion that the skilled person would have trivially implemented it by providing suitable software "selection means" for sequentially replacing the images shown in each display region. The skilled person would hence have arrived at the subject-matter of claim 1 without the exercise of inventive activity. Thus the subject-matter of claim 1 lacked inventive step (Art. 52(1) and 56 EPC).

In **T 643/00**, the underlying GUI was configured, upon a user instruction, to simultaneously display hierarchically encoded image data in a side-by-side manner at a low resolution in order to make the search process easier for the user. Although human activities were involved in solving the problem, which activities might relate to the information contents of images looked for and might be motivated by personal interests and/or other non-technical preferences, the board considered that the claimed features relating to the format of images displayed were not presentations of information as such. The board noted that it was true that non-technical aspects may be found in the design and the use of an interface through which the user interacts with a system (see decision **T 244/00**). Indeed, presenting information through a user interface, if the only relevant effect of the presentation relates to the visually attractive nature of the graphic design or artwork, does not have technical character. However, in its decision the board had not excluded the possibility that an arrangement of menu items (or images) on a screen might be determined by technical considerations. Such considerations might be intended to enable the user to manage a technical task, such as **searching and retrieving images** stored in an image processing apparatus, in a more efficient or faster manner, even if an evaluation by the user on a mental level was involved. Although such evaluation per se did not fall within the meaning of "invention" pursuant to Art. 52 EPC 1973, the **mere fact that mental activities were involved** did not necessarily qualify subject-matter as non-technical, since any technical solutions in the end were intended to provide tools which served, assisted or replaced human activities of different kinds, including mental ones. The board referred to **T 1177/97** where it was stated that the use of a piece of information in a technical system, or its usability for this purpose, may confer a technical character on the information itself in that it reflects the properties of the technical system, for instance by being specifically formatted or processed. Additionally, the board referred to **T 1194/97** where it was stated that **functional data** (line numbers, coded picture lines, addresses and synchronisations) recorded on a record carrier to be used in a picture retrieval system were to be distinguished from the **cognitive content** encoded. Even if the overall information could be interpreted in an

infinite number of different ways in other technical or human contexts, this did not detract from its technical function in the relevant context of the claimed invention (see also **T 424/03**). Finally, the prior art lacked any clear hint of the claimed combination of image processing functions, so that the presence of inventive step as required by Art. 56 EPC had to be acknowledged.

In **T 336/14** claim 1 of the invention was concerned with a user interface for an extracorporeal blood treatment machine. The parties quoted a large number of decisions regarding the assessment of inventive step, in particular the matter of presentations of information as such with respect to graphical user interfaces. The board, after summarising those decisions, stated that in the assessment of inventive step of a claim which comprises technical and non-technical features ("mixed invention") and in which the non-technical features relate to cognitive content presented to the user of a graphical user interface (GUI), i.e. relate to "what" is presented rather than "how" something is presented, it has to be analysed whether the GUI together with the content presented credibly assists the user in performing a technical task (related to "why" that content is presented) by means of a continued and/or guided human-machine interaction process (see point 1.2.4 of the Reasons).

The board noted that it was immediately apparent that the information presented according to features of claim 1, i.e. the operating instructions and the corresponding pictographs, were **cognitive rather than functional data** in the sense of **T 1194/97**, since they directly address the user of the blood treatment machine and were consequently meaningful only to a human mind. Further, the distinguishing features were related to the content of the information, i.e. to "what" was presented, rather than to the manner in which the information was presented, i.e. to "how". Next, the question was whether the underlying user interface and the content presented credibly assisted the user in performing a technical task by means of a continued and guided human-machine interaction process. So, this question was basically related to "why" (i.e. "for what purpose") the content was presented. In other words, it had to be established whether the information presented constituted "technical information", which credibly enabled the user to properly operate the underlying technical system and thus had a technical effect, or rather "non-technical information", which was exclusively aimed at the mental activities of the system user as the final addressee.

The board noted that not everything that supports a technical task has itself a technical character (cf. **T 1741/08**). Rather, the information of relevant features was evidently not related at all to any internal system state concerning the proper functioning of the underlying machine in the sense of **T 115/85**, let alone to a desirable or valid state within the meaning of **T 362/90** or **T 887/92**. Thus, in accordance with **T 1143/06**, making reference to **T 619/98**, an action (possibly) performed by a user in response to a message concerning the technical functioning of an apparatus did not necessarily render technical the information conveyed (**T 1143/06**). The board came to the conclusion that the information provided according to the relevant features could not credibly support a **continued and guided human-machine interaction** process. Thus, it could not assist the user in performing the technical task. It only addressed the human mental process of an "average user", however the latter was supposed to be defined based on **personal**

**skills and preferences** (see e.g. **T 407/11**). This had to be considered a non-technical effect.

In **T 125/04** the board stated that, in general, the task of **designing diagrams** is non-technical. This is so even if the diagrams arguably convey information in way which a viewer may intuitively regard as particularly appealing, lucid or logical. In **T 125/04** the invention, like **T 643/00** above, also concerned an **arrangement of images** but was different in that only the information conveyed by the images, ie their "cognitive content" (see **T 1194/97**, OJ 2000, 525), was relevant. The new features had to do with how this content was represented. Unlike **T 643/00**, the invention provided no information about the computer system itself, such as the location where the data are stored. According to decision **T 641/00** (OJ 2003, 352), features of a claim making no contribution to the technical character of an invention cannot support the presence of an inventive step. Implementing the claimed steps by merely providing means for carrying out these steps is obvious. Accordingly, the board could not find that the steps performed by the features in claim 1 had any technical effects which went beyond those obtained by the normal use of a computer. It followed that the subject-matter of claim 1 lacked an inventive step.

In **T 49/04** the application related to a method and an apparatus for enhancing the presentation of a text in a natural language on a (computer) display. The board followed **T 643/00** rather than **T 125/04** and stated that technical aspects could not be ruled out in the design and use of a graphic interface. Furthermore, the presentation of natural language text on a display in a manner which improved readability, enabling users to perform their task more efficiently, related to how, i.e. by what physical **arrangement of the text**, cognitive content was conveyed to the reader and could thus be considered as contributing a technical solution to a technical problem. Therefore, the board concluded that the claimed features, viewed as a whole, did not relate to a non-invention listed in Art. 52(2) EPC 1973 as such.

In **T 1214/09** the appellant had argued that the **arrangement of thumbnail file** images defined by feature (i) contributed to improved evaluation of a large number of thumbnail file images by the user and thereby solved the problem of how to enable more efficient image retrieval. The appellant referred to decisions **T 49/04** and **T 1749/06**. In decision **T 49/04**, a particular way of dividing text segments based on linguistic considerations was considered to produce a technical effect in that it improved the readability of text on a display. The deciding board did not consider it relevant that the improvement in readability was essentially of a cognitive nature. In decision **T 1749/06**, providing an icon with a three-dimensional appearance by modifying its edge with alternate dark and light stripes was found to be a technical effect. The deciding board was of the view that the test "happens in the brain of the viewer", which had been invoked by the examining division, was not useful for deciding whether a feature contributed to the technical character of a claim. The board recognised that both of these decisions could be understood as challenging the notion that **improving a human's cognitive evaluation** of certain information by changing the manner in which the information is presented is non-technical. The board, however, noted that the alleged effect of feature (i), i.e. the improved evaluation of thumbnail file images by the user, was due solely to the claimed arrangement of thumbnail file images. In the board's judgment, this arrangement was not

based on considerations other than those proper to the field of designing presentations of information for human viewing and is hence not an expression of any technical principle. The board therefore considered the alleged effect not to be a technical effect. The board held that, since in the context of this invention any **improvement** in the efficiency of image retrieval can only be the result of the non-technical improvement in the user's evaluation of the displayed thumbnail file images, feature (i) did not contribute to a technical solution of the problem of enabling more efficient image retrieval (see **T 1143/06** and **T 1741/08**). The board therefore followed the approach taken in decision **T 1143/06** and found that feature (i) at most contributed to the technical character of the invention through the details of its implementation.

In **T 1235/07** the invention used a tree diagram to view and navigate through the dimensions and levels of data in a multidimensional database. The board took a wider view of "presentation of information" than just the actual information that is displayed, the so-called cognitive content, to include also structural aspects of how the information is displayed. This broader meaning was supported by almost the only reference to the presentation of information in the travaux préparatoires. In the board's view, such additional aspects can only contribute to inventive step if they have technical character. The board noted that there was jurisprudence in this field holding that similar presentations of information are not technical. In particular, **T 1143/06** concluded that representing, by the speed of an element moving on a display, the relevance of data in a database to sort statements had no technical effect. The case was similar in that the information was presented to the user in a way that made it easier to evaluate and the user could then respond by selecting and displaying data. The board noted that the information was known per se, but only differed in the visual form in which it was displayed; i.e. speed of a moving element instead of in tables. In the board's view, the case before it was even less convincing because the invention was merely a visual display of a known analysis technique using known means, whereas in **T 1143/06** the idea of varying the speed of the element was at least not known. The board found that the solution was the implementation of user choices using known techniques that would be matters of routine design. Accordingly, the claimed invention did not involve an inventive step.

In **T 1741/08** the application was concerned with a method of entering data into a data processing system. The question was whether a technical effect could be attributed to a particular layout of a Graphical User Interface (GUI). It was undisputed that according to the established case law of the boards of appeal, the subject-matter of a claim cannot be inventive if there is **no additional technical effect** over and above any technical effects present in the closest prior art. The appellant argued that the required technical effect was to be seen in the reduction of computer resources resulting from the layout of icons which made it easier, particularly for an inexperienced user, to identify the stage reached in a process of data input requiring a number of steps and sub-steps. The board made clear that "lowering the cognitive burden of the user" is not of itself a technical effect (**T 1143/06** followed, **T 49/04** not followed). It found that the reduction in use of resources would be caused by the way the brain of the user perceives and processes the visual information given by a particular way of presenting information. The appellant also argued that there was a chain of effects. But in terms of technical effects this was a

broken chain. The board did not accept that such a broken chain could be used as evidence of the required technical effect overall. Following **T 1143/06**, the board considered a **GUI layout as such to be non-technical**, being a "presentation of information" (Art. 52(2)(d) EPC). In the case at issue, the **arrangement of icons** displayed was intended to convey information, namely at which step in the input process the user found him- or herself. The board stated that the mere fact that a particular **choice of information to display or of how to display** it is particularly clear, lucid, or "lowers the cognitive burden" of the user was not sufficient to demonstrate that the choice has a technical effect (see also **T 306/10**). The case law of the boards of appeal was entirely consistent with this principle. The fact that not all GUI-related applications are considered to be inventive does not mean that there is a contradiction between the decisions. As to the one possible exception, **T 49/04**, a single case deviating from the general case law was not a sufficient reason for a referral to the Enlarged Board of Appeal (see **G 3/08**, OJ 2011, 10, point 10.12 of the Reasons). The cases **T 643/00**, **T 928/03** and **T 333/95** which had been cited by the appellant were different from the case under consideration in that there was something other than the **simple choice** of what information to display and with what layout to display it, so that in these exceptional cases the displayed information might play a part in the assessment of inventive step of the claimed invention. The board made it clear that not everything that supports a technical task itself has a technical character.

**T 333/95** concerned using a computer to produce animations. In order to produce a scene in which a particular object moves, the selected object takes the place of the cursor, so that the user can move it around with the mouse as desired, while the system records the movements of the mouse and translates them into a script of commands for moving the object in the later display of the animated scene. However, the board in that case clearly considered the feature of "making said graphics object the current cursor" as a technical feature per se. This "graphics object cursor" replaced the normal cursor (also technical) and its movements were recorded and translated into a kind of programming language. There was at least a technical effect in allowing the user to move the selected object around under control of the mouse. The decision did not say that every GUI design that makes user's inputting more efficient has a technical character (see **T 1741/08**).

In **T 1073/06**, the underlying GUI was configured, upon user input, to display objects of a **simulation model**, including graphical link representations to improve the ease of a user's comprehension of the model. The contribution of the claimed subject-matter to the prior art was related to the utilisation of association data stored in the memory to cause the link between the objects in the simulation model to be displayed with the associated graphical link representation. The deciding board held that "an improvement in the comprehension of a model is a purely mental effect, so that the problem solved was not seen as being technical. The claimed 'graphical link representations' related to the state of the simulation model, rather than to the state of the claimed simulation apparatus, and thus constituted presentations of information and are therefore also non-technical" (see **T 336/14**).



In **T 1834/10** the contribution provided by the application had non-technical and technical aspects: a web page is made more attractive to potential customers by presenting images in a lively manner, and the images to be presented are selected and displayed automatically so that the presentation can be changed rapidly. The board noted that a web page designer may consider various approaches of selective content presentation as promising with respect to attracting customers' attention. However innovative an attractive content selection may be, it related to a presentation of information which was a priori non-technical (Art. 52(2)(d) EPC), even if it **lowers a user's cognitive burden (T 1741/08)** or prompts the user to start some technical action (**broken technical chain, T 1741/08, T 1670/07**). The desire to present a selection of images, to limit the selection to a predetermined number of images and to present the selected images in some **preferred layout** is a non-technical aim. The meaning of the display data does not convey any technical character to the presentation. Effects resulting from an image presentation depend on the user's perception and/or constitute indirect technical effects and/or relate to administrative and economic aspects. The board noted that the only aspect that can enter into the examination for an inventive step is a technical implementation of the desired image presentation. However, program elements (tags, widgets) for transferring parameters from a markup language document to a page-generating program (e.g. browser) were well-known and were only used by the application in suit for their conventional purpose. The board had general doubts about whether a piece of software serving a non-technical purpose (presentation of information) can be considered as a technical implementation; such software rather constitutes a computer program as such (Art. 52(2)(c) EPC) as it fails to provide any further technical effect beyond the elementary interaction between software and hardware (**T 1173/97**, OJ 1999, 609). The combination of two types of non-inventions (presentation of information, computer program) is not enough to define a **technical contribution (T 1755/10, "software implementation fallacy")**.

In **T 677/09** the appellant argued that in the context of vehicle information systems and the user action of actuating the component, the information provided about differences between vehicles went beyond the mere provision of the information because it resulted in enhanced safety, which was technical. The board considered that such an effect would depend on the content of the information and the user's reaction to it. This effect was thus not the **direct effect of the feature** and could not be used to formulate the technical problem. The board noted that the appellant invoked non-technical aspects as a reason for not modifying the prior art and that in **T 1670/07**, this kind of argument was referred to as a **"non-technical prejudice fallacy"** (point 16 of the Reasons). The fact that this was not possible followed from the fact that the non-technical features relating to the information content could not contribute towards an inventive step at all. The question was not whether the skilled person would consider providing these features because that had already been decided in formulating the technical problem, but whether it would be obvious to implement the features in the claimed manner. The appellant pointed out that in data processing a signal generally has cognitive information content, but according to the jurisprudence nevertheless has technical character. However, the board considered that this technical character was due to the so called "functional data" implied by the signal, which inherently comprises technical features that interact with those of the system in which the signal is operating, such as synchronising data (see for

example **T 1194/97**, point 3.3 of the Reasons). In the case at issue, there were no such inherent technical features of the difference information so that in the board's view it did not have a functional part, but remained purely cognitive.

The appellant considered that such an approach would rule out patents for all types of advanced driver assistance systems. The board did not share this concern as it is easy to imagine systems with features that might have a **direct technical effect**, such as giving information about the status of the engine, or about an imminent collision, or how to park the vehicle. The board noted that the information did not specifically relate to any technical condition of the vehicle, but simply differences between "features of a component", the effect of which depended on the information and covered any number of non-technical possibilities, such as the **colour** or the **shape** of the component. Accordingly the board held that the claim in question did not involve an inventive step.

In **T 1567/05** the examining division argued that computing the largest stress value was obvious since this value would determine whether a building structural component was likely to fail or not, and the use of colours to represent ranges of values was well-known to the skilled person. In the board's view, however, there was no need to assess the degree of originality of these features since they have no technical effect. Art. 52(2) EPC includes "presentations of information" in the list of subject-matters that shall not be regarded as inventions. As was noted in decision **T 154/04** (point 8 of the Reasons), this list covers subject-matters whose common feature is a substantial lack of technical character. That this is true for presentations of information was observed in decision **T 119/88** (OJ 1990, 395), which states in point 4.2 of the Reasons that the classification of objects by colour represents a non-technical effect. Thus, the indication of "strength levels" in the form of predetermined display colours - which is a classification - has no technical effect and cannot contribute to an inventive step. Nor does the choice of information to be presented have a technical effect. Art. 52(2)(d) EPC does not distinguish between different kinds of information. Therefore the presentation (as such) of any information must be regarded as a "non-invention". It is thus irrelevant that the present invention is arranged to display the largest stress value for each building structural component (rather than some other stress value). Although relating to technical phenomena, the stress values are mere pieces of information aimed exclusively at the human mind. Further, the problem indicated in the description was not of a technical character because it depends on the skills and preferences of the particular group of users for whom the invention is intended. (see also e.g. **T 579/11**).

In **T 1734/11** the board stated that a reduction of user interaction does not necessarily convey technical character to the means for achieving the reduction (following **T 1741/08**). For example, a travel agent who acts as an intermediary between providers of travel services and a prospective traveller also has the effect of reducing the interaction between the end consumer and the providers of those services. The travel agent collects and processes information, and presents the results to the customer in a suitable form. This is, in the board's view, an administrative process which can be performed without technical means and without the need of technical skill. Inputting information to a machine and **reducing the burden of doing so**, while these may be technical tasks a priori (at least in the sense that they are not listed in Art. 52(2) EPC),

not everything that supports a technical task has itself a technical character. On the other hand, presenting (i.e. outputting) information was deemed to be non-technical a priori (Art. 52(2) (d) EPC). However, in contrast to the presentation of the state of a technical machine, which may have technical character (**T 115/85**, OJ 1990, 30), the board considered that the presentation of pricing information, for example by **colour coding**, no matter how skilful that might be, is a non-technical aspect even if it helps the user to conduct a price-sensitive travel query more efficiently.

In **T 726/07** the feature in question was the **use of a colour** to represent a state of the cache. The board stated that even assuming that this could be considered as representing "conditions prevailing in an apparatus" in the sense of **T 115/85** (OJ 1990, 30), the board considered that the **use of a colour** was a common and obvious implementation of a status indication.

b) Display of data and user preferences

In **T 756/06** the board noted that the indication of internal states of a technical system, in the form of visual feedback for human interaction with the system, has been acknowledged to be technical by the boards in the past (see e.g. **T 115/85** (OJ 1990, 30; **T 362/90**). This finding has been confirmed by more recent cases, in particular in **T 643/00**, where the design of a GUI (Graphical user interface) was seen in the context of the technical process of fast and efficient image retrieval in an image processing apparatus. On the other hand, in cases where the GUI design aimed exclusively at the mental activities of a viewer, in particular at preparing the relevant data for a non-technical decision making process by the user as the final addressee, no technical contribution has been acknowledged beyond its mere implementation. For example, in **T 125/04**, the vectorial presentation of information on the screen informing the customer about the properties of a product was aimed exclusively at the non-technical mental activity of selecting a desired product and making a purchasing decision. In the case before it, the board considered that the **layout** of the schedule was for the user's mental use, i.e. according to the **user's requirements and preferences**, rather than for a technical purpose in a technical process. Although the appellant mentioned the possibility of user input of the first time span, the board considered that this only resulted in a subjective **improvement** of the appearance of the schedule and was not a part of any technical process.

In **T 1841/06** the board stated that the aim and object of the invention was at best the result of balancing various **mental preferences of the user** but it was per se not a technical problem. Having the option of choosing between an original language and the preferred language might be felt as an inconvenience by one user but as an advantage by another. The invention brought about a mental simplification and subjective advantage for some users but it did not provide any objective advantage nor any technical advance in any field of technology. Such purely subjective preferences like any other non-technical aspects of an invention do not form a valid basis for a technical and inventive contribution over the prior art. Accordingly, the invention failed to meet the requirement of inventive step (see above **T 1958/13**).

In **T 478/06** the claimed invention was a method of providing access to geographic information in a computer system. The board noted that, generally, any aspects that are based on the subjective interests, personal preferences and (business/commercial) activities or circumstances of the user are non-technical in nature. Thus the board agreed that managing, i.e. using depending on wishes, personal and geographical information was non-technical. Also, the choice of where to provide a control button was a matter of user preference, and/or the commercial circumstances such as which program was available to be modified. The same goes for the second aspect of prompting the user, when the map information was displayed, to indicate if directions were required. In the board's view this was technically no different from the basic function of offering directions, differing at most by a presentation of information in the form of a question, and by the point in time that the directions were offered, which was a matter of user preference, neither being a technical consideration. Finally, **the information content** itself was, of course, also non-technical and could not play a role in assessing inventive step (see also **T 1528/12**). The board came to the conclusion that in the case before it, the choice of where to put the control button was a purely non-technical consideration, such as the user's preferences, or the commercial circumstances of which program was available to be modified. It had no technical effect on the final outcome of displaying the map information, even if it did imply a particular technical implementation.

In **T 115/85** (OJ 1990, 30) the board took the view that giving visual indications automatically about conditions prevailing in an apparatus or system was basically a technical problem.

In **T 1000/09** the application addressed a need for a vehicle monitoring and reporting system that combined real-time vehicle performance data with **specific user preferences** for different types of data that could be captured by the system, such that a user could implement a maintenance plan that fitted their specific business plan for their vehicles. Data associated with the operation of a vehicle was gathered, processed to determine a probability of vehicle failure, and presented to the user. The board held that the failure probability information defined in claim 1 was only determined for presentation to the user, who could then decide to take technical action. The cognitive content of the presentation was not a technical feature, and it did not become technical even if it prompted the user to start a technical action (broken technical chain, **T 1741/08**, **T 1670/07**). The board also stated that setting user preferences for categories and ranges of data to be displayed in a convenient manner aims at a presentation of information, the latter being a priori non-technical (Art. 52(2)(d) EPC), even if it lowers a user's cognitive burden (**T 1741/08**). The cognitive meaning of the display data did not convey any technical character to the presentation. Effects resulting from a user-defined data presentation depended on the user's perception and/or constituted **indirect technical effects** and/or related to organisational and economic aspects. Regarding the technical, inputting side of the man-machine interface, the desire to provide it with inputting means for controlling the data output was driven by the obvious needs of users. The board judged that the system as defined in claim 1 did not involve any inventive step.

In **T 862/10** the board referred to its case law (**T 1143/06** and **T 1741/08**) and held that choosing the location of the display object in function of the urgency of the message was non-technical. In other words, the choice of where to put an object on a computer display depending on a value assigned to that object (its "urgency") could not be considered to have a further technical effect. Furthermore, the board also held that continuously moving the display object could serve no other objective purpose than that of presenting information as such. It therefore produced no further technical effect (i.e. no technical effect apart from the normal physical changes which inherently take place in a computer display) and did not contribute to the presence of an inventive step (see also **T 1562/11**). In contrast, feature (3) in claim 1 of the auxiliary request solved the objective problem of making it easier for the user to quickly locate the position of the display object on the display screen. In this context both the problem and the means to solve it were considered technical. They did not depend on psychological or other subjective factors but on technical parameters that can be precisely defined.

#### 9.1.7 Assessment of features relating to meta methods for software production

Purely conceptual aspects of software design and development will normally not contribute to an inventive step according to the jurisprudence of the boards of appeal (**T 983/10**; see e.g. **T 49/99**, **T 1171/06** and **T 354/07**).

In **T 354/07** the application related to a process for producing software programs by means of a computer system. The board pointed out that software development and manufacture takes place in several stages from demand analysis through various design phases to production. All these stages essentially involve intellectual activity comparable to an engineer's design work, even if it is supported by programming tools and what is being designed is a technical system. While the design and programming of complex systems in particular require the active involvement of engineers and the application of technical knowledge, the eventual result to which each of these development phases is directly geared is not the technical solution of a technical problem but a requirements specification, a data, process and/or function model, or a program code. This assessment applies in particular to meta methods, which are concerned with the process of software production itself on an even more abstract level. For instance, they give the software developer instructions as to how the design process should be structured and organised or what modelling methods are to be used. These kinds of conceptual processes and meta methods for software production generally have no technical features relevant for patentability and thus cannot provide a basis for inventive step, unless, in an individual case, a direct causal connection can be proved with a technical effect which is relevant to the solution of a technical problem. No such technical effect could be ascertained in the case in question.

In **T 42/10** and **T 1281/10** claim 1 defined a method which, based on outcomes of games, calculated indications of the skills of the players by passing messages between nodes of a factor graph. The board had to determine to what extent the features of the claim had a technical character and could contribute to inventive step. The board referred to the decision of the Court of Appeal of England and Wales in *Re Gale's Application* [1991] RPC 305. The board's approach to assessing questions of what is

and what is not technical about a computer-implemented method was, in this case, to ask the same questions as Nicholls LJ in *Re Gale's Application*. The first was what does the method as a whole do, and does it produce an overall technical result? The second was; if there is no overall technical result, does the method at least have a technical effect within the computer? If both questions were answered in the negative, no technical problem had been solved and there could be no inventive step. The board's view regarding technicality could be summarised as follows; the overall aim of keeping players interested is not technical. The intermediary aim of assessing and comparing playing performance is not technical. The representation of performance by probability distributions, and the updating of them, are mathematical methods. The use of factor graphs with message-passing is a matter of mathematics or abstract computer science. The board concluded that the only technical feature defined in this claim was the (computer) processor. The subject matter of claim 1, therefore, did not involve an inventive step if it would have been obvious to the skilled person, who had the task of implementing the method, to use a computer processor.

In **T 1539/09** the invention related to a graphic programming language and environment that was designed to allow a user to write code without much training or expertise. The board took the view that reducing a programmer's intellectual effort was not a technical effect. This applied all the more since the effect was likewise sought for all programs developed, regardless of their purpose (see **T 741/11**). The board stated that the activity of programming - in the sense of writing code - is a mental act, at least to the extent that it is not used in an actual application or environment to produce a technical effect. Therefore the definition and provision of a programming language does not per se contribute to a technical solution, even if the selection of a programming language helps to reduce the programmer's intellectual effort (see also **T 2270/10**).

#### 9.1.8 Assessment of features relating to mathematical algorithms

Mathematical algorithms may contribute to the technical character of an invention only in so far as they serve a technical purpose (see e.g. **T 1784/06**, point 3.1.1 of the Reasons; **T 1358/09**, **T 306/10**, **T 566/11**, **T 2035/11** and **T 2249/13**). In **T 1784/06** the board stated that as the algorithm is a mathematical (inter alia Boolean) method and mathematical methods as such are deemed to be non-inventions (Art. 52(2) and (3) EPC), a technical character of the algorithm could be recognised only if it served a technical purpose (see e.g. **T 1227/05**, OJ 2007, 574).

In **T 1358/09** claim 1 defined a method for classifying text documents essentially in terms of an abstract mathematical algorithm. The board noted that a mathematical algorithm contributes to the technical character of a computer-implemented method only in so far as it serves a technical purpose (see **T 1784/06**). In the case in point, the algorithm served the general purpose of classifying text documents. The classification of text documents was certainly useful, as it could help to locate text documents with a relevant cognitive content, but in the board's view it did not qualify as a technical purpose. Whether two text documents in respect of their textual content belong to the same "class" of documents was not a technical issue. The board noted that the same position was taken in decision **T 1316/09**, which held that methods of text classification per se did

not produce a relevant technical effect or provide a technical solution to any technical problem. The board pointed out that not all efficiency aspects of an algorithm are by definition without relevance for the question of whether the algorithm provides a technical contribution. However, such technical considerations must go beyond merely finding a computer algorithm to carry out some procedure (see **G 3/08**, OJ 2011, 10).

In **T 2035/11** the application mainly related to navigation systems that could be tailored to a user's particular wishes. The focus of the application was on the route-planning functionality of a navigation system. The board held that the subject-matter of claim 1 lacked an inventive step within the meaning of Art. 52(1) and Art. 56 EPC. Optimisation algorithms are mathematical methods, excluded "as such" from patentability under Art. 52(2) and (3) EPC. It noted that **mathematical algorithms may contribute to the technical character** of an invention only in so far as they serve a **technical purpose** (see e.g. decision **T 1784/06**). The purpose of the algorithm was the mere display of an optimal path to the user for cognitive processing. The user could act on the information, but did not need to. As stated in decision **T 1670/07**, a technical effect may arise from either the provision of data about a technical process, regardless of the presence of the user or its subsequent use, or from the provision of data (including data that on its own is excluded, e.g. produced by means of an algorithm) that is applied directly in a technical process. In the case at issue, the data was produced by means of an algorithm and was not applied directly in a technical process, so that neither possibility applied. The board's reasoning did not rely on a particular suggestion in the prior art, but on the finding that the proposed algorithmic change had no technical motivation and that its implementation was, uncontestedly, trivial. In so far as it was the appellant's view that technicality was irrelevant for the assessment of inventive step, this view was contrary to the established case law. The board noted that the German Federal Supreme Court had come to a similar conclusion in respect of a navigation system offering the user the possibility to exclude road segments based on a user-selectable property such as the road segment being a toll road (see BGH, 18 December 2012, X ZR 3/12, GRUR 2013, 275 – Routenplanung).

Methods of text classification per se did not produce a relevant technical effect or provide a technical solution to any technical problem (**T 233/09**, **T 1316/09**, and **T 1358/09**).

## 9.2. Combination invention

### 9.2.1 Existence of a combination invention

In assessing the inventive step involved in an invention based on a combination of features, consideration must be given to whether or not the state of the art was such as to suggest to a skilled person precisely the combination of features claimed. The fact that an individual feature or a number of features were known does not conclusively show the obviousness of a combination (**T 37/85**, OJ 1988, 86; **T 656/93**, **T 666/93**, **T 1018/96**). The question is not whether the skilled person, with access to the entire prior art, **could** have made the combination according to the invention, but whether he actually **would** have done so in expectation of an improvement (see **T 2/83**, OJ 1984, 265; **T 713/93**, **T 223/94**, **T 406/98**). When assessing inventive step in a combination invention, the

decisive criterion is not whether individual elements of the combination were known and obvious from prior art, but whether the state of the art would lead a skilled person to this particular overall combination of (possibly already known) features. Were this not so, it would be impossible for a combination consisting exclusively of known individual features to involve an inventive step (**T 388/89**, **T 717/90**, **T 869/96**).

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

The existence of a combination invention requires that the relationship between the features or groups of features be one of **functional reciprocity** or that they show a combinative effect beyond the sum of their individual effects. In **T 1054/05** the board stated that two features interact **synergistically** if their functions are interrelated and lead to an additional effect that goes beyond the sum of the effects of each feature taken in isolation. It is not enough that the features solve the same technical problem or that their effects are of the same kind and add up to an increased but otherwise unchanged effect (see also **T 926/11**, in which it was found there was no synergistic effect between the feature groups). See also in this chapter I.D.9.2.2.

In **T 406/98** the board found that as a rule, particularly when large numbers of citations were involved, it was necessary to ask **why** the skilled person would consider documents in that specific combination, and whether, **not knowing the invention**, he had reason to do so. In this case, a complete solution to the problem required deliberate selection from a large number of citations.

In **T 55/93** the appellant's argument, according to which the alleged invention should have been regarded as a mere aggregation of solutions of two independent partial problems which were not interrelated, was not accepted by the board. In the case in point, not only could the primary problem underlying the contested patent neither be found nor be derived from the prior art documents, but also the claimed features complemented each other. The board stated that the features were functionally linked together, which was the actual characteristic of a combination invention. It was wrong to select, on the basis of a plurality of partial problems to be solved, the respective constructional means used in the apparatus combination, or the steps of the method worded in terms of functional features, which by working together provided a solution to the problem taken as a whole. The non-obviousness of a combination claim turned on the simultaneous application of all its features (**T 175/84**, OJ 1989, 71). A combination effect was also acknowledged in **T 120/88**, **T 731/94**, **T 434/95** and **T 897/95**.

### 9.2.2 Partial problems

In patent law terms, the existence of a combination of features, i.e. of a combination invention, is to be viewed differently from the mere existence of partial problems, i.e. of an aggregation of features. According to current case law, partial problems exist if the features or sets of features of a claim are a mere aggregation of these features or sets of features (juxtaposition or collocation) which are not **functionally interdependent**, i.e. do not mutually influence each other to achieve a technical success over and above the sum of their respective individual effects, in contrast to what is assumed in the case of a



combination of features. What has to be established is whether each set of features is separately obvious in the light of the prior art (**T 389/86**, OJ 1988, 87; **T 387/87**, **T 294/90**, **T 363/94**, **T 926/11**). It should also be borne in mind that solutions to partial problems in differing technical fields must be assessed on the basis of the knowledge and expertise of the person skilled in the art where the solution is found (**T 32/81**, OJ 1982, 225; **T 324/94**).

In **T 389/86** (OJ 1988, 87) the relationship between the two groups of features was not one of functional reciprocity. The board ruled that in such circumstances no combinative effect could be advanced in support of inventive step; rather the question was whether each group, taken singly, was obviously derivable from the prior art. For the subject-matter of the claim to be inventive, it sufficed if one of these groups was (**T 345/90**, **T 701/91**, **T 94/05**, **T 450/06**, **T 102/08**, **T 619/08**, **T 2097/10**).

In **T 1836/11**, the patent concerned a two stage turbocharger for an internal combustion engine. The respondent (proprietor) argued that the backsweep and dual feed worm features could not be considered separately since they synergistically contributed to the stated aim of increasing efficiency. The board did not see any synergy between the two features. That the features both served the same overall purpose did not establish, in the board's view, a functional reciprocity between the two.

In **T 130/89** (OJ 1991, 514) the technical problem intended to be solved by the claimed invention also consisted of two technically independent partial problems, each solved independently by one of the claimed subject-matter's features. The board held that the independence of the claimed subject-matter's features (each producing a different effect) meant that in assessing inventive step the two closest states of the art had to be considered to enable each of the two partial problems to be defined. It concluded that since each of the partial problems was solved by means which merely performed their known functions, each partial solution was obvious and the invention thus lacked inventiveness. In **T 597/93** the board again saw no inventive step in combining the claim's two features - both known per se - since they related to the solving of two entirely separate partial problems. It cited **T 687/94** which held that in such cases the solutions could be assessed separately against the prior art (see also **T 315/88**, **T 65/90**, **T 2110/08**).

In **T 711/96** the board found that characterising features (a) and (b) functioned completely independently of each other; there was no functional interplay (combination) between them. Although the setting for one value (e.g. spread) could indirectly affect that for the other (e.g. quantity), in that spread and quantity could both be adjusted upwards to maintain constant distribution, the two features were not directly related. In other words, the characterising features did not necessarily influence each other, although they could do. The board therefore assessed the inventive step of the two features separately, and concluded that both partial problems were obvious (see also **T 1585/07**).

In **T 410/91** the board of appeal stated that no inventive step was involved since, although all the measures in claim 1 contributed to an increase in the efficiency of the plant, that contribution was based on known, different individual effects which resulted in

these measures being executed in a manner expected by the skilled person. The subject-matter of claim 1 therefore involved the stringing-together of known measures which displayed their characteristic effects; no **synergistic** effect based on a combination of the individual measures was discernible in the sense of a mutual influence on their respective operation (see also **T 144/85**, **T 141/87**, **T 407/91**, **T 1277/01**).

In **T 204/06** the board recalled that the "could-would approach" involves asking whether the skilled person would have - as opposed to could have - taken a certain step towards the invention in expectation of some improvement or advantage (**T 2/83**, OJ 1984, 265). This approach should not be taken to mean that inventions involving known design choices are non-obvious if only the number of choices is sufficiently great. It does imply, however, that if the skilled person expects some advantage of each feature in a claim and obtains no more than this advantage, then the claimed feature combination is obvious. It follows that any combination of features having known advantages (and disadvantages) is obvious unless it provides an unexpected effect (see also **T 2044/09**).

### **9.3. Combination of teachings**

In **T 1014/07** the examining division considered the subject-matter of claim 1 as obvious for the reason that each of the claimed features had been disclosed in the prior art. However, the board stated that the mere existence of teachings in the prior art is not a conclusive reason for explaining that the skilled person would have combined these teachings in order to solve the problem that he or she is confronted with. For the determination of the obviousness or non-obviousness of claimed subject-matter, it is not decisive that teachings are known - it must be decided whether or not the skilled person would have combined the known teachings such as to arrive at the claimed subject-matter when attempting to solve the underlying technical problem. Thus, the combination of known teachings may result in non-obvious subject-matter, namely when the skilled person is not motivated, for example by promptings in the prior art, to make such a combination. Under these circumstances the presence of any special effect arising from the combination is not necessary to establish an inventive step.

### **9.4. Technical disclosure in a prior art document**

In line with the established case law of the boards of appeal, when investigating inventive step it should be borne in mind that the technical disclosure in a prior art document should be considered in its entirety, as it would be done by a person skilled in the art and that it is not justified arbitrarily to isolate parts of such document from their context in order to derive from them technical information which would be distinct from the integral teaching of the document (**T 56/87**, OJ 1990, 188; **T 768/90**, **T 223/94**, **T 115/96**, **T 717/96**, **T 414/98**). According to **T 95/90**, **different parts of text in a document** can be combined if there is nothing to stop the skilled person from doing so. Any ex post facto analysis of a document, i.e. any attempt to misinterpret the disclosure of the prior art so as to distort the proper technical teaching of the disclosure in order to arrive at the claimed subject-matter, should be avoided since this would conceal the real technical contribution of the invention (**T 1967/08**).

## 9.5. Features not contributing to the solution of the problem

According to the established case law of the boards of appeal, features which do not contribute to the solution of the problem set in the description are not to be considered in assessing the inventive step of a combination of features (**T 37/82**, OJ 1984, 71). According to this decision, in assessing the inventive step of a combination of features, consideration had to be given to a feature only if the applicant had provided evidence that it contributed, either independently or in conjunction with one or more of the other features, to the solution of the problem set in the description (see also **T 65/87**, **T 144/90**, **T 206/91**, **T 574/92**, **T 226/94**, **T 912/94**, **T 15/97**, **T 471/98**, **T 442/02**). Therefore, only those claimed features are to be considered which contribute causally to the solution of the problem (**T 285/91**). In **T 294/89** the board stated that the additional feature provided no surprising advantage and did not make any contribution to solving the problem indicated. Hence, the said additional feature was not relevant for assessing the inventive step of the combination of features claimed.

In **T 589/95** the terms of the solution of the technical problem extended into an area of use where it had been admitted that the relevant problem was known not to arise in practice. The board stated that, for such an area, the features of the solution did not contribute to the solution of the technical problem and could not be taken into account in the assessment of inventive step.

With reference to **T 119/82**, Board 3.3.05 held in **T 72/95**, **T 157/97**, **T 176/97** and **T 158/97** that similar considerations applied to technically non-functional modifications. An inventive step could not be claimed on the basis of a non-functional modification of a known device. If a known device was modified by adding a feature which had no technical function, this modification could not be inventive (see also in this chapter I.D.9.1 "Treatment of technical and non-technical features").

In **T 1009/12** the board took the view referring to **T 206/91** that an ineffective concentration of a compound was considered as an arbitrary feature not contributing to the solution of the underlying problem and therefore not further considered. Since there were no further distinguishing features it was not feasible to identify the technical problem to be solved. Since no technical problem solved by the subject-matter of process claim 1 could be identified, the board considered that claim lacked inventive step.

Even if there is no pointer or suggestion in the prior art towards the addition of a distinguishing feature, if said modification is not linked to a particular functionality, then it cannot per se constitute the basis for acknowledging an inventive step (**T 2044/09**).

## 9.6. Substitution of materials - analogous use

According to **T 21/81** (OJ 1983, 15), it had to be regarded as forming part of his normal activities for a skilled person to select, from the materials known to him as suitable for a certain purpose, the one which was the most appropriate. The skilled person should therefore be at liberty, within the constraints of standard technical progress, to use

alternative means known by him to have the same effect (**T 324/94**). In **T 410/92** the board also held that using higher-quality materials in the design of single-phase synchronous motors with a double-pole permanent-magnet rotor was obvious. The appellants had argued that the skilled person using the superior materials available to him would be confronted with baffling starting problems. The board however concluded that the skilled person's encountering known problems when using newly developed materials would not deter him from using them in order to achieve specific, desired improvements, particularly since the means of overcoming such problems could be derived from the prior art.

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

In this connection the board also established in **T 130/89** (OJ 1991, 514) that the use of a known material on the basis of its known properties and in a known manner to obtain a known effect in a new combination was not normally inventive ("similar use"). Exceptions to this principle might be allowed in special cases, e.g. where a selection brought unexpected advantages, a known prejudice was overcome or unforeseen difficulties were encountered, such as the need to alter another component (see also **T 1216/05**, **T 330/07**, **T 422/09**).

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

### **9.7. Combination of documents**

It would not be obvious to a skilled person to combine an isolated, very old document (i.e. 50 year old document), which had not given rise to a trend in the art and whose teaching ran counter to the present trend, with the document reflecting the closest state of the art (**T 261/87**, **T 366/89**, **T 404/90**).

In **T 745/92** the board pointed out that the disclosure of two prior documents - even if they were classified under the same IPC classification - could only be combined so as to result in a finding of lack of inventive step if such combination would have been obvious to a skilled person seeking to solve the problem underlying the claimed invention (**T 104/95**, **T 395/00**).

In **T 715/09** the respondent submitted that the skilled person versed in the art of glow plugs would not, as part of his common knowledge, be aware of plasma deposition technology. Support for this submission was that glow plugs and surface treatment techniques were in two completely different classes according to the international patent

classification scheme. The board disagreed and stated that IPC classification alone was no reason for determining whether or not two pieces of prior art could be combined. The mere fact that two documents had the same classification was no reason for saying the combination of the teachings was obvious (**T 745/92**). Likewise the mere fact that the technologies had been given different IPC classes did not necessarily mean that they could not be combined.

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 (see also **T 302/02**, **T 881/09**).

In **T 302/02** the board added that, if an invention consisted of a new combination of features taken from different technical areas, a discussion whether or not it was obvious would normally involve at least as many documents as technical areas combined in it. The board adopted the approach taken in **T 552/89**, according to which a technical problem might be formed of "individual problems". The number of individual problems obviously depended on the degree of detail of the claim under consideration and the cited decision did not suggest that beyond a certain number the presence of an inventive step might be taken for granted. On the contrary, it was said to be obvious to try to solve the individual problems as long as the corresponding solutions were "merely aggregated together" in the claim.

In **T 881/09** the board stated that since the teachings of both documents stood in heavy discrepancy to each other, in view of their incompatibilities a combination of these documents was not obvious (**T 552/89**) but rather artificial and could only be the result of an ex post facto analysis.

## 9.8. Chemical inventions

### 9.8.1 Problem and solution approach in chemical inventions

In a number of chemistry decisions the problem and solution approach - based on landmark decisions **T 1/80** (OJ 1981, 206), **T 24/81** (OJ 1983, 133) and **T 248/85** (OJ 1986, 261) - involves the following steps:

- a) establishing the closest prior art
- b) defining the problem in the light of that prior art

- c) identifying the solution
- d) demonstrating the success of the solution
- e) optionally reformulating the problem
- f) examining the obviousness of the solution in view of the state of the art

Demonstrating the success of the solution and reformulating the problem are particularly important steps (see **T 231/97**, **T 355/97**).

### 9.8.2 Structural similarity

To deny inventive step for novel chemical compounds because of their structural similarity to known chemical compounds amounted to an allegation that a skilled person would have reasonably expected the same or similar usefulness of both the known and the novel compounds as the means for solving the technical problem underlying the application in question. Such an expectation would be justified, if the skilled person knew, be it from common general knowledge or from some specific disclosure, that the existing structural differences of the chemical compounds concerned were so small that they would have no essential bearing on those properties, which were important for solving the said technical problem and could be disregarded (**T 852/91**, see also **T 358/04**).

In **T 643/96** the board held that the concept of bioisosterism did form part of the common general knowledge of those skilled in the art, but that it had to be applied with caution when deciding upon inventive step. In the field of drug design, any structural modification of a pharmacologically active compound was, in the absence of an established correlation between structural features and activity, expected a priori to disturb the pharmacological activity profile of the initial structure. This also held true for an alleged case of bioisosterism, which was one option of a structure-activity relationship, as long as it was not an established case of bioisosterism (see also **T 548/91**). In **T 643/96** it was held that, when deciding upon inventive step in relation to pharmacologically active compounds, what was essential was not whether a particular substructure of a chemical compound was replaced by another known isosteric one, but whether information was available on the impact of such a replacement on the pharmacological activity profile of the specific (group of) compound(s) concerned (see also **T 467/94**, **T 156/95**).

In **T 2402/10** the board stated that in the field of drug design any structural modification of a pharmacologically active compound is, in the absence of an established correlation between structural features and activity, a priori expected to disturb the pharmacological activity profile of the initial structure (see **T 643/96**, **T 548/91**).

In **T 930/94** the board held that knowledge of the fact that one specific member of a class of chemical compounds did not lead to the effect achieved by several other members of this class, did not, without additional indications, mean that such an effect could be attributed to all the compounds in this group. In such circumstances, the effect in point did not lead to a recognition of the existence of a technical concept that could be generalised (**T 641/97**, **T 209/98**, **T 853/03**).

In **T 989/93** the board stated that, in the absence of the appropriate common general knowledge, no conclusions are possible on the basis of the known properties of one group of chemical compounds (here: benzene derivatives) regarding the properties of a different group of chemical compounds (here: naphthalene derivatives).

### 9.8.3 Broad claims

Art. 56 EPC 1973 requires the claimed invention, i.e. the proposed technical solution for a given technical problem, not to be obvious to a skilled person from the state of the art. If the inventive step of a claimed invention is based on a given technical effect, the latter should, in principle, be achievable over the whole area claimed (**T 939/92**, OJ 1996, 309; **T 694/92**, OJ 1997, 408; **T 583/93**, OJ 1996, 496).

**T 939/92** (OJ 1996, 309) contained fundamental rulings on broad claims in the field of chemistry. The board held that in view of the state of the art the technical problem which the patent in suit addressed was the provision of further chemical compounds with herbicidal activity. It was necessary for all the claimed compounds to possess this activity. Moreover, the question as to whether or not such a technical effect was achieved by all the chemical compounds covered by such a claim, might properly arise under Art. 56 EPC 1973, if this technical effect turned out to be the sole reason for the alleged inventiveness of these compounds. The appellants' submission that the test results contained in the description showed that **some** of the claimed compounds were indeed herbicidally active could not be regarded as sufficient evidence to lead to the inference that substantially **all** the claimed compounds possessed this activity. In such a case the burden of proof rested with the appellants. The requirements of Art. 56 EPC 1973 had not therefore been met (**T 268/00**, **T 1188/00**, **T 320/01**, **T 1064/01**, **T 924/02**).

Following **T 939/92** (OJ 1996, 309), the board stated in **T 668/94** that the technical problem could only be taken into account in the assessment of inventive step if it could be accepted as having been successfully solved, i.e. if it were credible that substantially all the claimed compounds possessed the plant growth regulating activity. When only some and not substantially all claimed compounds exhibited a particular technical effect, the conclusion had to be that the invention as broadly defined in the independent claim was not a solution to the technical problem of achieving the given technical effect, with the consequence that the alleged technical effect of some of the claimed compounds was to be disregarded when determining the objective problem underlying the invention and thus when assessing inventive step.

In **T 942/98** the problem as per the application was the preparation of improved selective herbicides. The board referred to the above-mentioned case law and did not agree with the applicant that, in the present case, he merely had to show an improved effect at the direct interface between prior art and the application in order to demonstrate, without providing further details, that such an improvement applied without qualification for the entire breadth of the claim. The appellant's position, in the board's view, amounted to allowing the applicant to decide how broad a claim could be, whether or not an improvement in the effect of all the compounds claimed was actually credible.

#### 9.8.4 Intermediate products

In decision **T 22/82** (OJ 1982, 341) the board ruled that the preparation of new intermediates for a surprisingly advantageous complete process for the preparation of known and desired end products was inventive.

Again in **T 163/84** (OJ 1987, 301) intermediate chemical products were held to be patentable on the grounds that their further processing to the known end products involved an inventive step. The board however held that a new chemical intermediate did not become inventive merely because it was prepared in the course of an inventive multi-stage process and was further processed to a known end-product; there had to be other factors as well, such as that the process for preparing the new intermediate had enabled it to be prepared for the first time and had done so inventively and other methods of preparing it had appeared to be ruled out.

In **T 648/88** (OJ 1991, 292) the board disagreed with the view expressed in **T 163/84**, pursuing instead the line taken in **T 22/82**. An intermediate intended for the preparation of a known end-product was deemed to be inventive if its preparation took place in connection with inventive preparation or inventive further processing or in the course of an inventive complete process (confirmed in **T 1239/01**).

In **T 65/82** (OJ 1983, 327) it was explained that new intermediates which take part in (non-inventive) analogy processes for sequent products (i.e. end products or intermediates of various kinds), must - in order to qualify as intermediates - provide a structural contribution to the subsequent products. Even where this condition is met, such intermediates are not thereby unconditionally inventive, i.e. not without taking the state of the art into consideration. As state of the art in relation to intermediates there are two different areas to be taken into account. One is the "close-to-the-intermediate" state of the art. These are all compounds identified from their chemical composition as lying close to the intermediates. On the other hand the "close-to-the-product" state of the art must also be taken into account, i.e. those compounds identified from their chemical composition as lying close to the subsequent products.

In **T 18/88** (OJ 1992, 107) the applicants had argued that the insecticidal activity of the known end products was significantly superior to that of another known insecticide with a similar structure; this was sufficient to establish an inventive step for the intermediate products, even if the end products were not novel and/or inventive. The board, referring to **T 65/82** (OJ 1983, 327), rejected the applicants' argument on the following grounds: claimed intermediates must themselves be based on an inventive step to be patentable. Whether, under certain circumstances, new and inventive subsequent products might support an inventive step of intermediates was not the question here, because the subsequent products in this case were either not novel or not inventive. The superior effect of subsequent products which were neither novel nor inventive was not sufficient to render the intermediates inventive (**T 697/96**, **T 51/98**).



### 9.8.5 Predictable improvements resulting from amorphous forms as compared to crystalline forms

In **T 777/08** (OJ 2011, 633) the claims in question related to a particular polymorph (form IV) of crystalline atorvastatin hydrate. The board considered that the amorphous form of atorvastatin, as obtained according to the processes of documents (1) and (2) represented the closest state of the art. The appellant defined the problem to be solved in view of this prior art as lying in the provision of atorvastatin in a form having improved filterability and drying characteristics. Having regard to the experimental results reported in document (25), which demonstrated shorter filtration and drying times for form IV compared to the amorphous form, the board was satisfied that this problem had been solved. It also found that the skilled person in the field of pharmaceutical drug development would have been aware of the fact that instances of polymorphism were commonplace in molecules of interest to the pharmaceutical industry, and have known it to be advisable to screen for polymorphs early on in the drug development process. Moreover, he would be familiar with routine methods of screening. Consequently, in the absence of any technical prejudice and in the absence of any unexpected property, the mere provision of a crystalline form of a known pharmaceutically active compound could not be regarded as involving an inventive step.

### 9.8.6 Synergistic effects

In **T 1814/11** the problem to be solved was to provide an alternative synergistically active fungicidal composition based on prothioconazole. The board concluded that synergistic effects were not foreseeable, i.e. even if a combination of two specific compositions had a synergistic effect as in document 1, such synergy could not necessarily be expected if the structure of one of the two compositions were modified. **Synergy** was not in principle foreseeable and therefore could not be attributed to a specific mechanism of action and/or structure. The board dismissed the respondent's suggestion of **trial-and-error** experimentation as inappropriate in this case.

## 9.9. Equivalents

According to established board of appeal case law, equivalents which are not disclosed in a published document must not be considered in assessing novelty, as this properly belongs to the examination for inventive step (see **T 167/84**, OJ 1987, 369; **T 446/88**, **T 517/90**; see also Guidelines G-VI, 2 – November 2015 version). In **T 697/92**, the board dealt with the concept of "equivalent means", according to which two means were equivalent if, despite having different embodiments, they fulfilled the same function with regard to the same result. Both means performed the same function if they shared the same basic idea, i.e. if they applied the same principle in the same way. The result was the totality of the technical effects produced by the means. In order to be considered as equivalents, the means had to achieve the same kind and quality of result. A means was thus not equivalent if, because of its different embodiment, it led to a result of the same kind but of a different quality or degree of effectiveness. The result did not necessarily even have to be better; it was sufficient for it to be different, since it was not the result

itself which was patentable but the means by which it was achieved (see **T 818/93**, **T 929/02**).

### 9.10. Problem inventions

The discovery of an unrecognised problem may in certain circumstances give rise to patentable subject-matter in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious (see **T 2/83**, OJ 1984, 265; **T 225/84**). The posing of a new problem did not represent a contribution to the inventive merits of the solution if it could have been posed by the average person skilled in the art (**T 109/82**, OJ 1984, 473). It also had to be taken into consideration that it was the normal task of the skilled person to be constantly occupied with the elimination of deficiencies, the overcoming of drawbacks and the achievement of improvements of known devices and/or products (see **T 15/81**, OJ 1982, 2; **T 195/84**, OJ 1986, 121). In **T 532/88** the board confirmed the established principle that to address a problem simply by looking for ways of overcoming difficulties arising in the course of routine work did not constitute inventiveness. Following this case law, the boards held in **T 630/92**, **T 798/92**, **T 578/92**, **T 610/95**, **T 805/97** and **T 1417/05** that the posing of the problem could not confer any inventive merit on the claimed subject-matter. Inventive step was however acknowledged in **T 135/94**, **T 540/93** (pet doors) and **T 1236/03** on the ground (also) that the posing of the problem was not obvious.

The absence of a hint in the prior art that there might still be a desire for further improvement does not mean that an unrecognised problem has been discovered (**T 252/10**).

In **T 971/92** the board emphasised that the appreciation of conventional technical problems which formed the basis of the normal activities of the notional person skilled in the art, such as the removal of shortcomings, the optimisation of parameters or the saving of energy or time, could not involve an inventive step. The appreciation of a technical problem could thus only contribute to the inventive step in very exceptional circumstances. However, if an applicant nevertheless wished to rely on an assertion that the inventive activity resided in the recognition of a technical problem to which the solution was admittedly obvious, then the minimum requirement to be met was that this technical problem be clearly and unambiguously disclosed in the application as filed (**T 43/97**, **T 1417/05**).

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

In **T 764/12** the technical contribution of the patent in suit resided in identifying a problem which was hitherto not recognised in the prior art, namely the need for protection during storage at ambient environmental conditions of a chewing gum base comprising environmentally degradable polymers. The arguments of the opponent that the claimed invention lacked inventive step because coating was well known to reduce degradation over time were not relevant. Referring to **T 2/83** (OJ 1984, 265) the board acknowledged an inventive step because the perception of the problem had to be considered as being the main contribution to the inventive merits of the solution claimed.

### 9.11. New use of a known measure

When determining inventive step in the case of a new use of a known measure, the boards of appeal examine whether or not the problem which has been solved with a known measure in a known case differs from the problem posed in the case to be decided. If this examination reveals that there is no fundamental difference between the two problems, it can in principle be concluded that there is no inventive step if the known measure is adopted (see in particular **T 39/82**, OJ 1982, 419; **T 142/84**, OJ 1987, 112; **T 332/90**, **T 485/91**, **T 25/97**). In **T 39/82** (OJ 1982, 419) the board stated that it could not be considered obvious for the skilled person to use a known measure in a different context since the problems differed fundamentally from one another.

Referring to **T 39/82** (OJ 1982, 419) the board confirmed in **T 818/93** that in a **combination invention** all the features might be known per se - the invention resided in the way the features were interrelated, both structurally and functionally. In assessing the inventive step of the combination in question it was therefore of no consequence that a suitable structure was already known, provided its use and application in the conditions, and circumstances disclosed in the patent were not suggested by the cited prior art.

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

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

In **T 590/90** the respondents argued that both the measures taken that distinguished the technical teaching of the contested patent from that of document 1 were already part of the prior art, and their application to the process described in document 1 was obvious.

However, the board held that the application of a measure known as such, contrary to warnings given in several documents, was not obvious. Since this measure involved an inventive step, the overall process of claim 1 encompassing that measure likewise involved an inventive step: the modification of a known process by two measures, at least one of which was not obvious, rendered the entire process inventive.

### 9.12. Obvious new use

In **T 112/92** (OJ 1994, 192) document (1), as the closest prior art, referred to the use of glucomannan as a thickener for an ungelled processed food product, but did not mention its function as a stabiliser. The board applied the principles set out in **T 59/87** (OJ 1991, 561) to the present case and stated that even if glucomannan did act as an emulsion stabiliser in preparing the product in accordance with document (1), this use would have been a hidden use. It came to the conclusion that the use of a substance as a stabiliser for emulsions, if not inextricably linked with its use as a thickening agent, was at least very closely related. The board held that it would have been obvious for the skilled person, knowing that glucomannan was effective as a thickening agent for emulsions, at least to try to find out if it was also effective as a stabiliser. Although **T 59/87** had found that a claim to an inherent but hidden later use of a known substance could be novel, the subject-matter of such a claim would still lack inventive step if the prior art indicated a well-established link between the earlier and later uses (see also **T 544/94**).

### 9.13. Need to improve properties

In its Headnote to **T 57/84** (OJ 1987, 53) the board stated that if a product is required to manifest a particular property (in this case a highly fungicidal effect) under various conditions, the superiority of the invention will depend on whether or not that property is improved under all conditions liable to be encountered in practice and particularly under the various conditions evolved in order to test it (in this case exposure to water and wind). If comparative tests are cited in support of that superiority, it is their combined results that have to be considered. The decisive factor is whether the invention outperforms the substance used for comparison in the tests as a whole (in this case, results in the need to use a significantly lower concentration of the pollutant substance), even if the substance used for comparison proves better in one of the tests.

Following **T 57/84**, it was stated in **T 254/86** (OJ 1989, 115) that an invention which relied on a substantial and surprising improvement of a particular property did not also need to show advantages over the prior art with regard to other properties relevant to its use, provided the latter were maintained at a reasonable level so that the improvement was not completely offset by disadvantages in other respects to an unacceptable degree or in a manner which contradicted the disclosure of the invention fundamentally (see also **T 155/85**, OJ 1988, 87). It was thus not necessary for there to be an improvement in every respect (**T 302/87**, **T 470/90**).

In **T 155/85** (OJ 1988, 87) it was further pointed out that subject-matter falling structurally between two particular embodiments of cited disclosure and displaying, in all relevant

respects, effects substantially between those known for the same embodiments, lacked inventive step in the absence of other considerations.

#### 9.14. Disclaimer

In **G 1/03** and **G 2/03** (OJ 2004, 413 and 448), the Enlarged Board of Appeal dealt with the allowability of "undisclosed disclaimers", i.e. "negative features" which have no basis in the application as filed. The Enlarged Board held that a disclaimer which was or became relevant for the assessment of inventive step or sufficiency of disclosure added subject-matter contrary to Art. 123(2) EPC 1973 (**T 1028/02**).

For further information on disclaimers, see in particular Chapters II.A.4. "Claims" und II.E.1.4 Amendments".

#### 9.15. Optimisation of parameters

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

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

In a number of other decisions, all of which referred to **T 36/82** (OJ 1983, 269) the subject-matter was found not to involve an inventive step, particularly when the problem addressed was to find a suitable compromise between different parameters (**T 38/87**, **T 54/87**, **T 655/93** and **T 118/94**). In **T 410/87** the board stated that it was part of the activities deemed normal for the skilled person to optimise a physical dimension in such a way as to reach an acceptable compromise, serving the intended purpose, between two effects which were contingent in opposing ways on this dimension (see also **T 409/90**, OJ 1993, 40; **T 660/91**, **T 218/96**, **T 395/96**, **T 660/00**).

In **T 73/85** the board stated that the very fact that the problem of improving the property in question was solved not - as was normal - by means of a specific change in structural parameters, but by amending process parameters, had in fact to be considered

surprising. In this case it did not matter that the individual reaction conditions claimed in the disputed patent were known per se; more important was whether the skilled person, in expectation of the sought-after optimisation had suggested, or - in the absence of possible predictions - had tried as a matter of priority, the combination of measures known per se claimed.

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

### **9.16. Small improvement in commercially used process**

In **T 38/84** (OJ 1984, 368) the board of appeal pointed out that the achievement of a numerically small improvement in a process commercially used on a large scale (here enhanced yield of 0.5%) represented a worthwhile technical problem which should not be disregarded in assessing the inventive step of its solution as claimed (see also **T 466/88** and **T 332/90**). In **T 155/85** (OJ 1988, 87) the board added that it was correct to say that even small improvements in yield or other industrial characteristics could mean a very relevant improvement in large-scale production, but the improvement had to be significant and therefore above margins of error and normal fluctuations in the field in consequence of other parameters. In **T 286/93** the invention related to a process for manufacturing wrapping paper and board. The results for the process had shown that the machine speed and the mechanical quality of the paper obtained had improved by some 3 % vis-à-vis a process in which the order in which aluminium polychloride and cationic starch were added had been reversed. Since a process of this kind was obviously intended for the production of paper on an industrial scale, even a small improvement had to be regarded as significant.

### **9.17. Analogy process - envisageable product**

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

According to **T 2/83** (OJ 1984, 265), so-called analogy processes in chemistry are only claimable if the problem, i.e. the need to produce certain patentable products as their effect, is not yet within the state of the art.

In **T 1131/05** the board deemed a process claim directed to an analogy process to be new and inventive.

**T 595/90** (OJ 1994, 695) was concerned with the inventiveness of a product which could be envisaged as such but for which no known method of manufacture existed. Accordingly, a product which could be envisaged as such with all characteristics determining its identity including its properties in use, i.e. an otherwise obvious entity, might nevertheless become non-obvious and claimable as such, if there was no known way or applicable (analogous) method in the art for making it and the claimed methods for its preparation were therefore the first to achieve this and do so in an inventive manner (**T 268/98**, **T 441/02**).

In **T 803/01** the board concluded that by analogy with **T 595/90**, the decisive question in the case in point was whether the polylactide in the claimed degree of purity was achievable at the priority date of the application in suit or whether there was an obvious way leading to it. But as this was not the case, the board concluded that the claimed subject-matter involved an inventive step.

In **T 233/93** the combination of properties defining the claimed products had been a desideratum which the skilled community had striven to achieve. These properties, however had been considered to be irreconcilable. The board stated that such a desired product, which may appear obvious per se, may be considered non-obvious and be claimable as such, if there is no known method in the art to make it and the claimed methods for its preparation are the first to produce it and do so in an inventive manner (**T 1195/00**).

In **T 661/09** the board concluded that the features actually claimed merely expressed obvious **desiderata** at an abstract level.

## **9.18. Examples of lack of inventive step**

### 9.18.1 Foreseeable disadvantageous or technically non-functional modifications

In some decisions the subject-matter was found not to involve an inventive step, when the invention was the result of a foreseeable disadvantageous modification of the closest prior art (**T 119/82**, OJ 1984, 217; **T 155/85**, OJ 1988, 87; **T 939/92**, OJ 1996, 309; **T 72/95**).

The board in **T 119/82** (OJ 1984, 217) had already found that disadvantageous modifications did not involve an inventive step if the skilled person could clearly predict these disadvantages, if his assessment was correct and if these predictable disadvantages were not compensated by any unexpected technical advantage. More recently, the board in **T 2197/09** confirmed that inventive step cannot be acknowledged on the basis of a purely disadvantageous modification of the closest prior art.

### 9.18.2 Reversal of procedural steps

The mere reversal of procedural steps in the production of component parts could not provide justification for inventive step (**T 1/81**, OJ 1981, 439).

### 9.18.3 Purposive selection

If, for a particular application of a known process, the skilled person could obviously use a material generally available on the market and suitable for the purpose, and was also highly likely to use it for reasons irrespective of its characteristics, such use should not be considered as inventive on account of those characteristics alone. It stood to reason that if carrying out such a step was itself already obvious for other reasons, the natural choice of the particular means on the market-place was devoid of mental or practical effort, or of "purposive selection", in the absence of anything to the contrary (**T 513/90**, OJ 1994, 154; see also **T 659/00**).

No inventive step is entailed in accepting a lower yield likely when using a more readily available raw material (e.g. where industrial hemp is substituted for marijuana (cannabis), the latter being more readily available for legal reasons) (**T 636/09**).

### 9.18.4 Automation

In **T 775/90** the board ruled that mere automation of functions previously performed by human operators was in line with the general trend in technology and thus could not be considered inventive (**T 1175/02**, **T 438/06**).

The mere idea of executing process steps automatically, e.g. replacing manual operation by automatic operation, was a normal aim of the skilled person (**T 234/96**).

In developing an automated process from a known manual process, apart from simply automating the individual steps of the manual process, the skilled person will also incorporate the facilities that automation typically offers for the monitoring, control and regulation of the individual process steps, provided they fall within the definition of technical skill (**T 850/06**).

### 9.18.5 Enhanced effect

According to the case law of the boards of appeal enhanced effects could not be adduced as evidence of inventive step if they emerged from obvious tests (**T 296/87**, OJ 1990, 195; **T 432/98**, **T 926/00**, **T 393/01**).

In **T 308/99** the claimed use was based on a thoroughly obvious property of known substances. The slightly enhanced effects associated with the claimed use in comparison with substances used in prior art emerged from obvious tests.



Work involving mere routine experiments, such as merely conventional **trial-and-error** experimentation without employing skills beyond common general knowledge, lacked inventive step (**T 455/91**, OJ 1995, 684; **T 104/92**).

In **T 253/92** the subject-matter of claim 1 related to a process for the manufacture of a permanent-magnet alloy. In the board's view, a skilled person would have regarded it as obvious to try out a variety of alloys known from the prior art to be of similar composition to those of the better examples and to measure their magnetic properties.

In **T 423/09** the board stated that the enhanced effect did not emerge from routine tests but from the practice to be followed according to the rules and recommendations of the handbook. The skilled person following the recommended practice prescribed in this handbook, and thus acting only routinely would inevitably obtain this enhanced effect, which therefore could not be taken as an indication of inventive step.

#### 9.18.6 Simplification of complicated technology

In **T 61/88** the board indicated that, in the face of an optimal but sophisticated solution to a technical problem, the skilled person could not be denied the capacity to recognise that less complicated alternatives generally achieved less perfect results and consequently to envisage such alternatives, at least in situations in which the advantages of decreased complexity could reasonably be expected to outweigh the resulting loss of performance (**T 817/94**).

In **T 505/96** the board concluded that the simplification of complicated technology in situations in which the advantages of decreased complexity could reasonably be expected to outweigh the resulting loss of performance must be considered to be part of the normal work of the person skilled in the art.

#### 9.18.7 Choice of one of several obvious solutions

A merely arbitrary choice from a host of possible solutions cannot be considered inventive (**T 939/92**, OJ 1996, 309; **T 739/08**). In **T 400/98** the board stated that applying one of the possible solutions which were available to the skilled person requires no particular skills and hence does not involve an inventive step (**T 107/02**).

In **T 588/99** the board stated that in the particular situation where a document explicitly defines any compound having a certain activity as a suitable component of a detergent composition, and urges the skilled person to look for such compounds in publications of other technical fields such as biochemistry and medicine, it requires no inventive activity to solve the technical problem of providing an alternative to the compositions disclosed in such prior art by replacing the explicitly specified compounds having the given activity with any other such compounds which may be found by exploring the other technical fields.

In **T 190/03** of 29 March 2006 the board stated that in connection with the obviousness of a solution chosen from various possibilities, it is sufficient that the one chosen is

obvious and not necessarily relevant that there are several other possible solutions. The board referred to **T 939/92** (OJ 1996, 309) where it was stated that (albeit in the field of chemistry) an arbitrary selection of a solution from a number of possibilities in the absence of a hint to do so is not inventive if not justified by a hitherto unknown technical effect that distinguishes the claimed solution from the other solutions. In the case before it, the board could not see any unknown or surprising effects, but only immediately predictable ones. The board in **T 1941/12** stated inter alia: the two specific strains chosen in claims 1 and 6 represented an arbitrary selection of strains already known from the prior art to provide the desired effect of strengthening natural immune defences. Such **an arbitrary selection, by the very fact of it being arbitrary**, did not involve any inventive step. This was even more so since the two specific strains chosen were known from the prior art as commercially available.

In **T 892/08** the board referred to the established case law whereby, when the technical problem is simply that of providing a further composition of matter or a further method, i.e. an alternative to the prior art, any feature or combination of features already conventional for that sort of composition of matter or method represented an equally suggested or obvious solution to the posed problem. The boards have repeatedly established that the simple act of arbitrarily selecting one among equally obvious alternative variations is devoid of any inventive character (see also **T 311/95**).

#### 9.18.8 Several obvious steps

If the technical problem that the skilled person has set himself to solve brings him to the solution step by step, with each individual step being obvious to him in terms of what he has achieved so far and what remains for him to do, the solution is obvious to the skilled person on the basis of the prior art, even if two or more such steps are required, and it does not involve an inventive step (**T 623/97**, **T 911/98**, **T 558/00**, **T 1514/05**).

#### 9.18.9 Selection from obvious alternatives

In **T 1072/07** the application related to an oxygen-fired front end for a glass forming operation. The prior art documents proposed two possibilities for solving the problem of choosing the fuel for the burners and thus two types of burners, an air-gas fired burner or an oxygen-gas fired burner. The board concluded that to solve the problem, (how to select a suitable type of burner), the person skilled in the art had to make a choice between two well-known possibilities. Either choice, which in a particular situation would be based on balancing the advantages of the specific type of burner being selected, such as efficiency in its operation, with its disadvantages, such as technical adaptations required and costs involved, was obvious, since the types of burner to be chosen from were well-known.

#### 9.18.10 Putting the closest prior art device into practice

In **T 405/13** the invention was a meter with rapid response glucose sensor. The question was whether or not the skilled person, while putting the meter of D10 (biosensing meter) into practice, would arrive at a **value falling within the claimed range** (for a similar

approach see **T 408/12**, point 7.3 of the Reasons and **T 315/97**, point 3.3.1 of the Reasons). In the board's view, no inventive step could be seen in including in the reasonably broad time range as required by the timing circuit of the meter of D10 the claimed value of **5 seconds** after the detection of sample application, the less so since reducing measurement time had to be considered as an obvious desire of the user.

#### 9.18.11 Animal testing and human clinical trials

In **T 1493/09** the board found that the skilled person seeking to solve the problem formulated (provision of a broadly effective vaccine against HPV, especially providing broad protection against cervical cancer) would have considered not only formulations for immediate use in human clinical trials but also additional animal testing. It took the view that its assessment according to the problem and solution approach applied for the same reasons to claim 1 of auxiliary request 1 (directed to the second medical use of the vaccine composition and including the therapeutic effect "prevention or treatment of a disorder related to HPV infection" as an explicit feature), and concluded accordingly that it too lacked inventive step.

### 10. Secondary indicia in the assessment of inventive step

#### 10.1. General issues

According to established case law of the boards of appeal, a mere investigation for indications of the presence of inventive step is no substitute for the technically skilled assessment of the invention vis-à-vis the state of the art pursuant to Art. 56 EPC. Where such indications are present, the overall picture of the state of the art and consideration of all significant factors may show that inventive step is involved but this need not necessarily always be the case (see **T 24/81**, OJ 1983, 133 and **T 55/86**). Secondary indicia of this kind are only of importance in cases of doubt, i.e. when objective evaluation of the prior art teachings has yet to provide a clear picture (**T 645/94**, **T 284/96**, **T 71/98**, **T 323/99**, **T 877/99**). Indicia are merely **auxiliary considerations** in the assessment of inventive step (**T 1072/92**, **T 351/93**).

In **T 754/89** - "EPILADY" the board detailed its reasons for ruling that an inventive step was involved. Although factors such as commercial success, the overcoming of prejudice, the age of the documents cited, the cost of advertising and the creation of a new market segment, the satisfaction of a long-standing need, the existence of imitations and forms of infringement had received considerable attention, particularly in the parties' written submissions, the technical facts of the case were such that secondary indications of inventive step had lost any relevance.

In **T 915/00** the board held that commercial implementation, licensing and the recognition of the inventor's merits by the scientific community constituted further convincing secondary indicia for the presence of inventive step.

## 10.2. Technical prejudice

According to the case law of the boards of appeal (see **T 119/82**, OJ 1984, 217; **T 48/86**), inventiveness can sometimes be established by demonstrating that a known prejudice, i.e. a widely held but incorrect opinion of a technical fact, needs to be overcome. In such cases, the burden is on the patentee (or patent applicant) to demonstrate, for example by reference to suitable technical literature, that the alleged prejudice really existed (**T 60/82**, **T 631/89**, **T 695/90**, **T 1212/01**). A high standard of proof to demonstrate prejudice is required (**T 1989/08**).

A prejudice in any particular field relates to an opinion or preconceived idea widely or universally held by experts in that field. The existence of such prejudice is normally demonstrated by reference to the literature or to encyclopaedias published before the priority date. The prejudice must have existed at the priority date, any prejudice which might have developed later is of no concern in the assessment of inventive step (**T 341/94**, **T 531/95**, **T 452/96**, **T 25/09**).

Generally speaking, prejudice **cannot** be demonstrated by a statement in a single patent specification, since the technical information in a patent specification or a scientific article might be based on special premises or on the personal view of the author. However, this principle does not apply to explanations in a standard work or textbook representing common expert knowledge in the field concerned (**T 19/81**, OJ 1982, 51; **T 104/83**, **T 321/87**, **T 392/88**, **T 601/88**, **T 519/89**, **T 453/92**, **T 900/95**, **T 1212/01**). In **T 515/91** the board regarded "ABC Naturwissenschaft und Technik" as a standard work (see also **T 461/92**, **T 152/93**). In **T 943/92** the existence of a prejudice was supported by a specialist book which reflected the technical knowledge in the special field of the contested patent. This book did not contain the opinion of just one specialist author, but that of experts in the field, as it had resulted from the collaboration of "numerous recognised scientists, technicians and practitioners as well as associations and institutes". General critical remarks in one textbook were not sufficient to substantiate an alleged prejudice, if a plurality of prior art documents pointed to the opposite (**T 134/93**).

Generally speaking, established board of appeal case law is **very strict** when it comes to recognising the existence of a prejudice. A solution put forward as overcoming a prejudice must clash with the prevailing teaching of experts in the field, i.e. their unanimous experience and notions, rather than merely cite its rejection by individual specialists or firms (**T 62/82**, **T 410/87**, **T 500/88**, **T 74/90**, **T 943/92**, **T 531/95**, **T 793/97**, **T 2453/09**). A declaration by a technical expert in the field was not interpreted as evidence that there was a prejudice in the prior art at the priority date; rather, this declaration was taken as the opinion of one expert, issued almost ten years after the priority date (**T 2044/09**). The fact that a disadvantage is accepted or the prejudice simply ignored does not mean that a prejudice has been overcome (**T 69/83**, OJ 1984, 357; **T 262/87**, **T 862/91**).

The board in **T 1989/08** observed that this meant the standard of proof was almost as high as that required for common general knowledge in the art. For example, it is not enough that the opinion or idea is held by a limited number of individuals or that it is a

prevalent view within a given firm, however large. In the case at issue all the evidence offered in support of the alleged prejudice amounted to no more than ten documents, all of which were either specialist papers or patents. This small number of publications intended for a select readership in the field was in itself a tenuous basis for asserting prejudice (see also **T 25/09**).

In **T 1212/01** the patent related to pyrazolopyrimidinones for the treatment of impotence (Viagra). The patentee referred to some thirty scientific articles in order to demonstrate the existence of a technical prejudice that drugs lowering blood pressure were a cause of impotence rather than a form of treatment for that condition. The board, however, stated that the contents of such a selection from the prior art could not be considered per se as creating a technical prejudice against oral treatment of male erectile dysfunction. Such a prejudice could only be established by proving that, in relation to the technical solution, a relatively widespread error or misapprehension about the technical invention existed among skilled workers in the relevant field before the priority date of the patent in suit. This was not the situation in the present case.

In **T 550/97** the respondent (patent proprietor) had argued that, years after the invention, technically less advanced solutions had been filed for and marketed as a means of integrating different mobile radio networks. However, the board did not consider the fact that arguably less advanced solutions had been developed later, to be evidence of inventive step, as there was no reason to assume that later development was attributable to a technical prejudice which the present invention had needed to overcome.

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

One form of secondary indicia in the nature of a "technical prejudice" is a **development of the art in a different direction** (**T 24/81**, OJ 1983, 133; **T 650/90**, **T 330/92**).

In **T 883/03** the board found that the teaching that could have led to the characterising feature of claim 1 had long formed part of the state of the art; yet for all that time experts had been "**blind**" to that knowledge. In the case in point that was a further indication of the inventiveness of the solution proposed in claim 1.

In **T 872/98** the board pointed out that the presence of secondary indicia might also be attested by the fact that a competitor had, shortly after the priority date, filed a patent application with the German Patent Office in which the invention took an entirely different direction to the European application.

In **T 779/02** the board indicated that a prejudice could be proved by the fact that the closest prior art and the invention were separated by a long period of time (in this case over 16 years), during which time the only solutions pursued led away from the invention, and the solution provided by the invention only becoming acceptable to experts in the field after this time.

### 10.3. Age of documents - time factor

The age of documents known long before the filing date might only be an indication of an inventive step if a need for the solution of an unsolved problem had existed for the entire period between the date of the documents and that of the invention (**T 79/82** and **T 295/94**). Nevertheless, the long period of time to be considered was not the period that had elapsed between the publication of a document and the filing of the European patent application disclosing the teaching of that document, but that between the time the problem became apparent and the date of filing of the European patent application providing a solution (**T 478/91**).

A period of 23 years between the publication date of the document deemed to be the closest prior art and the priority date of the contested patent in an economically significant and frequently studied field could normally be viewed as an indication of the presence of inventive step (**T 273/92**). In **T 203/93** and **T 795/93** a period of 11 years was considered to be an indication in support of inventive step, in **T 986/92** a period of 70 years, in **T 478/91** 80 years and in **T 626/96** 60 years (see also **T 774/89**, **T 540/92**, **T 957/92**, **T 697/94**, **T 322/95**, **T 255/97**, **T 970/97**, **T 6/02**, **T 2271/08**).

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

In **T 1077/92** the board faced the unusual situation of a problem and its ready solution having co-existed for 100 years in general, and more recently in a field of intensive research, and still the seemingly obvious step had not been taken. The board concluded that, as no other explanation could be found, this must have been because inventive insight was needed (**T 617/91**).

In **T 123/97** the failure to adopt an obvious solution to the technical problem underlying the patent in suit may have resulted from a variety of causes; for example, there may have been a commercial reason for not adopting this new technique, because the old technique was found satisfactory by the clients and could also be improved, thus avoiding considerable investment costs involved in the adoption of a new technique on an industrial scale.

The board in **T 833/99** found that, in addition to the other factors it had mentioned in examining whether a method of producing a grooved-rail frog for tramlines was inventive, it also had to be taken into account that citation D1 dated from 1930 and that, in the 60 years between it and the invention at issue, no skilled person had had the idea of taking up what it suggested and applying the method described to a single-piece frog. That was a serious indication of non-obviousness which could not be ignored.

The board in **T 1192/09**, having found that there was an inventive step, added that the actual developments in the relevant technical field, as evidenced by the documents on file, provided additional support in favour of an inventive step. The board noted in this respect that D8 (closest prior art) had been published about 12 years before the filing date of the patent in suit. The fact that the very inventors of D8 had not proposed the claimed structure, with its uncontested advantages, until 12 years after the publication of D8, and that this structure had later been praised in D10 (European patent, same inventors as D8, underlying application filed two months after the patent at issue) and made the subject of a granted European patent was considered by the board to be an additional indication of the non-obviousness of the concept which formed the basis of the claimed invention.

#### **10.4. Satisfaction of a long-felt need**

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

In **T 605/91** the board stated that it was not sufficient if only one individual skilled person discovered a "long-felt need". Only if various and repeated attempts to deal with the relevant disadvantages could be identified would such a long-felt need appear to have persisted.

In **T 1014/92** the board did not accept the appellant's further argument that the long period of time (about 35 years) during which documents (1) and (2) had been available to the public without having been combined, was in itself cogent evidence that there was no obvious connection between them. The board held that this conclusion might only be drawn if evidence relating to time were corroborated by other evidence, such as long-felt want (see also **T 1183/06**).

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

#### **10.5. Commercial success**

In principle, commercial success alone is not to be regarded as indicative of inventive step. The following requirements must first be met; a long-felt need must have been fulfilled, and the commercial success must derive from the technical features of the invention and not from other influences (e.g. selling techniques or advertising).

In **T 110/92** the board did not dispute that the heating assembly according to claim 1 might have been a commercial success. However, such a commercial success alone, with the technically relevant examination of the claimed subject-matter leading to a

negative result, could not be regarded as forming the basis for an indication of inventive step even if the board were convinced that the success derived from technical features of the heating assembly and not from other causes such as those of a commercial nature (see **T 5/91**, **T 219/90**, **T 373/94**, **T 109/15**).

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

In **T 1212/01** the patent related to pyrazolopyrimidinones for the treatment of impotence (Viagra). The board stated that in order to establish commercial success as an indicia of inventive step two evidentiary steps were required. Firstly, commercial success must be demonstrated and, secondly, it had to be shown that such success resulted from the claimed invention and not from one or more other causes. Viagra had been the subject of various awards and praise in various journals. The board stated that the prizes would have been significant if awarded by persons who understood patent law. If however the prizes were awarded for the product's life-enhancing nature, or for the appellants' high standard of research, or for a high level of sales, then, for all that any of those reasons might well be prize-worthy, the prizes can have no significance in the context of inventive step. The board arrived at the conclusion that the evidence did not establish that the "prizes and praises" resulted from the claimed inventive step.

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

In **T 626/96** the invention had likewise achieved great commercial success and gained widespread recognition in a number of countries. Furthermore, the success was achieved in a very short space of time, so that there seemed to be a pressing commercial need for this simple solution. Furthermore, the success was directly attributable to the structure of the product claimed and was not due to marketing techniques or advertising skills.

## **10.6. Market competitors**

Market **competitors' efforts** to obtain rights of joint use constitute further secondary indicia closely related to commercial success. They may result in a positive decision on inventive step, but need not necessarily do so. In **T 351/93** the board stated that the latter applied particularly where a technical and expert assessment of the invention in the



light of the prior art led, according to the problem-solution approach, to the conclusion that the existence of inventive step had to be denied.

The case was slightly different in **T 812/92** - the situation might arise where, shortly before the filing date of the contested patent, **one of the patent proprietor's competitors** offered a customer a technical apparatus without reducing to practice the advantageous technical solution according to the invention. This might be an indication that an inventive step was involved.

In **T 252/06** the board confirmed the presence of inventive step *inter alia* on the grounds that the proprietor's competitors had used the patent's teaching and had filed applications relating to it.

### 10.7. Simple solution

In a technical field of commercial importance to which considerable attention is directed the simplicity of a proposed solution may indicate inventive step. The difficulty of developing a simple solution without sacrificing quality may therefore indicate inventive step (**T 106/84**, OJ 1985, 132; **T 229/85**, OJ 1987, 237; **T 9/86**, OJ 1988, 12; **T 29/87**, **T 44/87**, **T 528/89**, **T 73/95**). This did however presuppose the absence in the prior art of anything that hinted at the proposed solution (**T 712/92**).

In **T 234/91** it was pointed out that experience in structural engineering showed that with the same or even an improved effect - in the case in point an increase in reliability - it was often much more difficult to identify and achieve a simple solution than complicated embodiments. In view of the large number of solutions suggested in the technical literature, the board came to the conclusion that the improvement achieved by the simple structural measure suggested in the contested patent had not been obvious (see also **T 330/87**).

In **T 349/95** the subject-matter at issue related to a simple form of a simple device, a device which, however, had brought about a surprising major functional improvement. In the board's view, this surprising improvement and the fact that the prior art gave no clear hint of the solution constituted evidence of the inventiveness of the claimed solution.

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

A solution is not obvious simply because its success is plausible. That success is plausible once a solution is known does not necessarily mean that the solution itself was already obvious to the skilled person. Whether success is plausible and whether the solution itself is obvious are two distinct matters requiring separate investigation (**T 862/11**).

### 10.8. Surprising effect - bonus effect

An effect which may be said to be unexpected can be regarded as an indication of inventive step (**T 181/82**, OJ 1984, 401). However, certain preconditions have to be met. In **T 21/81** (OJ 1983, 15) the board considered that if, having regard to the state of the art, it would already have been obvious for a skilled person to arrive at something falling within the terms of a claim, because an advantageous effect could be expected to result from the combination of the teachings of the prior art documents, such claim lacked inventive step, irrespective of the circumstance that an extra effect (possibly unforeseen) was obtained (see **T 365/86**, **T 350/87**, **T 226/88**). This case law was also confirmed in **T 69/83** (OJ 1984, 357). Where, because of an essential part of the technical problem being addressed, the state of the art obliged a skilled person to adopt a certain solution, that solution was not automatically rendered inventive by the fact that it also unexpectedly solved part of the problem. Therefore, an unexpected bonus effect does not confer inventiveness on an obvious solution (**T 231/97**). If it is obvious for the skilled person to combine prior art teachings in order to solve an essential part of the problem, the presence of even an unexpected extra effect allowing another part of the problem to be solved at the same time does not in principle imply the presence of inventive step (**T 170/06**).

Furthermore, in **T 192/82** (OJ 1984, 415) the board stated that the skilled person had to be free to employ the best means already available for his purposes, although the use of means leading to some expected improvements might well be patentable in relying on an additional effect, provided this involved a choice from a multiplicity of possibilities. The lack of alternatives in this respect might therefore create a "**one-way-street**" situation leading to predictable advantages which remained obvious in spite of the existence of some unexpected "bonus" effect. The board also pointed out in **T 506/92** that an additional effect achieved inevitably by the skilled person on the basis of an obvious measure without any effort on his part simply represented a bonus under EPO case law which could not substantiate inventive step, even as a surprising effect (see also **T 766/92**, **T 431/93**, **T 703/93**, **T 681/94**, **T 985/98**, **T 794/01**, **T 1192/09**).

The board in **T 936/96** held that, once a realistic technical problem had been defined and once it had been established that a particular solution to such a problem would have been envisaged by a skilled person in the light of the relevant state of the art, that solution could not be said to involve an inventive step, and this assessment was not altered by the fact that the claimed invention inherently also solved further technical problems. In the case in point the claimed surprising effect could not be regarded as an indication of the presence of an inventive step.

In **T 227/89** the board stated that in determining which effect was crucial and which was merely accidental (the so-called "bonus effect"), a realistic approach had to be taken, considering the relative technical and practical importance of those effects in the circumstances of a given case (see also **T 732/89** and **T 729/90**). When assessing chemical substances for inventive step, it is often their surprising properties that are considered (see in this connection **T 20/83**, OJ 1983, 419).

In **T 848/94** the solution of the existing technical problem required a combination of measures that was not suggested by the prior art in such a manner that it would have been adopted by the person skilled in the art. Therefore, the person skilled in the art was not in a "one-way-situation".

According to the boards' case law, an improvement is not a prerequisite for inventive step. In **T 154/87** it was pointed out that the achievement of a surprising effect was no precondition for the existence of inventive step. All that was necessary was to ascertain that the respective subject-matter could not be derived by the skilled person in an obvious manner from the available prior art (**T 426/92**, **T 164/94**, **T 960/95**, **T 524/97**, **T 888/08**).

In **T 551/89** the board stated that an effect which was to be expected as the result of an obvious measure could not contribute to recognition of the required inventive step, even if the scale of this effect was surprising to the skilled person. In this case an effect whose scale surpassed the skilled person's hopes merely represented a bonus effect following inevitably from the use of an obvious measure and obtained by the skilled person without any inventive effort on his part (**T 506/92**, **T 882/94**).

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

### **10.9. Comparative tests**

According to the established jurisprudence, a surprising effect (advantageous effect or feature) demonstrated in a comparative test can be taken as an indication of inventive step. If comparative tests are chosen to demonstrate an inventive step on the basis of an improved effect, the nature of the comparison with the closest state of the art must be such that the alleged advantage or effect is convincingly shown to have its origin in the distinguishing feature of the invention compared with the closest state of the art (**T 197/86**, OJ 1989, 371; **T 234/03**; **T 378/03**) and alleged but unsupported advantages cannot be taken into consideration in respect of the determination of the problem underlying the invention (see also Chapter I.D.4.2 "Alleged advantages"; **T 20/81**, OJ 1982, 217; **T 561/94**).

In **T 197/86** (OJ 1989, 371) the board supplemented the principles laid down in earlier decision **T 181/82** (OJ 1984, 401), according to which, where comparative tests were submitted as evidence of an unexpected effect, there had to be the closest possible structural approximation in a comparable type of use to the subject-matter claimed. In

the case in point the respondent (proprietor of the patent) strengthened support for his claim by voluntarily providing comparisons with variants which, although not expressly belonging to the prior art, differed from the claimed subject-matter only by the distinguishing feature of the invention. The board summarised its position by stating, that in cases where comparative tests were chosen to demonstrate an inventive step with an improved effect over **a claimed area**, the nature of the comparison with the closest state of the art had to be such that the effect was convincingly shown to have its origin in the distinguishing feature of the invention. For this purpose it might be necessary to modify the elements of comparison so that they differed only by such a distinguishing feature (**T 292/92, T 412/94, T 819/96, T 133/01, T 369/02, T 668/02, T 984/03, T 2043/09**).

As early as **T 35/85** the board had stated that an applicant or patentee may discharge his onus of proof by voluntarily submitting comparative tests with newly prepared variants of the closest state of the art identifying the features common with the invention, in order to have a variant lying closer to the invention so that the advantageous effect attributable to the distinguishing feature is thereby more clearly demonstrated (**T 40/89, T 191/97, T 496/02**).

It is for the applicant (patentee) to furnish evidence of an improved effect of the subject-matter of a claim, which has been asserted, but was not mentioned in the application as filed, in the whole of the claimed area vis-à-vis the closest prior art (**T 355/97, T 1213/03, T 653/07**).

In **T 415/11** the board stated when the credibility that a technical effect is achieved by substantially all claimed compounds is at issue and in a situation where, it is prima facie unlikely that this is credible, it is not the opponent (here: the appellant), but the patentee (here: the respondent) who has the burden of proving that the effect is achieved (see for example **T 939/92, OJ 1996, 309; T 97/00**).

In **T 390/88** the board addressed the question of the circumstances under which the production of comparative examples was unnecessary. In the above-mentioned earlier cases the invention had been obvious prima facie because the products, although novel, were very close structurally to the prior art products. The case in point was different. Here, the board said that the production of comparative examples was not essential to establish inventiveness, as the invention had not been obvious from the outset (**T 656/91**).

In **T 702/99** the board stated that in cases concerning products such as cosmetics, in which applicants or patentees seek to establish that their inventions have an improved "feel" over the prior art, or opponents seek to deny such an improved "feel", it is common for one or more parties to file evidence of comparative tests conducted by a number of persons. It is essential for such tests to be made under conditions which ensure maximum objectivity on the part of those conducting the tests and who may be required at a later date to give evidence in proceedings. It is always desirable that such tests can be shown to be "blind" and that they have been conducted in the strictest conditions; that the testers have had no part in the making of the claimed invention or research leading

up to the invention or the patenting procedure (see also **T 479/06**, **T 275/11** and **T 1962/12**, which reiterates the conditions for plausibility of comparative tests).

In **T 234/03** the board stated that to be of relevance in demonstrating that a technical improvement is achieved in comparison with the closest state of the art, any comparative test presented must be reproducible on the basis of the information thus provided, thereby rendering the results of such tests directly verifiable (**T 494/99**). This requirement implies, in particular, that the procedure for performing the test relies on quantitative information enabling the person skilled in the art to reproduce it reliably and validly. Vague and imprecise operating instructions render the test inappropriate and thus irrelevant.

In **T 172/90** the comparative examples produced did not constitute suitable evidence of inventive step. The board said that the products adduced as a basis of comparison were commercially available and had evidently been selected at random. Technical progress shown in comparison with products of this kind could not be a substitute for the demonstration of inventive step with regard to the closest prior art (see also **T 164/83**, OJ 1987, 149; **T 730/96**).

## E. The requirement of industrial application under Article 57 EPC

1.	Notion of "industrial application"	254
1.1.	Invention and industrial application	254
1.2.	Any kind of industry	256
1.2.1	Methods applied in the private and personal sphere	256
1.2.2	Cosmetic and beauty salons	257
2.	Reproducibility and sufficiency of disclosure	257
3.	Indication of a profitable use of the invention in industry	258

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### 1. Notion of "industrial application"

Art. 57 EPC provides that: "An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture". It thus defines the third criterion for patent grant referred to in Art. 52(1) EPC, namely "industrial application", making it clear that the possibility of making or using the invention in any kind of industry is sufficient (**T 144/83**) and that agriculture too is a kind of industry for the purposes of the EPC (**T 116/85**, OJ 1989, 13). Both products and processes (**T 208/84**) are susceptible of industrial application. Claims directed to substances or compositions for use in methods for treatment of the human or animal body by therapy are directed to inventions which are susceptible of industrial application (**G 1/83**).

In **T 80/96** (OJ 2000, 50), the board found that the use of a substance to make a new pharmaceutical product without delimitation to an indication did not contravene the requirements of Art. 57 EPC 1973 in conjunction with Art. 52(1) EPC 1973.

Regarding the amendments to Art. 52(1) EPC in the course of the revision of the EPC, see Chapter I.A.1 "Patent protection for technical inventions".

#### 1.1. Invention and industrial application

The requirement of industrial application must be satisfied in addition to the other patentability criteria. Art. 57 EPC excludes only a few inventions from patentability that are not already excluded by Art. 52(2) EPC (Guidelines G-III, 3 – November 2015 version), or by Art. 53 EPC. In particular the work of medical practitioners, previously excluded from patentability under Art. 52(4) EPC 1973 as lacking industrial application, is now covered in Art. 53(c) EPC. Industrial application is also lacking if the product or process is contrary to the laws of physics (**T 541/96**), such as for example a perpetual motion machine (Guidelines G-III, 3 – November 2015 version).

While the technical character of an invention and its susceptibility of industrial application are two different patentability requirements under the EPC, they are often discussed together.

In **T 953/94** the board stated that, as the Convention showed (Art. 52(1) EPC 1973), the requirement (defined in Art. 52(2) and (3) EPC 1973) of claimed subject-matter being an "invention" was distinct from the requirement (defined in Art. 57 EPC 1973) of the claimed invention being "susceptible of industrial application". Even though the former requirement might, *cum grano salis*, be equated with a requirement for a "technical" contribution, this was not the same as a requirement for "industrial" applicability; at least in this context, the terms "technical" and "industrial" were not synonyms. In Art. 57 EPC 1973, the meaning of "industrial" was evidently intended to cover commercial applications; this was made clear, for instance, by the German version ("gewerblich"). In the context of Art. 52(2) EPC 1973, this was clearly not the case for the meaning of "technical". This was because, in the context of "controlling a [...] process", the adjective "industrial" should, other than in the context of Art. 57 EPC 1973, be understood to relate only to technical processes usually occurring in "industry" (this latter term in its present context being understood in the narrower sense of what in German would be called "Industrie") and thus not as including "commercial", or even "financial", applications (see also **T 208/84** and **T 854/90**).

In **T 533/09** the board found that the claimed pulse train was of a tangible nature in that it was the result of modulating an electrical signal (derived from a capacitor discharge for defibrillation purposes) and its intensity was measurable at any time. Such a signal thus clearly came under the definition of "physical entity" within the meaning of **G 2/88** (OJ 1990, 93), in its original version. The board concluded that the nature of the subject-matter of claim 1 of the main request was no obstacle to its patentability; moreover, as there could be no doubt that such a signal could be produced and used for defibrillation purposes, that subject-matter clearly was susceptible of industrial application and thus met the conditions of Art. 57 EPC 1973. The board concluded that the wording chosen by the legislator for Art. 52 to 57 EPC on patentability does not in any way link the notion of patentable invention with any condition requiring such an invention to be of a tangible, viz. material, nature (see point 7.2 of the Reasons).

In **T 204/93** the board held that commercial use excluded from patentability under Art. 52(2)(c) and (3) EPC 1973 (in so far as it was not construed as a method for doing business) was a feature which might be understood to fall within the requirement that an invention had to be susceptible of industrial application (Art. 52(1) EPC 1973), i.e. that it could be made or used in any kind of industry (Art. 57 EPC 1973); reference was made in particular to the German word "gewerblich" in that provision of the Convention. The board noted that it was not disputed that computer programs could be exploited commercially. The exclusions from patentability defined in Art. 52(2) and (3) EPC 1973 did not in any way refer to the requirement in Art. 52(1) EPC 1973 of "industrial application" but to the requirement in that Article that the subject-matter claimed had to be an "invention". The exclusions in Art. 52(2) and (3) EPC 1973 were generally understood to share the common feature that the excluded matters lacked technicality but not that they could not be made or used, e.g. traded. In this case the board denied patentability for lack of technical effect.

## 1.2. Any kind of industry

Industry is subject to broad interpretation in this context (**T 74/93**) and extends to any activity that is carried out continuously, independently and for financial gain (**T 144/83**) or that can be offered commercially by a company (**T 1165/97**). The case law refers to the concepts of "financial (commercial) gain" (**T 144/83**) and of "profitable use" (**T 870/04**) in relation to industrial applicability (**T 898/05**). The need to show a "profitable use" is not to be understood in the narrow sense of an actual or potential economic profit (i.e. generating more income than expenditure) or of a commercial interest (i.e. creating a new or increased business opportunity). Rather, it must be understood in the wider sense that the invention claimed must have such a sound and concrete technical basis that the skilled person can recognise that its contribution to the art could lead to practical exploitation in industry (**T 898/05**). This interpretation therefore does not extend for example to inventions that merely amount to a research finding (**T 870/04**; **T 338/00**) or that are applied for exclusively private and personal purposes.

### 1.2.1 Methods applied in the private and personal sphere

In **T 74/93** (OJ 1995, 712) the application was refused by the examining division because claim 5, which was directed to the use of a contraceptive composition (e.g. a cream) for applying to the cervix of a female capable of conception, was not susceptible of industrial application as required by Art. 57 EPC 1973 in so far as the compound was to be applied to the cervix of a human female.

The board stated that in determining the borderline between industrial activities - in which the effects of patents had to be respected - and private and personal activities, which should not be adversely affected by the exercise of these rights, the board took into consideration the fact that Art. 57 EPC 1973 might be regarded as an expression of the general idea that any natural person had the right to have his or her privacy respected. The core of this right was not to be taken away from anybody. Therefore the fact that for some women contraception was connected with professional activities did not give an act, which was in essence private and personal, an industrial character. The board noted that this did not apply to contraception in general, but to the specific type of application of a composition as claimed in claim 5.

The board was unable to ascertain any field of industrial application for the direct use defined in claim 5, for which the requirement of Art. 57 EPC 1973 had to be met. The question as to whether it would be sufficient for an industrial application to be expected in future could be left unanswered as this assertion had not been further substantiated.

In **T 1165/97** the board held that a method of using a vaginal discharge collector and disposing of the collector after a single use could be considered susceptible of industrial application if it was conceivable that these steps were carried out as a paid service and were not exclusively dependent for their execution on the instructions of the woman in question. The board noted that, for the purposes of Art. 57 EPC 1973, what was relevant was the possibility that such a service might be offered by an enterprise. In that case, the board decided in the affirmative, pointing out that - in contrast to the case in **T 74/93** - the



service was not one satisfying only the strictly personal needs of the woman in question. Collecting a sample could be caused by external reasons, e.g. on the advice of a medical practitioner to have such a sample taken for further diagnosis.

### 1.2.2 Cosmetic and beauty salons

In **T 144/83** (OJ 1986, 301) the board stated that under Art. 57 EPC 1973 an invention was to be considered as susceptible of industrial application if it could be made or used in any kind of industry. Enterprises in the cosmetic field - such as cosmetic salons and beauty parlours - were part of industry within the meaning of Art. 57 EPC 1973, since the notion of "industry" implied that an activity was carried out continuously, independently and for financial gain. One board had already decided in **T 36/83** (OJ 1986, 295) that the professional use of such inventions in a cosmetic salon was an industrial application within the meaning of Art. 57 EPC 1973.

## 2. Reproducibility and sufficiency of disclosure

Another requirement for an invention to be considered susceptible of industrial application within the meaning of Art. 57 EPC is that the technical teaching disclosed in the application under Art. 83 EPC is reproducible.

In **T 718/96** the board held that reproducibility was to be assessed in the first instance with reference to Art. 83 and 100(b) EPC, which lay down that the invention must be disclosed in such a way that it can be carried out by a skilled person. Art. 57 could also serve as a basis for objecting to a lack of reproducibility, because an invention that could not be carried out was also not susceptible of industrial application, but such an objection was always to be based on the most specific applicable provision. Nevertheless, given the link between the two notions, any findings as to reproducibility would apply in equal measure to industrial application under Art. 57 EPC.

In **T 1450/07** the board noted that the information in the application as filed should make plausible the identity of the claimed compound. Thus, the compound could be attributed to a known family of molecules on the basis of a comparison between its primary structure and that of molecules known in the art. Then, its putative functions could be disclosed. Experimental evidence was not necessarily needed. A number of reasonable assumptions could be made by taking into account the known functions of other family members as well as, for example and not exclusively, by taking into account the distribution of the claimed compound in the body. The treatments therein mentioned were in relation to the function plausibly attributed to the molecule. Post published evidence backing up these assumptions was always welcome and the quality of the information was also fundamental. The board pointed out that each case had to be evaluated on its own merits. The board decided in the case at issue that the requirement of industrial applicability was fulfilled.

In **T 18/09** the board noted that the close inter-relationship between Art. 83 and 57 EPC was already addressed in previous decisions (see inter alia **T 898/05**). In respect of Art. 83 EPC, established case law of the boards of appeal stated that a patent could only

be objected to for lack of sufficiency of disclosure if there were serious doubts, substantiated by verifiable facts (see **T 19/90**, OJ 1990, 476). For the board, it would not be justified and unfair to set a different standard of proof in respect of Art. 57 EPC.

In **T 541/96** the gist of the invention consisted in inducing nuclear fusion between light nuclei and heavy unstable nuclei at low temperature by means of an electric field. The board held that an invention or an application for a patent on an alleged invention which was incompatible with the generally accepted laws of physics did not meet the requirements of Art. 57 and 83 EPC 1973, because it could not be used and therefore lacked industrial application.

The EPC did not exclude "revolutionary" inventions from being patented. However, Art. 83 EPC 1973 made the amount of information required for a sufficient disclosure of an invention somewhat dependent on the actual "nature" of the invention. However, if the invention seemed, at least at first, to offend against the generally accepted laws of physics and established theories, the disclosure should be detailed enough to prove to a skilled person conversant with mainstream science and technology that the invention was indeed feasible (i.e. susceptible of industrial application). This implied, inter alia, the provision of all the data which the skilled person would need to carry out the claimed invention, since such a person, not being able to derive such data from any generally accepted theory, could not be expected to implement the teaching of the invention just by trial and error.

The appellant had provided neither experimental evidence nor any firm theoretical basis which would enable the skilled person to assess the viability of the invention; the description was essentially based on general statements and speculations which were not apt to provide a clear and exhaustive technical teaching. Thus, it was irrelevant to consider whether the fusion reactions referred to in the description might be theoretically possible, or whether they might indeed occur under certain conditions.

### **3. Indication of a profitable use of the invention in industry**

R. 42(1)(f) EPC (former R. 27(1)(f) EPC 1973) prescribes that the description should "indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable".

In **T 1452/06** the board stated that a basic principle of the patent system was that exclusive rights could only be granted in exchange for a full disclosure of the invention, which included the need to indicate how to exploit the invention (Art. 57 EPC 1973). This indication must have "a sound and concrete technical basis", as a "speculative indication of possible objectives that might or might not be achievable by carrying out further research with the tool as described was not sufficient to fulfil of the requirement of industrial applicability" (see **T 898/05**, **T 870/04** and **T 1109/10**).

In **T 898/05** the board found that for the purposes of Art. 57 EPC 1973, a claimed invention had to have such a sound and concrete technical basis that the skilled person could recognise that its contribution to the art could lead to practical exploitation in

industry. The board explained that while industrial applicability should be construed broadly, to include any "immediate concrete benefit", this also entailed the need to disclose in definite technical terms the purpose of the invention and how it could be used in industrial practice to solve a given technical problem, this being the actual benefit or advantage of exploiting the invention. There had to be at least a prospect of a real as opposed to a purely theoretical possibility of exploitation, if it was not already obvious from the nature of the invention or from the background art. It should not be left to the skilled reader to find out how to exploit the invention by carrying out a research programme.

Accordingly, a product whose structure was given (e.g. a nucleic acid sequence) but whose function was undetermined or obscure or only vaguely indicated might not fulfil the above criteria, in spite of the fact that the structure of the product per se could be reproduced (made) (see **T 870/04**). If a patent was granted, it might prevent further research in that area. On the other hand, a product which was definitely described and plausibly shown to be usable, e.g. to cure a rare or orphan disease, might be considered to have a **profitable** use or concrete benefit, irrespective of whether it was actually intended for the pursuit of any trade at all.

In **T 1450/07** the board referred to the principles established in **T 898/05** that industrial applicability is acceptable if the disclosure in the application as filed on the function of a claimed compound (i) is plausible to the skilled person, (ii) is later confirmed by post-published evidence, and (iii) provides a clear basis for an industrial application.

In **T 870/04** the board stated that a "practical" application of the invention had to be disclosed. Merely because a substance could be produced in some ways did not necessarily mean that this requirement was fulfilled, unless there was also some profitable use for which the substance could be employed.

The board noted that biotechnological inventions were quite often concerned with substances found in nature (e.g. a protein, a DNA sequence, etc.). If a function was well known to be essential for human health, then the identification of the substance having this function would immediately suggest a practical application in the case of a disease or condition caused by a deficiency, as was the case, for example, for insulin, human growth hormone or erythropoietin. In such cases, an adequate description would ensure that "the invention can be made or used in industry". In cases where a substance, naturally occurring in the human body, was identified, and possibly also structurally characterised and made available through some method, but either its function was not known or it was complex and incompletely understood; no disease or condition had yet been identified as being attributable to an excess or deficiency of the substance; and no other practical use was suggested for the substance, then industrial applicability could not be acknowledged. Even though research results may be a scientific achievement of considerable merit, they are not necessarily an invention which can be applied industrially.

In cases **T 338/00** and **T 604/04** the boards found the inventions industrially applicable despite the absence of actual experimental data, because a profitable use could readily

be identified on the basis of the description, taking into account common general knowledge. Thus each case is decided on its own merits according to the particular technical circumstances, including extent of disclosure, background art and post-published evidence.

In **T 641/05** the board considered that no actual information regarding the function of the CEGPCR1a clone at any of the three particular levels of function referred to in decision **T 898/05**, i.e. molecular, cellular and biological function in a broad sense (binding of a ligand, propagation of a transmembrane signal, role in a transduction signal pathway and/or in a network of interconnected pathways of a multicellular organism), could be directly derived from the application itself or from the prior art on file. Although, under certain conditions, the board was well prepared - following the case-by-case approach adopted in decision **T 898/05** - to acknowledge a possible function based on computer-assisted methods, in the case before it the probative value of these (sequence homology) methods was completely lacking. In the absence of this functional information, no "immediate concrete benefit" in the sense defined in decision **T 898/05** could be recognised for the CEGPCR1a clone disclosed in the application.

In **T 1452/06** the board commented that the basis for all the therapeutic indications of the claimed subject-matter was the predicted role of the purported serine protease activity of the polypeptide of sequence SEQ ID NO: 24 in the degradation of the extracellular matrix. No experimental evidence whatsoever was present in the application in support of a serine protease activity for a polypeptide comprising the amino acid sequence of SEQ ID NO: 24. There was no example disclosing this serine protease activity, nor any evidence showing that the screening methods and the therapeutic indications based on this serine protease activity could actually be achieved with a polypeptide of sequence SEQ ID NO: 24. The only use of a polypeptide of sequence SEQ ID NO: 24 was to find out more about the polypeptide itself and its natural function(s); this was a speculative outcome and therefore provided no "immediate concrete benefit" (**T 898/05**, **T 870/04**).

## II. PATENT APPLICATION AND AMENDMENTS

### A. Claims

1.	Basic principles	262
1.1.	Purpose of claims under Article 84 EPC	262
1.2.	Types of claim	262
1.3.	Technical features	263
1.4.	The examination of clarity in opposition proceedings	263
1.5.	Clarity of claims and Article 83 EPC	263
2.	Form, content and conciseness of claims	263
2.1.	Form of claims: Rule 43(1) EPC	264
2.1.1	One-part or two-part claim	264
2.1.2	Two-part claims: preamble and characterising portion	265
2.2.	More than one independent claim per category: Rule 43(2) EPC	265
2.2.1	Conditions	266
2.2.2	Burden of proof	267
2.2.3	No applicability in opposition proceedings	268
2.3.	Conciseness and number of claims	268
2.4.	Reference to the description or drawings: Rule 43(6) EPC	269
3.	Clarity of claims	270
3.1.	Introduction and general principles	270
3.2.	Indication of all essential features	272
3.3.	Clarity of broad claims	274
3.4.	Functional features	275
3.5.	Characterisation of a product by a parameter	278
3.6.	Unspecified features and relative qualities	280
3.7.	Principles in connection with categories of claim	282
4.	Disclaimers	283
5.	Claims supported by the description	284
5.1.	General principles	284
5.2.	Restrictions on generalising the technical information and examples adduced in the description	284
5.3.	Bringing the description into line with amended claims	286
6.	Interpretation of claims	287
6.1.	General principles	287
6.2.	Meaning of terms	288
6.3.	Using description and drawings to interpret the claims	289
6.3.1	General principles	289
6.3.2	Relevance of Article 69 EPC	290
6.3.3	Interpretation of ambiguous terms or confirmation of the text of a claim	291
6.3.4	Reading additional features and limitations into the claims	292
6.3.5	Use in the examination relating to the clarity requirement pursuant to Article 84 EPC	294
6.3.6	Definition of the scope of protection with regard to infringement not within the EPO's competences	295
7.	Product-by-process claims	296

7.1.	Introduction	296
7.2.	Requirement that the claimed product must be patentable	296
7.3.	Requirement that the claimed product cannot be described in any other way	298
7.4.	Applicability of the principles for product-by-process claims to use claims	299
7.5.	Combination of product and process features	299
7.6.	Extension of protection conferred by product-by-process claims	299
8.	Claims fees	300
8.1.	Number of claims	300
8.2.	No refund of claims fees	301

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## 1. Basic principles

### 1.1. Purpose of claims under Article 84 EPC

Art. 84 EPC provides that claims must define the matter for which protection is sought. It lays down the relevant principles governing the content and wording of the claims, providing that claims should be clear and concise and be supported by the description. It is supplemented by R. 43 EPC, which requires inter alia that the claims "shall define the matter for which protection is sought in terms of the technical features of the invention".

In **G 2/88** (OJ 1990, 93, Corr. 469) the Enlarged Board stated that the primary aim of the wording used in a claim must be to satisfy the requirements under Art. 84 and R. 29(1) EPC 1973 (R. 43(1) EPC), having regard to the particular nature of the invention, and the purpose of the claims. The purpose of claims under the EPC is to enable the protection conferred by the patent or patent application to be determined (Art. 69 EPC), and thus the rights of the patent owner within the designated contracting states (Art. 64 EPC), having regard to the patentability requirements of Art. 52 to 57 EPC.

The boards of appeal have repeatedly confirmed that claims must be clear for the sake of legal certainty, as their purpose is to enable the protection conferred by the patent to be determined (see e.g. **T 337/95**, OJ 1996, 628; **T 586/97**, **T 437/98**, **T 728/98**, OJ 2001, 319; **T 877/99**, **T 1074/00**, **T 560/09**, **T 754/13**: "constant jurisprudence"). Legal certainty is of paramount importance in any system where the rights of the public are affected by the grant of a monopoly (**T 81/14**) and the public should not be left in any doubt as to which subject-matter is covered and which is not (**T 2086/11**). The skilled person should be able to establish the demarcation of the scope of the claim (i.e. its extent of protection) without undue burden (**T 754/13**).

### 1.2. Types of claim

The Enlarged Board set out in **G 2/88** that there are basically two different types of claim, namely a claim to a physical entity (e.g. product, apparatus) and a claim to a physical activity (e.g. method, process, use). These two basic types of claim are sometimes referred to as the two possible "categories" of claim. Within the above two basic types of

claim various sub-classes are possible (e.g. a compound, a composition, a machine; or a manufacturing method, a process of producing a compound, a method of testing, etc.). Furthermore, claims including both features relating to physical activities and features relating to physical entities are also possible. There are no rigid lines of demarcation between the various possible forms of claim.

### 1.3. Technical features

Under the EPC the claims must define the matter for which protection is sought "in terms of the technical features of the invention" (R. 43(1) EPC). In **G 2/88** the Enlarged Board described the technical features of the invention as being the physical features which are essential to it. The technical features of a claim to a physical entity are the physical parameters of the entity, and the technical features of a claim to an activity are the physical steps which define such activity. The Enlarged Board also pointed out, however, that the boards of appeal had in a number of cases allowed the technical features to be defined functionally in certain instances (e.g. **T 68/85**, OJ 1987, 228; **T 139/85**). See in this Chapter II.A.3.4.

### 1.4. The examination of clarity in opposition proceedings

Art. 84 EPC is not a ground for opposition. However, when substantive amendments are made to a patent during an opposition, consideration has to be given to whether the amendments introduce any contravention of any requirement of the EPC, including Art. 84 EPC (**T 301/87**, OJ 1990, 335). In **G 3/14** (applied in **T 1977/13**, **T 1905/13**) the Enlarged Board analysed whether, and if so to what extent, the requirements of Art. 84 EPC may be examined in opposition and opposition appeal proceedings, in particular if the amended claim is a mere combination of a granted independent claim and granted dependent claims or elements thereof. The Enlarged Board approved **T 301/87** and held that, for the purposes of Art. 101(3) EPC, the claims may be examined for compliance with Art. 84 EPC only when, and then only to the extent that the amendment **introduces** non-compliance with Art. 84 EPC (see Chapter IV.D.4.2 "Substantive examination of amendments").

### 1.5. Clarity of claims and Article 83 EPC

Art. 83 EPC requires that the European patent application discloses the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. In certain circumstances, for example when undefined parameters are used in the claims and no details of the measuring methods are supplied, the question arises whether there is a problem with respect to Art. 83 or Art. 84 EPC. The answer is important, because Art. 83 EPC is a ground for opposition, whereas Art. 84 EPC is not. See Chapter II.C.7. "The relationship between Article 83 and Article 84".

## 2. Form, content and conciseness of claims

R. 43 EPC concerns the form and content of claims. Apart from the requirement that the claims define the matter for which protection is sought in terms of the technical features

of the invention it concerns the following issues which are the subject of this sub-chapter: the two-part form of claims, the exceptions to the general rule that the application may contain no more than one independent claim in the same category, the reasonable number of claims and the provision that claims should normally not rely on references to the description and drawings in specifying the technical features of the invention.

R. 43 EPC has also been discussed in the context of clarity of claims (see in this Chapter II.A.3.7).

### 2.1. Form of claims: Rule 43(1) EPC

R. 43(1)(a) and (b) EPC (like R. 29(1)(a) and (b) EPC 1973) define the two-part form which a claim is to have where this is appropriate. Such claims must contain 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, form part of the prior art ("preamble"), and a characterising portion stating the technical features for which, in combination with the features stated in the first part, protection is sought (see also Guidelines F-IV, 2 – November 2015 version).

#### 2.1.1 One-part or two-part claim

In **T 13/84** (OJ 1986, 253), the board ruled that a claim in two-part form had to be regarded as appropriate if a clearly defined state of the art existed from which the claimed subject-matter distinguished itself by further technical features (likewise **T 181/95**). This was confirmed by **T 162/82** (OJ 1987, 533), where the board added that the extent to which prior art was cited in the description could not determine whether the one-part or the two-part form of a claim was appropriate in a given case.

In **T 170/84** (OJ 1986, 400) it was pointed out that where a two-part claim would lead to a complex formulation it was no longer appropriate. In a one-part claim, the features required for the definition which belonged to the state of the art had to be sufficiently clear from the description. This principle has been upheld inter alia in **T 269/84**, **T 120/86**, **T 137/86** and **T 278/86**. The latter two decisions stipulated that a two-part claim was not justified if it gave an incorrect picture of the state of the art (likewise **T 181/95**). In **T 735/89** the board did not accept a one-part claim because it gave the impression that there was no closer state of the art.

In **T 99/85** (OJ 1987, 413) the board held that in opposition proceedings there was no reason officially to insist on a change in the wording of the claim simply because one feature in the preamble to a two-part claim did not belong to the state of the art. Furthermore, the board saw R. 29(1) EPC 1973 as an implementing regulation which did not constitute a ground for opposition (a similar view was held in **T 168/85**, **T 4/87**, **T 429/88** and **T 65/89**).

In **T 350/93** the patent application disclosed processes for the production of electro-active material and composite materials containing such material and included claims 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 in the prior art and the distinctive features were difficult to pick out in a simple and unambiguous form.

In **T 121/06** the board found that the combination of features in claim 1 was not known from the prior art. It would thus be detrimental to the logic of the claim to split up its features (i) to (iii) into their basic building blocks merely to indicate which blocks happen to be known from the prior art, without having regard to their inter-relationships. Thus, the two-part form of the claim was found to be inappropriate (R. 29(1) EPC 1973).

For further instances in which a claim in two-part form was not regarded as appropriate, see inter alia **T 345/89**, **T 378/92**, **T 723/93** and **T 181/95**.

#### 2.1.2 Two-part claims: preamble and characterising portion

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

In **T 13/84** (OJ 1986, 253) the board considered it could not be accepted as a general rule that the piece of prior art used for the preamble of the claim should be concerned with the same problem as the invention (likewise **T 287/02**). Generally, the apparatus or process constituting the prior art which was nearest to the invention would have to figure in the preamble of the claim, stating such features of it as were necessary for the definition of the claimed subject-matter and which were in combination already part of this prior art (see also **T 897/90**). R. 29 EPC 1973 (like R. 43 EPC) made no reference to the necessity or desirability that the characterising portion of the claim should fairly set out the inventive step. It was the subject-matter of the claim as a whole which embodied the invention and the inventive step involved (see **T 886/91** and **T 157/93**).

**T 850/90** confirmed that examination for inventive step should also take account of the features in the preamble, since the invention was defined by the claims as a whole. Likewise, in **T 980/95** it was held that there was no explicit requirement in R. 29(1)(a) EPC 1973 that a claim in two-part form be set up on the basis of the "closest" prior art, since the rule made no reference to the necessity or desirability for the characterising portion of the claim to set out the inventive step. Basing the two-part form on a particular state of the art which later turned out not to be the "closest" state of the art for the assessment of inventive step did not in itself contravene R. 29(1)(a) EPC 1973.

In decision **T 688/91** (discussed in this Chapter II.A.3.3) the board took the view that there was a breach of R. 29 and Art. 84 EPC 1973 where an incorrect distinction was made between the preamble and the characterising portion (likewise **T 181/95**).

### 2.2. More than one independent claim per category: Rule 43(2) EPC

R. 29(2) EPC 1973 was amended with effect from 1 January 2002. Prior to this date it permitted an application to contain two or more independent claims in the same category where it was "not appropriate" to cover the subject matter by a single claim. The

amended version of R. 29(2) EPC 1973 specified that an application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter involves (a) a plurality of interrelated products, (b) different uses of a product or apparatus or (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

The case law below relates to the amended version of R. 29(2) EPC 1973 (corresponding to R. 43(2) EPC), which is not applicable in opposition proceedings (see in this Chapter II.A.2.2.3).

### 2.2.1 Conditions

In case **T 56/01** each of the appellant's requests in the appeal stage contained three independent claims of the same category: one claim to a broadband communications module and two claims to a signal transport system. Hence, the board had to discuss compliance with R. 29(2) EPC 1973. The board concluded from the preparatory documents that condition (a), in spite of the distinction made between products and apparatus in the opening part of the Rule, also applied to apparatus claims. Nevertheless, the board did not consider that condition (a) was met by the two claims for the signal transport system because they were not interrelated. The board inferred from the examples in an early proposal to the Administrative Council for the amendment of R. 29(2) EPC 1973 that interrelated products were meant to be different objects that complement each other, or somehow work together. However, in the present case, the two different claims to the signal transport system were for essentially the same object. Moreover, the board defined the "alternative solutions" under R. 29(2)(c) EPC 1973 as different or even mutually exclusive possibilities. The claims at issue, however, related to one and the same solution with slightly different wording and level of detail. Moreover, even alternative solutions were only allowed under the condition that "it is not appropriate to cover these alternatives by a single claim". The board concluded from the preparatory documents that "not appropriate" meant "not possible or not practical". The intention was that, if it was possible to cover alternative solutions by a single claim, then the applicant should do so. In the case at issue, given the overlap and similarities in the features of the claims, the board held that it would have been entirely appropriate to cover the subject-matter of the signal transport system by a single independent claim with dependent claims as necessary.

In **T 659/03** the board had to decide whether the two contentious independent claims in the same category were covered by the exception in R. 29(2)(c) EPC 1973. The board held, first of all, that the appellant's wish to protect the two alternative processes by two independent process claims was justified. It then confirmed that there were alternative solutions to a particular problem, since the independent claims each contained all the features required to solve the problem addressed.

In **T 525/03**, the board also found that there were alternative solutions and held that it would not appear appropriate to cover those alternative solutions in a single independent claim. Rather, attempting to redefine the subject-matter of these claims in a more generalising way in one independent claim might lead to an objection under

Art. 123(2) EPC 1973. Such generalisation could furthermore be problematic under Art. 87 EPC 1973. In **T 895/05** too the board found that the requirements of R. 29(2)(c) EPC 1973 were satisfied.

In **T 671/06** the board found that a claim to a system comprising a power source (specified in broad functional terms) and claims to power sources (specified in structural terms) for that system did not fall under the exception in R. 29(2)(a) EPC 1973. It could be deduced from the examples provided in the Guidelines that inter-related products were, on the one hand, products which, although existing independently from each other as stand-alone products, only performed the invention when interacting with each other (e.g. plug and socket, transmitter - receiver), and, on the other hand, chemical products which were derived from their predecessors (i.e. intermediate(s) and final chemical product, gene - gene construct - host - protein - medicament). In contrast, the claimed system and the claimed power sources did not interact with each other, as the claimed system was completely self-contained in performing the invention. The clause "for a system according to" in the claims for the power sources meant "suitable for substitution in" rather than "suitable for interaction with". The board concluded that the term "inter-related products" in R. 29(2) EPC 1973 did not extend to a system which is self-contained in performing the invention and a product which is a constitutive substituent part for that system.

The board did not follow **T 133/02**, which had held that a system claim and a means claim relating to a component of the system were directed to inter-related products, similar to a plug and a connection system combining the plug with an adapted socket. In **T 671/06** the board argued that a claim directed to a connection system comprising the plug would be dependent on the claim to the plug, as it necessarily comprised all the features of the plug. However, R. 29(2) EPC 1973 was not intended to permit or prohibit claims which were permitted under R. 29(4) EPC 1973. The scope of application of these rules should be kept separate.

Likewise in **T 1232/07** the board, discussing the exceptions laid down in R. 29(2) EPC 1973, highlighted that exception (a) referred only to interrelated products and not to some kind of interrelationship between the subject-matter of independent claims. Such products were, on the one hand, objects which although existing independently of each other as stand-alone products only performed the distributed invention when interacting with each other (e.g. lock and key) and, on the other hand, chemical compounds derived from their precursors. Moreover, the board found that the contested claims were not permissible under exception (b), which referred to different uses of a product or apparatus and not to different uses of a concept as argued by the appellant (applicant).

### 2.2.2 Burden of proof

In **T 56/01** the board emphasised that, when an objection under R. 29(2) EPC 1973 arose, the burden of proof was shifted onto the applicant, i.e. it was up to the applicant to argue convincingly why additional independent claims could be maintained. Likewise the board in **T 1388/10** stressed that the onus of setting out and proving the case for the

application of an exception (in this case, an exception under R. 43(2) EPC) lay with the party seeking to rely on that exception. Thus, an applicant wanting more than one independent claim in the same category must, if the examining division objects, convincingly demonstrate that all the additional independent claims fall under one of the exceptions provided for in R. 43(2) EPC.

### 2.2.3 No applicability in opposition proceedings

In **T 263/05** (OJ 2008, 329) the board considered whether R. 29(2) EPC 1973 (R. 43(2) EPC) applied in opposition proceedings by virtue of the reference in R. 61a EPC 1973.

The board reviewed decision **G 1/91** (OJ 1992, 253), which had considered the effect of R. 61a EPC 1973 in the context of the requirement of unity. The Enlarged Board had taken the view that the reference to Chapter II was only a general one and that R. 61a EPC 1973 could only be taken to refer "to those requirements which would still be reasonable to demand of the new documents relating to the amended patent". The board in **T 263/05** concluded that R. 29(2) EPC 1973 did not apply in opposition proceedings to prohibit an amendment to a granted patent if it would be unreasonable to demand of the amended claims that they comply with this rule. This condition was satisfied in a case where otherwise R. 29(2) EPC 1973 would force the proprietor to abandon potentially valid subject matter already contained in the granted claims.

The board could not envisage any circumstances in which R. 29(2) EPC 1973 would be of any application in opposition proceedings. Once an amendment to the claims had been established to be necessary and appropriate having regard to the grounds of opposition, it would be unreasonable to impose the additional requirement that the amendment complied with the purely administrative provisions of R. 29(2) EPC 1973 (see also **T 987/05**, **T 1242/06**, OJ 2013, 42 and **T 85/08**). For example it is, in principle, possible in opposition proceedings to replace an independent claim as granted by two independent claims directed to specific embodiments covered by the independent claim as granted (see **T 223/97**, **T 428/12** and Chapter IV.D.4.1.4 b) "Filing new independent claims").

### 2.3. Conciseness and number of claims

Whilst R. 43(2) EPC provides for a restriction in the number of independent claims per category, there is no equivalent limit on the number of dependent claims or claims concerning a particular embodiment of an invention (R. 43(3) and (4) EPC). R. 43(5) EPC provides that the number of claims shall be reasonable with regard to the nature of the invention claimed.

Pursuant to Art. 84 EPC claims must not only be clear, but also concise. In a number of cases this has been interpreted as requiring claims to be concise both individually and in their entirety (see e.g. **T 79/91**, **T 246/91**). The examination of these requirements depends on the specific facts of the case (see also **T 596/97**, **T 993/07**).

A Markush formula is the most concise means of defining a class of chemical compounds in a claim (**T 1020/98**). The examining division had held that "formulating claims in a style that makes routine tasks in substantive examination unnecessarily difficult" was a contravention of Art. 84 EPC 1973. However, there is no legal basis in the Convention for a request to restrict the content of an independent claim so that substantive examination can be carried out with greater ease and less effort.

Regarding lack of conciseness because of a superfluous claim, see e.g. **T 988/02**.

In **T 1882/12** the board pointed out that R. 43(3) EPC neither prohibited including optional features in a claim nor made it mandatory to draft a separate dependent claim for each particular embodiment to be cited in the claims.

#### **2.4. Reference to the description or drawings: Rule 43(6) EPC**

Pursuant to R. 43(6) EPC claims shall not rely, "except where absolutely necessary", on references to the description or drawings in specifying the technical features of the invention. Expressions such as "as described in part...of the description", or "as illustrated in figure...of the drawings" are to be avoided.

In **T 150/82** (OJ 1984, 309) the board ruled that claims relying on references to the description in the specification in respect of all their technical features (so called "omnibus claims") were unallowable as contrary to R. 29(4) and R. 29(6) EPC 1973 (R. 43(4) and (6) EPC), unless absolutely necessary, e.g. when a plurality of conditions would not lend themselves to verbal expression without such a reference. Examples of such exceptions included inventions containing features or limitations which could only be expressed by means of drawings or graphs defining a particular shape or a plurality of conditions. In **T 271/88** the board upheld **T 150/82** and decided that it was not possible to base claims on an appendix showing structural chemical formulae designated as "chemical formulae incorporated within claims". The board held that it was quite evident that the terms "description" and "drawing" in R. 29(6) EPC 1973 were meant to cover structural chemical formulae (see also **T 752/94**).

In **T 1156/01**, the board considered that, if the invention was characterised by parameters, the method of and means for measurement should appear completely in the claim itself, whenever this was reasonable, or by reference to the description in accordance with R. 29(6) EPC 1973, if the method was so long that it would impair the conciseness of the claim (confirmed in **T 796/01**).

In **T 237/84** (OJ 1987, 309) the board stated that the purpose of reference signs in a claim (R. 29(7) EPC 1973) was to make the claims easier to understand. They did not limit the scope of the claim but did affect its clarity and might enable it to be expressed more concisely than would otherwise be possible (confirmed e.g. in **T 572/90**). In **T 986/97** the board allowed a reference to the drawings.

In decision **T 816/90** plasmids were defined by use of a designation which had no technical meaning per se. Moreover, their structure was defined by reference to a figure.

The board was of the opinion that such a definition of a plasmid was contrary to the requirements of Art. 84 EPC 1973 and therefore could not be accepted.

### 3. Clarity of claims

#### 3.1. Introduction and general principles

Claims lack clarity if the exact distinctions which delimit the scope of protection cannot be learnt from them (**T 165/84**, **T 6/01**). The claims per se must be free of contradiction (see **T 2/80**, OJ 1981, 431). They must be clear in themselves when read by the person skilled in the art, without any reference to the content of the description (**T 2/80**, **T 1129/97**, OJ 2001, 273; **T 2006/09**). The description is taken into account for the purposes of interpreting the claims and has in some cases also been considered when determining clarity and conciseness (see in this Chapter II.A.6.3).

In the key decision **T 728/98** (OJ 2001, 319) the board held that it followed from the requirement of legal certainty that a claim could not be considered clear within the meaning of Art. 84 EPC 1973 if it comprised an unclear technical feature (here "substantially pure") for which **no** unequivocal generally accepted meaning existed in the relevant art. This applied all the more if the unclear feature was essential for delimiting the subject-matter claimed from the prior art (see also **T 1399/11**). Likewise in **T 226/98** (OJ 2002, 498) the board held that the feature "as a pharmaceutical product" for defining a pharmaceutical standard of purity in a claim related to a product as such (here, famotidine form "B"), rendered said claim unclear in the absence of a generally accepted quantitative definition for the purported standard of purity.

In **T 586/97** the main claim was directed to an aerosol composition comprising a propellant and an active ingredient which was not defined. The board held that, when an essential ingredient comprised in a chemical composition is open to be labelled arbitrarily "active ingredient" or not, the meaning of that feature would be variable. Leaving the public in doubt as to which compositions are covered by the claim would be at variance with the principle of legal certainty. Therefore, the claim at issue failed to meet the requirement of clarity imposed by Art. 84 EPC 1973 (see also **T 642/05** and **T 134/10**).

In decisions **T 1129/97** (OJ 2001, 273) and **T 274/98** the board emphasised that, to satisfy the clarity requirement, the group of compounds/ingredients according to the claim had to be defined in such a way that the skilled person could clearly distinguish compounds/ingredients that belonged to the claimed group from those that did not (see also **T 425/98** regarding the expression "consisting of a major amount of").

In **T 390/08** the board held that the definition of a composition as "consisting of" compulsory and optional components met the requirements of Art. 84 EPC, as such a composition defined a "closed" composition from which elements other than those mentioned were excluded (see also **T 1190/01** and **T 1998/07**).

In **T 651/05** the board found that the introduction of vague terms created a lack of clarity due to different but equally valid interpretations (see also **T 621/03** and **T 127/04**). In

**T 1534/10** a claim contained the feature "that the data carrier (1) is constructed in a multi-layered manner as a laminate and contains at least two films (4, 5) which are integrated as a cover film (4) or as a core film (5) into the layer construction of the laminated data carrier". The board considered this wording ambiguous because it combined a plural form ("at least two films (4, 5)") with a singular form ("as a cover film (4) or as a core film (5)"), making it unclear whether the "at least two films" were each either a cover film or a core film, or whether together they formed a new film that was then either a cover film or a core film.

Where, on one of several possible constructions of a vaguely formulated claim, part of the subject-matter claimed is not sufficiently described to be carried out, the claim is open to objection under Art. 100(b) EPC 1973 (**T 1404/05**, see also Chapter II.C.7.1 "Art. 83 EPC and support from the description").

In **T 762/90** a lack of clarity was found in the use of a trade mark designating a whole series of products which differed from one another depending on phases in their industrial development. Moreover, the board expressed doubts about the use of such a designation, since it was uncertain whether the meaning of the trade mark would remain unaltered up to the end of the patent term (see also **T 939/92** and **T 270/11**). Similarly, in **T 480/98** the board considered that a trade mark product referred to in the characterising portion of claim 1 did not have a clear technical meaning, in that it could refer to a plurality of products having different compositions and properties. In consequence there was a lack of clarity, and the claim was not allowable. According to the board in **T 623/91** the exclusion of a composition by reference to the trade mark or trade designation would not introduce uncertainty and therefore not offend against Art. 84 EPC 1973, as changes in the range of chemical composition would not be likely without a corresponding change in the trade name or trade mark.

The preamble of claim 2 of the application in **T 363/99** contained a reference to a German patent specification. The board considered this to be a violation of Art. 84, second sentence, EPC 1973 since it was impossible to establish the scope of the matter for which protection was sought without consulting the reference document mentioned. The fact that the indication of the publication number of the reference document provided the most concise definition of the matter for which protection was sought (Art. 84 EPC 1973) was irrelevant by comparison. When formulating a patent claim, the form that was objectively more precise always had to be chosen (**T 68/85**, OJ 1987, 228).

Complexity as such is not equivalent to a lack of clarity - clarity under Art. 84 EPC is not at stake in a case of mere complexity of a claim provided the subject-matter for which the protection is sought and the scope thereof are clear and unambiguous for a person skilled in the art, either per se or in the light of the description (see **T 574/96** re Art. 84 EPC 1973). In **T 1020/98** (OJ 2003, 533) the board confirmed that compliance with the clarity requirement of Art. 84 EPC 1973 was not dependent on the time required to establish whether a given compound was covered by the product claim. The clarity requirement was not a basis for objecting to the complexity of a claim. Clarity within the meaning of that article merely required the claims to define the subject-matter for which

protection was sought clearly and unambiguously for the skilled person, if necessary in the light of the description.

In **T 75/09** the board held that where higher ranking requests are refused because a feature common to all requests does not meet the requirements of Art. 84 EPC, all lower ranking requests retaining this feature have to be refused for the same reason.

### **3.2. Indication of all essential features**

According to the established case law of the boards of appeal Art. 84 EPC has to be interpreted as meaning not only that a claim must be comprehensible from a technical point of view, but also that it must define the object of the invention clearly, that is to say indicate all the essential features thereof. All features which are necessary for solving the technical problem with which the application is concerned have to be regarded as essential features; see on this issue **T 32/82** (OJ 1984, 354) and **T 115/83**, confirmed inter alia in **T 269/87**, **T 391/91**, **T 409/91** (OJ 1994, 653), **T 694/92** (OJ 1997, 408), **T 1055/92** (OJ 1995, 214), **T 630/93**, **T 61/94**, **T 488/96**, **T 1167/97**, **T 203/98**, **T 260/01**, **T 1069/01**, **T 844/02**, **T 813/03** and **T 1540/12**. The indication of all essential features is seen as necessary to meeting the clarity requirement.

The board's opinion in **T 32/82** was also confirmed in **T 622/90**, where it was held that lack of clarity could be caused not only by the presence of an ambiguous feature, but also by the absence of a feature which was necessary for clarity (see also **T 630/93**).

The essential features should in particular comprise those which distinguish the invention from the prior art (**T 1055/92**, OJ 1995, 214; **T 813/03**). Regarding the delimitation of essential from non-essential features, see also **T 61/94**, **T 203/98**, **T 141/00** and **T 260/01**.

If from the wording of an independent claim it must be concluded that a solution of the problem of the invention is achieved by not needing a step, whereas this very feature according to the description cannot be abolished, but is necessary for a workable solution, then such a feature is to be considered, so the board in **T 888/07**, an essential feature of the invention. An independent claim missing this feature is therefore neither clear, nor supported by the description. See also in this Chapter II.A.5.

In **T 809/12** the board stated that, if an independent claim contained a feature defined by a result to be achieved which essentially corresponded to the problem underlying the application, to comply with Art. 84 EPC 1973 the remaining features of the claim had to comprise all essential features necessary for achieving that result.

According to the board in **T 818/03** a method claim which does not state sufficiently clearly the steps by which a particular result was achieved might still be considered clear provided the result to be achieved was clearly defined. A claim which defines a method of achieving some less than clearly defined result might also still be considered clear provided the steps that need to be taken to achieve that result are sufficiently clearly defined. However, a claim must be considered to lack clarity if, as here, it sets out



insufficiently clearly both the necessary parameters of the method and the relevant characteristic features of the result.

In **T 409/91** the invention related to fuel oils. In the description the use of certain additives was presented as an essential constituent of the fuel oil composition. As this feature was missing in the claims, the board found that they defined some other invention which was not sufficiently disclosed. Although the requirements of sufficient disclosure of the invention (Art. 83 EPC) and support by the description (Art. 84 EPC) were related to different parts of the patent application, they gave effect to the same legal principle that the extent of a patent monopoly, as defined by the claims, should correspond to the technical contribution to the art (see also Chapter II.C.7 "The relationship between Article 83 and Article 84").

In **T 2001/12** the board held that, if doubt that the invention as claimed is capable of solving the problem defined in the application arises because the claim fails to specify those features which are disclosed in the application as providing the solution to the problem, then the description and claims are inconsistent in relation to the definition of the invention, and an objection under Art. 84 EPC 1973 may properly arise that the claims do not contain all the essential features necessary to specify the invention (see also Chapter II.C.5 "Reproducibility").

In **T 1055/92** the board stated that since the primary function of a claim was to set out the scope of protection sought for an invention, it was not always necessary for a claim to identify technical features or steps in detail. This primary function of the claims should be clearly distinguished from the requirement that the European patent application had to disclose the invention in such a way that it enabled a person skilled in the art to carry out that same invention. Under Art. 83 EPC 1973 sufficient disclosure was required of a European patent application but not of an individual claim as such. A claim had to comprise the essential features of the invention; the essential features should in particular comprise those features which distinguished the invention from the closest prior art (see also **T 61/94**).

In **T 914/02** the appellant sought to derive from the alleged sheer complexity of the proposed solution an implied use of technical means, in particular a computer. According to the board, it was doubtful as a matter of principle whether complexity could be used to disqualify an activity as a mental activity (see also Chapter I.A.1.4.2 "Technical considerations and technical implementations"). Rather, it would appear generally that if computer means were indeed indispensable, they should be included in the claim as an essential feature of the invention.

**G 1/04** (OJ 2006, 334) concerned **diagnostic methods**. The Enlarged Board recalled that an independent claim should explicitly specify all essential features needed to define the invention (R. 29 EPC 1973), and that the meaning of these features should be clear for the person skilled in the art from the wording of the claim alone. The same should apply mutatis mutandis in respect of a claim relating to the subject-matter excluded from patent protection under Art. 52(4) EPC 1973 (Art. 53(c) EPC). These requirements served the overriding purpose of legal certainty. A diagnostic method within the meaning

of Art. 52(4) EPC 1973 had an inherent and inescapable multi-step nature. If diagnosis as the deductive medical or veterinary decision phase was a purely intellectual exercise, the feature pertaining to the diagnosis for curative purposes and the features relating to the preceding steps which were constitutive for making the diagnosis represented the essential features of a diagnostic method within the meaning of Art. 52(4) EPC 1973. Thus, in order to satisfy the requirements of Art. 84 EPC 1973, an independent claim relating to such a method must include these features. The Enlarged Board further held that, while essential features were for the most part of a technical nature, a non-technical feature constitutive for defining the invention must likewise be included as an essential feature in the independent claim. Thus, although diagnosis *stricto sensu* was a purely intellectual exercise unless it was carried out by a device, the feature pertaining to it was such an essential feature as to be included in the independent claim. See also Chapter I.B.4.5.1.d) "Clarity of a claim relating to diagnostic methods".

**G 1/07** (OJ 2011, 134) concerned **surgical methods**. The Enlarged Board referred to **G 1/04** and stated that a claim should explicitly specify all essential features and must be clear. Under Article 84 EPC, whether or not a step being or encompassing a surgical step excluded from patentability can be omitted either by using positive wording for such omission like "pre-delivered" or by simply leaving it out from the claim depends on whether the claimed invention is fully and completely defined by the features of the claim without that step. See also Chapter I.B.4.3.4 b) "Surgical step part of claimed method".

In **T 2102/12** the application related to medical robotic systems which allow to robotically move a tool on an articulated arm in response to the surgeon's manipulation of an input device. The board referred to **G 1/07** and held that claiming the measurement of the movement of the tool while "unclaiming" the movement itself rendered the claim unclear under Art. 84 EPC. The claimed method of intertwined non-surgical ("claimed") and surgical ("unclaimed") steps was not comparable to that underlying **T 836/08**.

In decision **T 923/08** the board decided as follows: If a method for recording measurements on the human or animal body necessarily entails a surgical step in order to fix to the human or animal body a measuring device which is indispensable for performing the method, this step has to be deemed an essential feature of the method and is comprised in such a method, even if the claim contains no method feature explicitly directed to it. Such a method is excluded from patentability under Art. 53(c) EPC. The exclusion of such a surgical step, whether by stating that the surgically attached measuring device was already fixed to the body before the start of the method or whether by use of a disclaimer, breaches Art. 84 EPC 1973 because such a process claim does not then include all the essential features of the claimed invention.

### 3.3. Clarity of broad claims

It was established in **T 238/88** (OJ 1992, 709) that the clarity of a claim is not diminished by the mere breadth of a term of art (e.g. "alkyl") contained in it, if the meaning of such term - either per se or in the light of the description - is unambiguous for a person skilled in the art (see also **T 950/97**, **T 103/00**, **T 1173/03** and **T 2068/10**; see also in this Chapter II.A.6).

In **T 523/91** the board held that the wording "plastics in combination with inserts" and "this insert is combined with the plastics granules in a wound or folded manner" did not cause the subject-matter of the claim to be unclear within the meaning of Art. 84 EPC 1973. Although the nature of the combination covered many possibilities, the resulting subject-matter of the claim was broad rather than unclear. The broadness of a claim could not be contested on its own but only in conjunction with other criteria such as novelty, inventive step or reproducibility.

Likewise in **T 688/91** the board stated that a broad claim was not to be equated with one lacking clarity. The claim was worded as follows: "Integrated microprogrammed apparatus [...] with apparatus to generate [...] T-states [...] characterised in that [...] the generation [...] of the [...] 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 [...]". The board held that, even if the words "such as" were understood to mean "for example", with the result that the subsequent information was not to be interpreted in a restrictive sense, the words "state parameters" were clear in as much as they conveyed the fact that T-state generation was to be effected as a function of any parameters representing one of the states of the apparatus. Although the claim was to be regarded as broad, since the terms used were open to general interpretation, breadth was not to be equated with an absence of clarity.

In **T 630/93** the board noted that Art. 84, first sentence, EPC 1973 implied that it was not always necessary for a claim to identify technical features or steps in full detail. The function of the essential features, although normally expressed in technical terms, was often to define the borders of an invention rather than details of the invention within those borders. Thus, essential features could often be of a very general character and in extreme cases indicate only principles or a new idea (see also Chapter II.C "Sufficiency of disclosure").

In **T 29/05** it was held that the existence of unrelated subject matter in the claims at issue was merely hypothetical, and no evidence had been provided by the examining division to support its possible presence in the prior art. In the absence of such evidence, each and every nucleic acid molecule (as specified) had to be assumed to be related to the subject matter disclosed in the application. The fact that a large number of possible nucleic acid sequences might fall within the scope of the claim was not a reason for raising a lack of clarity objection.

The principle whereby a broad claim is not unclear per se was applied in several decisions (see inter alia **T 456/91**, **T 393/91**, **T 530/94**, **T 950/97**, **T 1345/08**, **T 2220/09**).

### 3.4. Functional features

In **T 68/85** (OJ 1987, 228) the board found that functional features defining a technical result were permissible in a claim (i) if, from an objective viewpoint, such features could not otherwise be defined more precisely without restricting the scope of the invention, and (ii) if these features provided instructions which were sufficiently clear for the expert to reduce them to practice without undue burden, if necessary with reasonable

experiments. The board further pointed out that the effort to define a feature in functional terms had to stop short where it jeopardised the clarity of a claim as required by Art. 84 EPC 1973. The following decisions agreed with these findings: **T 139/85**, **T 292/85** (OJ 1989, 275), **T 293/85**, **T 299/86** (OJ 1988, 88), **T 322/87**, **T 418/89** (OJ 1993, 20), **T 707/89**, **T 204/90**, **T 752/90**, **T 388/91**, **T 391/91**, **T 810/91**, **T 822/91**, **T 894/91**, **T 281/92**, **T 490/94**, **T 181/96**, **T 750/96**, **T 265/97**, **T 568/97**, **T 484/98**, **T 1186/01**, **T 295/02**, **T 499/02**, **T 1173/03**, **T 404/06**, **T 959/08**, **T 560/09**, **T 556/11**, **T 754/13**. Some of these decisions (see e.g. **T 204/90**, **T 181/96**, **T 265/97**) examine a third criterion, which is not strictly speaking a requirement under Art. 84 EPC 1973 and requires that (iii) the state of the art does not stand in the way of using such functional and therefore general and broad terminology.

In **T 361/88** the board distinguished between two types of functional feature: the first type of functional feature is related to process steps which are known to the man skilled in the art and may easily be performed in order to obtain the desired result; the second type of functional feature consists of process steps defined by the result which is aimed at. This is also allowable as long as the man skilled in the art knows, without exceeding his normal skills and knowledge, what he has to do in order to obtain said result.

In case **T 720/92** the board noted that the term "clarity" in Art. 84 EPC 1973 referred 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 EPC 1973. 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 of the applicant is not objectionable under Art. 84 EPC 1973.

In **T 560/09** the board emphasised with regard to technical features expressed in general functional terms that the function must be able to be verified by tests or procedures adequately specified in the description or known to the skilled person. That meant not only that a feature in the claim must be comprehensible, but also non-ambiguous in that it could be determined without any ambiguity whether the claimed functional requirement was satisfied or not. Hence, means of distinction were mandatory in order to allow a definition by a function instead of by a structure in a claim.

In **T 243/91** it was stated that a functional feature was allowable if that feature provided a clear instruction to a skilled person to reduce it to practice without undue burden. In **T 893/90** the feature "being present in amounts and proportions just sufficient to arrest bleeding" was held to be a functional feature which defined a technical result which also constituted a testable criterion to be satisfied by the claimed pharmaceutical composition. Because such testing involved only routine trials, the adopted functional language was allowable. The introduction of a reference to specific amounts and/or proportions of the components would limit the claim and was not necessary. The situation in **T 893/90** was distinguished from the one before the board in **T 181/96**. Although in the former case the testing might appear prima facie bothersome, it was nothing out of the ordinary for the field of medicine, involving only routine trials. In the

case in suit, however, which concerned an apparatus for hydrostatically testing a sealing element of a threaded connection between two connected sections of pipe, there was no general type of pipe connections with generally well-defined ranges of dimensions which were thus generally available for verification of the functional features as such. In **T 1802/12** the board stated that the description did not contain any test to verify whether the functional features were present after having applied the claimed method. The board concluded that - contrary to the situation in **T 893/90**, where a test was available - the requirements of Art. 84 EPC were not met.

In **T 391/91** claim 1 set out in general terms the sequence of steps to be followed in order to put the invention into practice, i.e. in order to produce unicellular micro-organism host cells having INA (ice nucleation activity) or enhanced INA. The claim was in fact a generalisation from the particular examples. The 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. The claim was thus allowable under Art. 84 EPC 1973.

In **T 241/95** (OJ 2001, 103) the Swiss-type second medical use claim defined the disease or disorder to be treated with substance X as "condition which is capable of being improved or prevented by selective occupation of the serotonin receptor". The board held that this functional definition was unclear because no test was at hand to determine whether the therapeutic effects were a result of the newly discovered property of X of occupying the serotonin receptor or any other known or unknown property of that substance.

The board in **T 830/08** was concerned with the clarity of a claim directed to a second medical use. Such claims are considered clear only if the disease to be treated are clearly defined in it (e.g. **T 1048/98**). In the case in hand the disease to be treated was defined in functional terms as "the preferential induction of apoptosis in a first population of cells compared to a second population of cells wherein the cells of the first population are tumour cells". The question was whether the skilled person could clearly attribute a disease or group of diseases to this functional definition. In the board's view, this was not the case. The skilled person reading this definition in claim 3 would be struck, on the one hand, by the explicit mention and the specific definition of the first population of cells and by the explicit mention, but absence of specific definition of the second population of cells, on the other hand.

In **T 1074/00** the board considered that the term "capable of hybridising under stringent conditions" was sufficiently clear for the purposes of Art. 84 EPC 1973, having regard to the particular nature of the subject-matter (see also **T 29/05**). The board found that, although different experimental protocols might be applied for assessing hybridization under stringent conditions, this did not mean that these protocols would lead to different results as far as the detected nucleotide sequence was concerned. Moreover, it had to

be taken into account that the present claim defined its subject-matter also by a further functional feature relating to the biological activity.

In **T 151/01** the product claim at issue was intended to be restricted vis-à-vis the prior art embodiments by a functional feature, namely that the amount of the ingredient present in the composition must be a "therapeutic amount". The board had no doubt that the skilled person was perfectly able in most cases to decide whether a certain amount of a given non-steroidal anti-inflammatory agent had a therapeutic effect or not. However, it pointed out that, in order to establish the lower limit of the therapeutic amount for a given non-steroidal anti-inflammatory agent, in other words, in order to clearly establish the scope of protection of the claims, a standard test was required, since the result would strongly depend on the experimental method used. As there was no such test in the description or known to the skilled person, the board concluded that the claim did not fulfil the requirement of Art. 84 EPC 1973.

In **T 143/06** the density of the product which was "close to the theoretical maximum" was identified by the board as a functional feature of the product inextricably linked to the process conditions for obtaining the product. There was thus no objection of lack of clarity under Art. 84 EPC.

### **3.5. Characterisation of a product by a parameter**

In decision **T 94/82** (OJ 1984, 75) the board ruled that the requirement of clarity could be fulfilled in a claim to a product if the characteristics of the product were specified by parameters related to the physical structure of the product, provided that those parameters could be clearly and reliably determined by objective procedures which were usual in the art (see also **T 452/91**, **T 541/97**, **T 437/98**, **T 193/01**). It is not mandatory to give instructions in the claim itself as to how the product is to be obtained (**T 94/82**).

In **T 849/11** the board summarised case law on the requirements of Art. 84 EPC with regard to the characterisation of a product by parameters. The board stated that

- i. the claims must be clear in themselves when read by the skilled person (not including knowledge derived from the description; see **T 988/02**, point 3.3.1 of the Reasons and **T 1898/06**, point 2.2 of the Reasons);
- ii. the method for measuring a parameter (or at least a reference thereto) must appear completely in the claim itself (**T 1156/01**, point 2.3 of the Reasons; **T 412/02**, point 5.9 of the Reasons; **T 908/04**, point 3.8 of the Reasons; **T 555/05**, point 3.2.10 of the Reasons; **T 1497/08**, point 2.2 of the Reasons), and that
- iii. the applicant who chooses to define the scope of the claim by parameters should ensure that a skilled person can easily and unambiguously verify whether he is working inside or outside the scope of the claim.

The board further stated that the requirements of Art. 84 EPC can still be met if it can be convincingly shown that

- i. the method to be employed belongs to the skilled person's common general knowledge, or
- ii. all the methodologies known in the relevant technical field for determining this parameter yield the same result within the appropriate limit of measurement accuracy (**T 1156/01**, point 2.3 of the Reasons).

In **T 29/05** it was found that although different experimental protocols might be applied in the case in point for assessing hybridisation under stringent conditions, they were usual in the art (following **T 1084/00**).

In **T 307/06** the claims contained the added feature "and a  $T_g$  of less than 25°C". The Board noted that there were different methods for determining  $T_g$  (glass transition temperature). However, the mere fact that several methods existed did not render the claims unclear if at least one of the following conditions was met: (a) the different methods yield essentially the same  $T_g$  values for the same material, or (b) the person skilled in the art had associated the range of  $T_g$  values mentioned in claim 1 at issue with only one standard method of measurement. Neither condition (a) nor (b) was fulfilled. The board concluded that this left doubt as to which subject-matter was covered by claim 1, and thus rendered said claim unclear (see **T 728/98**, OJ 2001, 319, and **T 306/13**).

In a number of decisions the boards stress that it must be clear to the skilled reader from the claim itself how the parameters are to be determined, unless it can be demonstrated that the skilled reader would immediately know which method and conditions to apply even without any such indication in the claim.

In **T 412/02** the board held that the unambiguous characterisation in a claim of a product by parameters or by a mathematical relation between parameters necessarily required that each parameter could be clearly and reliably determined. In the board's view, it followed that the knowledge of the method and conditions of determination of the parameter was necessary for the unambiguous definition of the parameters and, as a consequence, for the unambiguous definition of a mathematical relation between them. Thus, in order to allow the matter for which protection was sought to be defined, it had to be clear from the claim itself when being read by the person skilled in the art exactly how the parameters should be determined. This would, as a rule, imply that the method of determination and the conditions of measurement which might have an influence on the value of the parameter should be indicated in the claim, either expressly or, if appropriate, by way of reference to the description according to R. 29(6) EPC 1973. Such indication would only become superfluous provided it could be shown that the skilled person would know from the outset which method and conditions to employ (see also **T 1156/01**).

In **T 1819/07** the board held that the parameter "average particle size" rendered the claim unclear as neither the type of average (volume, surface, number) nor a method for determining it was indicated in the claims (see also **T 967/08** and **T 45/10**).

In **T 992/02** the board took the view that whilst noting the general principle that the claims must be clear per se, the non-inclusion in the claim of the method whereby one of

the parameters characterising the composition claimed (level of formation of volatiles) could be measured was justified by the requirement that the claims be concise. It is considered that such a conclusion could be reached in the case in hand because the method was clearly identified in the description and did not give rise to any ambiguity.

In **T 2086/11** the parameter "mean aspect ratio" represented the mean of the individual aspect ratios, defined as the ratio of the major axis to thickness, of 50 aluminium flake particles having major axes of not more than 10 µm. The board held that this parameter did not enable to distinguish which subject-matter is covered by the claims and which is not. According to the method of measuring explained in the description, the investigated sample contained thousands of particles having a major axis of not more than 10 µm and the method described in the application did not give any precise indication of how to select such 50 particles. One operator, by selecting at random one group of 50 particles, could measure a mean aspect ratio within the claim whilst another operator, by selecting a different group of 50 particles, could find a value of mean aspect ratio outside the claim. The parameter "mean aspect ratio" was thus by itself insufficient to characterise the claimed product in a reliable way and did not comply with Art. 84 EPC 1973.

### 3.6. Unspecified features and relative qualities

Unspecified features are permitted as follows:

- (a) To avoid an undue limitation of the scope of the claim where the person skilled in the art can verify the result by tests involving nothing more than trial and error (**T 88/87**).
- (b) To render the meaning of the feature intelligible from the actual claim.

Thus, the objection in **T 487/89** was based on the fact that the claim had indicated both tenacity and toughness with a lower but no upper limit. The opposition division took the view that such "open-ended" parameters were always objectionable if they related to an inherently desirable characteristic. The board, however, held that whether the absence of an upper or lower limit was acceptable in a claim in any individual case depended on all the surrounding circumstances. Where, as in the case in question, the claim sought to embrace values as high as could be attained above a specified minimum level, given the other parameters of the claim, then such open-ended parameters could not normally be objected to. This decision was confirmed by **T 129/88** (OJ 1993, 598), **T 87/84**, **T 92/84**, **T 136/84**, **T 297/90** and **T 1018/05**, although in the last two cases a role was played by the question of sufficient disclosure (see also **T 989/95**, in which **T 487/89** was agreed with but not applied). In **T 586/97**, on the other hand, the board found that the absence from any independent claim of any upper limit on the amount of a particular detrimental but necessary component in the chemical composition claimed was at variance with the aim of the invention as set out in the description, namely, to decrease the percentage of the undesirable ingredient in the claimed composition. The claim was thus so broad it went beyond the scope of the invention as disclosed in the description. Therefore the requirement of Art. 84, second sentence, EPC 1973 was not met.

In **T 227/91** (OJ 1994, 491) the claims comprised a coating thickness defined by a formula with two parameters (a) and (t). Parameter (a) represented the thermal diffusivity



of the coating means and was therefore a feature inherent in the instrument. Parameter (t) represented the effective pulse time of the laser and was related to the laser operating conditions, not to the structure of either the laser or the instrument. The thickness defined in the claims was still connected with the mode of operation of the laser, that is, with a human factor irrelevant to the instrument per se. The extent of the protection conferred by the subject-matter of the claims was therefore regarded by the board as ambiguous and indefinite.

In **T 455/92** independent claim 2 was worded as follows: "Covering [...] for a pressing [...], characterised by: (a) a length which corresponds at least to the circumference of the shell face of the pressing to be covered, (b) an overall breadth sufficient to cover the shell face and both end faces of the pressing, and (c) a fold such that [...] the breadth [...] corresponds to the breadth of the shell face of the pressing [...]". The board did not see this as a breach of Art. 84 EPC 1973, since reference had been made to a physical entity which was known; hence the range of sizes was definable in so far as it excluded packaging materials for other physical entities. Furthermore, it was self-evident to a skilled person in this field that the size of the packaging material (the covering) was dependent on the physical entity to be packed. In **T 1020/13**, however, the definition of a claimed entity by reference to a second entity that was not part of the claim was deemed a breach of Art. 84 EPC.

In **T 860/93** the board decided as follows: Where a quality is expressed in a claim as being within a given numerical range, the method for measuring that quality must either be general technical knowledge, so that no explicit description is needed, or a method of measuring that quality needs to be identified (decision **T 124/85** followed). In contrast, where a claim specifies a relative quality, in this case that the products should be "water-soluble", it is not normally necessary to identify any method for its determination (see also **T 785/92**). In **T 860/95**, **T 649/97**, **T 939/98**, **T 1041/98**, **T 193/01**, **T 545/01** and **T 378/02** the boards confirmed that the use of a relative term in a claim may be accepted where the skilled person is able to understand the meaning of this term in a given context. However, in **T 728/98** and **T 174/02** the boards ruled that the relative terms at issue were unclear.

In **T 378/02**, claim 1 contained the terms "a smooth impermeable surface". The appellants argued that the definition of the surface was ambiguous, because "smooth" was a relative term. The board recalled that, while relative terms constituted a potentially unclear element due to their characteristic to change their meaning according to the context, they nevertheless could be considered as clear and their use therefore allowed, if their meaning was clear in the context of the whole disclosure (see e.g. **T 860/93**, OJ 1995, 47, for "water-soluble", **T 860/95** for "a long period of time", **T 649/97** for "transparent", **T 1041/98** for "thin plate", **T 193/01** for "thin film composite"); in contrast, in decision **T 728/98** the term "substantially pure" was considered unclear per se and in **T 1640/11** the terms "value" or "worth" inherently subjective). The board considered that, in the context of the disclosure of the patent in suit as a whole, the term "smooth" represented a clear definition.

In the application at issue in **T 1888/12**, claim 1 referred to undated ISO standards. The board pointed out that such standards were typically revised over time, and the possibility of substantial changes could not be ruled out (see **T 783/05**). The appellant's argument that the date to be taken into account was the application's priority date did not convince the board because there was no such indication in the description. In the board's view, the definition of technical features by general reference to ISO standards was not sufficiently clear. However, in **T 2187/09**, the board decided that the UNISIG standard mentioned in the claim merely provided context for the invention. Details of the standard were not needed to define the scope of the invention and to enable the skilled person to know if he was working within or outside the claimed scope.

### **3.7. Principles in connection with categories of claim**

In **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 case **T 410/96** concerning a data processing system the question arose whether it was permissible for a claim to a system to refer back to a claim to a method. The board held that, although R. 29(4) EPC 1973 mentioned a reference only in the context of a claim including all the features of the claim it referred to, this did not imply a contrario that a reference which did not fulfil this condition was necessarily impermissible. The board found that there was no a priori objection under Art. 84 EPC 1973 to an independent claim which partially drew its features from preceding claims of a different category. The essential features were thus incorporated in the disputed claim by reference, the claim thus complying with R. 29(3) EPC 1973 (R. 43(3) EPC).

In **T 1722/11** a claim related to a computer program resident on computer-readable media was defined by reference to a method claim. The execution of the method required co-ordinated interaction between various resources in a communication network. As these resources were at different, mutually remote locations, the board considered it unclear how the method referred to could be executed solely by a (single) computer program when run on a computer. The claim thus lacked clarity.

In decisions **T 418/92** and **T 453/90** the boards confirmed that it was possible for claims to relate to both physical activities and physical entities, in particular where the inventions concerned were fully disclosed as processes to the skilled person only if apparatus features were also included in the definition. In **T 1046/05** too the board confirmed the clarity of an apparatus feature in a process claim.

In **T 426/89** (OJ 1992, 172) the board decided that a claim relating to a "method for operating" a device was not "clear" (Art. 84 EPC 1973) if the claimed features only described how the device worked.

In **T 841/95** the board found that where a claim for an apparatus sought to define the invention by reference to features of the use to which the apparatus was to be put, a lack of clarity could result. However, if the subject-matter of the application was an apparatus and it was not viable to define the apparatus other than by reference to the said use, an apparatus claim directed to a combination of apparatus and use and defining the apparatus unambiguously could be clear.

Including in a device claim "for carrying out a process" a reference back to an earlier claim did not alter the fact that it was an independent (non-process) claim; rather, it limited the claimed device to being suitable to carry out the process referred to (**T 1017/98**).

A claim in **T 952/99** contained two different aspects of a use claim: on the one hand it defined the use of a particular physical entity to achieve an 'effect', and on the other it defined its use to produce a product. Although a use claim normally falls into either one category or the other, the board found that such a clear distinction was not possible in this case. The claim contained both application and process features and there was a technical affinity between the additional process step and the 'core' of the invention. Both the application and process features were thus technical features of the invention, so that their combination did not contravene R. 29(1) EPC 1973, the relevant criterion for assessing the extent to which the combination of a 'use' claim and technical process features was allowable from the point of view of clarity. The board drew a distinction with **T 796/91**, in which it had been held that the heterogeneous combination of process features and application features rendered the claim fundamentally unclear. That case had concerned the combination of a process claim and a use claim with no process claim at all. In contrast to the case before the board, the process features had apparently had no affinity to the application features, which had made it impossible to subsume the two different types of technical feature under one claim.

For the particularities of product-by-process claims, see in this Chapter II.A.7.

#### **4. Disclaimers**

In its decisions **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) the Enlarged Board of Appeal used the term "disclaimer" as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding specific embodiments or areas from a general feature. The requirements of Art. 84 EPC apply to a disclaimer as to any other feature of a patent claim (**T 2130/11**; see also **T 1487/09**).

Disclaimers play an important role in the drafting of claims and amendments. The principles concerning the allowability of disclaimers are set out in Chapter II.E.1.5.3 d) "Drafting of disclaimers – clarity".

## 5. Claims supported by the description

### 5.1. General principles

Art. 84 EPC stipulates that the claims must be supported by the description. This requirement means that the subject-matter of the claim must be taken from the description and it is not admissible to claim something which is not described.

In decision **T 133/85** (OJ 1988, 441) the board took the view that a claim which did not include a feature described in the application (on the proper interpretation of the description) as an essential feature of the invention, and which was therefore inconsistent with the description, was not supported by the description for the purpose of Art. 84 EPC 1973. The boards apply this principle as part of their established jurisprudence, see e.g. **T 409/91** (OJ 1994, 653), **T 939/92**, **T 322/93**, **T 556/93**, **T 583/93**, **T 659/93**, **T 482/95**, **T 616/95**, **T 586/97**, **T 687/98**, **T 1076/00** and **T 637/03**. However, the requirement for all essential features to be indicated is inferred to some extent from different provisions of Art. 84 EPC (see in this Chapter II.A.3.2). In **T 2049/10** the board considered the topic "essential feature missing" explicitly not a question of clarity but of support by the description (both subsumed under Art. 84 EPC).

Many boards further stress that the requirement for the claims to be supported by the description was intended to ensure that the extent of protection as defined by the patent claims corresponds to the technical contribution of the disclosed invention to the art (see **T 409/91**, OJ 1994, 653; **T 435/91**, OJ 1995, 188; **T 1055/92**, OJ 1995, 214; **T 659/93**; **T 825/94**; **T 586/97**; **T 94/05**, **T 1217/05**, **T 1694/12**, **T 809/12**). Therefore the claims must reflect the actual contribution to the art in such a way that the skilled person is able to perform the invention in the entire range claimed (**T 659/93**, **T 94/05**). A purely formal support by the description, i.e. a verbatim repetition of the mention of a claimed feature, cannot meet these requirements (**T 94/05**; see also **T 127/02** and **T 1048/05**). However, according to a different view, a review of the discussions in the various drafts to be found in the preparatory material suggests that the requirement for support of the claims was viewed rather as a formal matter to ensure that the description and claims had the same extent (**T 1020/03**, OJ 2007, 204). In the case in point the board concluded that Art. 84 EPC 1973 could not be used to force an applicant to cut down the scope of first or second medical use claims considered too broad compared to any use disclosed in the description. Other decisions in turn consider both aspects (see e.g. **T 297/05**).

The description and drawings are used to interpret the claims. For case law in relation thereto see in this chapter II.A.6.3.

### 5.2. Restrictions on generalising the technical information and examples adduced in the description

The question of the extent to which the technical information and examples adduced in the description may be generalised in the formulation of the claims is usually examined in the context of the requirements of Art. 83 EPC (see in particular Chapter II.C.4 "Clarity and completeness of disclosure"). Sometimes though it is also considered in the context

of the requirement for support by the description. See also Chapter II.C.7 "The relationship between Article 83 and Article 84 EPC".

In **T 2231/09** the patent concerned a method of representing and analysing images. Claim 1 of the main request set out that "... at least one said descriptor element is derived using only a subset of pixels in said image." The appellant had put forward an interpretation according to which a "subset" could correspond to all pixels in the image, which the board considered inconsistent with essential parts of the described embodiments. The board stressed that, while a certain degree of generalisation may be permitted, features as claimed should make it possible to clearly identify features of embodiments that are covered by the terms of a claim. Moreover, the generalised subject-matter as claimed should make it possible to understand the technical problem to be solved. The terms of a claim should be commensurate with the invention's technical contribution to the art. The board regarded the division of the image into regions and subsets as essential for achieving the technical effect underlying the invention. Therefore, claim 1 was not supported by the description and did not comply with Art. 84 EPC 1973.

In **T 659/93** the board held that the requirement that the claims should be supported by the description meant that they had not only to contain all the features presented as essential in the description, but had also to reflect the applicants' effective contribution by enabling the skilled person to carry out their teaching throughout the field to which they applied (similarly **T 332/94** with reference to **T 409/91**, OJ 1994, 653).

In **T 939/92** (OJ 1996, 309) the examining division had raised the objection that the disputed claim was an unreasonable generalisation of the examples contained in the description. However, the board held that it did not follow from Art. 84 EPC 1973 that a claim was objectionable just because it was "unreasonably broad". The expression "supported by the description" meant that the technical features stated in the description as being essential features of the invention described must be the same as those used to define the invention in the claims, for otherwise the claims would not be true definitions but mere descriptions. If a claim concerned a group of chemical compounds per se, an objection of lack of support by the description could not properly be raised for the sole reason that the description did not contain sufficient information in order to make it credible that an alleged technical effect (which was not, however, a part of the definition of the claimed compounds) was obtained by all the compounds claimed (see, with regard to Art. 83 EPC, also **T 2001/12**). The facts of the case in question differed from those underlying **T 409/91**.

In **T 94/05** the board pointed out that the requirement for the claims to be supported by the description was intended to ensure that the extent of protection as defined by the patent claims corresponds to the technical contribution of the disclosed invention to the art (see also **T 409/91** and **T 435/91**). Therefore the claims must reflect the actual contribution to the art in such a way that the skilled person is able to perform the invention in the entire range claimed (**T 659/93**). In the board's view, a purely formal support by the description, i.e. a verbatim repetition of the mention of a claimed feature, could not meet these requirements. To be allowable, functional features must disclose a

clear teaching which the skilled person can carry out without undue burden (see **T 68/85**, OJ 1987, 228). From this, it followed that the skilled person, at least after reading the patent specification, taking account of his common general knowledge, and possibly also after carrying out normal experiments, must actually be provided with at least a plurality of different embodiment variants. The reproducibility from the patent specification of the above-mentioned functionally defined feature was confined to the sole embodiment described. The board concluded that the functional definition in claim 1 did not adequately reflect the technical contribution described in the patent specification. Moreover, claim 1 and the description were contradictory, so that the claim was not supported by the description and the requirements under Art. 84 EPC were not met.

In **T 568/97** the claims defined the physiological effect to be achieved by a sufficiently high concentration of vasoactive intestinal polypeptide and/or prostaglandins as active agents in a pharmaceutical composition for transurethral administration. Neither individual values nor ranges of the amounts of vasoactive intestinal polypeptide and/or prostaglandins were disclosed in the patent. Furthermore, it was impossible to find out without undue burden the physiologically effective amounts as claimed merely on the basis of common general knowledge. The board held that the description of the patent lacked support within the meaning of Art. 84 EPC 1973 as to the amount of vasoactive intestinal polypeptide and/or prostaglandins required to achieve a physiologically effective dose. The functional feature not only had to be such that the skilled person could understand it; he also had to be able to implement it.

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

### **5.3. Bringing the description into line with amended claims**

In **T 977/94** the board decided that if the patentee amended his claims he had also to bring the description into line with them, because of its fundamental importance. An invention was only claimable to the extent that it was supported by the description (Art. 84, second sentence, EPC 1973), and the claims were interpreted in the light of the description (Art. 69 EPC 1973). So it was necessary to check that the essential elements of the invention claimed were also described as such in the description (see **T 300/04**).

In **T 295/02** the board found that an inconsistency between a claim and the provisional description was not a valid reason to refuse the application if the inconsistency arose from an amendment, if it was apparent that the text of the description was not intended by the applicant to form the agreed basis of any decision, especially one concerning its consistency with the amended claims, and if the appellant was prepared to adapt the description to conform to a definite allowable set of claims.

In **T 1808/06** the board recalled that, in order to meet the requirement of Art. 84 EPC that the claims have to be supported by the description, any disclosure in the description and/or drawings inconsistent with the amended subject-matter should normally be excised. Reference to embodiments no longer covered by amended claims must be deleted, unless these embodiments can reasonably be considered to be useful for highlighting specific aspects of the amended subject-matter. In such a case, the fact that an embodiment is not covered by the claims must be prominently stated.

Reference to Art. 69(1) EPC was not an appropriate justification for a less stringent adaptation of the description and in so far misleading as it could be understood to suggest a direct applicability of its contents at the examination or opposition stage. This was clearly not the case as Art. 69(1) EPC related to the scope of protection. It was only in situations where the removal of inconsistencies was not possible for procedural reasons (e.g. no amendment possible of the granted version) that - purely as an auxiliary construction - Art. 69(1) EPC could be invoked for an interpretation of the claimed subject-matter.

## 6. Interpretation of claims

### 6.1. General principles

The skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity, i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent. The patent must be construed **by a mind willing to understand**, not a mind desirous of misunderstanding (**T 190/99**; confirmed inter alia in **T 437/98**, **T 1084/00**, **T 920/00**, **T 552/00**, **T 500/01**, **T 1023/02**, **T 749/03**, **T 859/03**, **T 1241/03**, **T 1418/04**, **T 906/05**, **T 405/06**, **T 1537/05**, **T 1204/06**, **T 1771/06**).

However, in **T 1408/04** the board emphasised that this is understood to mean only that technically illogical interpretations should be excluded. A mind willing to understand did not require that a broad term needed to be interpreted more narrowly (even if, as in the case at issue, the narrower interpretation would refer to a structure which is very common, but not exclusive, in the technical field concerned).

In **T 1771/06** a claim specifically referred with closed language to the characterising part (GBSS gene fragment in the antisense direction) of the gene construct and, in an attempt to generalise, left open other structural elements necessary to operate the system ("comprising a fragment ... which codes for ....., said fragment consisting of a nucleotide sequence selected from ... SEQ ID No: ..."). According to the board this was not an unusual claim formulation. The board did not accept the appellant's argument that the scope of the claim extended to gene constructs which comprised any DNA in addition to the GBSS gene fragments. The skilled person would certainly take into account the fact that the gene construct was made for the purpose of introducing the GBSS DNA fragment into the potato cells and integrating it into the genome.

Accordingly, the gene construct would be thought to contain all necessary DNA elements for these steps to take place.

In **T 409/97** the board held that an erroneous statement in the introduction to the description was of no assistance in interpreting the claim and establishing the subject-matter for which protection was being sought, where this statement contradicted its actual content.

Two methods having no technical bearing on each other cannot form a single multi-step process (i.e. a "technical whole") even though they are linguistically linked together in a claim (**T 380/01**).

## **6.2. Meaning of terms**

In **T 759/91** and **T 522/91** the claims contained the expression "comprising substantially". The board was of the opinion that this term lacked clear, explicit boundaries and its scope needed interpretation. While in everyday language the word "comprise" might have both the meaning "include" or "comprehend" and "consist of", in drafting patent claims legal certainty normally required it to be interpreted by the broader meaning "include" or "comprehend" (see e.g. **T 457/02**). The word "substantially" imposed a restriction on the word "comprising" in the sense that "to a large extent only that is comprised which is specified". The boundaries of the term "comprising substantially" were therefore to be drawn where the essential characteristics of the specified subject-matter ceased. The scope of the term "comprising substantially" was therefore interpreted as being identical to that of "consisting essentially of". However, in view of the unequivocal character of the words "consisting of" as compared to "comprising", the expression "consisting essentially of" was to be given preference (see also **T 1730/09**).

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

In **T 1599/06** the board likewise had to interpret the term "comprising". It emphasised that the meaning of terms in a patent claim has to be determined from the point of view of the skilled person, who reads the claim in the context of the application and against the background of his/her common general knowledge. The claim was directed to a vaccinating agent comprising at least one specific purified and isolated protein of *Mycobacterium tuberculosis*. The examining division had interpreted the term "comprising" broadly and held that the claimed subject matter lacked novelty in relation to a partially purified protein fraction which, in their view, contained inter alia the specified proteins. In the board's view, however, the skilled person would derive from the application as a whole the information that the specific characteristic of the vaccinating agents according to the invention was their generation from isolated and purified *Mycobacterium tuberculosis* proteins. Therefore, he/she would have considered that the



definition in claim 1 covered vaccinating agents that, firstly, were constituted from isolated and purified proteins as mentioned in the claims and, secondly, contained those proteins as their main constituents.

In **T 1023/02** the board expressed its view that a claim using "comprising" language should generally not be construed as covering subject-matter which included further steps of a nature that would manifestly counteract the specified technical purpose of the step(s) recited in the claim.

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

In **T 405/00** the board considered that, according to the language conventional for patent claims in the field of chemistry, the wording "composition comprising a persalt" defined exclusively the mandatory presence of at least one of the specific chemical compounds belonging to the group of persalts.

### 6.3. Using description and drawings to interpret the claims

#### 6.3.1 General principles

The subject-matter of claims is governed by Art. 84 EPC and their function by Art. 69 EPC. According to Art. 84 EPC the claims define the invention for which protection is sought. According to Art. 69 EPC the claims determine the extent of the protection which will be conferred by the patent, through their definition of the invention. Under Art. 69 EPC the description and drawings are used to interpret the claims. The question arises whether it is possible to interpret the claims in the light of the description and drawings as provided in Art. 69 EPC merely in order to determine the extent of protection or whether it is also possible to do so in order to establish whether the conditions governing patentability and clarity have been satisfied.

In a number of decisions, such as **T 23/86** (OJ 1987, 316), **T 16/87** (OJ 1992, 212), **T 89/89**, **T 121/89**, **T 476/89**, **T 544/89**, **T 565/89**, **T 952/90**, **T 439/92**, **T 458/96**, **T 717/98**, **T 500/01**, **T 1321/04** and **T 1433/05**, the boards of appeal have laid down and applied the principle whereby the description and drawings are used to interpret the claims and identify their subject-matter, in particular in order to judge whether it is novel and not obvious. Likewise, in a large number of decisions (e.g. **T 327/87**, **T 238/88**, OJ 1992, 709; **T 416/88**, **T 194/89**, **T 264/89**, **T 430/89**, **T 472/89**, **T 456/91**, **T 606/91**, **T 860/93**, **T 287/97**, **T 250/00**, **T 505/04**), the boards interpreted the claims in the light of the description and drawings in order to establish whether they were clear and concise within the meaning of Art. 84 EPC 1973.

Occasionally, however, the limits to interpretation in the light of the description and drawings are emphasised (see in this Chapter II.A.6.3.6). A discrepancy between the claims and the description is not a valid reason to ignore the clear linguistic structure of a

claim and to interpret it differently (**T 431/03**) or to give a different meaning to a claim feature which in itself imparts a clear credible technical teaching to the skilled reader (**T 1018/02**; see also **T 1395/07**). In **T 1023/02**, though, "unfortunate" claim language ("transcription" instead of "translation") in contradiction with the terms used in the description was interpreted differently.

In **T 2221/10** the board referred to established case law according to which the description can be used as the patent's "dictionary" to assess the correct meaning of ambiguous terms used in claims (see in this Chapter II.A.6.3.3). However, if a term used in a claim has a clear technical meaning, the description cannot be used to interpret such a term in a different way. In case of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description.

In **T 197/10** the board explained that if the claims are worded so clearly and unambiguously as to be understood without difficulty by the person skilled in the art, there is no need to use the description to interpret the claims. In the event of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description. Thus, in the event of a discrepancy between clearly defined claims and the description, those elements of the description not reflected in the claims are not, as a rule, to be taken into account for the examination of novelty and inventive step.

### 6.3.2 Relevance of Article 69 EPC

Several decisions refer to Art. 69(1) EPC 1973 (**T 23/86**, OJ 1987, 316; **T 16/87**, OJ 1992, 212; **T 476/89**, **T 544/89**, **T 565/89**, **T 952/90**, **T 717/98**). Other case law emphasises that Art. 69 EPC 1973 (Art. 69(1) EPC) and its Protocol are primarily for use by the judicial organs which deal with infringement cases (see e.g. **T 1208/97**, **T 223/05**; also **T 1404/05**). The board in **T 556/02** made it clear that it applied solely the general principle of law applied throughout the EPC that a document had to be interpreted as a whole (see e.g. **T 23/86**, OJ 1987, 316; **T 860/93**, OJ 1995, 47). Art. 69 EPC 1973 was a specific application of this general principle (see also **T 1871/09**).

In **T 1646/12** the appellant, citing Art. 69(1) EPC and **T 1808/07**, argued that the opposition division should have used the description to interpret claim 1. The board stressed that Art. 69(1) EPC concerned only the extent of protection, which in turn was relevant only for the purposes of Art. 123(3) EPC and in national infringement proceedings. A general requirement that claims be interpreted with the help of the description could not be derived from Art. 69(1) EPC. It was nevertheless a general principle that a term could be interpreted only in context. Terms in a claim therefore had to be interpreted in the overall context of the claims set and the description. Two extremes had to be avoided. On the one hand, limiting features mentioned in the description but not in the claims could not be read into the latter (see in this Chapter II.A.6.3.4). They could not be inserted this way through interpretation, but only by amending the claims. On the other hand, claims could not be considered in complete

isolation from the description. The skilled person interpreting the claim had to at least ascertain whether the expressions used were to be understood in their ordinary literal sense or whether they had a special meaning defined in the description. Likewise, if the claims were obscure, the skilled person had no alternative but to search for clarification both in the other claims and in the description and drawings (see in this Chapter II.A.6.3.3). Using the description to interpret the claims was therefore admissible within certain limits, and sometimes even necessary; there was no need to invoke Art. 69(1) EPC.

In case **T 1279/04** the board did not share the appellant's (proprietor's) view that, for the purposes of assessing novelty in opposition proceedings, claims should be interpreted in accordance with Art. 69(1) EPC 1973 and the Protocol on its interpretation. Art. 69(1) EPC 1973 and its Protocol related to the extent of protection conferred by the patent or patent application, which was primarily of concern in infringement proceedings. They served to determine a fair protection - inter alia by reference to the description and drawings - in circumstances where the claim wording was set in stone. By contrast, in examination and opposition proceedings the value of future legal certainty was paramount. In this forum the function of the claims was to define the matter for which protection was sought (Art. 84 EPC 1973, first sentence). There was no case for anything other than a strict definitional approach, given that in this procedural stage the claim could and should be amended to ensure legally certain patentability, in particular novelty and inventive step over any known prior art. Amendment rather than protracted argument should be the answer to genuine difficulties of interpretation in all aspects of the examination and opposition procedure, it being acknowledged that amendments to a patent as granted should be occasioned by grounds for opposition. In **T 1534/12** the board held that the specific vocabulary of a patent, in particular that of the claims, had to be construed from the standpoint of a skilled person reading the specification with a mind desirous to understand the intention behind it. The description and the drawings created the context and cast a light on the meaning to be reasonably attributed to the vocabulary employed in the claims. The "strict definitional approach" mentioned in **T 1279/04** should take place in this context. Any isolated, artificial, technically meaningless interpretation out of this context was to be carefully avoided.

Likewise in **T 1808/06** the board emphasised that, when the description has to be amended with regard to the requirement of Art. 84 EPC, it was only in situations where the removal of inconsistencies was not possible for procedural reasons (e.g. no amendment possible of the granted version) that - purely as an auxiliary construction - Art. 69(1) EPC could be invoked for an interpretation of the claimed subject-matter.

### 6.3.3 Interpretation of ambiguous terms or confirmation of the text of a claim

Many decisions which use the description and drawings to interpret the claims concern the interpretation of relative, ambiguous or unclear terms or cite the description merely to confirm the most obvious interpretation of the text of a claim (e.g. **T 23/86**, OJ 1987, 316; **T 16/87**, OJ 1992, 212; **T 327/87**, **T 121/89**, **T 476/89**, **T 565/89**, **T 952/90**, **T 439/92**, **T 458/96**, **T 717/98**, **T 556/02**).

In decision **T 50/90** the board pointed out that the description and drawings were used to interpret relative terms contained in the claims when the extent of protection had to be determined.

When the technical content of the claims and the description clearly establish how an invention operates, these features cannot be disregarded for the purposes of assessing patentability by interpreting them merely as defining an intended use (**T 458/96**).

In several decisions the boards stated that terms used in patent documents should be given their normal meaning in the relevant art, unless the description gives them a special meaning. The patent document may be its own dictionary (**T 311/93**, **T 1321/04**, **T 1388/09**; see also in this Chapter II.A.6.3.5; as to the limits, see **T 2221/10**). Likewise in **T 500/01**, the board considered that a patent, being a legal document, may be its own dictionary. If it was intended to use a word which is known in the art to define a specific subject-matter to define a different matter, the description may give this word a special, overriding meaning by explicit definition. Consequently, a claim, the wording of which is essentially identical to a claim as originally filed, can nevertheless contravene the requirements of Art. 123(2) EPC, if it contains a feature whose definition has been amended in the description in a non-allowable way.

In **T 1023/02** the invention was based on the recognition that the genes for a specific viral protein (ICP34.5) expressed in infected cells determine the ability of herpes simplex viruses to destroy central nervous system tissue. The respondent argued that a post-published document revealed the existence of an ORF-P gene coincident with but anti-sense to the ICP34.5 gene. Therefore, in view of the term "only", the claim had to be interpreted as requiring that the first method step did not interfere with the expression of this ORF-P gene. The board, however, pointed out that it was apparent from the description that the patentee had not envisaged the existence of this gene. The skilled reader would therefore, in the light of the description, not interpret the subject-matter of claim 1 in the way advocated by the respondent. Accordingly post-published knowledge of further technical details and/or complications could not justify this interpretation.

#### 6.3.4 Reading additional features and limitations into the claims

In case **T 223/05** claim 18, which was directed to a certain compound, was silent on the value of X, when Y was not present. The opposition division had held that the skilled reader would have referred to the content of the description and would have deduced that all the claimed compounds had a Michael acceptor side-chain. Hence, the skilled reader would have corrected the lack of information in claim 18 by referring to the content of the description and would have concluded that, in the absence of Y, X had to be a Michael acceptor side chain. For this reason the subject-matter of said claim was novel. The board, however, emphasised that Art. 69 EPC 1973 and its Protocol did not provide a basis for excluding what was literally covered by the terms of the claims. Applying this to the case at issue, the board considered it inconsistent with proper claim interpretation to read into claim 18 a particular meaning for X which only appeared in the description, and then to rely on this feature to provide a distinction over the prior art (see **T 881/01**). In **T 681/01** too it was stressed that Art. 69 EPC 1973 and its Protocol

could not be relied on to read into the claim an implicit restrictive feature not suggested by the explicit wording of the claim. See also **T 1105/04** and **T 299/09**.

In **T 932/99** claim 1 was directed to a product per se. The claim defined only the structure of a membrane as such, independently from its installation in an apparatus for gas separation. The board pointed out that, for this reason, the indication in the claim "capable of separating oxygen from oxygen-containing gaseous mixture" merely served the purpose of defining a capability of the claimed membrane, without imparting any limitations on any actual use of the structure claimed. The respondents had argued that, if claim 1 was interpreted in the light of the description, those limitations would be apparent. However, the board held that a distinction had to be drawn between, on the one hand, the fact that it might be necessary to take into account any explicit definition as given in the description for interpreting a claim's term and, on the other hand, the attempt to use Art. 69 EPC 1973 as a basis for reading limitations derived from the description into claims in order to avoid objections based on lack of novelty or inventive step. The latter approach to interpretation, whereby features mentioned only in the description were read into claim 1 as necessary limitations, was incompatible with the Convention (**T 1208/97**; see also **T 945/99**, **T 2049/07**).

In **T 1208/97** certain known molecules were encompassed by the terms of the product claim. Appellant 1 had argued that a novelty objection could not apply because the patent specification stated the clear intention not to cover these molecules. The board did not agree with this view. For the purposes of judging novelty, Art. 69 EPC 1973 offered no basis for reading into a claim features which could be found in the description. As this article and the Protocol concerned the extent of protection, they were primarily for use by the judicial organs which dealt with infringement issues. According to the board, it had to be established whether or not the wording of claim 1, independently of any alleged intention derivable from the description, allowed a clear distinction between the claimed molecules and the known molecules.

In **T 1018/02** the board emphasised that, although a claim must not be interpreted in a way which was illogical or did not make sense, the description could not be used to give a different meaning to a claim feature which in itself imparted a clear, credible technical teaching to the skilled reader. This also applied if the feature had not been initially disclosed in the form appearing in the claim (see also **T 373/01** and **T 396/01**).

In **T 121/89** the board used the description to interpret an ambiguous term ("loose ignition charge"), but at the same time stressed that only features recited in or deducible from the claims could be set forth to distinguish the invention from the state of the art. The examples cited in the description did not limit the scope of the claims unless they were explicitly mentioned in them (see also **T 544/89**).

In **T 416/87** (OJ 1990, 415), on the other hand, the board was confronted with the situation where a feature was not included in the claims which the description on its proper interpretation specified to be an overriding requirement of the invention. The board held that, following Art. 69(1) EPC 1973 and its Protocol, the claims might be interpreted as requiring this as an essential feature, even though the wording of the

claims when read in isolation did not specifically require such feature (confirmed in an obiter dictum in **T 717/98**).

#### 6.3.5 Use in the examination relating to the clarity requirement pursuant to Article 84 EPC

In a large number of decisions (see in this Chapter II.A.6.3.1) the boards interpreted the claims in the light of the description and drawings in order to establish whether they were clear and concise.

In **T 238/88** (OJ 1992, 709) the board stated that the fact that the features were not in fact usual terms of art did not rule out clarity and conciseness, since according to Art. 69 EPC 1973 the description should be used to interpret the claims.

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

Likewise, in **T 860/93** (OJ 1995, 47) the board assumed that the description might be used to determine whether the claims were clear. In so doing it took its cue from the general legal principle whereby the best interpretation is that made from what precedes and what follows. It accepted the reasoning in **T 454/89** (see below), namely that the description could only be used to determine the extent of the protection conferred and not to establish clarity, only in the case of claims which were self-contradictory, but not in general (see also **T 884/93** and **T 287/97**). In **T 523/00**, **T 1151/02** and **T 61/03**, the boards stated that a patent may be its own dictionary (see also in this Chapter II.A.6.3.3).

However, a number of decisions point out the limits to the use of the description and drawings in the examination relating to the clarity requirement.

**T 2/80** (OJ 1981, 431) pointed out that a claim did not comply with the requirement of clarity laid down in Art. 84 EPC 1973 if it was not, per se, free of contradiction. It had to be possible to understand the claims without reference to the description (see also **T 412/03**). In decision **T 454/89** the board shared this view and explained that Art. 84 EPC 1973 requires that claims must be clear in themselves when read using normal skills, including knowledge of the prior art but not any knowledge derived from the description contained in the patent application or the amended patent. While it was true that Art. 69 EPC 1973 allowed the description to be used to interpret the claims, it was only concerned with the extent of protection conferred as one of the effects of an application or patent whenever that extent had to be determined, particularly for third parties. It was not concerned with a claim's definition of the matter for which protection was sought, as was Art. 84 EPC 1973. In the course of the examination of an opposition, therefore, the applicant or patentee could not rely on Art. 69 EPC 1973 as a substitute

for an amendment which would be necessary to remedy a lack of clarity. The board took the same line in decision **T 760/90**.

In **T 1129/97** (OJ 2001, 273), the board held that the mere fact that the precise meaning of an unclear term ("low alkyl") was expressly disclosed in the description but not in the claims did not mean that the latter met the clarity requirement. The clarity stipulation under Art. 84 EPC 1973 concerned only the claims, and therefore - according to the established case law of the EPO boards of appeal - required that they be clear in themselves, without there being any need for the skilled person to refer to the description. True, under Art. 69(1) EPC 1973 the description was to be used to interpret the claims. But Art. 69 EPC 1973 concerned only the extent of protection where this was at issue, e.g. with third parties, and not (as in Art. 84 EPC 1973) the definition of the matter to be protected by a claim (confirmed in **T 56/04** and **T 64/03**).

In **T 49/99** the board held that since clarity was a claim requirement, a clarity deficiency in the claim wording was not rectified by the fact that the description and the drawings would help the reader to understand the technical subject-matter that the claim was intended to define.

In **T 56/04** the board pointed out that a claim containing an unclear technical feature prevented its subject-matter from being identified beyond doubt. That was particularly the case if the unclear feature was meant to delimit the claimed subject-matter from the state of the art. The board therefore took the view that a vague or unclear term which was used in the claim and a precise definition which was to be found only in the description could be allowed only in exceptional cases to delimit the claimed subject-matter from the state of the art. Such an exception pursuant - *mutatis mutandis* - to R. 29(6) EPC 1973 exists if the precise definition - for whatever reason - cannot be incorporated into the claim, and the precise definition of the vague or unclear term is unambiguously and directly identifiable by a skilled person from the description. In **T 56/04** the board said that an exception was not involved. The specific value of "approximately 1 mm" disclosed in the description could have been incorporated into the claim itself instead of "slightly less than [...]".

On the extent to which it must be clear from the claim itself how parameters are to be determined when a product is characterised by parameters, see in this Chapter II.A.3.5. In a number of decisions it is stressed that the claims must be clear in themselves when read with the normal skills but without any knowledge derived from the description (see e.g. **T 412/02** and **T 908/04**). In **T 992/02** however the board deemed it justified in the case in point for the claim not to include the procedure for measuring the parameter.

#### 6.3.6 Definition of the scope of protection with regard to infringement not within the EPO's competences

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 observed that the EPO concerned itself in opposition appeal proceedings with the extent of protection conferred by a patent only for the purposes of examining compliance with Art. 123(3) EPC 1973.

Beyond that, interpreting the extent of protection was a matter for national courts dealing with infringement cases. Whilst the EPO made it clear how terms of art used in the claims should be understood, it should not proffer any further interpretation of the patent's future scope beyond that (see also **T 740/96**). In line with this thinking, the board in **T 439/92** and **T 62/92** interpreted the claims with a view to identifying their subject-matter.

## **7. Product-by-process claims**

### **7.1. Introduction**

Under Art. 64(2) EPC (1973 and 2000) the protection conferred by a process patent extends to the products obtained directly by the process, even if they are not patentable per se. Certain applicants tried to acquire protection for known products by using process claims to define them, arguing that it follows from Art. 64(2) EPC 1973, that a product is rendered novel by the fact that it is produced by means of a new process.

The boards of appeal did not accept this line of argument and made a distinction between claims to a new and inventive product defined by its method of manufacture and claims to a new and inventive process, the protective effects of which also extended to the direct products of this process.

The first decision in this regard was **T 150/82** (OJ 1984, 309). The board stated that claims for products defined in terms of processes for their preparation (known as "product-by-process" claims) were admissible only if the products themselves fulfilled the requirements for patentability and there was no other information available in the application which could have enabled the applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter (established case law, see e.g. **T 956/04** and **T 768/08**; in **T 863/12**, the board considered a claim worded as a product-by-process claim admissible in the light of **T 150/82**).

### **7.2. Requirement that the claimed product must be patentable**

In decision **T 248/85** (OJ 1986, 261) it was stated that a product could be defined by the use of various parameters, such as its structure or its process of preparation. The use of a different parameter by which to define a particular product could not by itself give the product novelty. Furthermore Art. 64(2) EPC 1973 did not confer novelty upon a claim which was formulated as a "product-by-process" when no novelty existed in such product per se, and did not entitle or enable an applicant for a European patent to include such claims in his patent which did not satisfy the requirements of Art. 52(1) EPC 1973.

In **T 219/83** (OJ 1986, 211) the board stated that product-by-process claims had to be interpreted in an absolute sense, i.e. independently of the process. If their subject-matter as such was new, they still did not involve an inventive step merely because the process for their preparation did so. In order to be patentable, the claimed product as such had to be a solution to a separate technical problem which was not obvious in the light of the state of the art (see also **T 223/96**).



These criteria were confirmed and applied in many decisions (see for instance **T 251/85**, **T 434/87**, **T 171/88**, **T 563/89**, **T 493/90**, **T 664/90**, **T 555/92**, **T 59/97**, **T 1164/97**, **T 238/98**, **T 748/98** and **T 620/99**).

The board clarified the conditions for novelty of product-by-process claims in decision **T 205/83** (OJ 1985, 363). It stated that the polymer product of a known chemical process was not rendered new merely by virtue of a modification to the process. If a chemical product could not be defined by structural characteristics but only by its method of manufacture, novelty could be established only if evidence was provided that modification of the process parameters resulted in other products. It was sufficient for this purpose if it was shown that distinct differences existed in the properties of the products. This evidence might not include properties which could not be due to the product's substance parameters (see also **T 279/84**, **T 151/95**, **T 728/98**, **T 564/02** and **T 1247/03**).

In **T 300/89** (OJ 1991, 480) it was stated that the application lacked novelty if the claim neither defined the product structurally nor mentioned all the specific conditions needed to obtain necessarily the products whose novelty could be demonstrated, e.g. by means of comparative tests. Similarly, in **T 552/91** (OJ 1995, 100) the board ruled that the claim had to include all the process parameters required for unambiguously defining the claimed substances as inevitable process products. As chemical reactions only rarely took one particular course and therefore only rarely led to uniform substances, it was generally necessary to indicate not only the starting materials and reaction conditions, but also the method by which the reaction mixture was processed to obtain the claimed substances. This case law was confirmed in **T 956/04**, where the board considered that without clearly indicating the specific starting materials and the specific reaction conditions, the "obtainable-by" features as claimed failed to unequivocally define the claimed catalysts as inevitable process products.

In **T 728/98** the board stated that the general rule that the level of purity of a low molecular chemical compound could not entail novelty was also valid in the case of a product-by-process claim where the purity level was the inevitable result of the preparation process indicated in the claim. In the case at issue the appellant (applicant) had not been able to prove the existence of an exceptional situation where all attempts had failed to achieve a particular level of purity by conventional purification methods. See also Chapter I.C.6.2.4 "Achieving a higher degree of purity".

In **T 803/01** the board noted that there was no statement whatsoever in **T 205/83** (OJ 1985, 363) which prohibited the presence of parameters relating to impurities in a claim for reasons of clarity. The parameters relating to the purity of the polylactides were technical features in line with R. 29(1) EPC 1973. This was considered to be a relevant criterion for assessing the extent to which the use of purity parameters in a product claim was allowable from the point of view of clarity (**G 2/88**, OJ 1990, 93).

In **T 394/03** the board ruled that improved product quality achieved by means of a process did not generally constitute, in a product-by-process claim, a structural feature giving rise to novelty or inventive step. In the case at issue, a decorated ceramic product

was claimed which differed from known products of this type only by virtue of its better quality, which had been achieved by means of the process according to the invention.

In **T 564/02**, when examining whether the product itself met the requirements for patentability, the board had to deal with the burden of proof. The respondent (opponent) had raised an objection of lack of novelty which was based on the disclosure in an example in a prior art document. The board observed that the validity of this objection rested exclusively on the validity of certain assumptions made by the respondent with respect to parameters of the product disclosed in prior art. In such a case, the concept of the balance of probabilities could not be applied for the assessment of the validity of each assumption; it had to cede to a stricter criterion close to absolute conviction. In other words, there should be a degree of certainty which is beyond reasonable doubt.

### **7.3. Requirement that the claimed product cannot be described in any other way**

The criterion laid down in **T 150/82** (OJ 1984, 309), whereby it must be impossible to define the claimed product other than in terms of a process of manufacture is now established case law (see e.g. **T 333/93**, **T 749/95**, **T 950/97**, **T 1074/97**, **T 933/01**).

In **T 320/87** (OJ 1990, 71) the board stated that product-by-process claims were admissible for hybrid seeds and plants when they were not individually definable biological entities which could be characterised by their physiological or morphological features.

In **T 130/90** the board had to rule on recombinant monoclonal antibodies having two different specificities and produced by a process involving trioma cells or quadroma cells and thus producing antibodies in a native form. The patentability of the process was not questioned. The process known from prior art chemically recombined antibody half-molecules. At issue was the validity of the product claim. The prior art did not disclose how fully re-associated molecules, i.e. with the same structure as native antibodies, which might be contained in the mixture of hybrids, could be screened out and isolated from molecules which were chemically altered. The board allowed a claim for bispecific recombinant monoclonal antibodies comprising intact immunological chains produced by the process claimed in the independent process claims of the patent in suit. Defining the antibodies by their process was the only way of delimiting them vis-à-vis the prior art.

In **T 552/91** (OJ 1995, 100) it was held that where a European patent application relates to chemical substances originally defined by an incorrect chemical structural formula, correction of which is not allowable under R. 88 EPC 1973, replacement of the incorrect formula by the correct one infringes Art. 123(2) EPC 1973. Nevertheless, the submission of a "product-by-process" claim is compatible with Art. 123(2) EPC 1973 if it contains all the measures required to obtain this result (starting materials, reaction conditions, separation).

#### **7.4. Applicability of the principles for product-by-process claims to use claims**

In **T 81/14** the board held that when considering the definition of a product in terms of its production process the principles developed in the jurisprudence for the product-by-process claims are in general to be applied, also in the case of a claim directed to the use of that product. Claim 1-7 of one of the auxiliary requests were directed to a method of producing a sintered cemented carbide body. Claim 8 was directed to the use, for the production of a cutting tool, of a sintered cemented carbide body obtained according to the method of any one of claims 1-7. Hence, claim 8 comprised process and product features and was notionally equivalent to a claim directed to a process for the production of a cutting tool using the sintered cemented carbide body (see **G 2/88**, point 5.1 of the Reasons, OJ 1990, 93). Although the claim was not directed to a product but to a process, the board stated that the principles underlying the assessment of the clarity of product features should not depend on whether such product features appear in a claim directed to a product or in a claim directed to a process. Applying the principles developed in the jurisprudence for product-by-process claims to claim 8, the board stated it would have been possible to define the sintered body in terms of structural features, namely composition, microstructure and mechanical properties. Accordingly, the use of a product-by-process definition in claim 8 resulted in a lack of clarity.

#### **7.5. Combination of product and process features**

In decision **T 148/87** the board stated that it was admissible to combine product parameters and process parameters in the same claim. In **T 129/88** (OJ 1993, 598) the board was of the opinion that the inclusion in a product claim of one or more process features might be permissible if their presence was desirable having regard to the impact of the national laws of one or more contracting states (see also **T 592/95** and **T 288/02**). See also in this Chapter II.A.3.7.

#### **7.6. Extension of protection conferred by product-by-process claims**

In decision **T 411/89** the board had to decide whether the amendment of a product-by-process claim from "obtained" to "obtainable" extended the protection conferred by the patent. The board took the view that the protection was not extended because the amendment did not modify the definition of the product which was claimed per se from the beginning and because the process used for its characterisation remained the same.

In decision **T 423/89**, by restricting the claim to only one of a number of manufacturing processes specified in the original claim and disclosed in the description, the patent proprietors had ceased to claim absolute product protection and had undertaken a significant limitation of their claim. There were therefore no objections under Art. 123(3) EPC 1973. The change in category from a product-by-process claim to a manufacturing process claim was also admissible in this case, as the protection afforded by the granted patent had to extend to all those methods of manufacture covered by the processes described in the claim and disclosed in the patent specification.

In **T 20/94**, however, objections under Art. 123(3) EPC 1973 led to the board's refusing a change from process claims to a product-by-process claim by way of amendment, as despite the fact that a product-by-process claim was characterised by the process for its preparation, it nevertheless belonged to the category of claim directed to a physical entity and was a claim directed to the product per se. The scope of protection conferred by a product claim exceeded the scope conferred by a process claim under Art. 64(2) EPC 1973. See also Chapter II.E.2.6 "Change of claim category".

## **8. Claims fees**

Until 31 March 2008, under R. 31(1) EPC 1973 and then the new R. 45 EPC, any European patent application comprising more than ten claims incurred payment of a claims fee in respect of each claim over and above that number. With effect from 1 April 2008 the number of fee-exempt claims was increased to fifteen. For international applications entering the European phase the corresponding provisions are R. 110 EPC 1973 and R. 164 EPC.

The Legal Board of Appeal ruled in case **J 9/84** (OJ 1985, 233) that R. 31(1) EPC 1973 was to be interpreted as meaning that claims numbered 1 to 10 upon filing of the European patent application - or transmittal to the EPO of the international application under the PCT - were exempt from fees, and that claims numbered 11 onwards were not. Accordingly, abandoning a fee-exempt claim after filing - or transmittal - did not have the effect that its fee exemption was transferred to another claim.

### **8.1. Number of claims**

The question has arisen on a number of occasions as to whether part of, or an annex to, the description of a European patent application comprising a series of numbered paragraphs drawn up in the form of claims should be regarded as claims for the purposes of R. 31(1) EPC 1973.

In **J 5/87** (OJ 1987, 295) the application contained, under the heading "Claims", ten claims; however it contained 33 further claims which were annexed to the description as preferred, numbered embodiments presented in the form of claims. The addendum appeared in form as well as in substance only to consist of claims within the meaning of Art. 84 and R. 29 EPC 1973. Furthermore, the appellant had admitted that the addendum had been included in the application in order to maintain the possibility of making its content a basis for substantive examination. As a result, the applicant was required to pay the claims fee - applicants were not at liberty to ignore the provisions on the form and content of the description and claims contained in R. 27 and R. 29 EPC 1973.

In decision **J 15/88** (OJ 1990, 445), the board decided in a similar case that although the 117 disputed "clauses" in question were numbered and arranged as claims and seemed to define matter in terms of technical features, they were not to be regarded as such since the fact remained that they were never referred to as claims and there were claims elsewhere which were referred to as such.

Decisions **J 16/88**, **J 29/88**, **J 25/89**, **J 26/89**, **J 27/89**, **J 28/89**, **J 34/89** and **T 490/90** all confirmed this opinion, pointing out that the case dealt with in **J 5/87** differed from the others since the applicant had indicated an intention to regard the annexes as claims. The intention of the appellant not to have this part considered as claims is more important than the form of the text.

## **8.2. No refund of claims fees**

In **J 3/09** the Legal Board of Appeal rejected the appellant's request for a refund of the claims fee for claims 16-68 and noted that the legal basis for payment of those claims was R. 110(1) EPC 1973. It added that fees, once validly paid, were not refundable unless provision to the contrary was made. The appellant had not relied on any specific provision of the EPC in its support. In response to the appellant's argument that it was inevitable that the subject matter of the unsearched claims could not be prosecuted in the application, and had therefore to be considered as abandoned, the board noted *inter alia* that in the frequent case of an a posteriori objection of non-unity, even if justified, the claims could usefully serve as a basis for later limiting the claimed subject-matter to a more specifically defined but now unitary and searched invention. Whilst the extent to which this was possible depended on the circumstances of the individual case, it remained the position that the payment of claims fees for claims exceeding the number of ten could have a useful purpose on its own independently of the question whether all the claims concerned unitary subject-matter.

## B. Unity of invention

1.	Introduction	302
2.	Unity in the context of different types of claims	303
2.1.	Plurality of independent claims	303
2.2.	Dependent claims	305
2.3.	Intermediate products	306
3.	Assessing lack of unity of invention	307
3.1.	General approach - content of claims	307
3.2.	Assessment of lack of unity by the International Searching Authority (ISA)	308
3.3.	Assessment of lack of unity in examination proceedings	309
3.3.1	Lack of unity raised at different stages of the procedure	310
3.3.2	Assessment of requests for refund of further search fees	310
3.4.	No assessment of lack of unity in opposition proceedings	311
4.	Criteria for determining lack of unity	312
4.1.	Determination of the technical problem	312
4.2.	Examination as to novelty and inventive step	313
5.	The single general inventive concept	314
5.1.	General	314
5.2.	Special technical features and inventive character of the single general concept	316
5.3.	Unity of single claims defining alternatives ("Markush claims")	319
6.	Plurality of inventions and further search fees	321
6.1.	Consequences of non-payment of a further search fee	322
6.2.	Euro-PCT applications	324
6.2.1	Treatment of non-unity according to former R. 164 EPC	324
6.3.	Unsearched subject-matter and applicability of Rule 64, (former) Rule 164(2) EPC or Rule 137(5) EPC	325
6.4.	Dispensing with further search fee	326

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### 1. Introduction

Under Art. 82 EPC, the European patent application must relate to one invention only or to a group of inventions so linked as to form a **single general inventive concept**. R. 44(1) EPC (cf. R. 30 EPC 1973) gives an interpretation of the concept of unity of invention where a group of inventions is claimed. The principles set out by board of appeal case law relating to the earlier version of R. 30 EPC 1973 in force until 31.5.1991 can still be applied.

For international applications the corresponding provisions on unity of invention are Art. 3(4)(iii) and in particular R. 13 PCT. Protests in respect of additional fees paid following a non-unity objection by the EPO acting as ISA (Art. 17(3)(a), R. 40 PCT) or as IPEA (Art. 34(3)(a), R. 68 PCT), which were previously decided on by the boards of appeal (Art. 154(3) and 155(3) EPC 1973), are now decided on by review panels of the EPO (R. 158(3) EPC, Decision of the President of the EPO, OJ 2015, A59; for the

interim procedure applied between the entry into force of amended R. 40 and 68 PCT on 1.4.2005 and of the EPC 2000 on 13.12.2007, see Notice of 1 March 2005, OJ 2005, 226, and the "Case Law of the Boards of Appeal", 6<sup>th</sup> edition 2010, IX.A.1). The boards' competence to consider unity in the context of European applications remains unaffected. Given the harmonisation of the definitions concerning unity of invention in R. 13 PCT and Art. 82, R. 44 EPC, the criteria for unity in both systems are the same. Therefore, decisions of the boards of appeal rendered according to the former PCT protest procedures continue to be of interest for the consideration of unity in European applications.

Concerning procedural aspects of the assessment of unity, see R. 64 and 164 EPC (cf. also Art. 17(3)(a), R. 40 PCT; Art. 34(3)(a), R. 68 PCT) and also in this chapter II.B.3. and II.B.6.

The Guidelines for Examination in the EPO (November 2015 version) deal with unity of invention at the search stage in Part B-VII, unity as a procedural aspect of substantive examination in Part C-III, 3, and unity as a requirement of the European patent application in Part F-V. For international applications see especially Chapter 10 of the PCT International Search and Preliminary Examination Guidelines, as in force from 1.10.2015, and the Guidelines for Search and Examination in the EPO as a PCT Authority, B-VII and C-V – November 2015 version.

## **2. Unity in the context of different types of claims**

### **2.1. Plurality of independent claims**

Under Art. 82 EPC, as under R. 13.1 PCT, the application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the **same or different categories**.

In **W 5/92** the board considered it to be implicit in the definition of R. 13.1 PCT that the "invention" be considered in the broadest sense. Thus, according to the former PCT Search Guidelines VII-5 (PCT Gazette No. 30/1992, Sec. IV; No. 29/1993, Sec. IV), the mere fact that an international application contained claims of different categories or several independent claims of the same category was in itself no reason for objection on the grounds of lack of unity (see now guidance in para. 10.04 ff. PCT International Search and Preliminary Examination Guidelines, as in force from 1.10.2015).

R. 44(1) EPC and R. 13.2 PCT provide that where a group of inventions is claimed in a European/international application, the requirement of unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The former R. 30 EPC 1973 as in force until 31.5.1991, like the previous R. 13 PCT, specified the following three cases in which a combination of independent claims in different categories was to be considered as having unity in the above-mentioned sense:

(a) in addition to a claim for a given product, a claim for a process specially adapted for the manufacture of the product, and a claim for a use of the product;

(b) in addition to a claim for a given process, a claim for an apparatus or means specifically designed for carrying out the process;

(c) in addition to a claim for a given product, a claim for a process specifically adapted for the manufacture of the product, and a claim for an apparatus or means specifically designed for carrying out the process.

The list was not exhaustive and other combinations were permitted if they met the requirements of Art. 82 EPC 1973 (**T 861/92**). The same applied to the old version of R. 13.2 PCT (**W 3/88**, OJ 1990, 126; **W 29/88**, **W 3/89**). In **T 702/93** it was held that this version of R. 30 EPC 1973 did not provide for such a fictitious unity in the case of independent claims in the **same** category.

While this fiction was removed with the amendment of R. 30 EPC 1973 and R. 13 PCT (with effect from 1.6.1991), the principles based on it, as set out in the above case law, remain unchanged (**T 169/96**).

In **T 202/83** it was concluded from the old version of R. 30(c) EPC 1973 that the requirement of unity was not met by every subject-matter for carrying out a process. On the contrary, the provision presupposed that the means for carrying out the process had been specifically designed. Consequently, such a means in connection with the corresponding process did not meet the unity requirement if it was obvious that it could also serve to solve other technical problems.

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

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

In **W 32/88** (OJ 1990, 138) the board was of the opinion that an invitation to pay an additional search fee on the grounds that an international application concerning a process and an apparatus related to two different inventions, whereas the apparatus was specifically designed for carrying out the process, had no legal basis, even if the claims for the apparatus were not restricted to such use (see also **W 16/89**).



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

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

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

In **T 492/91**, the board found that, for the purposes of Art. 82 EPC 1973, the whole composition covered by claim 6 (new composition) need not be the product of the process according to claim 1 (process for preparing known products). It was sufficient for one component of the composition to be such a product where the composition and the process were intended to solve the same technical problem. The board concluded that the scope of claim 6 therefore did not have to be limited to the compositions resulting from the process according to claim 1, thus excluding the compositions obtainable by subsequent mixing.

## 2.2. Dependent claims

R. 13.4 PCT expressly provides that dependent claims must fulfil the requirement of unity in accordance with R. 13.1 PCT. The EPC makes no comparable express provision. The question has therefore arisen whether dependent claims have to be treated differently under the two provisions. Board of appeal case law on PCT cases has been uniform: the boards have repeatedly confirmed the principle that the requirement of unity must also be met by dependent claims (see inter alia **W 3/87**, **W 2/88**, **W 30/89**, **W 32/89**, **W 26/90**, **W 8/91** and **W 54/91**). In EPC cases the boards likewise assume that dependent claims have to meet the requirement of unity. Under the EPC the approach is not as strict as in the case of independent claims, where the examination is always carried out in accordance with the express requirement, but only in those cases where unity could be problematical (see **T 140/83** and **T 249/89**).

In **W 8/91** it was decided that, where claims were formally dependent, the ISA had to state expressly why they lacked unity; it was not enough simply to say that this was shown directly by the subject-matter as defined by the ISA.

In **W 6/98** the board held that anticipation of the subject-matter of an independent claim might well lead to a situation of non-unity a posteriori, which however could only be established by showing that there was indeed no unifying novel inventive concept

common to all dependent claims. The board noted that lack of novelty of the subject-matter of an independent claim did not automatically lead to a posteriori lack of unity for the claims directly or indirectly appended to said independent claim.

The board in **T 129/14** pointed out that, normally, a dependent claim has all the features of its independent claim. If the independent claim comprised one or more special technical features defining a contribution over the prior art, the dependent claim would also comprise them. Hence they would form a single general inventive concept within the meaning of Art. 82 EPC. If the independent claim did not comprise any special technical features defining a contribution over that prior art, e.g. because its subject-matter was not novel, then it would not form any inventive concept. Hence, again no more than one general inventive concept within the meaning of Art. 82 EPC - possibly defined by the additional features of the dependent claim - would result (cf. Guidelines F-V, 9 – November 2015 version).

### 2.3. Intermediate products

In **T 57/82** (OJ 1982, 306) it was stressed that the subject-matter of an application relating to new chemical end products, processes for their preparation, and to new intermediates for those end products at all events had unity within the meaning of Art. 82 EPC 1973 if all these subject-matters were technically interconnected and integrated into a single overall concept by being oriented towards the end products. In this context, starting materials which were used in a process for preparing end products and which were themselves products of a disclosed, albeit unclaimed, production process were also considered to be intermediates. This principle was confirmed in **T 110/82** (OJ 1983, 274) for low-molecular products. According to that board, an invention relating to new low-molecular end products and to several groups of new low-molecular intermediates invariably had unity if the groups of intermediates prepared and oriented towards the end-products were technically closely interconnected with the end products by the incorporation of an essential structural element into the end-products and if due account was taken of the regulatory function of Art. 82 EPC 1973 (prohibition of unjustified saving of fees, need for ready comprehensibility).

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

In **W 35/91** the board ruled that the requirements of unity of invention as set out in R. 13.1 and R. 13.2 PCT were met if the novel intermediates designed to give rise to the novel end products were technically sufficiently closely related by their contribution to an essential structural element of the end products.

In **W 7/85** (OJ 1988, 211) the board stated that there was sufficient technical information to justify a prima facie finding of unity between a claim to a mixture and a claim to one essential component of that mixture or a narrowly defined version thereof. If a finding of unity was justified in cases of chemical intermediates and end products even when, as was often the case, only a part of the intermediate structure was actually incorporated, there was all the more reason to view the intact components and the corresponding compositions in a mixture as technically interconnected by incorporation. The former were not even destroyed when the admixture was prepared and fully retained their properties and functions in the product, unlike typical intermediates, which lost their identity in the process. Thus, both inventions could be considered to fall within the same general inventive concept. In such cases the requirement that the means for preparing the end product should be "specially designed for carrying out the process" appeared to be fulfilled since none of the means led or was related to an end product outside the scope of its definition. In view of this the character of the invention in the component was, prima facie, also dependent on the existence of an invention in the end product.

### 3. Assessing lack of unity of invention

#### 3.1. General approach - content of claims

According to Art. 3(4)(iii) PCT, an international application must comply with "the prescribed requirement of unity of invention", the details of which are set out in R. 13 PCT. In the EPC, the requirements for unity are laid down in Art. 82 EPC and R. 44 EPC.

In **W 6/97** it was held that the determination of unity of invention must be made on the basis of the contents of the claims as interpreted in the light of the description and of the drawings, if applicable. The board referred to Annex B, Part 1(b) of the PCT Administrative Instructions (cf. now Annex B, para. (b) PCT Administrative Instructions, as in force from 1.7.2015), which stated that principle, and noted that the PCT Administrative Instructions are binding not only on the ISA but also on the board of appeal acting as the "three-member board" according to R. 40.2(c) and (e) PCT (see **G 1/89**, OJ 1991, 155; since 1.4.2005, the references in the PCT Regulations to "three-member board" have been replaced by "review body" – see also in this chapter II.B.1 "Introduction").

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

In **G 1/89** (OJ 1991, 155), the Enlarged Board of Appeal pointed out that neither in the PCT itself nor in the Rules under the PCT were there provisions indicating how to decide whether or not an international application complies with the prescribed requirement of unity of invention. However, the PCT Search Guidelines stated, *inter alia*, that lack of unity may be directly evident "a priori", that is before considering the claims in relation to any prior art, or may only become apparent "a posteriori", that is after taking prior art into consideration (see now para. 10.03 PCT International Search and Preliminary Examination Guidelines as in force from 1.10.2015).

### **3.2. Assessment of lack of unity by the International Searching Authority (ISA)**

Lack of unity may be directly evident a priori, i.e. before examination of the merits of the claims in comparison with the state of the art revealed by the search (**W 1/96** and **W 6/90**, OJ 1991, 438). If the objection of lack of unity is raised a priori, the technical problem must be defined solely on the basis of the description and not of the prior art (see **W 50/91**, **W 52/91**, **W 22/92**, **W 52/92** and **T 188/04**).

On the question whether the ISA had the power to assess unity of invention in an international application a posteriori, i.e. after taking into account the prior art brought to light by the search, the board in **W 3/88** (OJ 1990, 126) answered in the negative, interpreting the expression "a single general inventive concept" in R. 13.1 PCT as being simply the general concept of what the applicant subjectively claimed to be his invention. By contrast, in **W 44/88** (OJ 1990, 140) and **W 35/88**, the answer was affirmative. In the latter cases the boards referred to the PCT Search Guidelines, which permitted assessment of unity a posteriori. These conflicting interpretations gave rise to referrals under Art. 112 EPC 1973 by a board of appeal (**W 12/89**, OJ 1990, 152) and by the President of the EPO. See also in this chapter II.B.4.2.

The referred questions, dealt with in consolidated proceedings, were answered in **G 1/89** (OJ 1991, 155) and **G 2/89** (OJ 1991, 166) respectively. According to the Enlarged Board, 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 a posteriori. The Enlarged Board first noted that the problems involved were mainly due to the fact that, under the PCT, as well as under the EPC 1973, search and (substantive) examination were carried out in sequentially different steps and by different examiners. This procedural separation of search and examination led inevitably to a certain overlapping because of the functional relationship between search and examination. Thus, although the objective of the search was in principle limited to discovering and reporting on relevant prior art for the purpose of assessing novelty and inventive step, which was ultimately the task of the examining authority (i.e. the IPEA and/or the designated Office under the PCT and the examining division under the EPC 1973 respectively), it was obvious that in many instances the search examiner needed to form a provisional opinion on these issues in order to carry out an effective search. Otherwise, he would simply be at a loss how to judge the relevance of the documents in the prior art and how to arrange the search report accordingly. This overlapping was inherent in the PCT and the EPC 1973 and was in contrast to the system of most national patent laws, where search and examination were carried out in one combined operation, normally by

the same examiner, and where consequently there was no separation of fees for search and examination as under the PCT and the EPC 1973.

The Enlarged Board further noted that the requirement of unity of invention under the PCT applied equally to the procedure before the ISA and to the procedure before the IPEA according to Art. 17(3)(a) and 34(3)(a) PCT respectively, which was in conformity with the procedural separation of search and examination as referred to above and reflected the principle that the normal fees for search and examination were related to one invention (or a single general inventive concept) only. This led to the conclusion that the requirement of unity of invention under the PCT had in principle to be judged by the same objective criteria by both the ISA and the IPEA.

The Enlarged Board observed that the PCT Search Guidelines contained a direct reference to the consideration of unity by the ISA on an a posteriori basis, i.e. after an assessment of the claims with regard to novelty and inventive step in relation to the prior art. A comparison with the corresponding EPO Guidelines showed that under the EPC 1973 it was also clearly foreseen that consideration of unity by the search divisions might be carried out on an a posteriori basis (see also R. 46 EPC 1973; now R. 64 EPC). In the view of the Enlarged Board, this was a consequence of the special structure of the PCT and the EPC 1973. Therefore, the Guidelines had on this point to be considered as consistent with the PCT and the EPC 1973. As to the PCT Search Guidelines, it was noted that such guidelines were based on Art. 56 PCT dealing with the task of the Committee for Technical Cooperation (see in particular Art. 56(3)(ii) PCT and the reference to the need for uniformity of, inter alia, working methods; see now Chapter 10 of the PCT International Search and Preliminary Examination Guidelines, as in force from 1.10.2015).

According to the board in **W 21/89**, since, under the terms of R. 33.1(a) PCT, the prior art consisted of everything that had been made available to the public before the date of filing of the international application, the ISA could use such documents as grounds for a decision of lack of unity a posteriori even if it was not possible to cite these documents against a corresponding national patent application in one of the contracting states designated.

In **W 2/10** the board pointed out that in **W 4/85** (OJ 1987, 63) and many subsequent decisions, the boards had decided that the requirement to give reasons in an invitation under Art. 17(3)(a) PCT was so fundamental that an unsubstantiated invitation could be regarded as legally ineffective. This was so in the case in question and therefore the additional search fees had to be refunded.

### **3.3. Assessment of lack of unity in examination proceedings**

The requirement of unity under Art. 82 EPC has to be satisfied not only by the patent application as filed but also at later stages of the patent granting procedure, i.e. before the examining division, up until grant of the patent. R. 64(2) EPC (R. 46(2) EPC 1973) refers to the possibility that the examining division might disagree with the search division concerning lack of unity and that the examining division's opinion is decisive in

that the latter may order the refund of any further search fee at the applicant's request. It lies within the discretion of the examining division to decide that a patent application lacks unity of invention within the meaning of Art. 82 EPC, even if the search division did not raise a similar objection under R. 64(1) EPC (R. 46(1) EPC 1973) (**T 178/84**, OJ 1989, 157).

### 3.3.1 Lack of unity raised at different stages of the procedure

In **T 87/88** (OJ 1993, 430) the board noted that the Enlarged Board of Appeal had ruled that when the EPO carries out an international search, an international application may also be considered, under Art. 17(3)(a) PCT, not to comply with the requirement of unity of invention "a posteriori", i.e. after prior art is taken into consideration and a provisional opinion on novelty and inventive step is thereby formed (**G 1/89**, OJ 1991, 155; **G 2/89**, OJ 1991, 166). This principle applied equally when carrying out a European search (Art. 92 EPC 1973) because in both cases the searches and search reports were virtually identical. The appellants' objection that a search division was not entitled to decide that the claimed invention lacked unity "a posteriori" as well was therefore unfounded.

In **T 94/91** it was added that Art. 82 EPC 1973 clearly provided that European patent applications must satisfy the criteria of unity of invention without any restriction. There was no difference in the EPC 1973 between "a priori" and "a posteriori" lack of unity. It was of no importance whether the non-unity appeared immediately or only in view of a document found during the search or the examination.

In **T 544/88** (OJ 1990, 429) the board ruled that if an applicant, in response to an objection of lack of unity under Art. 82 EPC 1973, filed new claims allegedly relating to an invention meeting the unity requirement, examination should be continued even if the other application documents had not been limited to the subject-matter of those claims. However, the examining division might request the applicant to bring the description and drawings into line with the valid claims (R. 27(1)(d) EPC 1973 as in force until 31.5.1991; cf. subsequent R. 27(1)(c) EPC 1973, now R. 42(1)(c) EPC) and to delete from the patent documents those parts of the description and drawings which did not refer to claimed inventions (R. 34(1)(c) EPC 1973). It would then be necessary to check in each individual case whether such adjustments ought to be deferred until allowable claims were submitted.

### 3.3.2 Assessment of requests for refund of further search fees

In **J 24/96** (OJ 2001, 434) the appellant raised the issue of whether, in its decision concerning the refund of further search fees under R. 46(2) EPC 1973 (R. 64(2) EPC), the examining division should have dealt with the alleged incompleteness of the partial search report. The board held that within the framework of R. 46 EPC 1973 it was the task of the examining divisions (and the boards of appeal) to examine whether communications of the search divisions under R. 46(1) EPC 1973 asking for further search fees were justified. R. 46(2) EPC 1973 did not, however, refer to any acts of the search divisions other than communications issued under R. 46(1) EPC 1973. It was

therefore not necessary for an examining division to deal in a decision under R. 46(2) EPC 1973 with other objections raised by the applicants in connection with the search, such as the objection that the partial search report was not drawn up in accordance with the Guidelines. The board observed that the examining divisions of course have the possibility of arranging for an additional search to be performed, if they consider a search report delivered by the search division incomplete, but that this had nothing to do with a formal decision issued under R. 46(2) EPC 1973 concerning the refund of further search fees upon request.

With regard to the review by the examining division under R. 46(2) EPC 1973, the board in **T 188/00** pointed out that this had to be carried out having regard only to the facts presented by the search division in its communication under R. 46(1) EPC 1973. Since in most cases objections against lack of unity were raised having regard to the prior art (a posteriori unity objections), this meant that the examining division had to base its review solely on the documents cited in the partial search report and on the specification of the different inventions drawn up by the search division, while taking into account any arguments which the applicant might have submitted in support of his request for a refund. Concerning the analogous protest procedures under the PCT (R. 40.2(c) and (e) and R. 68.3(c) and (e) PCT), the boards of appeal had ruled that these reviews had to be based exclusively on the reasons given in the invitation to pay additional fees, having regard to the facts and arguments submitted by the applicants (**W 4/93**, OJ 1994, 939). However, in the case in hand the examining division had reasoned that the claims as filed lacked unity a posteriori as a consequence of the finding that claim 1 as filed lacked an inventive step having regard to documents D1 and D4, where the latter document was not cited in the partial search report. Thus the examining division did not review the finding of lack of unity of invention within the meaning of R. 46(2) EPC 1973, but carried out a fresh examination on the basis of a new document D4. The board therefore held that the decision to refuse the refund of a further search fee had to be set aside for formal reasons alone and that the appellant's request for a refund of a further search fee under R. 46(2) EPC 1973 was justified.

### **3.4. No assessment of lack of unity in opposition proceedings**

In **G 1/91** (OJ 1992, 253) the Enlarged Board held that unity of invention did not come under the requirements which a European patent and the invention to which it related had to meet under Art. 102(3) EPC 1973 (Art. 101(3)(a) EPC) when the patent was maintained in amended form. It was consequently irrelevant in opposition proceedings that the European patent as granted or amended did not meet the requirement of unity. It was clear from the "travaux préparatoires" not only that lack of unity was deliberately excluded as a ground for opposition, but also that any lack of unity arising during opposition proceedings as a result of amendment of the patent had to be accepted.

The Enlarged Board noted *inter alia* that although unity of invention under Art. 82 EPC 1973 was a material requirement, it was still merely an administrative regulation. It served a number of administrative purposes, particularly in demarcating the respective responsibilities of the departments. The administrative purposes of unity were fulfilled in the main up to the time the patent was granted. The purpose and intention of

opposition proceedings was to give a competitor the opportunity of opposing unjustified protective rights. Since this served the competitor's interests, he did not also need to be given the opportunity of contesting a patent on the ground of lack of unity. Lack of unity did not in fact rule out patent protection; it could only result in an application being divided to produce two or more patents.

#### **4. Criteria for determining lack of unity**

##### **4.1. Determination of the technical problem**

According to the established case law of the boards of appeal, determining unity of invention requires as a precondition an analysis of the technical problem or problems underlying the respective group of inventions (see **W 11/89**, OJ 1993, 225; **W 6/97**, **T 188/04**), i.e. whether or not the subject-matter claimed as the solution to such a problem represents a single general inventive concept (see **W 6/91**; also **T 129/14**). The disregard of this principle would be in itself sufficient justification for the reimbursement of the additional search fees. In **W 8/94** the board held that a discussion of the problem underlying the claimed subject-matter was required, because only then was it possible to decide whether or not a common special technical feature within the meaning of R. 13.1 and R. 13.2 PCT existed for different embodiments (see **W 11/89**, OJ 1993, 225; **W 14/89**, **W 59/90**, **W 14/91**, **W 17/91**).

In **W 6/97** the board found that establishing the technical problem underlying a claimed invention or group of inventions in relation to the state of the art should start, as a rule, from what was considered in the description as having been achieved by the claimed invention, since claims directed to compositions of matter at least were normally silent on the technical effects to be achieved by such compositions. As soon as the search revealed prior art which was clearly more relevant than that already acknowledged in the description of the international application, it was necessary to determine what was to be considered as the particular technical problem in view of both the disclosure of the international application as a whole and the prior art thus revealed (see **W 6/91**). Unity of invention might be assessed only after the technical problem had been determined in such a manner.

The boards have on several occasions stressed that an alleged lack of clarity in a claim cannot be used as a reason for an objection based on lack of unity (see **W 31/88**, OJ 1990, 134; **W 7/89**, **W 59/90**, **W 9/02**). In **W 21/04** the board observed that according to the established case law of the boards of appeal the features of an independent claim that the ISA held not to meet the requirements of Art. 6 PCT could not be disregarded in examining a lack of unity objection.

In **W 17/03** the board was concerned with the investigation of technical relationships for unity. The case is summarised in this chapter II.B.4.2.



## 4.2. Examination as to novelty and inventive step

In **W 12/89** (OJ 1990, 152) the board referred, inter alia, the following questions to the Enlarged Board of Appeal:

"Does an International Searching Authority have the power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering under Art. 17(3)(a) PCT whether the application complies with the requirement of unity of invention set forth in R. 13.1 PCT?

If an International Searching Authority does have such power, in what circumstance does it have an obligation to carry out such a substantive examination?"

The Enlarged Board of Appeal delivered its decision in **G 1/89** (OJ 1991, 155; see also the opinion given by the Enlarged Board in **G 2/89**, OJ 1991, 166, in response to a related referral by the President of the EPO). It found that in accordance with normal terminology, the term "examination" or "substantive examination" referred to the activities of the authorities responsible for deciding on patentability, such as the examining division of the EPO, or, in the case of the PCT, to the activities of the IPEA and/or the designated Office. Obviously, an ISA did not have any power to carry out such activities. The Enlarged Board held that an ISA might only form a provisional opinion on novelty and inventive step for the purpose of carrying out an effective search. This opinion was in no way binding on the authorities referred to above. The same principle applied also when an ISA considered that an international application did not comply with the requirement of unity of invention set forth in R. 13.1 PCT on an "a posteriori" basis. Such consideration had only the procedural effect of initiating the special procedure laid down in Art. 17 PCT and R. 40 PCT and was, therefore, not a "substantive examination" in the normal sense of that term. According to the decision an assessment of whether a single general inventive concept existed was to be undertaken only in so far as this was necessary to establish whether the invention complied with the requirement of unity when implementing the procedure laid down in Art. 17 PCT and R. 40 PCT. Such an assessment was **provisional** and did not constitute a substantive examination in the sense of an examination as to patentability (see **W 6/90**, OJ 1991, 438).

The Enlarged Board further noted that consideration by an ISA of the requirement of unity of invention should, of course, always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Art. 17(3)(a) PCT should be made only in clear cases. In particular, in view of the fact that such consideration under the PCT was being made without the applicant having had an opportunity to comment, the ISA should exercise restraint in the assessment of novelty and inventive step and in borderline cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step (see **W 24/90**, **W 23/91**, **W 43/91**). In **W 1/97** the board held that there was no such clear case where the ISA, having already searched part of the subject-matter, was still not in a position to identify several separate inventions.

Following the Enlarged Board's conclusions in **G 1/89** and **G 2/89**, the boards repeatedly used a lack of novelty or inventive step in the general inventive concept underlying the invention to justify a finding of lack of unity (see **W 17/89**, **W 27/89**, **W 18/90** and **W 19/90**). In **W 10/92** the board stressed that the problem-solution approach was to be applied to unity of invention (**W 16/91**, **W 21/91**).

In **W 17/03** the ISA had considered that the absence of common technical features and an allegedly different problem solved would be sufficient to demonstrate lack of unity between groups of inventions. The board suggested that the ISA's approach to the determination of the problem appeared to stem from the belief that what was required was the same analysis as that used to determine the problem when using the problem and solution approach to evaluate inventive step, possibly because differences and problems are involved in both situations.

The board stated that it was not convinced that the investigation of technical relationships for unity with the aid of common problems underlying the inventions is necessarily the same as the analysis that is used to determine the problem when using the problem and solution approach to evaluate inventive step. The board gave the following reasons:

(1) The evaluation of unity involves comparing problems solved (or effects achieved) by different claims, whereas the evaluation of inventive step is carried out on a single claim. As a result, when examining unity, the problems solved by different claims must be considered in the light of each other and cannot be determined in isolation in an absolute sense.

(2) In the evaluation of inventive step, the idea is to define a problem based on the distinguishing features that is essentially as narrow as possible, but not involving elements of the solution. On the other hand, in the evaluation of unity, these restrictions do not apply, since the overall object is to find out what the claims involved have in common, i.e. if the respective inventions are so linked as to form a single general inventive concept.

Thus, the specific problems solved by the different inventions with respect to the closest prior art might need gradual refinement, in particular generalisation starting from the problem directly solved, to find out whether or not there was a common denominator that still distinguished the inventions from the said prior art.

## **5. The single general inventive concept**

### **5.1. General**

When deciding on unity of invention, it is mandatory under Art. 82, R. 44 EPC and under R. 13.1 PCT to determine whether or not a group of inventions claimed in an application forms a single general inventive concept. Thus, when seeking to establish at the search stage whether inventions comply with the requirement of unity, the first question to be considered is whether the inventions are linked by a single general concept.

In **W 19/89** the board decided that the application clearly lacked unity of invention, since the four possibilities comprised by claim 1 related to a further development of the state of the art in different directions, namely by employing different classes of dehalogenation agents having no new technical feature in common. Where at least one solution of the underlying technical problem already formed part of the state of the art, the requirement of a "single general inventive concept" implied that the further solutions to that problem proposed in the application must have at least one new element in common, this new element being normally represented by at least one new technical feature. Since the absence of such a unifying new technical feature was admitted by the applicant, the application related to more than one invention.

A useful analysis of the single general concept was made in **W 6/90** (OJ 1991, 438). The board found that this concept manifested itself in features common to different teachings expounded individually in the same application. It observed that a teaching for the purposes of patent law encompassed not only the immediate subject-matter representing the solution to the problem as defined in the relevant claim, but also its technical consequences which were expressed as effects. It was noted that any subject-matter was defined by structural features and the relationship between them. The relevant effects, i.e. the outcome or results achieved by the invention as claimed, would usually already be apparent from the problem as stated. A single general concept might therefore be said to be present only if a partial identity existed between the teachings in an application deriving from the structural features of the subject-matters claimed and/or the outcome or results associated with those subject-matters.

Where subject-matters of the same category were concerned, a partial identity, generating unity of invention, could result from the structural features of these subject-matters and/or their associated effects. The absence of such an element common to all the different teachings in the application, and hence a lack of unity, might be established a priori under certain circumstances. A lack of unity might, however, also be established a posteriori between the subject-matters of different independent claims or in the remaining subject-matters if the subject-matter of a linking claim was clearly not novel or inventive vis-à-vis the state of the art. The board gave an example of what was meant by the abstract term "single general concept": a product, a process specially adapted for the manufacture of the said product, and a use of the said product, for example, embodied a single general concept because, on the one hand, the partial identity between the product and its use derived from the structural features of the product and, on the other hand, the partial identity shared by the product and the process specially adapted for its manufacture also derived from the product which was to be considered as the effect or result of this process (see **T 119/82**, OJ 1984, 217).

The board also noted that the criteria governing unity of invention for the purposes of R. 13.1 PCT elucidated above also applied in principle where the inventive step was based chiefly on the discovery of an unrecognised problem (see **T 2/83**, OJ 1984, 265). If the common problem, i.e. the effects to be achieved, was itself already known or could be recognised as generally desirable (a mere desideratum) or obvious, there would be no inventive merit in formulating the problem. If the common structural features were to

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

In **W 38/90** the sole common link between the subject-matter of claims 1, 2 and 4 was that the respective features all contributed to the realisation of the same device - a viewing assembly for a door. The board observed that this common pre-characterising feature was confined to indicating the designation of the invention, as part of the prior art; it was not, however, a specific feature interacting with the remaining characterising features and thereby contributing to the various inventions and their effects. Therefore, this sole link had to be rejected as irrelevant as regards any possible contribution to inventiveness. As already concluded, in the absence of any kind of common relevant feature, no unity "a priori" could be recognised.

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

In **T 861/92** the apparatus claimed was specifically adapted for carrying out only one step of the claimed process. The board came to the conclusion that the subject-matter of the claims satisfied the requirements of Art. 82 EPC 1973 as there was a technical relationship between both inventions.

In **W 9/03** the board considered whether the common problem underlying the claims could establish unity between the different inventions. The board held that a common problem could establish the unity of different inventions only under certain conditions, for example in the case of a problem invention. That was not the situation in the case at issue, however. According to the applicant, the common problem was considered that of providing a more secure, faster and easier connection setup. The board started from the assumption that the person skilled in the relevant art would normally consider this problem. The common problem was therefore so broadly formulated that it was "itself already known or could be recognised as generally desirable or obvious" (see **W 6/90**, OJ 1991, 438); as a result, unity could not thereby be established.

## **5.2. Special technical features and inventive character of the single general concept**

R. 13.2 PCT defines the method for determining whether the unity requirement is satisfied in respect of a group of inventions claimed in an international application: "Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in R. 13.1 PCT shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art" (cf. R. 44(1) EPC).

According to the case law, once such a single, i.e. common, concept was established, it was necessary to consider whether or not the same could contribute to the inventiveness

of the various subject-matters claimed in the case. Nothing indicated that this concept was known or belonged to the general knowledge of the man skilled in the art. Since the search examiner did not indicate that the documents cited in the case could exclude such a contribution, it could not be assumed that this could not be the case (**W 17/89**; see **W 6/90**, OJ 1991, 438). In view of this, a single inventive concept had to be attributed to all claims linking all their subject-matters (see **W 22/91**).

In **W 6/90** (OJ 1991, 438; see also in this chapter II.B.5.1) the board noted inter alia that R. 13.1 PCT also stipulated that the single general concept had to be inventive. Even with a given single general concept there was lack of unity if the concept had no inventive character. The boards of appeal have confirmed the above decision on several occasions (see e.g. **W 31/91**, **W 29/92**, **W 34/92**, **W 45/92**, **W 8/93** and **W 6/97**).

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

In **W 45/92** the board stated that the term "inventive" could not be interpreted as a requirement for the common part to be inventive per se and therefore claimable as such. The investigation in this respect should concentrate on whether or not all or some of such features could contribute to the later detailed consideration of the inventive steps. Only if the state of the art or common general knowledge which had already been taught showed, beyond reasonable doubt, that this was not possible in the circumstances, should non-unity be declared. It further held that the term "same or corresponding special technical features" recognised that the features should define a contribution to the invention vis-à-vis the prior art. As the features in question were also part of the most relevant state of the art, where they were set out in an identical manner, they could not provide such a contribution. Thus, the various inventions, if any, had to lie in the unshared specific characterising features in each case. Since the claims contained no other common feature between them in the characterising part, this confirmed the conclusion of lack of unity (see **W 32/92**, OJ 1994, 239).

In **W 38/92** the board confirmed **W 6/90** (see above) and noted that the common features in the claim groups represented the "sole concept" linking the various subject-matters. The board stated that the remaining question was whether or not any of these specific features in the claim groups or their combination could make a contribution to the inventive steps relating to each claimed subject-matter; if so, this would render the said concept linking the various subject-matters inventive. The board observed that the new R. 13 PCT also required such a contribution by the suggested common "special technical features" over the prior art, i.e. that more than novelty be provided. In **T 94/91** the board made it clear that the general inventive concept could not be equated with the features cited in a claim or in a particular combination of claims. What should be considered was the inventive concept as defined in the claims with due regard to the description and any drawings (see **W 2/95**).

In **W 9/93** the board noted that the intermediate compounds were known, so that these products could not serve as a common inventive concept, and that a technical feature contained in the process claims was also known. The board pointed out that a technical feature which already formed part of the state of the art could not, by definition, make a contribution over the prior art and did not, therefore, qualify as a unifying element within the meaning of R. 13.1 PCT. According to R. 13.2 PCT, as in force from 1.7.1992, an international application could relate to a group of inventions if there was a "technical relationship" among those inventions involving one or more of the same or corresponding "special technical features", i.e. such technical features that defined a contribution which each of the claimed inventions made over the prior art. R. 13.1 PCT did not simply require some link between a group of inventions claimed in an international 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.

In **T 957/96** the application described a number of processes which did not have any process step in common. According to the board, the decisive fact was that all the processes claimed shared a common technical feature, namely the use of the substantially pure regioisomer, which was essential for solving the technical problem addressed by the application. It was this use of the intermediate compound which formed the common "inventive" concept of all the claimed process variants. In other words, this feature constituted a special technical feature which defined the contribution that the claimed invention made over the prior art as required by R. 30(1) EPC 1973 (see now R. 44(1) EPC).

In **W 11/99** (OJ 2000, 186) the board held that if, in an international application, there are claims directed to products and to a process for the manufacture thereof, it could not be assumed that there were no corresponding special technical features within the meaning of R. 13.2 PCT simply because the process could also be used to manufacture other products. The board interpreted the requirement for the presence of "corresponding special technical features" under R. 13.2 PCT in cases where a manufacturing process and products were being claimed in the same application to mean that they could usually be assumed to be present where the production process is new and actually suited to making the claimed products accessible (where appropriate in addition to further products). In such cases the board regards the process as being "specially adapted" to the manufacture of the claimed products. A narrower interpretation of the terms "specially adapted" and "corresponding special technical features" would not fulfil the legislative purpose of Art. 34(3) PCT and associated R. 13.1 PCT, which, in the board's view, was the same as that of Art. 82 EPC 1973, namely to prevent subject-matters which were not interconnected being claimed in one and the same application. This interpretation accorded with Annex B to the PCT Administrative Instructions mentioned in the PCT Guideline III-7.2 (July 1998 version), where it is stated in Part 1, item (e), that a process is specially adapted for the manufacture of a product if it inherently results in the product (see now Annex B, para. (e) PCT Administrative Instructions, as in force from 1.7.2015). If this condition was met, it was irrelevant whether other products could be obtained using the process.

In **T 106/06** the board referred to the established case law of the boards of appeal according to which a manufacturing process and its resulting products are considered as unitary subject matter (e.g. **W 2/95** and **W 11/99**). The board gave consideration to the question whether the fact that claim 1 did not relate to a manufacturing process in the usual sense which may be characterised in that the specific end products are envisaged at the outset of the process, but to a process of isolating genes which, in view of its set up, has resemblance to a screening process which, in turn, may be characterised in that the final product is not known at the outset, should have an influence on the assessment of unity. The board held that the decisive question was whether the product had actually been produced by the process and not whether it had been known at the start of it. Therefore, there was no difference in the assessment of unity between a manufacturing process and a screening process and their resulting products.

In **W 18/01** the board pointed out that it followed from the definitions in the Regulations under the PCT and the PCT International Preliminary Examination Guidelines (which are binding on the EPO; see **G 1/89**, OJ 1991, 155, point 6 of the Reasons) that it was normally not sufficient merely to define and examine the common core of a group of inventions, for example by indicating the features which were specified in all the claims defining the inventions of the group. R. 13.2 PCT required an examination of the technical relationship among the inventions in a group. Such a relationship could exist even if the inventions did not involve the same technical features, provided they involved corresponding special technical features. The definition of "special technical features" given in R. 13.2 PCT required an analysis of the contribution which each of the claimed inventions made over the prior art. This first entailed analysing which of the features distinguished the claimed inventions from the cited prior art before their contribution could be examined in the light of the description, in particular the problems solved and the effects achieved by the claimed inventions.

### 5.3. Unity of single claims defining alternatives ("Markush claims")

R. 44(1) EPC and R. 13.2 PCT also apply where a single claim defines alternatives ("Markush claim"). According to R. 44(2) EPC and R. 13.3 PCT, the determination of whether a group of inventions is so closely linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims, or as alternatives within a single claim (see also **W 35/91**).

In considering whether the ISA had substantiated its findings of non-unity, the board in **W 3/94** (OJ 1995, 775) referred to the section on the "Markush practice" in Annex B, Part 1(f) of the Administrative Instructions under the PCT, as in force from 1.7.1992 (see now Annex B, para. (f) PCT Administrative Instructions, as in force from 1.7.2015). Here it is stated that the requirement of a technical interrelationship and the same or corresponding special technical features as defined in R. 13.2 PCT shall be considered met when the alternatives are of a similar nature. The section then specifies when alternatives are to be regarded as "of a similar nature."

In **W 1/94**, the EPO acting as ISA had found that the compounds according to the "inventions" it had identified did not have a new structural element. Nevertheless the

board concluded that the absence of such an element did not automatically destroy the unity of the invention. On the contrary, it was clear from the PCT Administrative Instructions that a technical relationship must be recognised for a group of alternative chemical compounds, such as all the compounds having a common property or activity, and such a common activity existed in the case in point. The new use could therefore form the general inventive concept linking the subject-matters of the claims in accordance with R. 13.1 PCT and had to be treated as a functional characteristic linking the compounds claimed.

In **W 6/95** the board referred to the PCT Administrative Instructions, binding not only on the ISA but also on the board of appeal acting as the "three-member board" according to R. 40.2(c) PCT (see **G 1/89**, OJ 1991, 155; since 1.4.2005, the references in the PCT Regulations to "three-member board" have been replaced by "review body" - see also in this chapter II.B.1 "Introduction"). The board noted that it followed from Annex B, Part 1(f)(i) PCT Administrative Instructions (now part of Annex B, para. (f) PCT Administrative Instructions, as in force from 1.7.2015) that in order to establish unity of invention "a posteriori", it was not sufficient for all alternatives of chemical compounds covered by a Markush claim to have a common property or activity, i.e. be suitable for solving a common technical problem, because according to item (B)(1) they had, in addition, to have a "significant structural element" in common in order for the alternatives to form unity. The board made it clear that it was, however, not in agreement with the explanation given in Annex B, Part 1(f)(ii) PCT Administrative Instructions to assume that the said "significant structural element" had to be novel per se. Rather, this expression meant that in relation to the said common property or activity there had to be a common part of the chemical structure which distinguished the claimed compounds from known compounds having the same property or activity (see also **W 6/97**).

In **T 169/96** the board noted that the fact that claim 1 also comprised a known compound, not covered by claim 2, was of no relevance to the question of unity, because R. 30(b) EPC 1973 (in the version as in force until 31.5.91; also in the version in force thereafter) did not require that there must be a common concept unifying different "means" according to it. It was not relevant here that the three different classes of chemical compounds identified by the examining division comprised completely different chemical structures of a residue. The board observed that Chapter C-III, 7.4a of the EPO Guidelines, which had been relied on by the examining division, as well as Annex B, Part 1(f) PCT Administrative Instructions (see now Annex B, para. (f) PCT Administrative Instructions as in force from 1.7.2015), concerning Markush-type claims, rightly stated that the said significant structural element might consist of a combination of individual components linked together. It was not stated there that the combination of individual structural elements had to be novel per se, nor did such a requirement follow from Art. 82 EPC 1973. Rather it followed from that guideline that this expression meant that in relation to the said common property or activity there had to be a common part of the chemical structure which distinguished the claimed compounds from known compounds having the same property or activity (see now Guidelines F-V, 5 – November 2015 version).



In **W 4/96** (OJ 1997, 552) the board noted that the requirement of a technical relationship as defined in R. 13.2, first sentence, PCT might be met when all claimed alternatives belong to a class of compounds which might be expected to behave in the same way in the context of the claimed inventions ("Markush claims"). The technical relationship involved those common special technical features that defined a contribution over the state of the art (R. 13.2, second sentence, PCT; see also **W 6/96**, **W 1/10**). However, such contribution could not be recognised on the basis of this expectation if members of the class had already been shown in the prior art to behave in the manner disclosed in the application. The board added that if at least one Markush alternative was not novel over the prior art, the question of unity had to be reconsidered by the examiner, i.e. a posteriori (Annex B, Part I (f)(v) PCT Administrative Instructions in conjunction with PCT Search Guidelines; see now Annex B PCT Administrative Instructions, as in force from 1.7.2015, also PCT International Search and Preliminary Examination Guidelines, as in force from 1.10.2015).

The board also held that an objection of lack of unity could be raised a posteriori with regard to all categories of grouping of alternatives of chemical compounds. An a posteriori assessment of unity had to be made in all circumstances in the same way, since the legal requirement of R. 13 PCT was the same for all cases. Therefore, the a posteriori assessment of unity in cases of a functional relationship within a group of compounds had to be made in a manner corresponding to the assessment in cases of a structural relationship. This was appropriate for compounds related by their structure as well as for compounds related by their function. The structural relationship within the meaning of Annex B, Part I (f)(i)(B)(1) and the relationship within the meaning of Annex B, Part I (f)(i)(B)(2) and (iii) served the same purpose: both tests were intended to show whether the alternative compounds were of a similar nature, as was said in the introductory part of Annex B, Part I(f)(i). These tests were only tools in order to determine whether there was unity of invention as defined in R. 13 PCT.

Claim 1 in **W 34/07** was directed to compositions for the coating of ceramic supports comprising micronised glass frits **and/or** nanosised zirconium hydroxide. The board concluded that the two claimed alternatives neither had in common express features not known in combination from the prior art nor represented two solutions to the same technical problem. The effects achieved by using either micronised glass or nanosised zirconium hydroxide were different and unrelated, although they might lead to "best results", i.e. when using a composition comprising both components.

## 6. Plurality of inventions and further search fees

If the search division or the ISA raises an objection of lack of unity, a further search fee is payable under R. 64(1) EPC (R. 46(1) EPC 1973) or Art. 17(3)(a) PCT, respectively, for each additional invention to be covered by the second report (for Euro-PCT applications in the European phase, see in this chapter II.B.6.2). If the fee is paid in due time applicants may select the single invention or group of inventions which they wish to retain in the (main) application.

### 6.1. Consequences of non-payment of a further search fee

The board in **T 178/84** (OJ 1989, 157) found that in the case of non-payment of the further search fee under R. 46(1) EPC 1973 the subject-matter not searched was regarded as abandoned and accordingly could not be pursued in the parent application. However, in **T 87/88** (OJ 1993, 430) it was stated that non-payment could not result in abandonment. According to the latter board, non-payment of further search fees in no way prejudiced the future legal fate of the unsearched parts. R. 46(1) EPC 1973 merely provided that in the case of non-payment of further search fees the search division was to draw up a European search report only for those parts of the application that related to the invention for which the search fees had been paid.

In view of these conflicting approaches, the President of the EPO referred the following point of law to the Enlarged Board of Appeal:

"Can an applicant who fails to pay further search fees for a non-unitary application when requested to do so by the search division under R. 46(1) EPC 1973 pursue that application for the subject-matter in respect of which no search fees have been paid or must he file a divisional application for it?"

In the opinion of the Enlarged Board, given in **G 2/92** (OJ 1993, 591), the application could not be pursued for subject-matter in respect of which the applicants had not paid the further search fees. Instead the applicants had to file a divisional application for that subject-matter if they wished to continue to protect it. In the view of the Enlarged Board, it was clear from the procedural system of the EPC that the invention which was to be examined for patentability had to be an invention in respect of which a search fee had been paid prior to the drawing up of the European search report. Part IV of the EPC envisaged that an application progressed after filing from the search division to the examining division. One object of R. 46 EPC 1973 was to implement this procedure by ensuring that an appropriately extensive search was completed in respect of each individual application before it was examined by the examining division. To this end, in response to an invitation from the search division to pay one or more further search fees in respect of one or more further inventions to which the application related, applicants had to pay such fees if they wished to ensure that one of the further inventions could become the subject of the claims of that application. That was the proper interpretation of R. 46(1) EPC 1973 in context. This confirmed the practice according to **T 178/84**.

In **T 319/96** the initial application lacked unity, but no further search fee was paid. The applicant had argued that, because of the international-type search (Art. 15(5)(a) PCT) carried out by the EPO (in the priority application) for the subject-matter of original claims 4 to 10, it had not forfeited its right to choose and could therefore continue pursuing this subject-matter. It had paid a search fee for each of the two inventions, and two search reports had been prepared by the Office. The board, however, stated that under R. 46(1) EPC 1973 a search fee was to be paid for each further invention if the **European** search report was to cover that invention. R. 46 EPC 1973 did not provide that a search report from another procedure could be substituted for the European search report. The board referred rather to the possibility under Art. 10(2) RFees

(see now Art. 9(2) RFees) of a full or partial refund of the European search fee where the Office has prepared an earlier search report on the same subject-matter. **G 2/92** applied also in the present case because in the context of the European procedure only one search report had been drawn up after payment of only one search fee.

In **T 2289/09** the appellant (applicant) had argued that since it was accepted practice that amendment in a divisional application could be based on subject-matter searched in the parent application, it should also be accepted that subject-matter that had been searched in a divisional was considered searched subject-matter generally and could thus form the basis for amendment in a parent. These circumstances were not explicitly excluded in **G 2/92** (OJ 1993, 591). The board disagreed. The Enlarged Board had stated in **G 2/92** that when an applicant failed to pay the requested search fees, that subject-matter could not be pursued in the application for which the search was carried out, and furthermore that "the invention which is to be examined ... must be an invention in respect of which a search fee has been paid prior to the drawing up of the European search report". This statement had significance beyond the reasons given in **G 2/92**. When an applicant for a divisional application sought the benefit of an earlier search, he still had to pay the search fees (R. 36(3) EPC). These were then refunded, conditional on the fulfilment of certain criteria (decision of the President of the EPO and notice from the EPO, OJ SE 1/2010, 322 and 325; see now decision of the President, OJ 2014, A29), namely if the EPO benefited from the earlier search report. There was no provision that would permit the EPO to proceed with search activities, including the examination of the claims in question and their scope, when no search fees were paid for a given part of an application, and also none that would entitle the examining division to request the payment of further search fees for the purpose of examining the usefulness of the earlier search on the divisional application.

In **T 631/97** (OJ 2001, 13) the board held that R. 46(1) EPC 1973 on its proper interpretation does not prohibit a review by the examining division of the search division's opinion on lack of unity where further search fees are not paid. A narrow interpretation of R. 46(1) EPC 1973 whereby the finding of lack of unity by the search division is considered as final where the additional search fees are not paid would deprive the applicant of an opportunity to dispute that finding during the examination proceedings and would also unjustifiably restrict the power of the examining division on the question of unity to the subject-matter for which search fees were paid. Thus the board did not share the view held in **T 1109/96**. The board found the above interpretation of R. 46(1) EPC 1973 to be in agreement with that of the Enlarged Board in **G 2/92**, and the examination procedure as set out in the Guidelines also to be in line with **G 2/92**. It noted furthermore, with reference to R. 112 EPC 1973, that the practice of search and examination of international applications where the EPO was elected or designated Office was consistent with the above view.

This decision was followed in **T 708/00** (OJ 2004, 160) - also referred to in this chapter II.B.6.3.

## 6.2. Euro-PCT applications

An applicant may pay additional search fees in the international phase if invited to do so by the ISA under Art. 17(3)(a) PCT.

Once the application has entered the European phase, R. 164 EPC "Unity of invention and further searches" (rule amended by Decision of the Administrative Council dated 16 October 2013, OJ 2013, 503) allows applicants to obtain, upon payment of a (further) search fee, a search of any invention claimed which was not searched by the EPO in the international phase. Moreover, applicants may choose any invention searched by the EPO either in the international phase, in the procedure for supplementary search or in the procedure under amended R. 164 EPC as a basis for further prosecution of the European phase (see Notice of 10 June 2014, OJ 2014, A70). Amended R. 164 EPC entered into force on 1.11.2014. For the transitional regime see Notice (supra), IV.23. and 24.

### 6.2.1 Treatment of non-unity according to former R. 164 EPC

In contrast to the current rule, R. 164(1) EPC in its previous version(s) prescribed that a European supplementary search report was to be drawn up on the invention or group of inventions first mentioned in the claims. Where no such supplementary search was to be carried out (i.e. where the EPO drew up the international search report or a supplementary international search report), the applicant had no possibility in the European phase to pay further search fees in that application in respect of inventions not covered by the international search report or any supplementary international search report. R. 164(2) EPC required the examining division, where it found that the application documents did not meet the unity requirements, or protection was sought for an invention not covered by the international search report, supplementary international search report or supplementary European search report, to invite the applicant to limit the application to one searched invention. Unsearched inventions could only be pursued in European divisional applications.

The following board of appeal decisions concern former R. 164 EPC.

In **J 3/09**, the Legal Board of Appeal confirmed in respect of R. 164 EPC (as then in force) that although the procedure on entry of an application into the European phase where the EPO had acted as the ISA changed with the coming into force of EPC 2000, the responsibility for establishing whether or not the application met the requirements of unity of invention still ultimately rested with the examining division, and the opinion of the EPO acting as the ISA on lack of unity was not final or binding on the examining division. The board observed that the practice of the examining division in this respect remained as before, noting in particular that to the extent that an objection of non-unity raised by the ISA turned out to be unjustified, the applicant was entitled to have the whole subject-matter of his unitary invention searched. This was also apparent from the then wording of R. 164(2) EPC, giving the EPO the power to invite the applicant to limit the application to one invention. This implied that where there was in fact only "one" invention there was no sanction.

The board in **T 1285/11** followed this reasoning, adding that the fact that the applicant did not pay further search fees or protest fees in the international phase could not be seen as a tacit agreement with the findings of non-unity of the ISA. As to the wording of R. 164(2) EPC as then in force, it could be deduced from the juxtaposition of "an invention not covered by the international search report" and "one invention covered by the international search report" that, for the Rule to be applicable, the non-searched and searched inventions must indeed be non-unitary with respect to one another. In the case in hand, there was, prima facie, a feature which could be regarded as a special technical feature establishing unity between "invention 1" and "invention 2", and R. 164(2) EPC as then applicable could not be seen as a bar to further prosecution based on the main request.

In considering the applicability of R. 164(2), second half-sentence, EPC in the version then in force, the board in **T 507/11** referred to the sanction of **G 2/92** (OJ 1993, 591), whereby the application may not be pursued for subject-matter in respect of which no search fee has been paid. In the board's view, this sanction did not necessarily apply to features disclosed in the original application documents in connection with an invention or group of inventions which has been searched. In the case in point, amended claim 1 contained all the features of searched claims 1 and 2. Protection was therefore still sought for the first, searched invention, now further restricted by features of original claim 13 (attributed by the ISA to another invention and therefore not searched), which, on account of the dependencies in the original claims, had been clearly and unambiguously disclosed. There was therefore no change to an unsearched invention. See also **T 442/11** and **T 509/11**.

Further decisions concerned with the interpretation and application of former R. 164 EPC are **T 1981/12**, **T 2473/12** and **T 2459/12** (see also the section that follows).

### **6.3. Unsearched subject-matter and applicability of Rule 64, (former) Rule 164(2) EPC or Rule 137(5) EPC**

In **T 708/00** (OJ 2004, 160) the board pointed out, with reference to preparatory document CA/12/94 cited in the Notice from the EPO in OJ 1995, 409, that the purpose of R. 86(4) EPC 1973 (R. 137(5) EPC) was to deal with the situation arising when amended claims relating to unsearched subject-matter were filed in response to the examiner's first communication. It did not apply when the applicant had not paid the search fee in respect of a non-unitary invention in spite of being invited to do so under R. 46(1) EPC 1973 (R. 64(1) EPC), cf. also **G 2/92**, OJ 1993, 591. These two rules were complementary in nature.

In case **T 1285/11** (see in this chapter II.B.6.2.1), the examining division had refused the application on the basis of R. 137(5) EPC as well as former R. 164(2) EPC. Referring to the afore-mentioned Notice and the applicable version of the Guidelines, the board found that R. 137(5) EPC was not contravened because the subject-matter of the amended claims had already been present in the claims as originally filed. See also **T 442/11**, **T 507/11**, **T 509/11** and **T 998/14**.

In **T 2459/12** it was acknowledged that the board in **T 1981/12** had doubted the appropriateness of R. 137(5) EPC as a basis for refusing an application based on the requests in that case. However it was the present board's view that where, following the drawing up of a supplementary European search report by the EPO, an applicant filed amended claims seeking protection for subject-matter not covered by that report as a result of the application of former R. 164(1) EPC, an objection under R. 137(5) EPC should be raised. Non-compliance with R. 137(5) EPC was a ground for refusing an application.

Reference is also made to Chapter IV.B.5 "Amendments relating to unsearched subject-matter - R. 137(5) EPC".

#### **6.4. Dispensing with further search fee**

In **W 36/90** and **W 19/89** the board observed that where there was lack of unity in an international application, in particular if the objection was evident a posteriori, the search examiner might decide to supplement the international search with a search on the additional inventions as well as on the first invention. This was so particularly if the concepts of the inventions were very close and none of them required a search in different classification units, so that the search could be performed for all the inventions without creating too much extra work (see PCT Search Guidelines as agreed upon by the Interim Committee for Technical Cooperation at its seventh session in Geneva in October 1977, PCT/INT/5). In such a case no objection of lack of unity should be raised because charging further fees would be incompatible with the principle of equity vis-à-vis the applicant (see **G 1/89**; for searches of additional inventions without payment of fees, see paras 10.64-10.65 PCT International Search and Preliminary Examination Guidelines, as in force from 1.10.2015, and Guidelines for Examination B-VII, 2.2 – November 2015 version; see also e.g. **T 755/14**).

**C. Sufficiency of disclosure**

1.	Date of compliance	328
2.	Parts of the application relevant for assessing sufficiency of disclosure	329
3.	Knowledge of skilled person relevant for assessing sufficiency of disclosure	330
3.1.	The disclosure is aimed at the skilled person	330
3.2.	References may also enable the skilled person to carry out an invention	332
4.	Clarity and completeness of disclosure	333
4.1.	General principles	333
4.2.	Indication of at least 'one way'	333
4.3.	Examples	334
4.4.	Invention to be performed over whole range claimed	335
4.5.	Parameters	335
5.	Reproducibility	338
5.1.	Repeatability	338
5.2.	Hypothetical embodiments	339
5.3.	Variants	339
5.4.	Use to which invention is put	339
5.5.	Reach-through claims	339
5.6.	Reproducibility without undue burden	340
5.6.1	Trial and error	340
5.6.2	Occasional failure	340
5.6.3	Routine selection	340
5.6.4	Wrong citations	340
5.6.5	Forbidden area of the claims	341
5.6.6	Non-disclosed steps	341
5.6.7	Experiments	341
5.6.8	Measuring methods	342
5.6.9	Chemical compounds	342
5.7.	Trial and error	343
5.8.	Post-published documents	344
6.	The requirement of sufficiency of disclosure in the biotechnology field	344
6.1.	Clarity and completeness of disclosure	344
6.1.1	General	344
6.1.2	One way of implementing invention over whole scope of claim	345
6.1.3	Repeatability	346
6.1.4	Broad claims	346
6.2.	Level of disclosure required for medical use	347
6.3.	Level of disclosure required for antibodies	349
6.4.	Factors contributing to a finding of undue burden	351
6.5.	Requirements relating to nucleotide and amino acid sequences	353
6.6.	Deposit of living material	353
6.6.1	Substantive law questions	354
6.6.2	Procedural law questions	355
a)	Conversion into deposit under the Budapest Treaty	355
b)	Late submission of deposit number	355

7.	The relationship between Article 83 and Article 84 EPC	356
7.1.	Article 83 EPC and support from the description	356
7.2.	Article 83 EPC and clarity of claims	358
8.	Evidence	362

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

The subject-matter of an application must be sufficiently disclosed at the date of the application (see in this chapter II.C.1), based on the application as a whole (II.C.2), including examples (II.C.4.3), and taking into account the common general knowledge of the skilled person (II.C.3). At least one way of enabling the person skilled in the art to carry out the invention must be disclosed (II.C.4.2), but this is sufficient only if it allows the invention to be performed in the whole range claimed (II.C.4.4). Parameters must be sufficiently defined (II.C.4.5). The disclosure must also be reproducible without undue burden (II.C.5); evidence for this from post-published documents is allowable under certain circumstances (II.C.5.8).

The distinction between the requirements for sufficiency of disclosure under Art. 83 EPC and clarity of the claims under Art. 84 EPC (II.C.7) is important, as examination in respect of the requirements of Art. 83 EPC is still permitted during opposition proceedings, whereas in respect of Art. 84 EPC it is limited to cases where there has been an amendment.

The burden of proof generally lies with the opponent to establish that an invention is insufficiently disclosed (II.C.8).

Sufficiency of disclosure as applied in biotechnology is considered in this chapter II.C.6, including the issue of broad claims (II.C.6.1.2).

## 1. Date of compliance

Sufficiency of disclosure under Art. 83 EPC requires inter alia that the subject-matter claimed in a European patent application be clearly identified. This requirement must be complied with as from the date of filing because a deficiency in a European patent application as filed, consisting in an insufficient identification of the subject-matter claimed, cannot subsequently be cured without offending against Art. 123(2) EPC which provides that the subject-matter content of a European patent application as filed may not be extended (**G 2/93**, OJ 1995, 275).

It is not the purpose of the patent system to grant a monopoly for technical speculations that cannot be realised at the time of filing (**T 1164/11**). See also in this chapter II.C.5.8 "Post-published documents".



According to the board in **T 512/07**, objections under Art. 83 EPC 1973 may under some circumstances be overcome by amending the claims, since thereby the "invention" referred to in Art. 83 EPC may be so changed that it no longer depends on the insufficiently disclosed aspects of the application for its realisation. However such objections cannot be overcome by amendment of the description and drawings, since the amendment would then add subject-matter to the application as filed. In general, the claimed subject-matter at issue had to be examined for compliance with Art. 83 EPC 1973 on the basis of the application documents as originally filed.

## **2. Parts of the application relevant for assessing sufficiency of disclosure**

Sufficiency of disclosure within the meaning of Art. 83 EPC must be assessed on the basis of the **application as a whole** - including the description and claims - (see leading decisions **T 14/83**, OJ 1984, 105; and also **T 169/83**, OJ 1985, 193) and not of the claims alone (see e.g. **T 202/83**, **T 179/87** of 16.1.1990, **T 435/89**, **T 82/90**, **T 126/91**). The drawings must be considered as ranking equally with the other elements of the application when considering whether the requirements of Art. 83 EPC (and Art. 84 EPC) have been satisfied (see **T 169/83**, OJ 1985, 193; **T 308/90** and **T 818/93**).

In **T 32/84** (OJ 1986, 9) it was pointed out that the fact that certain elements of an invention essential to its operation were not referred to explicitly either in the claims, or in the relevant portion of the description nor shown in the drawing of the invention as claimed did not necessarily mean that the application did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art as required by Art. 83 EPC 1973. This decision was cited, inter alia, in **T 391/91**, **T 830/02** and **T 25/09**.

According to established case law, substantially any embodiment of the invention, as defined in the broadest claim, must be capable of being realised on the basis of the disclosure. This implied in particular that an objection of insufficiency could be raised against the subject-matter of any claim, independent or dependent (R. 29(3) EPC 1973, now R. 43(3) EPC). From a legal point of view it was therefore irrelevant whether or not the feature objected to was essential or to what degree the scope of protection conferred by the patent depended on the claim in question (**T 226/85** (OJ 1988, 336), cited in many decisions, for example, **T 1011/01** and **T 1129/09**). The board in ex parte case **T 206/13** could not accept the appellant's submissions to the effect that preferred or optional features defined in a claim should be disregarded in the assessment under Art. 83 EPC. According to the established case law the requirement of sufficiency of disclosure defined in Art. 83 EPC was only complied with if the disclosure of the invention allowed the skilled person to perform, without undue burden, essentially all the embodiments covered by the claimed invention. This applied in particular to the specific particular embodiments of an invention defined in dependent claims pursuant to R. 43(3) EPC (**T 1011/01**) and, by the same token, to any optional feature defined in a claim, since such a feature also constituted, by its very nature, a particular embodiment of the claimed invention, irrespective of whether the optional feature was qualified as being "preferred" or not.

Disclosure is insufficient if the skilled person, taking into account the entire teaching of the patent, cannot rework an invention which is defined in the claims in a completely clear and comprehensible manner, unless he disregards a meaningful feature. (**T 432/10**).

An objection of insufficient disclosure under Art. 83 EPC cannot legitimately be based on an argument that the application would not enable a skilled person to achieve a non-claimed technical effect (**T 2001/12**, citing mainly **G 1/03** (OJ, 2004, 413) but also **T 1079/08**, **T 939/92** and **T 260/98**). **T 2001/12** clarified the distinction between the requirements of sufficiency of disclosure (Art. 83 EPC), clarity of the claims (Art. 84 EPC) and inventive step (Art. 56 EPC). That decision was cited in **T 862/11**, in which the board addressed the relevance of the technical effect for the purposes of Art. 83 EPC and concluded that a distinction had to be made between how the effect was to be considered in that context and how it was to be considered for the purposes of Art. 56 EPC.

**T 206/13** also applied **T 2001/12**, in so far as the examining division, in the context of the assessment of sufficiency of disclosure of claims 1 and 11, had referred to technical aspects which, in its opinion, were not sufficiently disclosed. The board pointed out that these technical aspects were not defined in claims 1 and 11 and, consequently, were not to be considered in the assessment under Art. 83 EPC of the invention defined in claims 1 and 11. The requirement of sufficiency of disclosure related to the invention defined in the claims, and in particular to the combination of structural and functional features of the claimed invention, and there was no legal basis for extending such a requirement also to encompass other technical aspects possibly associated with the invention (in particular, technical features or effects mentioned in the description) but not required by the claimed subject-matter. Such technical aspects might be pertinent in the assessment of other requirements of the EPC (in particular, the requirements of Art. 84 and 56 EPC).

### **3. Knowledge of skilled person relevant for assessing sufficiency of disclosure**

#### **3.1. The disclosure is aimed at the skilled person**

The same level of skill has to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step are being considered (**T 60/89**, OJ 1992, 268; **T 694/92**, **T 187/93**, **T 412/93**). However, the standard of disclosure required for amendments by Art. 123(2) EPC 1973, namely that of being directly and unambiguously derivable, is inappropriate, the criterion being that it must be possible to reproduce the invention on the basis of the original application documents without any inventive effort and undue burden (**T 629/05**; cited in **T 79/08**).

It is the **same skilled person** that has to be considered when construing the subject-matter of a claim. It accordingly follows that the construction of a particular claim should be identical for the assessment of inventive step and sufficiency of disclosure (**T 967/09**).

The skilled person may use his common general knowledge to supplement the information contained in the application (**T 206/83**, OJ 1987, 5; **T 32/85**, **T 51/87**, OJ 1991, 177; **T 212/88**, OJ 1992, 28; **T 772/89**) He may even recognise and rectify errors in the description on the basis of such knowledge (**T 206/83**, OJ 1987, 5; **T 171/84**, OJ 1986, 95; **T 226/85**, OJ 1988, 336). Textbooks and general technical literature form part of the common general knowledge (**T 171/84**, **T 51/87**, **T 580/88**, **T 772/89**). Common general knowledge does not normally include patent literature and scientific articles (see **T 766/91**, point 8.2 of the Reasons; **T 1253/04**, point 10 of the Reasons; both cited in **T 2059/13**, a decision concerning therapeutic use of a chemical compound in which the board also examined the possible role of post-published evidence). Information which can only be obtained after a comprehensive search is likewise not to be regarded as part of the common general knowledge (**T 206/83**, **T 654/90**). According to the board in **T 475/88**, a disputed claim of common general knowledge must be backed up by evidence. As a rule, demonstrating that the knowledge in question can be obtained from a textbook or monograph will be sufficient.

In **T 2305/11**, the application did not give details of how to determine the essential feature (maximum solubility pressure of at most 1 000 bar), but the board accepted the appellant's argument that the skilled person knew of suitable methods. It nevertheless found that crucial information was missing because the application did not disclose that, in many cases, no maximum could be found, or how to proceed in those cases. No useful guidance could be found in the description, and the appellant had failed to show how the skilled person could use his common general knowledge to fill in the gaps in disclosure or overcome the lack of guidance.

The patent must provide guidance enabling the skilled person to identify the process features decisive in overcoming a prejudice. The skilled person should not have to work this out himself (**T 419/12**).

Patent specifications cannot normally contribute to the sufficiency of the disclosure unless they are available to the skilled reader of the patent in question (**T 171/84**, OJ 1986, 95). By way of exception, however, patent specifications and scientific publications may be considered to form part of the common general knowledge where the invention is in a field of research so new that the relevant technical knowledge is not yet available from textbooks (**T 51/87**, OJ 1991, 177; see also **T 772/89**, **T 676/94**, **T 1900/08**). In **T 676/94** the board considered that the question whether or not the contents of a technical periodical formed part of the average knowledge of a skilled person when assessing sufficiency of disclosure, should be answered on the basis of the facts and evidence in each particular case.

References to DVB standards were found insufficient to meet the standards of Art. 83 EPC in **T 1191/04**.

**T 658/04** summarised the case law about what forms part of the common general knowledge. The board considered that an expert opinion submitted by the appellant (patent proprietor) which contained general considerations (not supported by verifiable

facts) did not form part of the common general knowledge (see also Chapter I.C.2.8.1 "Definition of common general knowledge").

In **T 443/11**, the board noted that during the course of the proceedings the examining division had argued that claim 1 had to be taken literally. The board disagreed with this statement, since it was established case law of the boards of appeal that claims should be interpreted in the manner that they would be understood by a person skilled in the art. In the context before it the board considered that the skilled person would understand (mathematical operations implemented in electronic devices).

### **3.2. References may also enable the skilled person to carry out an invention**

It is established case law that features not mentioned in the application documents themselves but in a document to which they refer may be incorporated into a patent claim if they unequivocally form part of the invention for which protection is sought. However, all the essential structural features thus disclosed which belong together must be incorporated into the claim; it is not permissible to single out a particular one (**T 6/84**, OJ 1985, 238; cited in numerous decisions).

In **T 288/84** (OJ 1986, 128), the board held that where an invention relates to the improvement of prior art originally cited in the description of the invention, a feature described in broad terms in the cited document but not mentioned expressly in the invention is sufficiently disclosed if it is realised in the examples of the invention in the form of an embodiment also mentioned in the reference document.

An invention is also sufficiently disclosed if reference is made to another document in the patent specification and the original description, and the skilled person can obtain from this cross-reference the information required to reproduce the invention but not disclosed in so many words in the description itself (**T 267/91**, **T 611/89**). In **T 920/92** the board held that this applied irrespective of the language in which it was drafted; (here Japanese).

However, where the reference document was possibly short-lived advertising material, the applicant was wise to incorporate the published information explicitly rather than by mere reference (**T 211/83**, cited in **T 276/99**).

In **T 737/90** it was explicitly stated that a reference to another document can only be taken into account if the document referred to can be unambiguously identified and the relevant addressees have ready access to it. This depends solely on the facts of the case. Following **T 737/90**, the board in **T 429/96** confirmed that a document incorporated by reference into the text of a European patent application had to become available to the public at the latest on the **publication date** and not on the **filing date** of the European patent application, in order to be taken into account for the purposes of Art. 83 EPC 1973.

The enabling disclosure of the invention in **T 521/10** relied on the content of (US) patent applications incorporated by reference which did not fulfil the requirements set out in

**T 737/90.** In order to be validly incorporated, each document must: (i) be available to the Office on or before the date of filing of the application; and (ii) be available to the public no later than on the date of publication of the application under Art. 93 EPC. As neither of the two documents was made available to the public and the only publication originating from the two documents was a continuation-in-part application which was published on a date later than the publication date of the European application at issue, the two documents were not validly incorporated by reference.

In **T 341/04**, the question was whether a referenced document, which could be unambiguously identified at the date of filing of the document containing the reference by its document number, but which document itself was "missing" in the sense that it was not available at said date of filing, could be "taken into account" for the purpose of Art. 83 EPC 1973 by relying on information present in a family member of the referenced document. The board answered in the affirmative.

## 4. Clarity and completeness of disclosure

### 4.1. General principles

It must be possible to reproduce a claimed step using the original application documents without any inventive effort over and above the ordinary skills of a practitioner (**T 10/86**). Where an applicant did not furnish details of the production process in the description in order to prevent the invention from being copied easily and the missing information could not be supplied from the general knowledge of a person skilled in the art, the invention was held to be insufficiently disclosed (**T 219/85**, OJ 1986, 376).

In **T 1164/11** the board was not aware of a known physical mechanism according to which light was able to push molecules of a medicament, contained in the matrix of a solidified medicamentous solution, into the skin. The board had serious doubts regarding the claimed interaction of the (laser light) energy emitter with the molecules and the claimed result of penetration of the molecules into the skin. The appellant (applicant) admitted that there might be a **lack of scientific explanation**, but stated that nevertheless a "surprising effect" was achievable with the claimed device "without knowing the real phenomena occurring in the skin". The board accepted that it might not be possible to provide a scientifically sound explanation and that the invention might still be sufficiently disclosed if such an unexpected effect was convincingly demonstrated. However, the original application was devoid of any test results or experimental evidence that could give an indication of light-induced enhancement of penetration of medicament molecules into the skin.

### 4.2. Indication of at least 'one way'

An invention is in principle sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry out the invention. If this is the case, the non-availability of some particular variants of a functionally defined component feature of the invention is immaterial to sufficiency as long as there are suitable variants known to the skilled person through the disclosure or common general knowledge which provide

the same effect for the invention (**T 292/85**, OJ 1989, 275). This has been confirmed by many decisions, for example: **T 81/87** (OJ 1990, 250), **T 301/87** (OJ 1990, 335), **T 212/88** (OJ 1992, 28), **T 238/88** (OJ 1992, 709), **T 60/89** (OJ 1992, 268), **T 182/89** (OJ 1991, 391), **T 19/90** (OJ 1990, 476), **T 740/90**, **T 456/91** and **T 242/92**.

If a claim comprises non-working embodiments, the consequences differ depending on the circumstances (**G 1/03**, OJ 2004, 413, citing **T 238/88**, OJ 1992, 709, **T 292/85**, OJ 1989, 275, and **T 301/87**, OJ 1990, 335).

### 4.3. Examples

Whether or not the disclosure of the patent in suit is sufficiently clear and complete within the meaning of Art. 100(b) and 83 EPC must be decided by appraising the information contained in the examples as well as other parts of the description in the light of the common general knowledge of the skilled person at the priority date (**T 322/93** and **T 524/01**).

However, where the application disclosed the claimed invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, it then necessarily disclosed at least one way of carrying out the invention disclosed in accordance with R. 42(1)(e) EPC, with the necessary details being derivable from the description including the prior art referred to therein (see e.g. **T 389/87**, **T 561/96** and **T 990/07**). The board in **T 990/07** pointed out that, although the case underlying decision **T 561/96** differed from that in **T 990/07** in that in **T 561/96** the description and the drawings were not erroneous, the board in **T 561/96** had also held that in cases where examples were not indispensable, their omission did not contravene R. 27(1)(e) EPC 1973 (R. 42(1)(e) EPC). This Rule only required the insertion of such examples "where appropriate". The jurisprudence of the boards of appeal thus drew a clear distinction between the concepts of "way of carrying out the invention claimed" and "examples" referred to in R. 27(1)(e) EPC 1973. According to this jurisprudence, the detailed description of one way of carrying out the invention claimed had to be interpreted in the light of Art. 83 EPC. It constituted a condition to be met by the description as a whole and was clearly mandatory. In contrast, the presence of examples would only be indispensable if the description would otherwise not be sufficient to meet this requirement. Hence, the purpose of the "examples" evoked in R. 27(1)(e) EPC 1973 appeared primarily to be to complete an otherwise incomplete teaching. (See also **T 1918/07** and **T 1169/08**).

In **T 226/85** (OJ 1988, 336), **T 409/91** (OJ 1994, 653) and **T 694/92** (OJ 1997, 408) the patent or the patent application disclosed only one or very few ways of carrying out the invention. In each of these decisions the boards had held that the disclosure of the specific examples was not sufficient to enable the invention to be carried out as claimed. However, according to **T 617/07**, no principle could be deduced from these decisions that sufficiency of disclosure is always to be denied if there is only example of carrying out an invention. Rather all three decisions emphasised that an objection of lack of sufficiency of disclosure (i) presupposes that there are serious doubts, substantiated by verifiable facts, and (ii) depends on the evidence available in each case whether or not a

claimed invention can be considered as enabled on the basis of the disclosure of one worked example.

#### 4.4. Invention to be performed over whole range claimed

The disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed **in the whole range claimed** rather than **only in some** members of the claimed class to be obtained (**T 409/91**, OJ 1994, 653; **T 435/91**, OJ 1995, 188; and **T 172/99**). This is considered a question of fact. Sufficiency of disclosure thus presupposes that the skilled person is able to obtain substantially **all** embodiments falling within the ambit of the claims. This view has been taken by the board in numerous decisions, for example **T 19/90** (OJ 1990, 476), **T 418/91**, **T 548/91**, **T 659/93**, **T 435/91** (OJ 1995, 188) and **T 923/92** (OJ 1996, 564; more recently, issue discussed in detail in **T 1727/12** ("Biogen Sufficiency")). This principle applies to any invention irrespective of the way in which it is defined, be it by way of a functional feature or not. The peculiarity of the functional definition of a technical feature resides in the fact that it is defined by means of its effect. That mode of definition comprises an indefinite and abstract host of possible alternatives, which is acceptable as long as all alternatives are available and achieve the desired result (**T 1121/03** and **T 369/05**). With respect to a claimed process defined in a functional manner, i.e. by its outcome, the board in **T 1051/09** concluded that what was lacking was a generalisable teaching applicable within the scope of the claims, i.e. beyond the specific examples.

More technical details and more than one example may be necessary in order to support claims of a broad scope (**T 612/92**, **T 694/92**, OJ 1997, 408; **T 187/93**). This must be decided on a case-by-case basis. The board must also be satisfied firstly that the patent specification put the skilled person in possession of at least one way of putting the claimed invention into practice, and secondly that the skilled person could put the invention into practice over the whole scope of the claim. If the board was not satisfied on the first point that one way existed, the second point did not need to be considered (**T 792/00**).

In **T 553/10**, the board stated that the passages cited by the appellant disclosed a method for producing lithium nickel manganese cobalt oxides which fell either within or outside the ambit of claim 1. An additional process step required when seeking to prepare oxides falling within the ambit of claim 1 was missing. The application lacked guidance, and this could not be overcome by drawing on common general knowledge. A declaration written by an employee of the appellant was therefore of little probative value for establishing what was common general knowledge in the art.

See also in this chapter II.C.6.1.2.

#### 4.5. Parameters

According to **T 517/98**, if the disclosure of a patent in suit was limited to products which, when prepared by the method according to the invention, were characterised by distinctive parameters, then a claim which did not stipulate these parameters a priori

encompasses embodiments which were not obtainable by the method disclosed. Such disclosure of a single way of performing the invention would only be considered sufficient if it enabled a person skilled in the art to carry out the invention within the whole ambit of the claim. In **T 172/99**, the board found that in the case of claimed subject-matter relying on a newly formulated and hence unfamiliar parameter to define the solution of a technical problem by which a relevant effect is achieved, the patentee is under a particular obligation to disclose all the information necessary reliably to define the new parameter not only (i) in a formally correct and complete manner such that its values can be obtained by a person skilled in the art without undue burden, but also (ii) in a manner which reliably retains the validity of the parameter for the solution of the technical problem for the application or patent in suit as a whole in the sense that the values routinely obtained will not be such that the claimed subject matter covers variants incapable of providing the relevant effect or, therefore, of solving the associated technical problem (followed in numerous decisions; see, for example, **T 914/01**, **T 179/05** and **T 75/09**).

In **T 815/07** the board pointed out that the purpose of a parameter contained in a claim is to define an essential technical feature of the invention. Its significance is that the presence of this technical feature contributes to the solution of the technical problem underlying the invention. The method specified for determining the parameter should therefore be such as to produce **consistent values**, so that the skilled person will know when he carries out the invention whether what he produces will solve the problem or not. This decision was cited in **T 120/08** and **T 593/09**. According to the latter decision, what is decisive is whether the parameter is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) the technical measures (e.g. selection of suitable compounds) necessary to solve the problem underlying the patent at issue (see also in this chapter II.C.7.2 " Article 83 EPC and clarity of claims").

The fact that no direct independent method of specifically determining the parameter has been described is not in itself prejudicial to the sufficiency of the description where the claims do not relate to a method of determining the parameter (**T 256/87**, case concerning Art. 84 and 83 EPC, compliance of amended claim 1). In **T 83/01** the board held that where the skilled person had no reason to doubt the definition of the parameter given, but there was no indication in the patent how to measure this parameter, the patent failed to fulfil the requirements of Art. 83 EPC 1973. In **T 808/09** (cartridge for use in a beverage preparation machine / liquid chocolate ingredient), the board considered that the patent failed to enable the measurement of the essential parameter of the invention, i.e. the viscosity of the liquid chocolate ingredient. Even if this viscosity feature had been shifted into a preamble of method claim 1 and supposing this preamble had been directed to the prior art, this shifting of the feature would still not have solved the problem of insufficiency. For a reference to prior art in the preamble to adequately serve this purpose the patent in suit still needs to contain all the necessary information in sufficient detail in order to enable the person skilled in the art to perform the invention. In the case before the board this would require information as to the viscosity measurement device to be used and the parameters to be observed. All this information was missing. The board's decision, taken in line with the long-standing jurisprudence, cited **T 805/93**



(dealing with viscosity measurement at "room temperature"), **T 83/01** and **T 1250/01** (both concerning the measurement of an essential parameter).

The board in **T 602/10** found that the proprietor had deliberately decided to use a method for determining rugosity which was different from the one commonly used in the state of the art. It was therefore its duty to provide full information with regard to the means and the procedures for implementing said method. In general terms, when the issue of sufficiency concerned the description of a method for determining a parameter, the less common the method the more accurate the information provided in the description should be. In the case at issue, in the absence of any known prior-art work applying the same method used in the patent for measuring the rugosity, the skilled person had to rely primarily on the teaching of the patent to put the method into practice.

Where the calibration of (undisclosed) test conditions may be achieved although the methods of determination of the parameter are incompletely described, the invention may be sufficiently disclosed. See for example **T 1062/98**. In both **T 485/00** and **T 225/93**, three methods were known in the art for the determination of the specific surface area of a CaCO<sub>3</sub> particle. In neither case did the description or common general knowledge indicate a preference for one of them. In **T 485/00**, the board held that reproducing an example and measuring the surface area of the resulting product by two or three well-known methods did not represent an undue burden for the skilled person. In **T 225/93**, however, the board found that, as there were three different measuring methods which did not always lead to the same result, this amounted to an undue burden. In **T 641/07** the board held, citing **T 485/00**, that when a skilled person was enabled to reproduce the invention, and it was sufficient for him to reproduce one of the examples in order to identify the method employed to measure the value of a parameter, there was no insufficiency in the description since the identification procedure in question could not be regarded as involving an undue burden. In **T 1712/09**, the board held that the opponent had failed to prove that the method of measuring the parameters was unworkable. The tests referred to in its experimental reports had been carried out using measuring apparatus different from that described in the patent, and so not as instructed there. The board found that no attempt had been made to reproduce the invention (no attempt at calibration), which was the first condition for an objection under Art. 100(b) and 83 EPC. It cited **T 815/07** (need for consistent values) and **T 1062/98** and **T 485/00** (possibility of calibrating methods of determining the relevant parameters).

In **T 45/09** too, the opponent's test conditions were called into question since the tests had been carried out using a commercially available product. Observing that two products of the same brand but available on the market at different times would not necessarily have the same properties, the board found that it had not been established that the properties had been the same in this specific case. The board also considered the issue of calibrating the method of measuring the parameter. The board concluded that the opponent had failed to show that the method of measuring the parameter could not be reproduced and thus to prove insufficient disclosure. It was, indeed, for the opponent to do so, and it could have discharged its burden of proof by attempting to reproduce the method using at least one of the claimed silica.

Where it is obvious that a skilled person would select a particular analytical measuring method, (none being disclosed in the patent), balancing its simplicity and convenience against the required accuracy, the requirements of Art. 83 EPC are met (see e.g. **T 492/92**). This differed substantially from the case considered in decision **T 466/05**. In **T 492/92** it was considered that the fact that two methods suggested by the appellant did not necessarily lead to identical results when measuring a specific parameter was not sufficient evidence that a skilled person could not determine this parameter of the claimed compositions with the required accuracy. In **T 466/05**, the skilled person did not even know which parameter should be determined and the invention was insufficiently disclosed.

The board in **T 2403/11** acknowledged that an ambiguity of a parameter in the claim was not enough in itself to deny sufficiency of disclosure. Whether such an ambiguity led to insufficiency of disclosure was to be decided on a case-by-case basis (see **T 593/09**). The case at issue was different from **T 882/03**, which also concerned viscosity and where the variations resulting from the ambiguity were only minor, and from **T 492/92**, where the skilled person knew which method to choose. In **T 2403/11** the method and the measurement parameters to be chosen were not known to the skilled person. **T 482/09** also concerned a method of measuring viscosity (see also **T 808/09** and **T 805/93** supra). In **T 1697/12** the claims covered, through open-ended ranges, embodiments that could not be obtained with the process disclosed in the patent, but which might be obtainable with different methods still to be invented in the future (insufficiently disclosed invention).

Where inventions are defined by claims containing unclear features, e.g. **ambiguous parameters**, which cannot be clarified in the light of the description, the effect sought may be the only means of understanding such inventions. This effect must then be taken into consideration and assessed under Art. 83 EPC with a view to establishing whether the invention can be reproduced (see **T 862/11**, headnote).

See also in this chapter II.C.7.2.

## 5. Reproducibility

### 5.1. Repeatability

In **T 281/86** (OJ 1989, 202), it was held that there is no requirement under Art. 83 EPC 1973 according to which a specifically described example of a process must be exactly repeatable. Variations in the constitution of an agent used in a process are immaterial to the sufficiency of the disclosure provided the claimed process reliably leads to the desired products. See also **T 292/85** (OJ 1989, 275); **T 299/86** (OJ 1988, 88); **T 181/87**, **T 212/88** (OJ 1992, 28); **T 182/89** (OJ 1991, 391) and **T 19/90** (OJ 1990, 476).

In **G 1/03** (point 2.5 of the Reasons) the Enlarged Board of Appeal indicated that a lack of reproducibility of the claimed invention is relevant under the requirements of sufficiency of disclosure if the technical effect is a technical feature of the claim, since then it is a feature characterising the subject-matter claimed (**T 1079/08**). A lack of

reproducibility of the claimed invention (i.e. a failure of the claimed features to deliver the effect aimed for) is seen to represent, in the case of an effect which is not expressed in a claim but is part of the problem to be solved, "a problem of inventive step". If an effect is expressed in a claim, there is lack of sufficient disclosure (**G 1/03**, OJ, 2004, 413, and **T 939/92**, OJ 1996, 309, cited by **T 2001/12**).

## 5.2. Hypothetical embodiments

In **T 515/00** the board pointed out that an invention cannot be considered to be irreproducible merely because a claim encompasses a hypothetical embodiment which lies outside the breadth of the claim as determined by the Protocol on the Interpretation of Art. 69 EPC 1973, which embodiment cannot be reproduced (endorsed in **T 519/07**).

## 5.3. Variants

If the only embodiment disclosed with concrete details in a patent is not disclosed in a manner sufficiently complete for the claimed invention to be carried out by a person skilled in the art on the date of priority with respect to the fundamental scope of said invention, it is of no significance with regard to the question of sufficient disclosure whether on the relevant date of filing a variant could have been carried out if the variant, although it is covered by the wording of the patent claim, does not fall within the fundamental scope of the claimed invention with regard to the teaching of the patent due to a lack of comparable technical success (**T 1173/00**, OJ 2004, 16).

The board went on to state that if an invention is insufficiently disclosed, it is of no relevance whether it was objectively impossible to provide the **missing information** on the date of priority. The decisive issue is whether the invention is disclosed in a manner sufficiently complete for it to be carried out by an average person skilled in the art on the date of priority, with knowledge of the patent and on the basis of that person's common general knowledge.

## 5.4. Use to which invention is put

Where a disadvantage of an invention (in this case the risk of injury to users) could prevent its use, this is not an obstacle to reproducibility provided that the otherwise desired result is achieved by the technical teaching disclosed in the patent in suit (**T 881/95**, see also **T 468/09**). An Art. 83 EPC objection concerning the absence of any detailed indication of the **use** envisaged for the products cannot succeed, as Art. 83 EPC merely requires the invention to be sufficiently disclosed (see e.g. **T 866/00**).

## 5.5. Reach-through claims

In **T 1063/06** (OJ 2009, 516) the board held that a formulation of a claim whereby functionally defined chemical compounds were to be found by means of a new kind of research tool using a screening method set out in the description constituted a reach-through claim which was also directed to future inventions based on the one now being

disclosed. The applicant was entitled to claim patent protection only for his actual contribution to the art and not to reserve an unexplored field of research.

## **5.6. Reproducibility without undue burden**

The disclosure must be reproducible without undue burden.

### **5.6.1 Trial and error**

Even though a reasonable amount of trial and error is permissible when it comes to sufficiency of disclosure, e.g. in an unexplored field or where there are many technical difficulties, the skilled person has to have at his disposal, either in the specification or on the basis of common general knowledge, adequate information leading necessarily and directly towards success through the evaluation of initial failures (**T 226/85**, OJ 1988, 336; following **T 14/83**, OJ 1984, 105; **T 48/85**, **T 307/86** and **T 326/04**) (see also **T 2220/14**, highly complex technical field). Where the skilled person can only establish by trial and error whether or not his particular choice of numerous parameters will provide a satisfactory result, this amounts to an undue burden (**T 32/85**). Nor can sufficiency of disclosure be acknowledged, if, for an invention which goes against prevailing technical opinion, the patentee fails to give even a single reproducible example (**T 792/00**. See also **T 397/02**, **T 1440/07** and **T 623/08**).

### **5.6.2 Occasional failure**

It suffices for the disclosure of an invention that the means intended to carry out the invention are clearly disclosed in technical terms which render them implementable and that the intended result is achieved at least in some, equally realistic, cases (**T 487/91**). The occasional failure of a process as claimed does not impair its reproducibility if only a few attempts are required to transform failure into success, provided that these attempts are kept within reasonable bounds and do not require an inventive step (**T 931/91**). The skilled person is used to occasional failures when testing a technical teaching (**T 14/83**, cited in **T 1133/08**).

### **5.6.3 Routine selection**

Reproducibility is not 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**).

### **5.6.4 Wrong citations**

Wrongly citing a method of measuring an essential product parameter may constitute insufficient disclosure (**T 1250/01**).

### 5.6.5 Forbidden area of the claims

According to **T 256/87** all that has to be ensured is that the skilled person reading the specification will be able to carry out the invention in all its essential aspects and know when he is working within the forbidden area of the claims. The possibilities of indirect empirical investigation referred to in the specification were, in the board's view, an acceptable solution which sufficed to fulfil the requirements of Art. 83 EPC 1973 without undue burden. This decision was followed in **T 387/01**, **T 252/02**, **T 611/02** and **T 464/05**. **However**, according to more recent decisions, the concept of 'forbidden area' was rather associated with the scope of the claims, i.e. Art. 84 EPC, than with sufficiency of disclosure (see in this chapter II.C.7.2; see in particular **T 619/00**, **T 943/00**, **T 396/02**, **T 1033/02**, **T 452/04**, **T 466/05**, **T 1015/06**, **T 1250/08**, **T 593/09**, **T 1507/10**, **T 2331/11**).

In **T 1886/06**, the board emphasised that the above finding in **T 256/87** could not mean, conversely, that if the claims used a term undefined under Art. 84 EPC 1973 the invention necessarily became impossible to carry out within the meaning of Art. 83 EPC 1973 in the absence, in the description or the common general knowledge of the skilled person, of concrete indications towards a possible definition; doubts as to the claims' reproducibility over their entire scope had to be substantiated by verifiable facts. A mere conjecture that their scope might extend to undisclosed variants was not enough. In the more recent decision **T 482/09**, the board addressed this same issue in detail and stated in particular that whether a competitor could know that he was working within the forbidden area of the claims depended at most on whether the claims were worded clearly enough to satisfy Art. 84 EPC. Art. 83 EPC, by contrast, made no mention of the scope of protection conferred by the claims of the patent.

### 5.6.6 Non-disclosed steps

There is no requirement in the EPC that the claimed invention may be carried out with the aid of only a few additional non-disclosed steps. The only essential requirement is that each of those additional steps be so apparent to the skilled person that, in the light of his common general knowledge, a detailed description of them is superfluous (**T 721/89**).

### 5.6.7 Experiments

The legislative purpose of Art. 83 EPC is to ensure that the skilled person can reproduce the invention without his own research or undue experimentation. Experiments are an undue burden if their primary aim is to find the solution to the problem but not if they are carried out merely to determine the numerical limits of a functionally defined range (**T 312/88**). They should quickly give a reliable picture of how the products can be produced or manufactured (**T 475/88**). However, it is not necessary for the experimental data filed with the patent in suit to be an exact repetition of the worked examples of the patent, as long as the experimental work can be regarded as being within the scope of the invention (**T 674/96**).

For experiments to be considered reasonable, the application need not disclose the best and easiest method; a long and complicated route which is nevertheless clearly successful may be considered reasonable (**T 412/93**).

The board in **T 1133/08**, faced with a multitude of options for selecting suitable materials, dimensions and procedural parameters which were merely outlined in the part of description relating to embodiments, found that there was no specific information describing in detail at least one way of carrying out the invention claimed. Experiments were needed to solve the problem (i.e. identify parameters and conditions resulting in a sinusoidal profile), and, as established in **T 312/88** in conjunction with **T 68/85** and **T 18/89**, such experimentation had to be considered unduly burdensome. If an invention had several variants, it was very important first of all to describe as many as possible in detail, rather than merely outlining them, to show the skilled person that the invention could be carried out in practice across the entire breadth of the claims. Here, not one single way of carrying out the invention was apparent, nor had any subsequently been demonstrated, e.g. on the basis of experiments. The board also analysed **T 14/83**, contrasting it with **T 412/93** (genetic engineering).

#### 5.6.8 Measuring methods

Where it is obvious that a skilled person would select a particular analytical measuring method, (none being disclosed in the patent), balancing its simplicity and convenience against the required accuracy, the requirements of Art. 83 EPC are met (see e.g. **T 492/92**). This is the case even if the two different analytical methods proposed by the patentee give significantly different results with the same composition. It also suffices if the person skilled in the art would assume that it was most likely that a certain method was used and this assumption could be tested in the light of the information given in the examples of the patent in suit (**T 143/02**). However, where there are different measuring methods which do not always lead to the same result, this can amount to an undue burden, as in **T 225/93**. In **T 930/99**, the board considered **T 225/93** inapplicable, as there was only one measurement method before them. The respondent's argument that there would be legal uncertainty, since third parties would not know whether they were working within or outside the range specified, was clearly an argument based on lack of clarity, which was not a ground of opposition and so could not be considered (see also in this chapter II.C.6.2).

#### 5.6.9 Chemical compounds

According to **T 954/05**, the structural definition of a chemical compound may not be replaced in a claim by the mere juxtaposition of a feature purportedly representing a complete chemical structure and of a functional feature if on the one hand the first feature comprises an indefinite number of compounds and there is no systematic selection rule based on the feature in question enabling the skilled person to identify the claimed compounds, and on the other hand the second, functional feature is not identifiable in the indefinite list of compounds potentially suitable for such a function because there is no indication of a typical standardised test for determining its presence or absence.

In **T 544/12** the board confirmed that a definition of a group of compounds in a claim by both structural and functional features is generally acceptable under Art. 83 EPC as long as the skilled person is able to identify, without undue burden, those compounds out of the host of compounds defined by the structural feature(s) in the claim which also fulfil the claimed functional requirements (following **T 435/91** and **T 1063/06**). In **T 544/12** it was up to the skilled person to identify within the almost infinite host of alternatives covered by the structural definition of claim 1 those compounds that were phosphorescent. Claim 1 extended to classes (of iridium complexes) that were entirely different from the concept as argued by the proprietor (non-compliance with Art. 83 EPC). The board did not share the view taken by the German Federal Court of Justice (Bundesgerichtshof) in its decision of 11 September 2013 (X ZB 8/12).

### 5.7. Trial and error

Where the person skilled in the art has to find out by trial and error which, if any, compound meets the parameter set out in the claim, this constitutes an undue burden. The fact that this could be done by routine experimentation was not sufficient for the subject-matter claimed to meet the requirements of Art. 83 EPC. Nor did the question whether or not the parameter could be reliably determined play a role (**T 339/05**). In **T 123/06** the board found that the functional definition of the device was no more than an invitation to perform a research programme, the skilled person only being able to establish through trial and error whether the claimed device was achieved. This amounted to an undue burden.

According to **T 1063/06** (OJ 2009, 516), a functional definition of a chemical compound (in this case in a reach-through claim) covered all compounds possessing the capability according to the claim. In the absence of any selection rule in the application in suit, the skilled person, without the possibility of having recourse to his common general knowledge, had to resort to trial-and-error experimentation on arbitrarily selected chemical compounds to establish whether they possessed the capability according to the claim; this represented for the skilled person an invitation to perform a **research programme** and thus an undue effort (following **T 435/91**). See also **T 1140/06**.

Following **T 1063/06**, the board held in **T 852/09** that since the enhancers to be used were characterised in functional terms only and the claim merely represented for the skilled person an invitation to perform a research programme, he/she could not carry out the invention within the entire scope claimed without undue burden (see also **T 155/08**).

If the patent claims require that a specific aim should be achieved (in this case, that a specific value of a parameter should not be reached), then there is no guarantee that the invention can be carried out in accordance with Art. 100(b) EPC if the patent affords the skilled person no clue as to how he can achieve this aim outside the scope of the embodiments without an undue burden of research (**T 809/07**).

## 5.8. Post-published documents

In the absence of any tangible proof in the patent specification that the claimed concept can be put into practice, post-published documents can be used as evidence whether the invention merely disclosed at a general conceptual level was indeed reproducible without undue burden at the relevant filing date (**T 994/95** and **T 157/03**). In **T 1262/04**, the board considered that this principle applied at least to cases such as the one at issue, where the technical teaching as disclosed in the application was credible. In **T 1205/07**, the post-published documents were considered, as the evidence they provided was not aimed at "curing" any alleged insufficiency of disclosure, but rather at confirming the teachings of the application. See also **T 1547/08**.

Even though sufficiency of disclosure must, in principle, be established at the priority date, post-published documents can be used as evidence that the claimed concept can be put in practice. Accordingly, the board decided to consider documents in spite of their late filing (**T 1164/11**).

If a disclosure is seriously insufficient in that it provides no guidance for performing a particular aspect of the invention, a reference to later documents showing how such performance was accomplished at a later date is manifestly incapable of curing the insufficiency (**T 222/00**). Sufficiency of disclosure must, in principle, be shown to exist at the effective date of a patent. If the description of the patent specification provides no more than a vague indication of a possible medical use for a chemical compound yet to be identified, later more detailed evidence cannot be used to remedy the fundamental insufficiency of disclosure of such subject-matter (**T 609/02**). The disclosure in post-published documents can only be taken into account for the question of sufficiency of disclosure if it was used to back up the positive findings in relation to the disclosure in a patent application (**T 1273/09** citing **T 609/02**).

See also in this chapter II.C.6.2 "Level of disclosure required for medical use".

## 6. The requirement of sufficiency of disclosure in the biotechnology field

### 6.1. Clarity and completeness of disclosure

#### 6.1.1 General

The principles elucidated under Chapter II.C.3 and 4 above are also applicable to biological inventions. In particular, reference should be made to the case law laid down by the boards in **T 281/86** (OJ 1989, 202), **T 299/86** and **T 409/91** (OJ 1994, 653). Issues related to completeness of disclosure are also discussed by the boards in context with inventive step (see e.g. **T 1329/04**, **T 604/04**, **T 898/05**, above Chapter I.D.4.1) and industrial applicability (see e.g. **T 870/04**, **T 641/05**, **T 1452/06**, above Chapter I.E). Whether the application discloses sufficient information making it plausible that the claimed polynucleotides or polypeptides have the alleged technical effect was considered a matter of inventive step (**T 743/97**; **T 1329/04**) or industrial applicability (**T 1165/06**, **T 1452/06**), whereas the relevant question under Art. 83 EPC 1973 was



whether the description was sufficiently clear and complete for the skilled person to prepare the claimed products (**T 743/97**).

In **T 449/90**, the board considered that the requirements of Art. 83 EPC 1973 had been satisfied where the claimed degree of inactivation ("substantially") of the Aids virus could be demonstrated with sufficient certainty. Complete inactivation of the life-threatening virus - which the opponent had argued was necessary - was indeed highly desirable, but not an issue under Art. 83 EPC 1973, given the claim as worded.

#### 6.1.2 One way of implementing invention over whole scope of claim

When examining sufficiency of disclosure, the boards have to be satisfied, firstly, that the patent specification places the skilled person in possession of **at least one way** of putting the claimed invention into practice, and secondly, that the skilled person can put the invention into practice **over the whole scope of the claim** (see e.g. **T 792/00**, **T 811/01**, **T 1241/03**, **T 364/06**; see also **T 1727/12**, "Biogen sufficiency"). The scope of the patent should be justified by the technical contribution to the art (**T 612/92**). The necessary extent of disclosure is assessed on a case-by-case basis having regard to the essence of the invention (**T 694/92**, OJ 1997, 408).

In **T 292/85** (OJ 1989, 275) the board stated that an invention is regarded as sufficiently disclosed if at least one way is clearly indicated enabling the skilled person to carry out the invention. The invention at issue concerned a recombinant plasmid comprising a homologous regulon, heterologous DNA and one or more termination codons for expression in bacteria of a functional heterologous polypeptide in recoverable form. The application was refused by the examining division on the grounds that not all embodiments falling within the broad functional wording of the claims were available. The board, however, held that the non-availability of some particular variants was immaterial as long as there were suitable variants known which provided the same effect.

Similarly, in **T 386/94** (OJ 1996, 658) the patent specification provided a technically detailed example for the expression of preprochymosin and its maturation forms in *E. coli*. It suggested the possibility of expressing these proteins in micro-organisms in general. The board held that the invention was sufficiently disclosed because one way to carry out the invention was clearly indicated and the state of the art contained no evidence that foreign genes could not be expressed in organisms other than *E. coli*. The principles set out in **T 292/85** (OJ 1989, 275) were also applied in **T 984/00** (where the invention lay in the use of the T-region of the *Agrobacterium* without the genes of the T-region of wild type Ti-plasmids to avoid the deleterious effects of these genes on the target plant) and in **T 309/06** (where the appellant had disclosed a novel group of enzymes characterised by useful properties and the board allowed the appellant to claim the enzymes independently of their origin).

As for the amount of detail needed for a sufficient disclosure, this depends on the correlation of the facts of the case to certain general parameters, such as the character of the technical field and the average amount of effort necessary to put into practice a

certain written disclosure in that technical field, the time when the disclosure was presented to the public and the corresponding common general knowledge, and the amount of reliable technical details disclosed in a document (see **T 158/91**; **T 694/92**, OJ 1997, 408; **T 639/95**; and **T 36/00** and **T 1466/05**).

### 6.1.3 Repeatability

An invention may also be sufficiently disclosed where results are **not exactly repeatable**. Variations in construction within a class of genetic precursors, such as recombinant DNA molecules claimed by a combination of structural limitations and functional tests, were immaterial to the sufficiency of disclosure provided the skilled person could reliably obtain some members of the class without necessarily knowing in advance which member would thereby be made available (**T 301/87**, OJ 1990, 335).

The claimed subject-matter in **T 657/10** included an "elite event", i.e. a particular event resulting from a random method (for which the expectations always range from nil to high) and having at least one surprising, advantageous property. There was ample jurisprudence of the boards of appeal on "elite events". Although the specific random methods and resulting products with (normal) average properties might well be known in the prior art, the presence of a particular product with an unexpected advantageous property might justify the recognition of an inventive step. However, the disclosure has to enable a skilled person to obtain the particular product resulting from the "elite event" without the need to repeat the random method *de novo*, i.e. he must be able to obtain the particular product without having to rely on pure chance again. In the case before the board these requirements were not fulfilled.

### 6.1.4 Broad claims

In some cases, more technical details and more than one example were found necessary in order to support claims of a broad scope, for example where the essence of the invention was the achievement of a given technical effect by known techniques in different areas of application and serious doubts existed as to whether this effect could readily be obtained for the whole range of applications claimed, more technical details and more than one example may be required (see **T 612/92**; **T 694/92**, OJ 1997, 408; **T 187/93** and **T 923/92**). In **T 694/92** incomplete guidance was given. The claimed subject-matter concerned a method for genetically modifying a plant cell. In fact, the board held that the experimental evidence and technical details in the description were not sufficient for the skilled person to reliably achieve, without undue burden, the technical effect of expression in any plant cell of any plant structural gene under the control of any plant promoter. Further cases, where more than one example was required, may be found in this chapter II.C.6.4.

An application may only be objected to for lack of sufficient disclosure if there are serious doubts, substantiated by verifiable facts. The mere fact that a claim is broad is not in itself a ground for considering that the application does not comply with the requirement that it be sufficiently disclosed under Art. 83 EPC (see e.g. **T 19/90**, OJ 1990, 476; **T 612/92**, **T 309/06** and **T 617/07**; see also **T 351/01**, **T 21/05**, **T 1188/06**, **T 884/06** and

**T 364/06**). In **T 19/90** the claimed invention was defined by the incorporation of an activated oncogene sequence into the genome of non-human mammalian animals in general. The examining division refused the application on the grounds that in the light of the differences among different animals, it could not be assumed that the sole example given - mice - could be extended to all other non-human mammalian animals and the claims were thus unrealistically broad. The board disagreed.

However, in **T 636/97** it was emphasised that it is a fundamental principle of patent law that a claim can validly cover broad subject-matter, even though the description of the relevant patent does not enable every method of arriving at that subject matter to be carried out. Otherwise no dominant patent could exist, and each developer of a new method of arriving at that subject matter would be free of earlier patents. In **T 694/92** (OJ 1997, 408) the board held that, where an invention relates to the actual realisation of a technical effect anticipated at a theoretical level in the prior art, a proper balance must be found between, on the one hand, the actual technical contribution to the state of the art by said invention, and, on the other hand, the terms in which it is claimed, so that, if patent protection is granted, its scope is fair and adequate. The board highlighted the interrelation between the requirements of Art. 84, 83 and 56 EPC 1973. See also **T 187/93**.

## **6.2. Level of disclosure required for medical use**

In **T 609/02** the board pointed out that where a therapeutic application is claimed in the form allowed by the Enlarged Board of Appeal in **G 5/83** (OJ 1985, 64), i.e. in the form of the use of a substance or composition for the manufacture of a medicament for a defined therapeutic application, attaining the claimed therapeutic effect is a functional technical feature of the claim (see **G 2/88**, OJ 1990, 93) and **G 6/88**, (OJ 1990 114) for non-medical applications). As a consequence, under Art. 83 EPC, unless this is already known to the skilled person at the priority date, the application must disclose the suitability of the product to be manufactured for the claimed therapeutic application.

If the description in a patent specification provides no more than a vague indication of a possible medical use for a chemical compound yet to be identified, more detailed evidence cannot be used later to remedy the fundamental insufficiency of disclosure of such subject-matter (**T 609/02**). Referring to **T 609/02**, the board in **T 433/05** recalled that where a therapeutic application was claimed in the Swiss-type form, attaining the claimed therapeutic effect was a functional technical feature of the claim. As a consequence, under Art. 83 EPC 1973 the application had to disclose the suitability of the product to be manufactured for the claimed therapeutic application (see also **T 1685/10**). Note, however, that according to **G 2/08** (OJ 2010, 456), where the subject matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so-called Swiss-type claim as instituted by decision **G 5/83** (OJ 1985, 64). Following **T 609/02**, the board in **T 801/06** the board recalled that a claimed therapeutic effect may be proven by any kind of data as long as they clearly and unambiguously reflect the therapeutic effect. Thus, the fact per se that the experiments in the patent were not carried out with a "real" metastasis was not sufficient to deny sufficiency of disclosure.

According to **T 609/02**, showing a pharmaceutical effect in vitro may be sufficient if for the skilled person this observed effect directly and unambiguously reflects such a therapeutic application (**T 241/95**, OJ 2001, 103, see also **T 158/96**) or, as decision **T 158/96** also put it, if there is a "clear and accepted established relationship" between the shown physiological activities and the disease. Once this evidence is available from the patent application, then post-published (so-called) expert evidence (if any) may be taken into account, but only to back-up the findings in the patent application in relation to the use of the ingredient as a pharmaceutical, and not to establish sufficiency of disclosure on their own. See also **T 491/08** and **T 1364/08**. This has also been applied to decisions concerning second medical use claims (see, for example, **T 699/06** and **T 1396/06**) and in **T 604/04**, to claims directed to first medical use claims and to pharmaceutical compositions.

A post-published document reporting that no proven effective vaccine against HSV was available did not prove the non-workability of the invented vaccine, since there might have been other reasons, e.g. regulatory reasons, for not producing vaccines according to the invention. Furthermore, for compliance with the requirements of Art. 83 EPC 1973, it was not necessary to undertake and disclose clinical trials (**T 1023/02**).

For the acceptance of sufficient disclosure of a therapeutic application, it is not always necessary for results of clinical trials to be provided at the relevant date, but the patent/patent application must provide some information showing that the claimed compound has a direct effect on a metabolic mechanism specifically involved in the disease. Once this evidence is available from the patent/patent application, post-published evidence may be taken into account to support the disclosure in the patent application (**T 433/05**).

In more recent decisions such as **T 2181/08**, **T 338/10**, **T 1685/10**, **T 943/13** and **T 2059/13**, the boards have cited the approach taken in **T 433/05** and **T 609/02** and applied it to the specific cases before them. In **T 895/13** the board stated that, pursuant to decision **T 609/02**, attaining the claimed therapeutic effect was a functional technical feature of a claim drawn up in the Swiss-type form. In its view, the same principle applied to purpose-related product claims drawn up in accordance with Art. 54(5) EPC. Accordingly, the therapeutic effect provided by the claimed subject-matter was to be examined in the context of the assessment of sufficiency of disclosure (Art. 83 EPC) (see **G 1/03**, point 2.5.2 of the Reasons) and not, as in the decision under appeal, in the context of the assessment of inventive step.

In **T 1616/09** the board pointed out that, for the purposes of Art. 83 EPC, the level of disclosure in the application which is required for claims directed to pharmaceutical compositions or kits is not the same as that which is required for medical-use claims. For claims directed to pharmaceutical compositions or kits it is in principle sufficient that the application provides information which allows the skilled person to produce the composition or kit, and that there are no substantiated doubts that it could indeed be used in therapy. For second-medical-use claims, on the other hand, it is required not only that the composition itself is disclosed in an enabling way but also that its suitability for the claimed treatment is plausibly disclosed in the application. In the case of a claim

directed to a pharmaceutical composition comprising two classes of compounds which had both already been used in therapy in the prior art, there was a priori no reason to doubt that such a pharmaceutical composition could be produced; no specific functional effect had to be demonstrated. In the case of second-medical-use claims, if the claimed therapeutic effect was already known to the skilled person at the priority date, it was not necessary to demonstrate it in the application.

In **T 1823/11**, claim 1 related to phaseolamin for use as an anticaries agent. In its decision to refuse the application for non-compliance with the requirements of Art. 83 EPC, the examining division had pointed out two deficiencies, namely the absence of indications as to the preparation of phaseolamin and the absence of any information as to the pH conditions. The board did not share this conclusion. It decided to remit the case and addressed some observations to the first-instance department. It observed that claim 1 was drafted as a purpose-limited product claim in accordance with Art. 54(5) EPC. The technical effect of phaseolamin of being useful as an anticaries agent was expressed in the claim. When the technical effect was expressed in the claim, the issue as to whether this effect was indeed achieved over the whole scope of the claim was a question of sufficiency of disclosure (**G 1/03**, OJ 2004, 413, point 2.5.2 of the Reasons). This general approach applied in particular to claims including a **therapeutic effect** as a feature of the claim, such as purpose-limited product claims in accordance with Art. 54(4) and 54(5) EPC or claims drafted in accordance with the "Swiss-type" format (**T 906/10**, **T 1616/09**, **T 1869/11**). Thus, in order to establish whether the requirement of sufficiency of disclosure was met it had to be assessed at first instance whether the application disclosed the potential suitability of phaseolamin to act as an anticaries agent or whether this information could be derived from the prior art.

**T 338/10** concerned a claim for a second therapeutic use in which the active ingredient was a "first allergen" and the therapeutic use the treatment or prevention of an allergy caused by a different, second allergen. The board found that there was no experimental data in the patent proving that a first allergen could be used to treat an allergy caused by a different allergen.

### 6.3. Level of disclosure required for antibodies

In **T 431/96** the skilled person seeking to reproduce the invention would have had to produce monoclonal antibodies by routine methods and test them singly in an assay. Although this might possibly involve some tedious and time-consuming work, it was nothing out of the ordinary since the techniques for the production and selection of hybridomas were common routine techniques at the priority date of the patent in suit.

The board found that the essential issue to be considered in **T 601/05** of 2.12.2009 was whether or not the patent enabled the production of human monoclonal antibodies binding with high affinity to soluble TNF and, consequently, whether or not the skilled person could practise the invention over the whole scope of the claim (following **T 792/00**). On the evidence before the board it did not.

In **T 1466/05** the question arose whether the availability of a hybridoma producing one specific antibody together with a general description of the epitope recognised by this antibody put the skilled person in the position to obtain further antibodies with the same specificity. The board observed that similar questions had arisen in various cases decided by the boards of appeal, and different boards had given different answers depending on the circumstances of each case (**T 510/94**, **T 513/94**, **T 349/91**, **T 716/01**).

In **T 1466/05** the claim was not restricted to monoclonal antibodies defined by reference to the deposited hybridoma. As the application did not disclose any specific antigen for preparing further antibodies as claimed, the board considered that a skilled person seeking to prepare such antibodies would have had to embark on a **research programme** without any teaching in the application as how to achieve the desired specificity which amounted to an undue burden.

The claim at issue in **T 405/06** was directed to immunoglobulins with certain stated features. The question to be answered was whether a skilled person would have found at the filing date in the application as filed a sufficiently clear and complete disclosure of the precise structure of such an immunoglobulin in order to be in a position to prepare it over the broad range of the claim. Although the claim was not limited to immunoglobulins obtained from camelids, the experimental part of the description as a whole and the corresponding figures dealt exclusively with camel immunoglobulins and the general part of the description did not contain a complete disclosure of any non-camelid immunoglobulin either. The requirements of Art. 83 EPC 1973 were thus not satisfied, as the skilled person would be left with the task and burden of finding out how the teaching relating to camelid immunoglobulins could be extended to products of different origins (e.g. human immunoglobulins) falling within the broad area of the claim.

The application the subject of **T 433/07** concerned broadly reactive opsonic antibodies that react with common staphylococcal antigens. The board held that the invention was insufficiently disclosed; the application did not disclose either any serotype cross reactive monoclonal antibody or the isolation of an antigen associated with the serotype cross protective response required by the claim. A European patent application containing a claim referring to a method of production had to provide the skilled person with the means to produce the desired product. If this was not the case, this shortcoming could not be overcome by telling him exactly how the desired product had to look and which screening criteria had to be applied to find it.

In **T 617/07** the claim at issue concerned monoclonal antibodies and synthetic and biotechnological derivatives thereof defined by structural and functional features. The board found that, given his common general knowledge, the skilled person would be able, in a possibly time-consuming but straightforward manner, to provide antibody variants having the functional requirements indicated in the claim. There was no doubt that the structural definition in the claim included antibodies that did not have the desired function but, when attempting to rework the invention the skilled person would on the basis of his knowledge be able to avoid non-functional variants. Therefore, because the skilled person knew how to achieve antibodies with the desired function on the basis of a

particular known antibody, he was not in the situation of having to sort out non-functional variants in a burdensome manner.

In **T 386/08** the patent concerned humanised antibodies with framework sequences. It disclosed not only one, but many examples. The board pointed out that the concept of sufficiency of disclosure over the whole scope of the claim did not mean that, for a disclosure to be considered as sufficient, it had to be demonstrated that each and every conceivable embodiment of a claim could be obtained; see **G 1/03** (OJ 2004, 413). There may be situations where the specification contains sufficient information on the relevant criteria for finding appropriate alternatives ("variants") over the claimed range with reasonable effort. Under these circumstances the non-availability of certain variants encompassed by the claim at the priority date is considered immaterial for the sufficiency of disclosure. For an example where this was not so, see **T 601/05**. The current situation however was different in that the patent described quite a number of appropriate alternatives and in that the allegedly non-obtainable variants were "hypothetical" variants. The requirements of Art. 83 EPC were fulfilled.

#### **6.4. Factors contributing to a finding of undue burden**

In **T 187/93** there were experimental uncertainties in the patent application. The board found that the skilled person, when trying to obtain the same technical effect with a different glycoprotein would have experienced lack of predictability, which amounted to an undue burden.

In **T 2006/08**, although no experimental details were provided for factor IX in the patent-in-suit, the board considered that no undue experimentation would be required to carry out the method steps. It was plausible that the claimed process achieved an improvement of the in vivo function of factor IX. The requirements of Art. 83 EPC were fulfilled.

Similarly, in **T 727/95**, the board found that the invention relied too much on chance. The claimed subject-matter included a "microorganism designated *Acetobacter* and having the ability of microorganisms [...]". The board observed that by including the phrase "having the ability of", the claim covered not only *Acetobacter* microorganisms derived from the deposited strains, but also *Acetobacter* microorganisms which had the stated characteristics in common with the deposited strains. In the board's judgment, finding other stable, cellulose high-producing *Acetobacter* strains in nature was a chance event, and relying on chance for reproducibility amounted to an undue burden in the absence of evidence that such chance events occurred and could be identified frequently enough to guarantee success. The board concluded that the claim was not repeatable without undue burden over the entire breadth of the claim.

The claimed subject-matter in **T 639/95** concerned a method for producing PHB biopolymers in a host transformed with genes encoding the enzymes  $\beta$ -ketothiolase, acetoacetyl-CoA reductase and polyhydroxy butyrate (PHB) synthetase. The board found that the experimental plan for identifying and isolating the PHB gene was very general. Some references were missing and/or incomplete. There were no results and

no details which could facilitate the repetition of the work. The board thus held that the total amount of experimental effort necessary amounted to an undue burden for the skilled person.

However, in **T 412/93**, where errors and omissions prejudiced the reproducibility of one of the examples in toto and of another example in part, the reproducibility of the invention was not affected, as the examples were alternatives to previous ones.

In **T 612/92**, further scientific research would have been necessary in order to carry out the invention in some of the areas claimed. The board held the requirements of Art. 83 EPC 1973 were not fulfilled because there were serious doubts as to whether such a method could be performed over the whole range that was claimed (see **T 694/92**, OJ 1997, 408).

However, in **T 223/92** the disclosure enabled those skilled in the art to reproduce the invention, possibly in a time-consuming and cumbersome way, but, in the given circumstances, without undue burden of experimentation and without needing inventive skill (see also **T 412/93**).

**T 1456/06** concerned the level of disclosure required for enablement of a claim directed to peptide vaccines. It was apparent from the prior art that the development of peptide-based vaccines to treat cancer - the sole specific type of vaccine mentioned in the application as filed - was not only extremely laborious, but also fraught with uncertainties. The application as filed did not disclose any telomerase peptide which might - plausibly - be regarded as a suitable candidate for a vaccine, nor did it contain either technical information as to how to identify possible candidate peptides, or instructions on how to proceed in case of failure. The board concluded that identifying immunogenic fragments of the telomerase protein suitable for the manufacture of a vaccine by a trial and error procedure constituted an undue burden to a person skilled in the art.

The application in **T 1364/08** concerned viruses for the treatment of cellular proliferative disorders. It provided no experimental data proving that the claimed adenovirus was able to replicate in cells having an activated Ras-pathway but not in normal cells. No data was present demonstrating that such a virus could be useful for the treatment of Ras-mediated cell proliferative disorders. However, based on what was described in the application as filed and taking into account what was known in the prior art, it was credible that the modified adenovirus specified in the claim would have been effective for the treatment of Ras-mediated cell proliferative disorder. Post-published evidence could therefore be taken into account to back up this evidence (following **T 609/02**).

In **T 1846/10**, the invention under consideration related to the preparation of a live vaccine against *L. intracellularis* which relied on the use of attenuated *L. intracellularis* bacteria. *L. intracellularis* is the causative agent of proliferative enteropathy in pigs, also known as porcine proliferative enteropathy (PPE). To be suitable as a live vaccine strain, the attenuated bacteria must fulfil the following three criteria: (i) apathogenicity, which means that they do not cause the disease; (ii) be suitable and retain immunogenicity,



which means that they induce protective immunity in the animal host, and (iii) genetic stability, which means that they do not revert to being pathogenic or conversely become too attenuated. This was undisputed among the parties.

The skilled person, wanting to carry out the claimed invention, could not rely on his common general knowledge or the prior art to obtain suitable attenuated *L. intracellularis* bacteria. The patent had to provide the necessary guidance for the successful implementation of the claimed invention. The board concluded that the guidance provided by the patent did **not** allow the skilled person to obtain an attenuated *L. intracellularis* strain **without undue burden** or inventive step.

The skilled person was taught by the patent that he had to test the passaged strain, but only to confirm attenuation. The *L. intracellularis* strain suitable to carry out the invention not only had to be less virulent than the corresponding wild type strain, but also had to fulfil the additional two criteria of appropriate immunogenicity and genetic stability. Relying on the guidance provided by the patent and not knowing why the strain used in example 5 did not protect the vaccinated animals he would have had no reason to assume that the number of passages had to be increased. The person skilled in the art would not be inclined to consider the intervals disclosed in the description of the patent as mere lower limits but would have understood these indications as concrete ranges. The board concluded that example 5 of the patent represented evidence that the skilled person, by following the guidance of the patent, would fail to obtain an attenuated strain of *L. intracellularis* suitable for the preparation of a live vaccine.

### 6.5. Requirements relating to nucleotide and amino acid sequences

Under R. 30(3) EPC, where the applicant has not filed the necessary sequence listing prescribed in R. 30(1) EPC, the EPO shall invite him to furnish it on payment of a fee. In **J 7/11**, the Legal Board held that such invitations cannot be given orally only - a telephone call was, given the short time available, useful, but had to be followed by a written invitation enumerating all objections raised. Failure to do so amounted to a substantial procedural violation.

In **J 8/11** the crucial issue on appeal was the interpretation of the term "disclosed" in R. 30(1) EPC, namely the question whether a patent application which related to the use of polypeptides well known in the prior art and which identified these polypeptides by their common names and by database accession numbers concerning specific representative sequences had to be regarded as "disclosing" amino acid sequences. The board concluded that prior art sequences do not require the filing of a sequence listing and that the Receiving Section had been wrong to apply R. 30 EPC. With reference to **J 7/11** the board pointed out that the Receiving Section is restricted to a merely formal examination of the sequence listing requirements.

### 6.6. Deposit of living material

If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a

manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Art. 83 EPC if a sample of the biological material has been deposited with a recognised depository institution not later than the date of filing of the application (R. 31(1)(a) EPC) and if the application fulfils the other requirements set out in R. 31 EPC (see also **G 2/93**, OJ 1995, 275).

The disclosure of a microorganism need not depend on a deposit according to R. 28 EPC 1973 where the microorganism is sufficiently disclosed by other means (**T 2068/11**).

As part of the 2000 EPC revision, for greater clarity and consistency, R. 27a, 28 and 28a EPC 1973 were restructured, trimmed and incorporated (as R. 30 to 34 EPC) into the chapter on biotechnological inventions (see OJ SE 1/2003, 164, OJ SE 5/2007, 44 and 54). New R. 31 EPC deals with the deposit of biological material, new R. 32 EPC with the expert solution and new R. 33 EPC with the availability of the deposited biological material as from the date of application of the European patent application (OJ SE 5/2007, 46; see also Notice in OJ 2010, 498).

#### 6.6.1 Substantive law questions

In decision **T 418/89** (OJ 1993, 20) the characteristics of the monoclonal antibodies produced by the deposited strain were different from those mentioned in the claims. It was not possible to produce monoclonal antibodies from the deposited hybridoma using techniques recommended by the depository institution. The requirements of Art. 83 EPC 1973 were thus not met. A disclosure could not be regarded as sufficient if it was only possible to reproduce the invention after repeated requests to the depository institution and by applying techniques considerably more sophisticated than those the latter recommended. Nor could the scope of the patent be restricted to what had been deposited, as the characteristics of the deposit differed from the written disclosure in the patent. Thus a mere deposit of a hybridoma without any corresponding written description did not provide a sufficient disclosure. Similar conclusions were reached in decisions **T 495/89** and **T 498/94**.

R. 31(1) EPC cannot be interpreted such that there is an obligation to deposit material to facilitate the reproduction if the invention can be repeated on the basis of the written description, even if this should be a much more cumbersome way than by merely growing the deposited micro-organism (see e.g. **T 223/92**).

Similarly, in **T 412/93** the board stated that the need for a deposit cannot be introduced by reference to the concept of undue burden. This concept relates more to cases where the route that the reader is to follow is so poorly marked that success is not certain such as in **T 418/89** (see above). If the road is certain but long and laborious, the patentee is under no obligation to assist the disclosure by making actual physical samples available. The board felt that to come to the opposite conclusion would be effectively to introduce a requirement to make the best mode immediately accessible to the public, and such a requirement is not part of the European patent system (see also **T 431/96**).

With respect to the question whether the reproducibility of specific micro-organisms (e.g. plasmids or viral strains) was assured by the written description in the absence of a deposit, the board, after careful examination of the written disclosure, held in some cases that the information provided in the application was sufficient to lead the skilled person reliably to the same micro-organisms (**T 283/86**, **T 181/87**); in other cases it was not (**T 815/90**, **T 816/90**; see also **T 2542/12**, commercial fish farms in Norway – not a reliable source).

#### 6.6.2 Procedural law questions

##### a) Conversion into deposit under the Budapest Treaty

**T 39/88** (OJ 1989, 499) affirmed the principle that one important purpose of R. 28 EPC 1973 (R. 31 EPC) is to make the availability of the deposited organisms independent of any consent by the depositor. The board observed that the proper way of bringing a deposit originally filed for another purpose (here a US application) into line with the requirements of the EPC system was to formally convert the deposit into a deposit under R. 28 EPC 1973 (in the case of a deposit made on the basis of a special agreement between the EPO and the depositary institution) or into a deposit under the Budapest Treaty (which automatically covered R. 28 EPC 1973), as the case might be (see also **T 239/87**, **T 90/88**, **T 106/88**).

##### b) Late submission of deposit number

According to R. 28(1)(c) EPC 1973, the application had to state the depositary institution and the file number of the deposited biological material. In **G 2/93** (OJ 1995, 275) the Enlarged Board of Appeal held that the provisions of R. 28 EPC 1973 were subordinate to the requirements of Art. 83 EPC 1973. The indication of the file number (accession number) of a culture deposit in a patent application was substantive because, under the EPC, it was instrumental in enabling a person skilled in the art to carry out the invention. The Enlarged Board therefore held that, contrary to the ruling in **J 8/87** (OJ 1989, 9), the information concerning the file number could not be submitted after expiry of the time limit set out in R. 28(2)(a) EPC 1973 (i.e. sixteen months after the date of filing of the application or, if priority is claimed, after the priority date).

As for the term "publication" within the meaning of R. 28(2)(a), second part of sentence, EPC 1973 in the context of a European application filed as an international one, see **T 328/04**.

See **T 227/97** (OJ 1999, 495) for the board's decision that reestablishment of rights may be available for the time limit set by R. 28(2)(a) EPC 1973 and R. 13bis.4 PCT.

## 7. The relationship between Article 83 and Article 84 EPC

### 7.1. Article 83 EPC and support from the description

The patent claims must clearly define the subject-matter for which protection is sought under Art. 84 EPC. In **T 94/82** (OJ 1984, 75) it was held that this requirement was fulfilled in a claim to a product when the characteristics of the product were specified by parameters relating to the physical structure of the product, provided that those parameters could be clearly and reliably determined by objective procedures which were usual in the art. In such a product claim, it sufficed to state the physical properties of the product in terms of parameters, since it was not mandatory to give instructions in the claim itself as to how the product was to be obtained. The description, however, had to fulfil the requirements of Art. 83 EPC 1973 and thus enable the person skilled in the art to obtain the claimed product described in it (see also **T 487/89**, **T 297/90**, **T 541/97**). Nor should this be understood as also referring to those variants falling under the literal wording of the claim but which the skilled person would immediately exclude as being clearly outside the scope of practical application of the claimed subject matter, for example, claims including an open ended range for a parameter where it was clear for a skilled person that the open-ended range was limited in practice. Values of the parameter not obtainable in practice would not be regarded by the skilled person as being covered by the claims and thus could not justify an objection of insufficiency of disclosure (**T 1018/05**).

It is of relevance whether a problem falls within Art. 83 or Art. 84 EPC when taking into consideration that examination in respect of the requirements of Art. 83 EPC is still permitted during opposition proceedings, whereas in respect of Art. 84 EPC it is limited during opposition proceedings to those cases where there has been an amendment (see **T 127/85**, OJ 1989, 271; see also **T 301/87**, OJ 1990, 335; **T 1055/98**, **T 5/99**). With regard to the examination in respect of Art. 84 EPC during opposition proceedings see also Chapter IV.D.4; and recent decision **G 3/14**, confirming the jurisprudence exemplified by **T 301/87**).

In **T 292/85** (OJ 1989, 275) the stated grounds for the refusal were that the disclosure was not sufficient under Art. 83 EPC 1973 and there was consequently a lack of proper support under Art. 84 EPC 1973. The board pointed out that in appropriate cases it is only possible to define the invention (the matter for which protection was sought, Art. 84 EPC 1973), in a way which gives fair protection having regard to the nature of the invention which had been described by using functional terminology in the claims. The need for fair protection governs both the considerations concerning the scope of claims and the requirements for sufficient disclosure. The board found that an invention is sufficiently disclosed if **at least one way** is clearly indicated enabling the skilled person to carry out the invention.

In **T 409/91** (OJ 1994, 653; ex parte proceedings) and **T 435/91** (OJ 1995, 188; inter partes proceedings) it was pointed out that the protection conferred by a patent should correspond to the technical contribution to the art made by the disclosure of the invention described therein, which excludes the patent monopoly being extended to subject-matter

which, after reading the patent specification, would still not be at the disposal of the skilled person. The available information must enable the skilled person to achieve the envisaged result within the whole ambit of the claim containing the respective functional definition without undue difficulty, and the description with or without the relevant common general knowledge must provide a fully self-sufficient technical concept as to how this result is to be achieved. **T 409/91** was followed up in **T 713/98**, where the board stated that the requirement of understanding a claim characterised by a functional feature defining a result to be achieved was one of clarity and the requirement of implementing it was one of support, both within the meaning of Art. 84 EPC 1973. Implementation, viewed in relation to the disclosure as a whole, was highly relevant to the question of sufficiency under Art. 83 EPC 1973. See also **T 1225/07**.

In the inter partes case **T 435/91** (OJ 1995, 188), one of the essential technical features was defined only by its function. It was not possible to identify, on the basis of the information contained in the patent specification or of common general knowledge, compounds other than those specifically mentioned as bringing about the desired effect. The board held that the compositions must all be available to the skilled person if the definition was to meet the requirements of Art. 83 EPC 1973.

However, as long as there are no concrete grounds for believing that the invention cannot be carried out within the whole range claimed, there is no reason for not allowing more broadly based claims in an application (**T 242/92**, **T 484/92**). In opposition proceedings the opponent bears the burden of proving that the invention cannot be carried out within the whole range claimed (**T 418/91**, **T 456/91**, **T 548/91**). See in this chapter II.C.8.

In **T 1404/05** the board found that where a claim is vaguely formulated and leaves several constructions open as possibilities, and on one of these constructions part of the subject-matter claimed is not sufficiently described to be carried out, the claim is open to objection under Art. 100(b) EPC. To avoid this objection the claim needs to be explicitly restricted to a construction which is also possible on the vague formulation of the claim, but which construction is not open to an Art. 100(b) EPC objection. The mere fact that the description makes clear that this latter construction is the one intended does not mean that the claim can be treated as being confined to this latter construction. Art. 69 EPC and its protocol were intended to assist a patent proprietor in contending for a broader interpretation of a claim than perhaps its wording warranted, not for cutting down the scope of a claim.

In **T 553/11** the board pointed out that if the proprietor wishes to argue for a narrow scope of a claim, this should be on the basis of the ordinary wording of the claim, and not on the basis of something appearing only in the description (following **T 1404/05**). The board also referred to **T 681/01**, where it was emphasised that the normal rule of claim construction is that the terms used in a claim should be given their ordinary meaning in the context of the claim in which they appear. The description may not be used to rewrite the claim and **redefine** the technical features required by the claim in a way not warranted by the wording of the claim itself. In particular the description cannot be relied

on to exclude subject-matter from the claim which the ordinary meaning of the terms used would include as part of what is claimed.

## 7.2. Article 83 EPC and clarity of claims

When undefined parameters are used in the claims and no details of the measuring methods are supplied, the question arises whether there is a problem with respect to Art. 83 or Art. 84 EPC. The answer to this question is important because in opposition proceedings the patent can be examined for its compliance with Art. 83 EPC without any restriction. Compliance with Art. 84 EPC is however examined only in cases where there has been an amendment. In its recent decision **G 3/14** (OJ 2015, A102) the Enlarged Board reiterated the principles governing the extent to which patents amended in opposition proceedings can be examined for compliance with Art. 84 EPC. A more detailed account of its decision can be found in Chapter II.A.1.4.

In some decisions (for example, **T 123/85**, **T 124/85**, **T 172/87**, **T 358/88**, **T 449/90**, **T 148/91**, **T 267/91**, **T 697/91**, **T 225/93**, **T 378/97**, **T 387/01**, **T 252/02**, **T 611/02** and **T 464/05**) the absence of information in the application on methods for measuring undetermined parameters in the application was considered a problem with respect to Art. 83 EPC 1973. These were all inter partes proceedings. This problem has also been addressed with reference to Art. 83 EPC 1973 in ex parte proceedings, (see **T 122/89** of 5.2.1991 and **T 503/92**). Other decisions have considered this a problem with respect to Art. 84 EPC 1973, for example, in **T 860/93** (OJ 1995, 47), also ex parte proceedings, it was decided that the absence of methods for measuring a relative quality in the claim was a problem with respect to the clarity of the claim under Art. 84 EPC 1973 (see also **T 230/87**, **T 176/91** (10.12.1992), **T 917/92**, **T 299/97**, **T 439/98**, **T 413/99**, **T 930/99**, **T 960/98**, **T 619/00**, **T 943/00**, **T 344/01**, **T 563/02**, **T 1033/02**, **T 208/03**, **T 882/03**, **T 452/04**, **T 1316/04**, **T 466/05**, **T 1586/05**, **T 859/06**). Some of these decisions are discussed further below.

According to **T 593/09** (see Headnote about ill-defined ("unclear", "**ambiguous**") **parameter**) the requirement of sufficient or "enabling" disclosure in the sense of Art. 83 EPC is different from and independent from the clarity requirement pursuant to Art. 84 EPC. The board saw this distinction as underlying the decision in **T 1062/98**. The board in **T 593/09** saw a distinction between the meaning of "clear" in Art. 83 EPC, which concerns the disclosure (the "technical teaching") of the application or the patent on the one hand, and in Art. 84 EPC, where that expression relates to the claims, which "shall define the matter for which protection is sought" on the other hand. In short, there is a distinction between clarity of what has been disclosed and clarity of what is claimed. The board found that this distinction was not always properly made, in particular in respect of so called "ambiguous parameters", i.e. parameters present in the description and/or claims, whose exact definition and/or applicable measuring method remained doubtful. For example, numerous decisions of the boards of appeal have as a relevant criterion for the sufficiency of a disclosure containing an ill-defined parameter, whether the skilled person knows if he is working within or outside of the scope of the claim (see **T 256/87**; **T 387/01**; **T 252/02** and **T 18/08**). It was however, not always apparent from the

reasoning of these decisions whether or not this criterion was meant to be the sole or the decisive one.

In **T 943/00**, the board **disagreed with T 256/87**, finding that the concept of 'forbidden area' was associated with the scope of the claims, i.e. Art. 84 EPC 1973, rather than with sufficiency of disclosure. The board in **T 466/05** agreed, also stating that a distinction should be made between the requirements of Art. 84 EPC 1973 and those of Art. 83 EPC 1973, and that with respect to sufficiency, the relevant question was whether the patent in suit provided sufficient information which enabled the skilled person when taking into account common general knowledge to reproduce the invention. Numerous decisions (e.g. **T 960/98**, **T 619/00**, **T 396/02**, **T 1033/02**, **T 452/04**, **T 466/05**, **T 1586/05**, **T 1015/06**, **T 1250/08**, **T 593/09**, **T 1507/10**, **T 2331/11**), have also interpreted the statement, 'knowing when working within the forbidden area of the claims' formulated in **T 256/87** as addressing the question of the limits of protection conferred by the claims, and thus relating to a requirement of Art. 84 EPC rather than of Art. 83 EPC.

The board in **T 608/07** found the issue before it with regard to sufficiency of disclosure was quite similar to the situation in **T 256/87**, both concerning an insufficiency which arose through ambiguity. Although the board accepted that, depending upon the circumstances, such an ambiguity might very well lead to an insufficiency objection, it should be borne in mind that this ambiguity also related to the scope of the claims, i.e. Art. 84 EPC 1973. Since, however, Art. 84 EPC 1973 was in itself not a ground of opposition, care had to be taken that an insufficiency objection arising out of an ambiguity was not merely a hidden objection under Art. 84 EPC 1973. The board was convinced that, for an insufficiency arising out of ambiguity, it was not enough to show that an ambiguity existed, e.g. at the edges of the claims. It would normally be necessary to show that the ambiguity deprived the person skilled in the art of the promise of the invention. It went without saying that this delicate balance between Art. 83 and 84 EPC 1973 had to be assessed on the merits of each individual case.

According to **T 593/09**, the same rationale underlay both **T 608/07** and **T 815/07** (and also *Kirin-Amgen Inc v. Hoechst Marion Roussel Ltd* [2004] UKHL 46 of the United Kingdom House of Lords); namely, where a claim contains an ill-defined ("unclear", "ambiguous") parameter and where, as a consequence, the skilled person would not know whether he was working within or outside of the scope of the claim, this, by itself, is not a reason to deny sufficiency of disclosure as required by Art. 83 EPC. Nor is such a lack of clear definition necessarily a matter for objection under Art. 84 EPC only. What is decisive for establishing insufficiency within the meaning of Art. 83 EPC is whether the parameter, in the specific case, is so ill-defined that the skilled person is not able, on the basis of the disclosure as a whole and using his common general knowledge, to identify (without undue burden) the technical measures (e.g. selection of suitable compounds) necessary to solve the problem underlying the patent at issue.

The board in **T 1526/09** observed that it had been decided in **T 593/09** that a claim containing a vague or ambiguous parameter preventing the skilled person from knowing whether he was working within or outside the scope of the claim did not result in insufficient disclosure of the invention. The crucial question in deciding on sufficiency of

disclosure was whether the parameter was so vaguely defined that the skilled person could not identify, in the patent as a whole, the measures required to solve the underlying problem. The parameter at issue had been essential to preparing the product. In **T 1526/09** the vague definition of chargeability affected the clarity of the claimed subject-matter but did not prevent the skilled person from preparing the claimed product.

In **T 378/11**, the values disclosed in claim 1 referred to the average particle size. **No proof** had been submitted by the appellants/opponents that the lack of any indication as to the precise kind of average particle size hindered the skilled person from carrying out the invention at issue. The board found that the skilled person could select those kinds of mean values falling within the range 10-500 mym in order to prepare a composition according to the invention at issue. Whether or not the use of two kinds of mean values would lead to different results was a matter of clarity, rather than sufficiency of disclosure.

In **T 2399/10**, none of the cited documents, which had been published before the contested patent's priority date, used the expression "form factor". It appeared only in documents not forming part of the prior art under Art. 54(2) EPC. The patent thus did not disclose how to produce the alumina particles needed to obtain the claimed composition. This situation differed from cases where the features of the end product described in the patent were not clearly defined, which frequently resulted in a lack of clarity. Instead, it was a starting material which had not been here defined clearly enough. Since there was therefore inadequate information to select the **starting material**, the claimed composition could not be produced. This typically meant there was insufficient disclosure.

In **T 287/10**, the claimed invention concerned a composition for the surface treatment of paper, paperboard or the like. The respondent (opponent) alleged that the invention was insufficiently disclosed; the gist of its objection was that the end values of the size range of the synthetic silica nanoparticles of the claimed composition were ambiguous. The board disagreed. Exactly the same point of law had been considered and answered by the same board in the same composition in **T 1414/08**, with respect to another parameter common in the art, namely tensile strength. The reasoning and the conclusion drawn in decision **T 1414/08** was, in the board's opinion, directly applicable to the case at issue, where the undefined parameter was the particle size. Hence, the ambiguity of **the end values** of the size range of the nanoparticles comprised in the claimed composition, just as in decision **T 1414/08**, was "not a matter to be addressed under Art. 83 EPC but a question of Art. 84 EPC". The board found the invention sufficiently disclosed.

In **T 1055/92** (OJ 1995, 214) the examining division had rejected the patent application under Art. 84 EPC 1973 because in the claim it was not clear how certain values were to be computed. The board held that the requirements of Art. 84 EPC 1973 should be clearly distinguished from the requirement under Art. 83 EPC 1973. Under Art. 83 EPC 1973, sufficient disclosure was required of a European patent application, i.e. of the application as a whole, comprising the claims, together with the description and the drawings, but not of an individual claim as such. A claim, on the other hand, had to comprise the essential features of the invention (**T 32/82**, OJ 1984, 354); the essential



features should comprise those features which distinguished the invention from the closest prior art. The primary function of a claim was to set out the scope of protection sought for an invention, which implies that it is not always necessary for a claim to identify technical features or steps in detail (see also **T 713/98**).

According to **T 882/03**, slightly varying results obtained when using different mathematical models for the calculation of the intrinsic viscosity did not prevent a person skilled in the art from carrying out the invention but were rather related to the question of whether the matter for which protection was sought was sufficiently defined in accordance with Art. 84 EPC 1973.

In **T 430/10** if the alleged lack-of-clarity was that a feature could be interpreted narrowly or broadly, the sufficiency requirements were met if the skilled person, applying the broad interpretation, was at least able to carry out all embodiments covered by the claims. In the case at issue, the requirements were fulfilled.

In **T 378/97**, the board noted that sufficiency of disclosure addressed the practitioner who reduced the invention to practice, but did not stick to any precise theoretical values. Varying results did not, therefore, necessarily prevent a person skilled in the art from carrying out an invention (Art. 83 EPC 1973), but could be a matter of the definition of the invention under Art. 84 EPC 1973. See also **T 960/98**, where the board stated that the relevant question with respect to sufficiency of disclosure was whether the patent in suit provided sufficient information to enable the skilled person, taking into account common general knowledge, to reproduce the invention, and **T 586/94**, **T 245/98** and **T 859/06**.

Following **T 378/97**, the board in **T 439/98** found that the appellant's objections in regard to sufficiency of disclosure (the patent in suit allegedly failed to indicate a suitable method for measuring porosity), concerned the scope of the value of porosity indicated in the claim and therefore the clarity of the claim, rather than the possibility of reproducing the invention. In **T 619/00**, the board agreed that the different methods for determining the value of the gel fraction did not per se represent an undue burden. In the absence of evidence that the different methods specified would lead to determination values deviating from each other by a substantial amount having technical significance (following **T 378/97**), or by an amount that would place the skilled person in a situation where he was unable to carry out the invention (following **T 930/99**), the mere fact that the patent specification was silent as to which method should be used did not prejudice sufficiency of disclosure. The question whether the methods defined lead to a unique value or to different values also concerned the clarity of the definition of the subject-matter of the claim under Art. 84 EPC 1973. In **T 930/99** only one measuring method was involved and the board had therefore considered **T 225/93** inapplicable, (according to **T 225/93**, different measuring methods which did not always lead to the same result could amount to an undue burden.) The respondent's argument that there would be legal uncertainty, since third parties would not know whether they were working within or outside the range specified, was clearly an argument based on lack of clarity, which was not a ground of opposition and so could not be considered. See also **T 396/02**, **T 347/10**.

In **T 805/93** the **viscosity** was the only characterizing feature of the claim at issue and its role in defining the matter for which protection was sought under Art. 84 EPC, was clearly crucial. The lack of information on how the viscosity limit of the claim was to be determined meant the matter for which protection was sought could not be deemed defined, so that the claim did not comply with Art. 84 EPC 1973. In addition, the disclosure of the application in suit did not enable him to carry out the claimed subject-matter on a general basis, so that the requirements of Art. 83 EPC 1973 were also not met. Similarly, in **T 431/07**, since no method to measure the viscosity was mentioned in the description and due to the numerous methods and devices used to measure viscosity, the information available in the description as originally filed was not sufficient for the person skilled in the art to reproduce the claimed subject-matter under Art. 83 EPC.

**T 482/09** concerned the **viscosity** of a substance, a common parameter for which **standard measurement methods** were undisputedly **known**. The appellants' argument was instead that the parameter's value was uncertain because different measurement methods led to different results. According to the board, however, using an indefinite term in the claims was not a problem under Art. 83 EPC, but rather under Art. 84 EPC (see also **T 1886/06**), which requires, among other things, that the claims define the matter for which protection is sought. The appellants had cited one of the criteria for sufficient disclosure set out in **T 256/87**, namely that a skilled person reading the patent specification should be able to carry out the invention in all its essential aspects and know when he is working within the forbidden area of the claims, but the board held that this criterion could not be taken to mean that an invention was inevitably unworkable under Art. 83 EPC wherever the claims used a **term** which was **vague** for the purposes of Art. 84 EPC and could not be defined more precisely on the basis of the description or common general knowledge. In opposition and any ensuing appeal proceedings, the result of using such an indefinite term in a claim was instead that it could not be taken to determine the limits to the protection sought, so that novelty and inventive step had to be assessed in the light of the prior art identified on the basis of all its technically meaningful possible interpretations. If the term had no specific meaning whatsoever, it would even lose entirely its effect of delimiting the claimed subject-matter from the relevant prior art.

See also the decision in **T 2001/12**, which clarified the distinction between the requirements of sufficiency of disclosure (Art. 83 EPC), clarity of the claims (Art. 84 EPC) and inventive step (Art. 56 EPC). **T 862/11** dealt with this distinction in detail too.

## 8. Evidence

The objection of lack of sufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts (**T 19/90**, OJ 1990, 476; **T 890/02**, OJ 2005, 497). Otherwise it is unlikely to succeed (**T 394/06**, **T 1437/07**). There is no requirement for an example in the patent (**T 1437/07**).

In order to establish insufficiency, the burden of proof is upon an opponent to establish on the balance of probabilities that a skilled reader of the patent, using his common general knowledge, would be unable to carry out the invention (**T 182/89**, OJ 1991, 391).

A mere statement that one of several examples in a patent has been repeated once "exactly as described" without obtaining exactly the results claimed in the patent is in principle inadequate to discharge that burden (see also **T 406/91**, **T 418/91**, **T 548/91**, **T 588/93**, **T 465/97**, **T 998/97**, **T 499/00**, **T 751/00** and **T 967/09**). Where the parties make contradictory but unsubstantiated assertions concerning facts relevant for establishing patentability and the EPO is not in a position to establish the facts of its own motion, the benefit of the doubt is given to the patent proprietor (**T 72/04**). If the patent contains only an example with a hypothetical experimental protocol, and this example is to be relied on for showing sufficiency, then the burden of proof lies on the patentee to show that in practice this protocol works as stated. Evidence that a variation of this protocol works is unlikely to be enough (**T 792/00**). (For more details see chapter III.G "Law of evidence"). However, the patent at issue in **T 397/02** disclosed a specific humanised version of a mouse antibody and also many specific alternatives thereof. The case was therefore not comparable to **T 792/00** (or **T 984/00**) where not a single specific example of the claimed subject-matter was disclosed. Thus the appellant-opponent bore the burden of proving that the invention could not be carried out.

The board in **T 63/06** agreed that the opponent generally bears the burden of proving insufficiency of disclosure. When the patent does not give any information as to how a feature of the invention can be put into practice, only a weak presumption exists that the invention is sufficiently disclosed. In such a case, the opponent can discharge his burden by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice. It is then up to the patent proprietor to prove the contrary, i.e. that the skilled person's common general knowledge would enable him to carry out the invention (for a more recent example, see **T 338/10**, in which the board found that the opponent's reasoned arguments had reversed the **burden of proof**). In **T 491/08** the board, referring to **T 63/06** held that a presumption exists that, in general, a patent application relates to an invention which is disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The weight of arguments and evidence required to rebut this presumption depends on its strength. A strong presumption requires more substantial arguments and evidence than a weak one. If a patent application does not contain detailed information of how to put the invention into practice, this requires less substantial arguments and evidence. Serious doubts whether the skilled person can carry out the invention as claimed, e.g. in the form of comprehensible and plausible arguments, are sufficient.

In **T 518/10**, the board looked at the rules concerning the burden of proof of insufficiency, which was, as a general rule, on the opponents. In the case at issue, the appellant (patent proprietor) had asserted that, against the prevailing technical opinion, by using the extraction method described in the patent in suit the skilled person was able to obtain from marine and aquatic animal material an extract comprising compound (II). The respondents denied this and provided evidence that compound (II) could not be obtained when working according to the general method described in the patent. Under these circumstances the burden of proof was on the appellant to show that the method in the patent worked as alleged. The mere assumption that compound (II) could theoretically be present in an extract due to the krill's diet on algae was not evidence that could disprove the respondents' experimental reports or discharge the burden of proof resting

on the appellant. The board also did not share the appellant's opinion that it was for the respondents, after having failed to obtain the claimed extract by following the teaching of the patent, to embark on a **research programme** in an attempt to find a compound which, according to the prevailing technical opinion, was not expected to be found in the first place, and for the presence of which not even the patent in suit provided conclusive evidence.

In **T 2403/11** (report supra) the board observed that example 5 in the patent provided verifiable facts which raised serious doubts that the invention could in fact be carried out by the average person skilled in the art, without undue experimentation or inventive skills, by following the guidance provided in the patent. Under these circumstances, no additional experimental evidence from the appellant (opponent) was required as it could rely on the evidence provided by the patent itself. The board concluded that the appellant had discharged its burden of proof.

As proof that an invention has been insufficiently disclosed, the boards require that the attempt to repeat it must fail despite following the conditions given in the examples. This requirement is not fulfilled where the opponent repeats the patented process under conditions covered by claim 1 but differing in many respects from those applying in the contested patent's examples (**T 665/90**). In **T 1712/09**, the tests referred to in the opponent's experimental reports had been carried out using measuring apparatus different from that described in the patent, and so not as instructed there. The board found that the opponent had made no attempt to reproduce the invention, although this was essential for an objection under Art. 100(b) and 83 EPC and would have enabled it not only to verify or disprove the results but, above all, to calibrate the method of determining the parameter or parameters in question to the values given in the patent. The board therefore held that the opponent had failed to show that the method was unworkable and thus to discharge its burden of proving insufficient disclosure. On the possibility of calibrating methods, see also **T 1062/98**, **T 485/00** and **T 45/09**.

An invention should be reproduced using the examples given. Insufficiency cannot be proven on the basis of laboratory trials when the only embodiment exemplified in the patent is an industrial fermentation process (**T 740/90**). The disclosure was also considered sufficient where the opponent had only used equivalents of the surfactants given in the patent, as he had not discharged his burden of proof (**T 406/91**).

It was held in **T 541/96** that if an invention seems to offend against the generally accepted laws of physics and established theories, the disclosure should be detailed enough to prove to a skilled person conversant with mainstream science and technology that the invention is indeed feasible, the onus being on the applicant (see also **T 1023/00**, **T 1329/07** and **T 1796/07**). The more a new invention contradicts previously accepted technical wisdom, the greater the amount of technical information and explanation is required in the application to enable the invention to be carried out by the average skilled person to whom only that conventional knowledge is available (**T 1785/06**).

in **T 1273/09** the board had serious doubts that the claimed **homeopathic treatment** of hypertension could be reliably and reproducibly achieved by the mixture claimed for the following reasons, namely (i) because on the standards of "conventional" medicine and science it was inconceivable that a homeopathic medicament which did not contain any active substance achieved specific therapeutic effects and (ii) because on the standards of homeopathic medicine it was inconceivable that a homeopathic medicament that was not applied according to homeopathic principles could achieve **specific therapeutic effects**. The board could not conclude that the disclosure in the application - and this was the only source of information in the case at issue - put the skilled person in a position to achieve the claimed treatment of hypertension in a reliable and reproducible manner. The reason was **not**, as suggested by the appellants, a mere, **unsubstantiated "disbelief"**. Rather, the conclusion was drawn by taking into account the quality and quantity of available evidence.

See Chapter III.G.5.1.2c) "Law of evidence".

**D. Priority**

1.	Introduction	367
2.	Applications giving rise to a right of priority	368
2.1.	Application filed in or for a state which is party to the Paris Convention or a member of the WTO	368
2.2.	Priority right of the applicant or his successor in title	370
2.3.	National deposit of industrial design	370
2.4.	Exhibition priority	371
2.5.	Postdating of the previous application	371
2.6.	Multiple exercise of the right of priority for one contracting state	371
3.	Identity of invention	372
3.1.	Disclosure in the previous application of the invention claimed in the subsequent application	372
3.1.1	Interpretation of "the same invention"	372
3.1.2	Amendments and disclaimers	373
3.1.3	Disclosure in the previous application as a whole	373
3.1.4	Reference to common general knowledge	374
3.1.5	Explicit or implicit disclosure of the "essential" features in the priority document	375
	a) General	375
	b) Cases of non-disclosure of essential features	375
	c) Example of disclosure of essential features	377
3.1.6	Solution of the same problem	377
3.1.7	Same teaching in the priority document	378
3.1.8	Error margins and definitions of limits	379
3.1.9	Selection from generic disclosure	380
3.1.10	Inventions relating to nucleotide and amino acid sequences	382
3.2.	Claiming the invention disclosed in the earlier application in the subsequent application	383
3.2.1	Implicit features of the technical teaching of the subsequent application	383
3.2.2	Features missing with respect to the earlier application	384
	a) Omission of non-essential features	384
	b) Omission of indispensable features	384
3.3.	Enabling disclosure in the priority document	385
4.	First application	387
4.1.	Identity of invention	388
4.2.	Identity of applicant	390
5.	Partial and multiple priorities	391
5.1.	Publications during the priority interval	392
5.2.	Different priorities for different parts of a European patent application	392
5.3.	Multiple priorities for one claim	393

## 1. Introduction

Art. 87 to 89 EPC govern the concept of priority under the EPC.

According to Art. 87(1) EPC, any person who has duly filed, in or for (a) any State party to the Paris Convention for the Protection of Industrial Property or (b) any Member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application.

The right of priority is generally regarded as one of the cornerstones of the Paris Convention. Its basic purpose is to safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention, thereby alleviating the negative consequences of the principle of territoriality (**T 15/01**, OJ 2006, 153).

Art. 87 to 89 EPC provide a complete, self-contained code of rules on claiming priority for the purpose of filing a European patent application (see **J 15/80**, OJ 1981, 213, confirmed in e.g. **J 9/07**). However, since the EPC - according to its preamble - constitutes a special agreement within the meaning of Art. 19 of the Paris Convention, it is clearly intended not to contravene the basic principles concerning priority laid down in the latter (see **T 301/87**, OJ 1990, 335; **G 3/93**, OJ 1995, 18 and **G 2/98**, OJ 2001, 413). Furthermore, in view of Art. 87(1) and (2) EPC, the priority system adopted by the European legislator also recognises "internal priorities" (**T 15/01**, OJ 2006, 153).

The EPO does not normally check the validity of a priority right during examination. A check must be made, however, if relevant prior art has been made available to the public within the meaning of Art. 54(2) EPC on or after the priority date claimed and before the date of filing or if the content of the European patent application is totally or partially identical with the content of another European application within the meaning of Art. 54(3) EPC, such other application claiming a priority date within the above-mentioned period (Guidelines F-VI, 2.1 - November 2015 version). In opposition proceedings this applies where prior art is invoked in connection with a ground for opposition under Art. 100(a) EPC in relation to which the priority date is of decisive importance (Guidelines D-III, 5 - November 2015 version). Failure by the respective division to check the validity of the priority right in the circumstances described has been held to be a substantial procedural violation (see **T 16/89**, **T 737/95**, **T 2170/08**).

For issues of evidence concerning the validity of the priority claim, see also Chapter III.G.4.3.4 and 5.1.2c). For decisions on the correction of the priority declaration see Chapter IV.A.8.2.

## 2. Applications giving rise to a right of priority

### 2.1. Application filed in or for a state which is party to the Paris Convention or a member of the WTO

Under the EPC 2000 Art. 87(1) EPC was amended to align it with Art. 2 TRIPS, which requires that priority rights also be extended to first filings made in or for any member of the World Trade Organization (WTO) (OJ SE 4/2007, 88). The revised provision governs applications filed on or after 13 December 2007.

Previously, in **G 2/02** and **G 3/02** (OJ 2004, 483) the Enlarged Board decided that the obligations deriving from the TRIPS Agreement did not bind the EPO directly and did not therefore entitle the applicant for a European patent to claim priority from a first filing in a state which at the relevant dates was not a member of the Paris Convention but was a member of the WTO/TRIPS Agreement.

### 2.2. Priority right of the applicant or his successor in title

In **T 1008/96** the European patent application resulting in the patent in suit and the two Italian utility model applications from which priority was claimed had been filed by different persons. The board held that the succession in title had to be proven to its satisfaction. It was a general principle of procedural law that any party claiming a right had to be able to show that it was entitled to that right (see **J 19/87**). This question had to be answered in accordance with national law. The board concluded that the respondent had **failed to prove that it was the successor in title** in respect of the two Italian utility model applications. Consequently, no priority rights existed for the patent in suit.

In **T 62/05** the board pointed out that the EPC did not contain any regulations on the formal requirements that an **assignment of priority rights** for the filing of a European patent application should fulfil in order to be considered valid for Art. 87(1) EPC 1973. However, having regard to the crucial effect that a valid priority date has on patentability (cf. Art. 89 EPC 1973), and to the fact that, in the case at issue, the validity of the priority claim depended on the validity of the transfer of the ownership of the right of claiming priority from the Japanese first filing for the European patent application, such transfer of priority rights, in the board's view, had to be proven in a formal way (by analogy with **T 1056/01** – also summarised in Chapter III.G.4.3.4). It hence appeared reasonable to the board to apply an equally high standard of proof as that required for the assignment of a European patent application by Art. 72 EPC 1973, which, however, the board concluded was not met here. Furthermore, the appellant could not convince the board that an assignment had taken place implicitly and tacitly before the end of the twelve-month period or that it would have been illogical for the applicant of the priority application to assign the application to the applicant for the patent in suit without assigning the corresponding priority rights.

In **T 160/13** the board confirmed that the opposition division had rightly examined the transfer of the priority right on the basis of German law, which called for a bilateral declaration of transfer by both applicants (§§ 398 and 413 in conjunction with §§ 145 ff.



of the German Civil Code (BGB)). Such declarations were not subject to any particular formal requirements under German law, and no other requirements of a formal nature could be inferred from the decisions cited by the appellant, **T 1056/01** and **T 62/05**. In the board's view the correspondence on file provided ample proof of the transfer.

According to **T 205/14**, it is generally accepted that the right of priority is transferable independently of the corresponding first application and may furthermore be transferred to a third person for one or more countries only. It is thus an independent right until it is invoked for one or more later applications, to which it becomes an accessory, and it has to be distinguished from the right to the patent deriving either from substantive law or from the status of being the applicant of the first application.

Neither Art. 87 EPC 1973 and Art. 88 EPC nor R. 52 and 53 EPC set out any requirement for determining the law governing transfer of the priority right. The board disagreed with the reasoning of **T 62/05** that the transfer had to be proven in a formal way, applying an equally high standard of proof as that required by Art. 72 EPC 1973. Art. 72 EPC 1973 set out formal requirements for a valid assignment of a European patent application and thereby limited the means of giving or obtaining evidence for determining such a transfer. Having regard to Art. 117 EPC and the principle of free evaluation of evidence, the rule should not be extended beyond its scope of application. Art. 72 EPC 1973 constituted harmonised law with respect to the formal requirements for a transfer of a validly filed European patent application, and no reason was apparent for applying it by analogy in the context of a transfer of the priority right preceding a subsequent filing. To do so in view of a subsequent European patent application would, in the case of a European first filing, ignore the fact that the priority right is a right independent of the right to the first application and, in the case of a non-European first filing, that Art. 72 EPC 1973 does not govern the relationship between the applicant of a European patent application and a different applicant of a distinct first application. Art. 72 EPC 1973 and R. 20 EPC 1973, and the related provisions (Art. 60(3) EPC 1973 and 61 EPC), rather defined the conditions under which the EPO may take into account questions of substantive law and procedural acts by a person other than the registered applicant (**J 2/01**, OJ 2005, 88, point 3 of the Reasons). The board came to the same conclusion as the German Federal Supreme Court in its decision of 16 April 2013 that Art. 87 EPC does not require a formal and separate assignment as provided by Art. 72 EPC.

Since the provisions of the EPC did not lend themselves to an autonomous determination of the requirements for transfer of the priority right, the validity of such transfer was a matter of national law (cf. **T 1008/96**; cf. also approach in **T 160/13**, **J 19/87**, **T 493/06**). In the circumstances of those cases, however, the choice of applicable national law did not seem to be an issue. In none was the law of the state for which protection was sought by the subsequent filing considered to be relevant, nor did they provide guidance on whether the law applicable to the legal relationship between the transferor and the transferee (e.g. corporate agreement, employment contract, or universal succession) should apply, or the law of the state of filing of the first application. This point of law was, however, relevant to the decision in hand. Accordingly, the board considered both the law applicable to the legal relationship between the transferor and

the transferee of the priority right and the law of the state of filing of the first application and concluded that the former - in this case the law of the state of the employment relationship between the applicants (inventors) of the US provisional applications from which priority was claimed and the patent proprietor (here the law of Israel) - determined the transfer. On the basis of the evidence before it, the board was satisfied both that Israeli law did not require an assignment in writing signed by both parties and that the priority right had been transferred to the patent proprietor before the date of filing of the international application underlying the patent in suit. See also **T 517/14**.

In **T 493/06** it was held that the respondents had provided sufficient proof of the assignment of priority rights. In the board's view even a copy of an assignment agreement could be sufficient provided that evidence was supplied that the content of the copy was identical to that of the original document. Such evidence might, according to board of appeal case law, take the form of an affidavit - even though affidavits were not expressly mentioned in Art. 117(1) EPC 1973 - and the principle of unfettered consideration of the evidence applied to them (see e.g. **T 970/93**, **T 804/94**, **T 558/95** and **T 43/00**; also **T 535/08**).

The question of succession in title has also arisen where the validity of the priority claim has been put in doubt in view of a still earlier previous application (see in this chapter II.D.4).

### **2.3. National deposit of industrial design**

In **J 15/80** (OJ 1981, 213) it was held that a priority right based on the deposit of an industrial design was not recognised for a European patent application. As the EPC was a special agreement within the meaning of Art. 19 of the Paris Convention, a general understanding by the EPC contracting states that the deposit of an industrial design clearly gave a priority right for a national patent application could, by application of Art. 4 Paris Convention, lead to an interpretation of Art. 87(1) EPC 1973 going beyond its terms. However, in the absence of such a general understanding there was no reason to read Art. 87(1) EPC 1973 more broadly than its express terms and scope required. In the board's opinion, a right of priority under the Paris 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.

### **2.4. Exhibition priority**

In **T 382/07** it was held that an exhibition priority could not be validly claimed for a European application or patent. The board stated that the possibility of recognising exhibition priorities internationally followed from Art. 11 Paris Convention. Its provisions allowed Paris Union member countries to recognise exhibition priorities in their domestic law under certain conditions but did not oblige them to do so. Entitlement to claim an exhibition priority was to be decided on the basis of the national law of the country where protection and priority were claimed, i.e. for a European application or patent the EPC,

and not the law of the country where the exhibition took place or a first application claiming the exhibition priority was filed. Since the EPC did not recognise exhibition priorities, any priority claim based on an invention disclosure at an exhibition must fail in the case in hand.

### **2.5. Postdating of the previous application**

Swiss patent law formerly allowed a patent application to be postdated if it was subsequently amended. In **T 132/90** the patent proprietor had claimed 11.3.1983, the original filing date of the earlier Swiss application, as the priority date for his European application dated 9.3.1984. In 1985 the Swiss Patent Office ordered that the filing date of the Swiss patent application be set at 1.7.1983 following subsequent completion of the technical documentation. The board of appeal concluded that the original application should serve as the basis for claiming a priority right and that the priority date was the filing date of the original application. The postdating order did not take effect ab initio, and the subsequent fate of the original application was immaterial as far as the priority date was concerned.

### **2.6. Multiple exercise of the right of priority for one contracting state**

In **T 998/99** (OJ 2005, 229) the board held that Art. 87(1) EPC 1973 made no provision for multiple filings in the same country within the priority period for the same subject-matter and hence the same invention in conjunction with the same priority document. As derogations had to be interpreted strictly, only the first filing could validly claim priority. Neither Art. 4.G(1) of the Paris Convention nor its equivalent in the EPC 1973 (Art. 76(1), second sentence, EPC 1973) allowed a divisional application to give rise to a right of priority with effects going back to the date of filing of the initial application.

However, in **T 15/01** (OJ 2006, 153) the board pointed out that, with respect to the issue of exhaustion of priority, the wording of Art. 87(1) EPC 1973 appeared to be open to different interpretations. Since the EPC constituted a special agreement within the meaning of Art. 19 of the Paris Convention, this provision was not intended to contravene the basic priority principles of this Convention. The Paris Convention in its present version explicitly recognised the possibility of claiming multiple and partial priorities and guaranteed the right to divide patent applications while preserving the benefit of the right of priority for the divisional application as well (principles also recognised in Art. 76(1), second sentence, EPC 1973 and Art. 88(2) and (3) EPC 1973). The board considered that the priority provisions of the Paris Convention had to be construed in a manner which ensured that the general purpose they served, namely to assist the applicant in obtaining international protection for his invention, was fulfilled as far as possible. The board also examined the circumstances under which the issue of exhaustion might arise (splitting up of the subject-matter of the priority application to avoid non-unity objections; filing of a deficient subsequent application and remedying it by means of a second filing; combination of the originally disclosed subject-matter with further improvements and additional embodiments developed during the priority period) and analysed the interests involved. It concluded that the same priority right might be validly claimed in more than one European patent application; there was no exhaustion

of priority rights. In **T 5/05** the board again confirmed that neither the EPC nor the Paris Convention contained any indication that the right of priority constituted an exception which had to be interpreted narrowly and thus allowed the right of priority to be exercised only once for one contracting state. These decisions were followed in **T 1562/06**.

### 3. Identity of invention

In accordance with Art. 87 EPC a European patent application is only entitled to priority in respect of "the same invention" as was disclosed in the previous application.

#### 3.1. Disclosure in the previous application of the invention claimed in the subsequent application

##### 3.1.1 Interpretation of "the same invention"

In **G 2/98** (OJ 2001, 413), the Enlarged Board of Appeal, ruling on points of law referred by the President regarding the interpretation of Art. 87(1) EPC 1973, addressed the concept of "the same invention" in this provision. It first considered whether interpreting "the same invention" narrowly was consistent with the relevant Paris Convention and EPC 1973 provisions. A narrow interpretation meant that the subject-matter of a claim which defined the invention in a European patent application - i.e. the specific combination of features in that claim - had to be at least implicitly disclosed in the application whose priority was claimed. The Enlarged Board held that a broad interpretation, distinguishing between those technical features which related to the function and effect of the invention and those which did not - with the result that an invention could still be considered "the same" even if a feature were amended, deleted or added - was inappropriate and prejudicial to a proper exercise of priority rights. To ensure a practice fully consistent, inter alia, with equal treatment for applicants and third parties, legal certainty and the principles for assessing novelty and inventive step, "the same invention" had to be interpreted narrowly and in a manner equating it to "the same subject-matter" in Art. 87(4) EPC 1973. This interpretation was underpinned by the Paris Convention and the EPC 1973, and was entirely consistent with opinion **G 3/93** (OJ 1995, 18).

The Enlarged Board therefore ruled that the requirement for claiming priority of "the same invention", referred to in Art. 87(1) EPC 1973, means that priority of a previous application in respect of a claim in a European patent application in accordance with Art. 88 EPC 1973 is to be acknowledged only if the skilled person can derive the subject-matter of the claim **directly and unambiguously**, using common general knowledge, from the previous application as a whole. The subject-matter of the claim defining the invention in the European application has to be understood as "the specific combination of features present in the claim" (see also **T 948/97**).

The older case law which devised the "**novelty**" and "**disclosure**" tests still applies following **G 2/98** (and **G 1/03** and **G 2/03**). According to the "novelty test", all the features of the invention claimed in the European patent application had to be disclosed in the priority document. In **T 311/93** and **T 77/97** in particular, boards looking at the validity of

priority claims applied the criterion of at least implicit disclosure used for the disclosure test under Art. 123(2) EPC 1973. Thus, this older body of case law provides that two applications relate to "the same invention" within the meaning of Art. 87 EPC 1973 when they both contain "the same subject-matter". The invention or subject-matter of a previous application is to be considered identical to that of a subsequent one if the disclosure of both applications is the same (**T 184/84**). Disclosure in the previous application means that the subject-matter of the claims of the European application must be clearly identifiable in the documents of the previous application taken as a whole (**T 81/87**, OJ 1990, 250; **T 359/92**, **T 469/92**, **T 597/92**, **T 296/93** and **T 620/94**). Identical wording is not required (**T 81/87**, OJ 1990, 250; **T 184/84**, **T 837/13**).

On the other hand, the principles laid down in **G 2/98** mean that many statements made in decisions based in particular on **T 73/88** (OJ 1992, 557), holding that adding non-essential and merely scope-limiting features did not invalidate a priority claim, are no longer relevant (e.g. **T 16/87**, OJ 1992, 212; **T 582/91**, **T 255/91**, OJ 1993, 318; **T 669/93**, **T 1056/93** and **T 364/95**; see also "Case Law of the Boards of Appeal of the EPO", 3rd ed. 1998, p. 263 et seq. and 269 et seq.).

### 3.1.2 Amendments and disclaimers

As has been stated in **G 2/98** (OJ 2001, 413), the extent of the right to priority is determined by, and at the same time limited to, what is disclosed in the priority application.

In **T 923/00** the application as filed and the priority document were in essence identical. The board emphasised that any conclusion in favour of or against the amendments' allowability under Art. 123(2) EPC 1973 would also apply in favour of or against entitlement to the claimed priority, and dealt with both issues jointly.

In **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) the Enlarged Board held that in order to avoid any inconsistencies, the disclosure as the basis for the right to priority under Art. 87(1) EPC 1973 and as the basis for amendments in an application under Art. 123(2) EPC 1973 had to be interpreted in the same way (see also **G 2/10**, OJ 2012, 376). That meant that a disclaimer, not providing a technical contribution as outlined, which was allowable during the prosecution of a European patent application did not change the identity of the invention within the meaning of Art. 87(1) EPC 1973. Therefore its introduction was allowable also when drafting and filing the European patent application without affecting the right to priority from the first application, which did not contain the disclaimer (see also **T 175/03** and **T 910/03**; further, **T 680/08**).

### 3.1.3 Disclosure in the previous application as a whole

Under Art. 88(4) EPC it suffices if the features claimed in the later application are disclosed by the earlier application taken as a whole (**T 497/91**, **T 184/84** and **T 359/92**). Art. 88(4) EPC cannot be construed as meaning that a priority document must comprise claims in order to form a regular national filing within the meaning of Art. 87(3) EPC which can give rise to a right of priority. If the priority document does not include any

claims, this does not mean that the conditions of Art. 88(4) EPC are not fulfilled (**T 469/92**). While in such a case it could be more difficult to establish whether the priority document discloses the same invention, the principles of **G 2/98** equally apply (**T 1437/10**). Features of the invention may also be disclosed in the drawings (**T 169/83**, OJ 1985, 193; **T 837/13**).

On the other hand, **T 409/90** (OJ 1993, 40), showed that a broad claim in the previous application was not necessarily a suitable basis for a priority right. This decision was based on the principle that what was disclosed by a priority document was what could be deduced from the priority document as a whole by a person skilled in the art. However, when considering what was disclosed in a priority document's claim it was necessary to bear in mind the purpose of the claim, i.e. to define the protection sought. The fact that a claim in a priority document was broad enough to cover specific subject-matter filed for the first time in a later application was not by itself sufficient evidence that such subsequently filed subject-matter had already been disclosed in the priority document, or that subsequent claims based on the later-filed subject-matter still defined the same invention as that which was the subject of the priority document (see also **T 77/97**).

At issue in **T 289/00** was whether the feature in Claim 1, namely that a channel was enclosed on all sides, was directly and unambiguously disclosed in the priority application. The board accepted that the latter's reference to the channel as "filled with air" did not in itself mean that it was enclosed. However, the reference had to be seen together with the other information on this matter which the skilled person would derive from the application (cf. Art. 88(4) EPC 1973). A skilled person considering the priority application documents as a whole would conclude, without further information, that the channel would be enclosed on all sides.

In **T 515/00** the board noted that a claim passed the priority test if its subject-matter could be derived from the previous application **as a whole**, and that comparing the claim with the corresponding claim of the previous application was not a valid approach (see also summary in this chapter II.D.3.2.2).

#### 3.1.4 Reference to common general knowledge

According to **T 136/95** (OJ 1998, 198), identity of invention has to be assessed by reference to the skilled person. A patent application is a technical document, addressed to the skilled person, not a work intended for the general reader. However, the skilled person is not familiar, unlike in the assessment of inventive step, with all the prior art, but only with those elements of it which form part of his **general knowledge**, and it is on the basis of this knowledge, or by carrying out simple operations derived from it, that he may infer whether or not there is identity of invention. According to the board, it was necessary to give some flexibility to the requirement for identity of invention between the two applications. Some features claimed in the European application need not be expressly mentioned in the application whose priority is claimed, provided that the skilled person is able, purely on the basis of his knowledge or by performing simple operations to carry out the invention, to infer these features from the prior application. In the case in

question a **structural feature** claimed in the European application was supported by a **general functional feature** described in the prior application.

In **T 744/99** the board noted that for the subject-matter of a claim to be derivable "directly and unambiguously, using common general knowledge, from the previous application as a whole" (cf. **G 2/98**, OJ 2001, 413), such subject-matter could not be novel with respect to the disclosure of the priority document. The application of common general knowledge could only serve to interpret the meaning of a technical disclosure and place it in context; it could **not** be used to **complete** an otherwise incomplete technical disclosure. In the case in hand, since the priority document only disclosed a new signal protocol without any disclosure of a suitable receiver, claim 8 of the subsequent application, which was directed to such a receiver, was not entitled to the claimed priority date.

In **T 1312/08** the patent proprietor had submitted that the definition of "PU" was correct in the patent in suit but erroneous in the priority document. The board, referring to the established jurisprudence, stated that the reworking of an example and especially of a method which was not a standardised one and was not reported in encyclopaedias, textbooks, dictionaries and handbooks could not be considered to be the application of common general knowledge. The mere fact that it was necessary to carry out a test, which was not part of common general knowledge, in order to find out whether the definition of PU in the priority document was erroneous made it clear that the different definition of PU used in the patent in suit was not derivable directly and unambiguously, using common general knowledge, from the whole content of the priority document. See also **T 1579/08**.

### 3.1.5 Explicit or implicit disclosure of the "essential" features in the priority document

#### a) General

In order to give rise to priority all the essential elements, i.e. features of the invention in the priority document must be either expressly disclosed or directly and unambiguously implied by the text as filed. The question therefore arises as to what constitutes the essential elements, i.e. features of the invention, claimed in the European patent application, and whether or not these features are disclosed in the respective priority documents (cf. Art. 88(4) EPC; see **T 81/87**, OJ 1990, 250; also **T 65/92**, **T 127/92**, **T 296/93**, **T 479/97**, **T 342/98** and **T 188/97**). Essential elements missing in the priority document and recognised as essential only later on are not part of the disclosure of the previous application and there is then no right to priority (**T 81/87**, OJ 1990, 250; **T 301/87**, OJ 1990, 335; **T 269/87**, **T 296/93**, **T 1228/01**). **T 81/87** has also been followed in numerous decisions since **G 2/98** (e.g. **T 479/97**). To be noted is that the "essential features" in this context are not the counterpart to the "non-essential features" within the meaning of **T 73/88** ("Snackfood", OJ 1992, 557).

#### b) Cases of non-disclosure of essential features

In **T 923/92** (OJ 1996, 564) the board maintained a patent on a process comprising the preparation of a protein with (further specified) human tissue plasminogen activator

function. The subject-matter of the claim was defined by means of reference to an **amino acid sequence**. The sequence contained in the European application was disclosed for the first time in the third priority document (P3). It differed from the sequence reported in the first and second priority documents (P1 and P2) in respect of three amino acids.

The board held that only the priority of P3 could be claimed. In the board's judgment, the skilled person would consider the primary amino acid structure of a protein to be an essential feature thereof because it represented its chemical formula. He would therefore consider the reference to the amino acid sequence of a protein as having not merely an informational character but as being a **primary technical feature** linked to the character and nature of the product. When comparing the sequences reported in P1/P2 and in P3, the skilled reader could not know whether, in spite of the differences, the sequences were identical in their physical and biological characteristics; at least on paper the quoted replacements of amino acids could imply important structural and functional differences. The evidence submitted by the patentee was understandably restricted to the testing of a limited number of parameters and left open the possibility that the two polypeptides could differ in many other properties (see also in this chapter II.D.3.1.10).

In **T 1052/93** it was an essential feature of the wash adjunct products claimed in the European patent that they contained sodium perborate monohydrate in conjunction with a **functionally defined activator**. The priority document only mentioned certain activators complying with the functional definition in the European patent; these specific compounds could not be considered to disclose the broad group of activators functionally defined in claim 1 of the European patent. See also **T 132/09**.

In **T 1054/92** of 20.6.96 claim 1 contained the feature that the absorbent structure had a **moisture content** of less than 10%. This feature could not be derived from the disclosures in the first and second priority documents. The said upper limit was only introduced by the third priority document. The board could accord to the subject-matter of claim 1 only the third priority date. The feature concerning the moisture content of less than 10% was an essential element. The relevant feature appeared in claim 1 as originally filed and was relied upon by the appellant in the examination proceedings when seeking to distinguish the subject-matter of this claim from cited prior art.

In **T 277/95** the board found that a claim to a method of producing in CHO cells hEPO characterised by the presence of a specific **glycosilation pattern** did not enjoy priority from a priority application which made available the cell line but gave no information on the specific glycosilation pattern.

In **T 479/97** a first priority document characterised the *pelC* gene claimed in the subsequent application as being on a **5kb DNA fragment** which was carried by a deposited plasmid. The board found that even if the sequence of the DNA fragment was known this did not necessarily imply that the provision of this fragment made available in a direct and unambiguous manner a specific gene which it contained, if only because the 5kb fragment which was bigger than the gene of interest might carry more than one gene.



In **T 908/09** the board concluded that the priority document did not clearly allocate to one single group the classes of substances which were named in granted claim 1 as components b). Accordingly, the skilled person could not derive directly and unambiguously from the priority document a mixture of at least one substance a) with at least one substance b), as was required by claim 1.

In **T 521/10** the enabling disclosure for the embodiment of claim 1 relied on the content of patent applications incorporated by reference. The reference to one of these (D9) was not present in the priority document. Indeed, D9 was not filed until after the claimed priority date. Therefore, as far as the subject-matter of claim 1 was based on the disclosure of D9, the priority was not validly claimed. As D9 was published before the filing date, it was pertinent prior art. See also summary of this decision in Chapter II.C.3.2.

In **T 846/10** the US priority application P1 claimed (on Form PTO/SB/01 (12-97)) the benefit under 35 U.S.C. 119(e) of two provisional applications P2 and P3. The board rejected the appellant's claim that their contents were for this reason to be considered incorporated by reference into the disclosure of P1; P1 itself contained no mention of "incorporated by reference" or any equivalent expression.

#### c) Example of disclosure of essential features

In **T 172/95** the board did not accept the appellant's (opponent's) argument that for the copolymer the subsequent European application contained information not to be found in the priority document. As to the objections concerning the fractionation method the appellant could provide no evidence that the differences present would result in different ethylene polymers being claimed in the priority document and in the patent in suit. The respondent provided evidence of the contrary. Regarding the calculation methods for two parameters defining the claimed copolymer, the board pointed out that the passage not present in the priority document did not change anything in the actual method of determination of these parameters, but merely specified how a person skilled in the art would normally operate. Therefore, the introduction of the above passage into the application as filed did not change anything in the definition of the copolymer, hence did not in substance modify the teaching of the priority document. Whereas in the priority document the copolymer could have one or more melting points, in the subsequent European application the possibility of two melting points was excluded.

#### 3.1.6 Solution of the same problem

Concerning the requirement of the same invention or subject-matter (cf. Art. 87(1) and (4) EPC), according to **T 647/97** it was not only required that the solution to a given problem (i.e. the features of the main claim) was the same, but also that the problem itself was the same in both applications. The **proper definition of the problem to be solved in the priority document** as understood by the skilled person reading the document with his common general knowledge in the art at its filing date was decisive to that end. The board noted that the priority document only mentioned solid and gel copolymer compositions for providing a sustained-release composition for treating

periodontal disease (first problem), but was silent about any fluid or liquid compositions. The skilled person would moreover not consider fluid and liquid compositions as a suitable solution for the problem addressed in the priority document. It was only disclosed in the contested patent that the fluid and liquid compositions surprisingly transformed into a near solid phase and would therefore be suitable for treating difficult to reach areas of periodontal cavities (second problem). It therefore constituted a second invention involving a different problem and a different solution.

In **T 837/13** the patent and the priority document aimed at solving technical problems of the Palmaz-Schatz stent (low stent-to-vessel ratio uniformity, comparative rigidity, limited flexibility), the problem posed in the patent being identical to one posed in the priority document. The appellant objected that the priority document solved a second problem not even addressed in the patent (provision of a wide range of design options). The board stated that there was no reason why the priority-claiming application would need to solve all problems raised in the priority document. It could well relate to only one aspect of the disclosure in the priority document. What could be objected to - see **T 647/97** - was a situation where the priority-claiming application solved a new problem different and not derivable from that posed in the priority document. This did not apply here.

For a further example, see **T 782/07**.

### 3.1.7 Same teaching in the priority document

In **T 250/06** the board emphasised that, for priority to be acknowledged, it was not sufficient that a formal support for the claimed subject-matter be found in the priority document; on the contrary, it pre-supposed that the priority document also provided an adequate technical teaching in respect of said subject-matter and that this was the "same" teaching as that of the European patent.

Claim 1 related to a group of recombinant DNA molecules comprising a nucleotide sequence encoding a vertebrate delta opioid receptor (DOR) characterised as hybridising under conditions of low stringency to the mouse DOR DNA sequence shown in Figure 5. The priority document taught the cloning of the mouse DOR DNA and its sequence. According to the board, it was readily apparent from the priority document that its teaching on its own was not sufficient. In Example 6, a human DOR DNA was allegedly identified by probing a human DNA library with mouse DOR DNA. Yet, the clone so isolated turned out to be  $\mu$ OR DNA. The European application disclosed the isolation of  $\mu$ ,  $\kappa$  and DOR clones and their unambiguous characterisation, in particular by comparison with sequences then available in the art. Thus, it contained a technical teaching different from (more complete than) that of the priority document.

In **T 1443/05**, too, the board concluded that the teaching of the contested patent, which included a disclaimer not present in the previous European application from which priority had been claimed, was different from the teaching of the latter, such that the requirement of the "same invention" according to Art. 87(1) EPC and **G 2/98** (OJ 2001, 413) was not met. The board also found in this case that examples included in

the previous application (now an Art. 54(3) EPC 1973 document) anticipated the subject-matter of claim 1 of the patent in suit (in this respect see also **T 680/08**).

### 3.1.8 Error margins and definitions of limits

Prior to the opinion given in **G 2/98** (OJ 2001, 413), it was sometimes possible to claim error margins or definitions of limits which differed in the subsequent application from the original one. In the jurisprudence which came after **G 2/98**, however, reference is no longer made to the decisions handed down in **T 212/88** (OJ 1992, 28), **T 957/91**, **T 65/92** and **T 131/92** (see "Case Law of the Boards of Appeal of the EPO", 3rd ed. 1998, p. 263 et seq.). But since the facts are only comparable up to a certain point, it is not possible to say unequivocally to what extent the principles laid down earlier still apply.

In **T 201/99** the cited priority applications disclosed, in respect of the **mean residence time** of the material in the granulator/densifier, either the range "from about 1-6 minutes" (claim 1 of both priorities) or, for all the examples, a specific residence time of "about 3 minutes". In contrast, claim 1 of the granted patent claimed a mean residence time of "1-10 minutes". The appellant had argued that the upper limit of "6 minutes" was not disclosed in the cited priorities as a cut-off value (i.e. as possibly related to the function of the invention and its effect) and thus constituted a feature which might be modified without changing the nature of the invention. The board, however, held that, even if for the sake of argument the range of "about 1 to 6 minutes" given in the priority applications was interpreted as an open range extending far beyond "6 minutes", the value of "10 minutes" as well as, for instance, the range from above 6 minutes up to 10 minutes still constituted selections not disclosed in the priority applications. It followed that for a skilled person applying his common general knowledge the value of "10 minutes", at least, was not derivable directly and unambiguously from the prior applications.

The invention in **T 423/01** concerned a method for analysing length polymorphisms in simple or cryptically simple DNA regions. According to claim 1, the DNA sequences in the invention incorporated repeating units of between three and six nucleotides. The respondents objected that the claimed upper limit, in particular, could not be found in the original application documents. The board considered **T 201/83** (OJ 1984, 481) to be relevant to the question of rightful priority claims, even though it concerned the original disclosure of quantitative ranges of values within the meaning of Art. 123(2) EPC 1973. According to this decision, an amendment to a range in a claim is allowable on the basis of a particular value described in a specific example, provided the skilled man could have readily recognised this value as not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention as a whole in a unique manner and to a significant degree. In the case in hand, the board had already established in the context of Art. 123(2) EPC 1973 that the phrase "approximately 6 to 10" explicitly disclosed the number six. A range between the value 3, which was disclosed as preferred in Example 2 (identical to Example 2 of the priority document), and the lowest value of the "range" already mentioned in the priority document for the upper limit value (at least one nucleotide and a maximum of 6 to 10 nucleotides) was to be considered disclosed in the original application. The claimed priority was valid.

In **T 250/02** the board found that the subject-matter of a claim for a herbal essential oil in which the total amount of carvacrol and thymol was at least 55%, and preferably 70%, by weight of the said essential oil could not be derived directly and unambiguously from a priority document disclosing a herbal oil containing "thymol and carvacrol in levels of 55% to 65%".

Further decisions concerned with differing ranges indicated in a priority document and disputed sets of claims include **T 903/97**, **T 909/97**, **T 13/00**, **T 136/01**, **T 788/01**, **T 494/03** and **T 537/03**. See also **T 110/07**, reported in this chapter II.D.3.1.9.

### 3.1.9 Selection from generic disclosure

A generic disclosure implicitly encompassing two or more alternative embodiments cannot generally give rise to a right of priority in respect of one specific embodiment that is **neither explicitly nor implicitly** disclosed (**T 61/85** and **T 30/01**).

In case **T 77/97** dependent claims 4 and 5 related to individual compounds which were part of the group defined by the generic formula of claim 1. Claim 3 of the priority document defined by means of a generic formula a **group of four chemical compounds**, including those according to claims 4 and 5 in issue. The board acknowledged that the priority document contained sufficient information for a skilled person to obtain without difficulty the four chemical compounds according to the generic formula of claim 3. However, this could not automatically lead to the recognition of the priority for claims 4 and 5 in issue. It was not sufficient to establish that the compounds concerned fell within the scope of the claims of the previous application, and that they could be prepared without difficulty in accordance with the information contained in this application (**T 409/90**, OJ 1993, 40; see in this chapter II.D.3.1.3). The expression "the same invention" as used in Art. 87(1) EPC 1973 had to be interpreted in conformity with Art. 88(2) to (4) EPC 1973. The applicant had claimed priority not only in respect of the element which distinguished all the compounds claimed in all the claims of the European application from the prior art, but also in respect of the specific combination of individual substituents which precisely defined the actual chemical compounds. It was therefore necessary to examine whether these elements, this **set of features**, had been revealed precisely by the documents of the prior application, as required by Art. 88(4) EPC 1973. Although there was no doubt that the priority document described a very narrow group as being preferred, it did not distinguish between the four compounds of this group, and neither did it specify that the formula of claim 3 had to be considered as an "abridged" formulation of a list or table indicating four individual chemical compounds. As a consequence, claims 4 and 5 could not be granted the claimed priority right (see also **T 295/87**).

The invention at issue in **T 30/01** concerned an apparatus for optical imaging and measurement. The board rejected the appellant's argument relating to an implicit disclosure in the priority document of two possible implementations of the teaching of the document, noting that its description unmistakably indicated the provision of the light steering means "in the sample arm". This precise disclosure deprived of support the appellant's construction of the disclosure as implicitly disclosing the provision of the light

steering means in and outside the probe as two complementary alternative implementations - let alone as disclosing any specific one of these two alternatives by way of "implicit disclosure" by reference to common general knowledge (**T 823/96**, **T 744/99** and **T 818/00**). According to the criterion consistently applied by the boards of appeal, a generic disclosure **implicitly encompassing two or more alternative embodiments** can generally not give rise to a right of priority in respect of a **specific one of the embodiments** that is neither explicitly nor implicitly disclosed (**T 61/85**) the latter criterion being a particular form of the "disclosure test" laid down in **G 2/98** (OJ 2001, 413) and constituting the logical corollary of the established principle - confirmed in **G 2/98** (see also **T 744/99**) - that no right to priority can be acknowledged for an invention that is regarded as novel over the disclosure of the corresponding priority document.

**T 788/01**, **T 899/04**, **T 70/05** and **T 971/08** also saw the boards apply the principle that a generic disclosure cannot provide priority for a specific embodiment not disclosed in the priority document.

In **T 903/05** the claims related to the use of a telomerase peptide consisting of the sequence of SEQ ID NOs: 2, 3, 4, 9 or 10 for the manufacture of a medicament for the treatment or prophylaxis of cancer, the treatment or prophylaxis comprising generating a T cell response. The priority document disclosed more generally the use of telomerase peptides for use in a method of treatment or prophylaxis of cancer, in which a T cell response is generated. Among the preferred peptides were those of SEQ ID NOs: 2, 3, 4, 9 and 10, which were also part of the list of peptides disclosed in Tables 1 and 2. The board recalled that, according to **G 2/98** (OJ 2001, 413), if the invention claimed in a later European patent application constituted a selection invention in respect of the subject-matter disclosed in a first application whose priority was claimed, the criteria applied by the EPO with a view to assessing the novelty of selection inventions over the prior art had also to be considered carefully when assessing whether the claim in the European patent application was in respect of the same invention as the priority application (Art. 87(1) EPC 1973). Such priority claims should not be acknowledged if the selection inventions in question were considered "novel" according to these criteria. The board considered that in the case before it the selection of specific peptides from the disclosure of the priority document did not result in novel subject-matter since the selection was made from only one list of entities, i.e. the preferred peptides specified in the claims and Tables 1 and 2, such that the claimed subject-matter was directly and unambiguously derivable from the priority document.

According to the board in case **T 110/07**, the priority document P1 failed to disclose the range in the feature of claim 1 of the subsequent European application "sodium diffusion barrier layer ... having a thickness of at least 10 nm". Nor, in view of **G 2/98** (OJ 2001, 413), was either the claimed lower limit of 10 nm or the open-ended range of  $\geq 10$  nm directly and unambiguously derivable from P1. The board considered a "novelty test" based on the concept of overlapping ranges (as had been applied by the opposition division) to be inappropriate in view of **G 2/98**, because in this case there was no overlap but rather a generalisation of ranges. According to **G 2/98** priority claims should not be acknowledged if the selection inventions in question are considered "novel" according to

the criteria applied by the EPO in assessing novelty of selection inventions over the prior art. However, it did not automatically follow from this statement that priority claims **should be** acknowledged if the selection inventions in question were considered **not** "novel". The board drew attention to **T 1233/05**, **T 230/07** and **T 1130/09**, according to which the demonstration of a technical effect over a sub-range is not decisive for acknowledging novelty. A sub-range must be novel per se.

### 3.1.10 Inventions relating to nucleotide and amino acid sequences

In **T 923/92** (OJ 1996, 564 - see also in this chapter II.D.3.1.5 b)), claim 1, the subject-matter of which was defined by means of a reference to the amino acid sequence of Figure 5, was held not to be entitled to priority from earlier applications P1 and P2, in which that amino acid sequence was not disclosed. The sequence reported in Figure 5 was observed to differ from that of Figure 5 of P1 and P2 in respect of three amino acids. In the board's judgment, the skilled person would consider the reference to the amino acid sequence of a protein as a primary technical feature linked to the character and nature of the product. Evidence from the patentee was restricted to the testing of a limited number of parameters and constituted at most proof of similarity, not of identity of the two polypeptides. These differed in one essential characteristic, i.e. the primary amino acid sequence.

In **T 351/01** a polynucleotide which was the subject-matter of claim 1 was characterised both in structural terms and by its function. Priority documents I and II disclosed a polynucleotide having the same function as that of the polynucleotide of claim 1. However, its structure differed from that of the polynucleotide of claim 1 by five bases, all found in the part of the sequence which does not relate to the function i.e. outside of the coding region. The board, referring to the Enlarged Board's opinion which had rejected an extensive or broad interpretation making a distinction between technical features which are related to the function and effect of the invention and technical features which are not, concluded that the subject-matter of claim 1 could not be seen as the same subject-matter as that disclosed in the priority documents.

In **T 30/02** the board held that the presence of two additional guanine residues in the nucleotide sequence disclosed in an application cited in this case under Art. 54(3) EPC 1973 resulted in a different molecule that was not directly and unambiguously derivable from the earlier application from which priority was claimed. It was generally acknowledged in the case law of the boards of appeal that the nucleotide sequence of a nucleic acid represents an essential feature linked to the character and nature of the nucleic acid as such, and, where the nucleotide sequence is a coding sequence, also of the encoded protein (see **T 923/92**, OJ 1996, 564). The skilled person was aware of the fact that even a minimal modification of the nucleotide sequence may result in a different nucleic acid not only from the structural but also from the functional point of view. See also decision **T 70/05**.

In **T 1213/05** the invention related to the human BRCA1 gene isolated from the genome and its use in the diagnosis of predisposition to breast and ovarian cancer. The BRCA1 coding sequence disclosed in the priority document (P2) deviated from that disclosed in

the application as filed by 15 nucleotide residues. The board recalled that the Enlarged Board of Appeal in **G 2/98** (OJ 2001, 413) had rejected an extensive interpretation of the concept of "the same invention", which makes a distinction between technical features which are related to the function and effect of the invention and technical features which are not, with the possible consequence that a claimed invention is considered to remain the same even though a feature is modified or deleted, or a further feature is added. The case law of the boards dealing with the concept of "the same invention" in the field of biotechnology and especially in connection with inventions involving nucleotide sequences and amino acid sequences (**T 351/01**, **T 30/02**, **T 70/05**, **T 923/92**) had also taken a strict approach. The proprietor took the view that, if parameters (here: the nucleic acid sequence) which are used to define a substance (here: a nucleic acid) in a claim were known to vary within margins of commonly encountered experimental errors, the occurrence of variation in such a parameter between a disclosure in a priority document and the later application did not necessarily abrogate entitlement to the claimed priority. The need for legal certainty for third parties could not be higher than experimental certainty. The proprietor further argued that the technical problem underlying the patent in suit was the provision of the isolated BRCA1 gene as a tool to diagnose a predisposition to breast or ovarian cancer. The sequence deviations were irrelevant for solving this problem. However, the board rejected both approaches as not being compatible with the Enlarged Board's conclusion in **G 2/98**.

On the other hand, in two further decisions of Board 3.3.04, **T 80/05** and **T 666/05**, it was held that certain sequence deviations between the patent in suit and the contested priority documents (P2 and P4, respectively) did not affect the invention claimed. Consequently, in both cases the corresponding priority date was found to be valid.

In **T 250/06**, claim 1 of the second auxiliary request related to recombinant DNA molecules comprising a nucleotide sequence encoding a murine delta opioid receptor (DOR), characterised as hybridising under conditions of low stringency to the DNA sequence shown in Figure 5. Appellant II pointed out that Figure 5 of the priority document differed by the addition of seven interspersed bases in the 3' untranslated region. The board indicated that conditions of low stringency were developed for screening molecules which differ somewhat from the probe. It was fully expected that the group of molecules obtained by hybridisation to the DNA of Figure 5 of the priority document and of the patent in suit respectively would not be different.

### **3.2. Claiming the invention disclosed in the earlier application in the subsequent application**

The features of the invention disclosed in the priority application must also characterise the invention claimed in the subsequent application.

#### **3.2.1 Implicit features of the technical teaching of the subsequent application**

In **T 809/95**, the opponents submitted that the "thin-walled" feature, which was **disclosed** in the first priority application **as essential**, was not contained in granted claim 1. The board of appeal was of the opinion that granted claim 1 was based on a

"collapsible" plastic bottle "produced by the blow-moulding method" which had folds "to facilitate a reduction of volume upon the exertion of a pressure applied to the walls by hand". This description in itself implied that the bottle would have to be made from thin-walled plastic flexible enough to be collapsible by hand when empty, as required by independent claim 3 in the first priority application.

### 3.2.2 Features missing with respect to the earlier application

#### a) Omission of non-essential features

In **T 809/95**, the opponents maintained that the claim at issue did not contain all the features which a skilled person would recognise as essential from the second priority document, with the result that the claim was directed to another invention. The board established, however, that the features which the opponents thought were missing were not connected in **any recognisably close way with the problem put forward in this priority document**. This problem was not solved by the missing features, but by other features, all of which could be found in the claim. Thus the subject-matter of this claim was entitled to claim the second priority.

In **T 576/02** the board pointed out that the omitted feature was even less essential in that it did not even appear in the independent claims of the priority document, which by definition specified all the essential features of the invention.

In **T 515/00** the appellant had argued that features pertaining to hardware components relating to the printing process were no longer present in the claim and that there was no basis in the priority document for the deletion of these features. The board referred to **G 2/98** (OJ 2001, 413, point 8.3 of the Reasons), in which the Enlarged Board had warned against an approach whereby a distinction was made between technical features which were related to the function and the effect of the invention and technical features which were not. Priority could not be acknowledged if a feature was modified or deleted, or a further feature was added. The board further noted that a claim passed the priority test if its subject-matter could be derived from the previous application **as a whole**. It followed that comparing the claim with the corresponding claim of the previous application was not a valid approach to performing the "priority test". The priority test was basically a disclosure test in which the skilled reader could use common general knowledge. If, in the description of the previous application, a distinction was made between features that were essential for the performance of the invention and features which were not, the latter could be deleted from the subject-matter of a claim without losing the right to priority. The omitted hardware components were nowhere presented as essential features in the priority document's description. The skilled reader would not have any reason to assume that they were essential merely because they were present in claim 1 of the priority document. This decision was followed in **T 321/06**.

#### b) Omission of indispensable features

In **T 134/94** the priority document disclosed a **process** which worked under specific conditions indicated as features (a) to (d). Requirements (a) and (c) did not appear in the



granted claim of the patent in suit. The board held that this claim was not entitled to priority. As requirements (a) and (c) did not appear in the granted claim the scope of the invention as defined thereby comprised areas which, according to the priority document, did not belong to the invention. Thus the invention defined by granted claim 1 was not the same as that defined in the priority document. On the priority date the technical problem underlying the invention was considered to be solved only if each of the conditions (a) to (d) was satisfied; according to granted claim 1 features (a) and (c) were no longer necessary for solving the problem underlying the invention. According to the board, the respondent's position that the priority claim should be acknowledged whenever the disclosure of the priority document would destroy the novelty of the claims of the later application or patent ("novelty test") had no basis either in the EPC or in the EPO case law. Such a position would imply that essential features of an invention disclosed in a priority document could be omitted in a later application based thereon without loss of priority right. However, if an essential feature of an invention was so omitted, the invention was no longer the same, i.e. the requirement of Art. 87(1) EPC 1973 was not fulfilled.

In **T 552/94** the patent's claim 1 lacked four features which according to the priority document were indispensable for carrying out the invention. In other words, they were no longer essential to the invention as now defined. Citing **T 134/94** and **T 1082/93**, the board found that without those features the invention according to claim 1 could not be the same as that described in the priority document, and the requirements of Art. 87(1) EPC 1973 were therefore not met. See also **T 59/11** and **T 1890/09**.

In **T 1050/92**, on the other hand, the disclosure of the invention in the earlier application provided an adequate basis for replacing the term used in said application with a more general one in the European application. See also **T 250/12**.

### 3.3. Enabling disclosure in the priority document

The decisions below highlight that the priority document must disclose the invention claimed in the subsequent application in such a way that it can be carried out by a person skilled in the art.

In **T 81/87** (OJ 1990, 250), concerning living cells capable of expressing bovine preprorennin, only the priority claim of the second previous application was valid because in the first one the steps leading to the desired bovine preprorennin gene were **not sufficiently disclosed**. With reference to this specific field of recombinant DNA technique, the board took the view that the argument that the skilled person would supplement the disclosure from his common general knowledge to make it work, should any difficulty be encountered, was no excuse when this was a feature of the definition of the invention, and was missing, not envisaged by the inventor and not implied by the description. In order to give rise to priority rights the essential elements, i.e. the features of the invention, in the priority document had to be either expressly disclosed or directly and unambiguously implied in the text as filed; missing elements recognised as essential only later on were not part of the disclosure, and gaps with regard to basic constituents could not be retrospectively filled by relying on knowledge acquired in this manner. It

could become a misuse of the priority system if some parties in a competitive situation were allowed to jump ahead of others on the basis of mere expectations and by omitting the critical features of the invention altogether. See also **T 301/87**, OJ 1990, 335; **T 296/93**, OJ 1995, 627; **T 188/97**.

In **T 296/93** (OJ 1995, 627) the board examined whether the priority document was deficient in respect of relevant technical information necessary for reducing the claimed invention to practice by the person skilled in the art without undue burden. Equally, in **T 207/94** (OJ 1999, 273) the board examined the question of whether the requirement in Art. 87 EPC 1973 that the same invention must be claimed in the priority application and the European patent application was fulfilled in the sense that the priority application disclosed the invention claimed in the subsequent European application in an enabling manner. See also **T 20/04**.

In **T 767/93** claim 1 of the European patent related to a process which comprised expressing from a recombinant DNA vector in a suitable host organism a polypeptide capable of raising HCMV-neutralising antibodies in humans. The board found this invention to be the same as that disclosed in the first priority document: the reported DNA and amino acid sequences were identical and the teaching of the priority document, as it would be read by a skilled person, was not limited to a specific example but was of more general scope, since it referred to the expression of a protein from the isolated genome fragment by using conventional genetic engineering techniques in suitable vectors and also mentioned the possibility of expressing discrete portions of the protein.

In **T 919/93**, claim 1 of the European patent comprised a reference to the inactivation of a virus related to Acquired Immune Deficiency Syndrome (AIDS) which was neither cited expressis verbis in the priority document nor implicitly derivable therefrom. In a previous appeal concerning the patent (**T 449/90**) it had been found that the feature of inactivation of the virus upon dry heating had to be testable by the skilled person in order that the sufficiency of disclosure requirement of Art. 83 EPC 1973 be fulfilled. The technical information of the application as filed was considered by the board to be sufficient for that purpose. In its decision on the present appeal, however, the board found that these passages in the European application as filed, essential for the application to meet the requirements of Art. 83 EPC 1973, had no counterpart in the priority document, which was thus not enabling for the claimed subject-matter.

In **T 843/03** the board pointed out that the priority document had to provide an enabling disclosure (**T 81/87**, OJ 1990, 250; **T 193/95**) and recalled that it has been established in a number of board of appeal decisions that sufficiency of disclosure presupposes that the skilled person is able to obtain substantially all embodiments falling within the ambit of the claims and that he/she, in order to reach this goal, may not be confronted with an undue burden. The examining division had taken the view that the first priority document was not enabling for the production of the claimed VLP (virus-like particle) comprising human papilloma virus-16 (HPV-16) L1 capsid protein. However, based on previous case law on the requirement of Art. 83 EPC 1973 (**T 19/90**, OJ 1990, 476) and on the novelty requirement (**T 464/94**) the board concluded that, when an applicant provided a technical disclosure and **prima facie evidence** as to certain technical elements in an

application, **it was the EPO which had the burden of proof** when judging that something was not shown. The board held that the examining division had not taken the legally appropriate approach when deciding to the disadvantage of the applicant with the reason that "[...] no absolute fact can be deduced from figure 7 as to whether it shows correctly formed HPV 16 particles or not". The board did not see full proof of such facts as a requirement within the framework of the EPC and could not see any serious doubts of the examining division substantiated by verifiable facts.

In **T 903/05** the board rejected the argument of appellant II that the claims did not relate to the same invention since the priority document **lacked any experimental data** which made it plausible that the invention now claimed worked. The enablement of the disclosure of the priority document had explicitly not been challenged by appellant II. The board saw no legal basis for imposing additional criteria such as the presence of experimental data in the priority document which made it plausible that the invention would work. The board was furthermore convinced that the experimental data which were present in the patent and not in the priority document did not change the nature of the invention disclosed.

According to the board in **T 107/09**, the antibody MR1 was indispensable in order to reproduce the invention of claim 1. The "written" disclosure in the earlier US application from which priority was claimed, even if supplemented by common general knowledge, would not enable the skilled person to carry out the invention. The hybridoma cell line producing the antibody MR1 had been deposited with the ATCC (American Type Culture Collection) only after the filing date of the earlier application. In view of the absence of explicit provisions in the EPC as to when a deposit of biological material had to be made in relation to an earlier application (R. 28 EPC 1973 being concerned with European applications), the board referred in particular to decision **G 1/03**, according to which the requirement of sufficiency of disclosure had to be complied with - in relation to an earlier application from which priority was claimed - at the date of filing of that application. Thus, the board reasoned, if the deposit of biological material was necessary for the requirement of sufficiency of disclosure to be fulfilled for a "priority application", the deposit of this material had to have been made no later than the date of filing of that earlier application. This was not the case here.

#### **4. First application**

In principle, only the first application filed in a state party to the Paris Convention or a member of the WTO can form the basis of a priority right. In the EPC, this is made clear in Art. 87(1) and (4) EPC.

Therefore, if apart from the application whose priority is being claimed in the subsequent European application, an earlier previous application was also filed, in order to check the validity of the priority claim it must be established whether the invention claimed in the subsequent application was already disclosed in the earlier previous application (see in this chapter II.D.4.1). Three decisions in particular have also focused on the identity of the applicants (see in this chapter II.D.4.2).

In **T 477/06** the board held first that since Euro-PCT application D8 had been deemed withdrawn due to non-payment of the designation fees (R. 23a EPC 1973), it was not prior art under Art. 54(3), (4) EPC 1973 for the application in suit. However, it had been filed by the same applicant and earlier than the priority application. In view of the fact that claimed subject-matter was anticipated by this earlier application, the priority application was not the first application within the terms of Art. 87(1) and (4) EPC 1973 (cf. Art. 8(2)(b) PCT), so that the priority claim was not valid. Hence, the application in suit enjoyed priority only from the date of filing and D8 was prior art under Art. 54(2) EPC 1973. See also **T 1222/11** in chapter II.D.4.1 below.

For the case of a priority held invalid because it was **not** shown, for the purpose of Art. 87(4) EPC 1973, that at the date of filing of the application from which priority was claimed, a previous first application filed by the applicant in respect of the same invention had been **withdrawn**, see **T 1056/01** (reported in Chapter III.G.4.3.4).

#### 4.1. Identity of invention

To establish whether the invention claimed in the subsequent European application was already disclosed in the earlier previous application, the same principles have to be applied as when establishing identity of invention between the application forming the basis of priority and the application claiming priority. The question is whether the person skilled in the art could derive the subject-matter of the claim of the subsequent application directly and unambiguously, using common general knowledge, from the earlier previous application or only from the later one (cf. **G 2/98**, OJ 2001, 413).

In **T 323/90** the board concluded that the alleged first application disclosed a different invention from that in the European application and the application from which priority had been claimed: the claimed process (for increasing the filling power of tobacco lamina filler) differed as regards both the moisture content of the tobacco for processing and the first step in the process.

In **T 400/90** priority had been claimed from a US application in respect of a European application concerning an electromagnetic flowmeter. According to the opponents, an earlier US application filed by the same applicant outside the priority period 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 concluded 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** the Japanese application from which priority was claimed in the European patent application but also an earlier Japanese application claimed a method of producing a single crystal of ferrite. 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 one. The board held that the **significant differences in properties** were indicative of the presence of different materials and therefore found that the earlier Japanese application was not the first filing of the invention claimed in the European patent application. It based its finding on **T 205/83** (OJ 1985, 363), which stated that the novelty of products prepared using a modified process could be established by the fact that according to an empirical principle in chemistry, a product's properties were determined by its structure, so that differences in the properties of products indicated a structural modification.

The subject-matter of the patent in case **T 107/96** contained the feature "angle of contact greater than 120°", which feature was disclosed in P2, the later of two previous US applications. In P2 a particular advantageous effect was also attributed to the large extent of the said "angle of contact". The earlier previous US application P1 was totally silent about the aforementioned feature "angle of contact" and its advantageous effect. However, the figures of P1 represented **diagrammatic** and schematic drawings. The board concluded that therefore, and in line with the established jurisprudence of the boards of appeal, they could not serve as a basis for determining the extent of a minimum "angle of contact" because dimensions obtained merely by measuring a diagrammatic representation of a document did not form part of the disclosure. Hence, the said feature "angle of contact greater than 120°", was not disclosed in P1 but only in P2.

In **T 449/04**, in order to establish whether the priority application PR, and not an earlier application D1 of the applicant, was the "first application" within the meaning of Art. 87(1) EPC 1973, the board referred to **G 2/98** (OJ 2001, 413), according to which, firstly, the concept of the "same invention" in Art. 87(1) EPC 1973 has to be narrowly or strictly interpreted, that is, in a way equating it with the concept of "the same subject-matter" under Art. 87(4) EPC 1973, and, secondly, that the description of the invention of the earlier publication has to be considered **as a whole**. The board concluded that the invention disclosed in D1 was not the "same invention" as that disclosed in application PR. With regard to a **comparative example** in D1, the composition of which fell within the elemental ranges claimed in the application-in-suit as well as in application PR, the board emphasised that the "same invention" considered in Art. 87(1) EPC 1973 did not encompass the comparative example(s) which were clearly and definitely **excluded from the scope of the invention** in D1. Having regard to the strict and narrow interpretation of the term "the same invention" pursuant to Art. 87(1) EPC 1973, this term was focused on what constituted the elements of the invention.

In **T 1222/11**, claim 1 had been amended to include six disclaimers for the purpose of restoring novelty over D4b, an earlier international (Euro-PCT) application of the same applicant, which had been published within the priority interval. The board found that the combination of features defined in positive terms in claim 1 (i.e. without any disclaimer) could not be distinguished from the disclosure of D4b and was not entitled to the claimed priority as far as it concerned the subject-matter already disclosed in D4b (Art. 87(1), (4) EPC). The compositions of D4b were therefore prior art under Art. 54(2) EPC. As the

anticipatory disclosure of D4b was not an accidental anticipation (cf. **G 1/03**, OJ 2004, 413), the disclaimers based on it were not allowable under Art. 123(2) EPC. For further mention of this decision see in this chapter II.D.5.3.

#### **4.2. Identity of applicant**

In **T 5/05** the opposition division had concluded that neither of the two claimed priority applications qualified as the first application within the meaning of Art. 87(1) and (4) EPC 1973 on the grounds that two inventors and part of the subject-matter were the same as in an earlier previous application. As the filing date of that application was more than twelve months prior to the filing date of the contested patent and the application had been "made public", the same invention of the same inventors could no longer serve as a basis for claiming priority.

The board, however, stressed that priority could be based only on earlier applications filed by the applicant of the European application or by his predecessor in title. Moreover, only such applications could meet the further requirement, derivable from Art. 87(4) EPC 1973, that an application giving rise to the priority right had to be the first application by the applicant or by his predecessor in title in respect of the invention. The inventor was not relevant. Applications filed by various applicants figured alongside one another as state of the art within the meaning of Art. 54(2) or Art. 54(3) EPC 1973. The board also rejected the respondent's argument that the economic aspect was relevant to the requirements relating to priority and that the two wholly owned subsidiaries of the same parent company were not independent of each other in view of their association through the parent. Legal acts were in principle attributable to the (legal) person who had performed them. Exceptions to this needed a legal basis, which did not exist in the law relating to priority.

In **T 788/05** the proprietor had been co-applicant in a previous European application D1 with an earlier priority date than that of the patent in suit. The appellant (opponent) argued that since the proprietor was also designated as applicant in D1, it had to be regarded as the "person" referred to in Art. 87(1) EPC 1973 regardless of the designation in D1 of a second applicant. Since, moreover, the invention was the same in both documents, D1 had to be considered as the first application. Therefore the priority claimed for the application in issue was not valid and D1 was prior art under Art. 54(2) EPC 1973.

The board held that the term "a person" in Art. 87(1) EPC 1973 (or "an applicant" in Art. 88(1) EPC 1973) implied that the applicant was the same for "the first application" (or "previous application" in Art. 88(1) EPC 1973) and for the later application for which a priority right was claimed. In the case of D1, the priority right belonged to the two applicants simultaneously, unless one decided to transfer his right to the other, who then became his successor in title and this before the filing of the later application. No evidence of such a transfer had been submitted. Since the application in issue was only filed by one applicant, D1 could not represent the "first application" within the meaning of Art. 87(1) EPC 1973. The priority date was valid and D1 represented state of the art under Art. 54(3) EPC 1973. The disclaimer introduced during the examination

proceedings to restore the novelty of claim 1 vis-à-vis D1 was also accepted by the board.

In **T 1933/12** the application underlying the patent was filed by the patent proprietors A1 and A2 and claimed the priority of D0, also filed by A1 and A2. Prior to D0, however, A2 had filed application D1, whose priority was not claimed but which undisputedly disclosed a gearbox drive in accordance with claim 1 in issue. The patent proprietors argued that D1 could not be considered the first application within the meaning of Art. 87 EPC. Since A2 was the sole applicant for D1 there was no identity of applicant with the patent in suit.

The board disagreed. **T 788/05**, cited by the proprietors, concerned the opposite case, namely multiple applicants for the priority document but only one for the later European filing. For succession in title – as for first filings by multiple applicants but subsequent applications by only one or some of those applicants – it had to be shown that the priority right held jointly by the multiple earlier applicants had been transferred to the sole applicant or the group of applicants (**T 382/07**). Art. 87(1) EPC did not exclude the (sole) applicant for the first filing sharing his priority right with a third party by filing a subsequent application jointly with the latter, but it did require that the applicant for the first filing, or his successor in title, be among the applicants for the subsequent, priority-claiming filing. In such a case, if there was only one additional applicant for the subsequent filing, there was no need to provide proof of the transfer of the priority right to him. In the case at issue, sole applicant A2 for D1 was also one of the applicants for the application leading to the patent, so D1 was the first application (Art. 87(1) EPC). The fact that D0 and D1 designated different inventors made no difference. Some of D0's inventors were also designated as inventors in D1, so it could not be assumed that the two applications derived from two different inventive acts. Most importantly, identity of inventor was not relevant for Art. 87 EPC, which, for the purpose of claiming a right of priority, referred to the applicant (**T 5/05**).

## 5. Partial and multiple priorities

In cases where partial or multiple priorities can be validly claimed the subject-matters of the subsequent application have two or more operative priority dates. In the case of a **partial priority** that part of the subsequent application's subject-matters disclosed in the previous application has the priority date of the previous application; for the remaining part the date of filing of the subsequent application applies. With multiple priorities, the priority of two or more previous applications is claimed. In this case, claims in the subsequent application have the priority date of the previous application in which the subject-matter subsequently claimed was disclosed. **Multiple priorities** may be claimed for any one claim (Art. 88(2), second sentence, EPC 1973), as long as several subject-matters are included (see also in this chapter II.D.5.3).

In such situations, when the content of an application forming the basis of a priority claim is published during the priority interval, the question arises whether such content belongs to the state of the art which can be cited against the partial subject-matters of the subsequent application which have a priority date after the date of publication.

## 5.1. Publications during the priority interval

In **G 3/93** (OJ 1995, 18), the Enlarged Board decided that a document published during the priority interval, the technical contents of which corresponded to that of the priority document, constituted prior art citable under Art. 54(2) EPC 1973 against a European patent application claiming that priority, if such priority was not validly claimed. This also applied if a claim to priority was invalid due to the fact that the priority document and the subsequent European application did not concern the same invention because the European application claimed subject-matter not disclosed in the priority document.

The Enlarged Board emphasised that the existence of a right of priority depended, *inter alia*, on the fulfilment of the requirement of identity of invention, that is, whether the previous application disclosed the same invention as that claimed in the subsequent European application. Where priority was claimed but could not be allowed because the inventions were not the same, there was no right to priority. Consequently, any publication of the contents of a priority document during the priority interval constituted prior art citable against elements of the European application which were not entitled to priority (see **T 441/91**, **T 594/90**, **T 961/90** and **T 643/96**; for another view see **T 301/87**, OJ 1990, 335). **T 131/99** stresses that to that extent there is no difference between dependent and independent claims.

## 5.2. Different priorities for different parts of a European patent application

In **T 828/93** the board stated that it followed from Art. 88(3) EPC 1973 that different priorities (including no priority, i.e. only the date of the European application) could be conferred on different parts of a European application. All that had to be checked was whether the subject-matter to be compared with the prior art, i.e. the **subject-matter of the independent patent claims**, corresponded to the disclosure of the documents of the priority application as a whole (see Art. 88(4) EPC 1973). Only one (or, as the case may be, no) priority could be conferred on each claimed **subject-matter as a whole**, in so far as the subject-matter was defined by the given elements as a whole. This subject-matter as a whole represented the invention, which either corresponded to the disclosure of a priority application or not.

**T 132/90** concerned a case in which claim 1 of the contested patent contained a feature B not disclosed in the Swiss priority document. The board held that a priority right therefore subsisted only with regard to part of the subject-matter of the claim, i.e. claim 1 without feature B, but not with regard to the subject-matter of that claim as a whole. The part of the subject-matter entitled to priority did not involve an inventive step. The subject-matter as a whole of claim 1 of the European application, which only had the priority status of the filing with the EPO, was no longer new because the patent proprietors had published all its features after filing the Swiss application.

In **T 127/92** a European patent application claimed the priority of two German utility models, which had been published during the priority interval (documents D1 and D2). The board of appeal took the view that priority had been validly claimed from D1 for claim 1 and several dependent claims. It was necessary to establish whether those **sub-**



**claims** that also contained **elements not disclosed in D1** were entitled to claim partial priority from D1 for the subject-matter of claim 1 contained within them. On the basis of the principles developed in **G 3/93** (OJ 1995, 18), the board concluded 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.

### 5.3. Multiple priorities for one claim

Art. 88(2), second sentence, EPC provides that, where appropriate, multiple priorities may be claimed for any one claim.

In **T 828/93** (see in this chapter II.D.5.2) the board confirmed that, because of the legal situation explained above, the possibility mentioned in Art. 88(2) EPC 1973 of multiple priorities for any one patent claim related only to instances where, unlike in the case at issue, the claim contained **alternatives** and could therefore be split into **several subject-matters**. See also **G 2/98** below.

In **T 620/94** it became apparent that the granted claim 1 covered two alternatives A and B of the invention. Only alternative B was disclosed in the priority document; alternative A was contained only in the subsequent European application. Prior art published during the priority interval rendered obvious alternative A. The patent could thus only be maintained in amended form, i.e. limited to alternative B.

In **T 441/93** the European patent related to a process for preparing a strain of the yeast *Kluyveromyces*, which comprised transforming *Kluyveromyces* yeast cells with a vector comprising, inter alia, a DNA sequence encoding a polypeptide. The invention disclosed in the priority document was a process for the preparation of new strains of the yeast *Kluyveromyces*, characterised in that **protoplasts** of such yeast were mixed with and transformed by vector molecules. The board concluded on the evidence that the references to protoplasts in the priority document were of crucial importance and that no mention had been made in it of the possibility of **transforming whole cells**. It was decisive what process had been disclosed in the previous application since claim 1 of the subsequent application was directed to a process. In so far as claim 1 covered whole cell transformation, it could only be entitled to the filing date of the European application. The board's conclusion was that the claims could be divided into two groups: Group A, enjoying priority rights from the previous application and comprising claim 1 in so far as directed to a process for the transformation of *Kluyveromyces* protoplasts, and the related further claims; and Group B, only enjoying the priority of the subsequent European application, and comprising claim 1 in so far as not directed to a process for the transformation of protoplasts, and the related further claims.

In **G 2/98** (OJ 2001, 413) the Enlarged Board of Appeal analysed the legislative intention behind Art. 88(2), second sentence, EPC 1973 and concluded that a distinction has to be drawn between the two following cases. The legislator did not want several priorities to be claimable for the **"AND" claim** (e.g. a claim to features A and B, with the first priority document disclosing claim feature A alone and only the second priority document

disclosing claim feature B). With regard to the **"OR" claim** the Enlarged Board drew the following conclusion from the historical documentation relating to the EPC 1973: where a first priority document disclosed a feature A, and a second priority document disclosed a feature B for use as an alternative to feature A, then a claim to A or B could enjoy the first priority for part A of the claim and the second priority for part B of the claim. It was further suggested that these two priorities might also be claimed for a claim directed to C, if the **feature C**, either in the form of a generic term or formula, or otherwise, **encompassed feature A as well as feature B**. The use of a generic term or formula in a claim for which multiple priorities were claimed in accordance with Art. 88(2), second sentence, EPC 1973 was perfectly acceptable under Art. 87(1) and 88(3) EPC 1973, provided that it gave rise to the claiming of a **limited number of clearly defined alternative subject-matters**.

In **T 665/00**, the appellant (opponent) had raised an allegation of public prior use within the priority interval and had challenged the validity of the priority claim. According to the board, the subject matter of the alleged prior use was both described in the priority document and fell within the scope of the claims of the disputed patent, but the priority document did not necessarily describe all the subject-matters claimed. The board observed that, under Art. 88(3) EPC 1973, the right of priority covered only those elements of the patent application included in the application from which priority was claimed. Different elements of a patent application could have different priority dates. According to **G 2/98** (OJ 2001, 413), the approach of recognising different priority dates also applied to a claim using a generic term or formula, provided that the use of such a term or formula gave rise to the claiming of a limited number of clearly defined alternative subject-matters. For the case in hand, the board concluded that, of the different alternatives contained in claim 10 of the disputed patent (relating to a powder containing hollow microspheres the specific mass of which was described by the generic term "less than 0.1 g/cm<sup>3</sup>"), the non-compacted powders containing "Expancel DE" microspheres were covered by the claimed date of priority. The claimed prior use, which involved a product containing the same "Expancel DE" microspheres, could therefore not be novelty-destroying. See also **T 135/01**.

On the other hand, in **T 1443/05** (also referred to in this chapter II.D.3.1.7), the board concluded that the generic wording of claim 1 did not reveal any clearly defined alternative subject-matters which could have justified the priority right.

In **T 1877/08** the patentee had argued that at least for the overlapping portion of the ranges disclosed respectively in claim 1 of the patent in suit and in the priority document, the subject-matter of claim 1 was entitled to the first priority date. Referring to **G 2/98** (OJ 2001, 413), the board held that the claimed amounts represented a continuum of a numerical range of values not corresponding to distinctive alternative embodiments. Consequently, no separable alternative embodiments, i.e. elements in the sense of Art. 88(3) EPC, could be identified within that continuum. Hence, the subject-matter of claim 1 as a whole was not entitled to the claimed priority date.

The board in case **T 476/09** confirmed this decision, while it distinguished **T 441/93** and **T 665/00** on the facts.

However, in **T 1222/11** the board remarked obiter, in relation to the "OR"-claim situation, that the condition "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" (see **G 2/98** above) should be given a different meaning from that attributed to it in **T 1877/08**, **T 476/09**, **T 1443/05** and **T 1127/00**. This condition could not be meant to set out the manner in which the subject-matter of the "OR"-claim must be defined. This would, at least in relation to generic terms, be at variance with the disclosure test based on the principle of an unambiguous and direct disclosure (cf **G 3/89**, OJ 1993, 117). For the purpose of the assessment required by Art. 88(3) EPC, the board considered that the wording of the above condition referred to the ability to conceptually identify, by comparison of the claimed subject-matter of the "OR"-claim with the disclosure of the multiple priority documents, a limited number of clearly defined alternative subject-matters to which the multiple rights of priority claimed could be attributed or not (cf. examples in the Memorandum drawn up by FICPI (M/48/I, Section C) for the Munich Diplomatic Conference in 1973, as cited in **G 2/98**).

**T 571/10** applied the approach of **T 1222/11**. The application in suit, which concerned a pharmaceutical composition, and European application D9 shared the same filing date and claimed priority from the same earlier national application. By comparing the generic subject-matter of claim 1 in issue with the priority document, the board identified two clearly defined alternative subject-matters (a) and (b). Only alternative (a) was fully disclosed in the priority document and therefore enjoyed the claimed priority. D9 could belong to the state of the art under Art. 54(3) EPC only in so far as the priority of the application in suit was not validly claimed while the priority of D9 was. For alternative (a) of claim 1, this was not the case, since D9 had no valid earlier effective date. For alternative (b) of claim 1, D9 was state of the art under Art. 54(3) EPC only for the subject-matter for which the priority claimed for D9 was valid, which was that of alternative (a). This subject-matter was not novelty-destroying for the subject-matter of alternative (b) of claim 1, as it had no overlap with the latter.

The decision headnote states: "In a case in which a single priority is claimed for a given application and a number of features of a claim of said application are generalisations of specific features disclosed in the priority document, a partial priority is to be acknowledged, as long as it is possible to conceptually identify, by a comparison of the claimed subject-matter with the disclosure of the priority document, a limited number of clearly defined alternative subject-matters, including among the alternatives the specific embodiments which are directly and unambiguously derivable from the priority document. In order for this condition to be met, it is not necessary that the clearly defined alternative subject-matters are spelt out as such in the application, nor that the word "or" actually occurs. This condition extends to the case of multiple priorities. In that case, a comparison with the disclosure of each of the priority documents is necessary and for each of the clearly defined alternative subject-matters the earliest priority from which the alternative subject-matter is directly and unambiguously derivable is acknowledged."

The patent in suit in **T 2406/10** concerned a pharmaceutical modified release tablet. The application underlying the patent was filed a few days after the filing of Euro-PCT application D15, and both claimed priority from national application D10. The proprietor argued that examples 1 to 4 of the patent enjoyed the priority claimed to the extent that

they were disclosed in D10. The board therefore examined whether the claims enjoyed partial priority from D10 with respect to examples 1 to 4 within the terms of Art. 88(2) EPC and **G 2/98** (OJ 2001, 427). Claim 1 defined a dissolution range of "not more than 60 % ... at 2 hours" for each of three media. According to the board, a product of a working example within the scope of claim 1 would however exhibit a dissolution profile corresponding to one distinct value in each of the three media. This combination of three values was just one of an **unlimited** number of combinations within the dissolution ranges for the three media defining the dissolution profile in the claim. Therefore, the product of such a working example could not be considered as attributable to a **limited** number of clearly defined alternative subject-matters. Accordingly, partial priority with respect to the examples disclosed in D10 was denied and the whole content of D15, including the working examples, was novelty-destroying prior art under Art. 54(3) EPC.

The patent in suit in **T 557/13** was granted on a divisional application. Claim 1 was to the use of a cold flow improver to enhance the lubricity of a fuel oil composition. The opposition division concluded that an intermediate generalisation in granted claim 1 with respect to the disclosure of priority document D16 did not give rise to the claiming of a limited number of clearly defined alternative subject-matters (cf. **G 2/98**, OJ 2001, 427). Hence, although the patent met the requirements of Art. 76(1) EPC, the subject-matter of claim 1 did not enjoy the priority date of parent application D1. D1 was thus state of the art under Art. 54(3) EPC, and claim 1 lacked novelty in view of the use of the product of example 1 disclosed identically in D16 and D1. In so deciding, the opposition division relied inter alia on **T 1496/11** (see Chapter I.C.2.4.2).

The board therefore had to consider issues of partial priority and, if partial priority was to be denied, also whether the parent application D1 could be relevant prior art under Art. 54(3) EPC. The board set out the legal framework and reviewed the jurisprudence concerning partial priority in respect of a generic "OR" claim, which it defined as a claim directed to subject-matter defined by one or more generic expressions, such as a chemical formula, a continuous range of numerical values or a functional definition, or otherwise. Such a generic "OR"-claim encompassed, without spelling them out, alternative subject-matters having all the features of the claim. The concrete question to be resolved was whether claim 1 enjoyed partial priority to the extent that the use of the product of example 1 as disclosed in D16 was encompassed by the more generic definition of claim 1, rather than being spelt out in it.

In the light of the differing approaches adopted in the various decisions both before and after **G 2/98**, the board decided to refer the following questions to the Enlarged Board:

1. Where a claim of a European patent application or patent encompasses alternative subject-matters by virtue of one or more generic expressions or otherwise (generic "OR"-claim), may entitlement to partial priority be refused under the EPC for that claim in respect of alternative subject-matter disclosed (in an enabling manner) for the first time, directly, or at least implicitly, and unambiguously, in the priority document?

2. If the answer is yes, subject to certain conditions, is the proviso "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" in point 6.7 of **G 2/98** to be taken as the legal test for assessing entitlement to partial priority for a generic "OR"-claim?

3. If the answer to question 2 is yes, how are the criteria "limited number" and "clearly defined alternative subject-matters" to be interpreted and applied?

4. If the answer to question 2 is no, how is entitlement to partial priority to be assessed for a generic "OR"-claim?

Concerning the further issue of whether parent application D1 could be opposed as state of the art under Art. 54(3) EPC to claim 1, the board referred the following question to the Enlarged Board:

5. If an affirmative answer is given to question 1, may subject-matter disclosed in a parent or divisional application of a European patent application be cited as state of the art under Article 54(3) EPC against subject-matter disclosed in the priority document and encompassed as an alternative in a generic "OR"-claim of the said European patent application or of the patent granted thereon?

This referral is now pending as **G 1/15**.

**E. Amendments**

1.	Article 123(2) EPC – added subject-matter	401
1.1.	Content of the application as filed	402
1.1.1	Description, claims and drawings	402
1.1.2	Abstracts, priority documents, parallel applications	402
1.1.3	Reflection and imagination of skilled person	402
1.1.4	Interpretation of the content of the application as filed	402
1.1.5	Language issues	404
1.1.6	Cross-references to other documents	404
1.1.7	Different sets of claims for different contracting states	405
1.2.	Standard for assessing compliance with Article 123(2) EPC	405
1.2.1	Gold standard: directly and unambiguously derivable	405
1.2.2	Implicit disclosure	405
1.2.3	Criteria not relevant for assessing compliance with Article 123(2) EPC	407
	a) Obviousness	407
	b) Consistency with original disclosure	407
	c) Relevance of technical information	408
	d) Plausibility	408
	e) Mere comparison of amended and unamended subject-matter – mere semantic analysis	409
	f) Enabled to achieve result without undue difficulty	409
1.2.4	The essentiality and the three-point test	409
1.2.5	The "novelty test"	412
1.2.6	Non-technical subject-matter	414
1.3.	Ranges of parameters – setting upper and lower limits	414
1.3.1	Forming a range by combination of end-points of disclosed ranges	414
1.3.2	Forming a range with isolated value taken from example	416
1.3.3	Setting new end-point with not expressly disclosed value	419
1.4.	Lists and singling out combination of features	419
1.4.1	Combination of features pertaining to separate embodiments; application as filed is not a "reservoir"	419
1.4.2	Selection from two lists and deletion of elements from two lists	420
1.5.	Disclaimers	425
1.5.1	Notion of disclaimer	425
1.5.2	Applicable law	426
	a) Decisions of the Enlarged Board of Appeal on disclaimers in G 1/03, G 2/03 and G 2/10	426
	b) Applying G 2/10 to undisclosed disclaimers	428
	c) G 1/03, G 2/03 not applicable to disclosed disclaimers	429
	d) Applicability of G 1/03, G 2/03 to pending cases	429
1.5.3	Decisions applying the criteria established by the Enlarged Board	429
	a) Accidental anticipation	429
	b) Drafting of disclaimers - disclaimer shall not remove more than is necessary	431
	c) Drafting of disclaimers - restoration of novelty	433
	d) Drafting of disclaimers - clarity	433

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e)	No relevance for inventive step and insufficiency of disclosure	436
f)	Availability of remaining subject matter at filing or priority date	436
1.6.	Generalisations	437
1.6.1	Replacing specific feature with more general term - no inclusion of undisclosed equivalents	437
1.6.2	Generalisation and claim category	438
1.6.3	No generalisation of an effect obtained for particular embodiments	439
1.6.4	Amendments to preamble of claim by substituting general term for specific term	439
1.7.	Intermediate generalisation - undisclosed combination of selected features	439
1.8.	Specific derived from generic	444
1.8.1	Specific term derived from generic term	444
1.8.2	Component of entity derived from entity	445
1.8.3	Restricting a generic definition of a substituent to a specific (individual) one	445
1.8.4	Isolation of one species	445
1.9.	Additions	445
1.9.1	Addition to the claim of a feature taken from drawings	445
1.9.2	Addition to the claim of an isolated feature taken from description	446
1.9.3	Addition to the claim of features originally presented as prior art	446
1.9.4	Addition of advantages and effects	446
1.9.5	Addition of new claim category	446
1.9.6	Adding prior art citations to the description	446
1.9.7	Insertion of an ambiguous feature in the claim	447
1.9.8	Characteristic described for intermediate product added to the claimed end product	448
1.10.	Deletions and replacement	448
1.10.1	Replacement or removal of features from claim	448
1.10.2	Broadening of claim by deleting a feature	449
1.10.3	Deletion of feature, broadening the protection conferred by the claim, without providing a technical contribution	450
1.10.4	Elimination of contradictions and inconsistencies	450
1.11.	Errors in the disclosure	452
1.11.1	Calculation errors	452
1.11.2	Incorrect structural formula	452
1.11.3	Amendment based on erroneous figure in the disclosure	452
1.11.4	Incorrect information in earlier application as filed but correct information directly and unambiguously derivable	453
1.12.	Description and drawings	453
1.12.1	Disclosure in drawings	453
1.12.2	Shift in the interpretation of claim by amending description	456
1.12.3	Shift in the information provided by the examples after amendment of claims	457
1.12.4	Replacement of complete description and drawings	457
1.13.	"Comprise", "consist (essentially) of", "contain"	457
1.14.	Reformulating the technical problem	458
2.	Article 123(3) EPC – extension of the protection conferred	459

2.1.	Purpose of Article 123(3) EPC	459
2.2.	Totality of claims	459
2.3.	Extent of protection	460
2.3.1	Article 123(3) EPC and Article 69 EPC	460
2.3.2	Cut-off point	462
2.3.3	General claim interpretation	464
2.4.	Deletions and replacements	464
2.4.1	Deletion of a feature in a claim	464
2.4.2	Deletion of important feature from description where claim remains unchanged	465
2.4.3	Deletion of examples for a general feature	465
2.4.4	Deletion of disclaimer referring to trade names	466
2.4.5	Deletion of a drawing	466
2.4.6	Deletion of feature in a claim mentioned "in particular"	466
2.4.7	Reducing scope of claim by adding embodiments to a negative feature	467
2.4.8	Replacement of a restrictive term by a less restrictive term	467
2.4.9	Replacement of "cell of a plant" by "plant"	467
2.4.10	Replacement of drawings	468
2.4.11	Replacement of substance by device containing substance	468
2.4.12	Replacement by aliud	468
2.4.13	Narrowing down a generic class or list of chemical compounds; open claims ("comprising"); sequential drafting ("cascade")	469
2.5.	Transposition of features within claims	470
2.6.	Change of claim category	470
2.6.1	From product claim to a claim directed to the use of the product	470
2.6.2	From product claim to a claim directed to using that product for producing another product	472
2.6.3	From product or product-by-process claim to a claim directed to a process for manufacturing/preparing the product, and vice versa	472
2.6.4	From method claim for treating the human body by therapy to product claim	473
2.6.5	From use claim to process claim, and vice versa	474
2.6.6	From use claim to Swiss-type claim	475
2.6.7	From Swiss-type claim to purpose related product claim under Article 54(5) EPC	475
3.	Relationship between Article 123(2) and Article 123(3) EPC	475
3.1.	Inescapable trap	475
3.2.	Attempts to resolve the conflict	476
3.3.	Addition to the claim of an undisclosed feature limiting protection conferred, without providing a technical contribution	478
4.	Correction of errors in the description, claims and drawings – Rule 139 EPC	481
4.1.	Relationship of Rule 139 EPC with Article 123(2) and (3) EPC	482
4.2.	Obviousness of the error and the correction	483
4.2.1	Documents to be taken into account for the assessment of obvious error and correction	483



4.2.2	Obvious error – incorrect information objectively recognisable	484
4.2.3	Immediately evident that nothing else would have been intended than what is offered as the correction	485
4.3.	Correction of errors in the description, claims and drawings after grant, and in opposition proceedings	488
5.	Evidence and standard of proof for allowing amendments and corrections	489

This chapter concerns the allowability of amendments under Art. 123(2) and (3) EPC, as well as corrections of errors in the parts of a patent application or of a patent relating to the disclosure (the description, claims and drawings) under R. 139 EPC. Other aspects related to amendments are dealt with elsewhere; see for example Chapters II.F. "Divisional applications"; II.D.3.1.2 "Priority"; IV.B.1.1, 2.5, 3.3, 3.4, 3.6, 3.7, 5 for the admissibility of amendments during the "Examination procedure"; IV.D.4 "Opposition procedure"; IV.E.4 "Appeal procedure"; III.I. "Main and auxiliary requests". Part H of the Guidelines for Examination in the European Patent Office gives an overall picture of the various principles applicable to amendments (formal admissibility and substantive allowability).

### 1. Article 123(2) EPC – added subject-matter

According to Art. 123(2) EPC the European patent application or the European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. The revision of the EPC has introduced a purely editorial change to the wording of Art. 123(2) EPC to bring it into line with Art. 123(1) EPC.

The underlying idea of Art. 123(2) EPC is that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (see **G 1/93**, OJ 1994, 541).

The "**gold standard**" (**G 2/10**, OJ 2012, 376) for assessing compliance with Art. 123(2) EPC is the following; any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Art. 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (**G 3/89**, OJ 1993,117; **G 11/91**, OJ 1993, 125). See also in this chapter II.E.1.2. "Standard for assessing compliance with Article 123(2) EPC" further below.

The Enlarged Board has stressed the importance of applying a **uniform concept of disclosure** (with reference to Art. 54, 87 and 123 EPC; see **G 2/10**, point 4.6 of the Reasons, citing **G 1/03**, OJ 2012, 436, point 2.2.2 of the Reasons).

In the case of divisional applications, the same principles are to be applied for determining whether subject-matter extends beyond the content of the earlier application as filed (**G 1/05**, OJ 2008, 271, point 5.1 of the Reasons). The decisions dealing with such cases are also reported in this chapter.

### 1.1. Content of the application as filed

#### 1.1.1 Description, claims and drawings

Regarding the concept of the content of the application, **G 3/89** (OJ 1993, 117) and **G 11/91** (OJ 1993, 125) laid down that it related to the parts of the European patent application which determined the disclosure of the invention, namely the description, the claims and the drawings.

Amendments can only be made within the limits of what a skilled person would derive from the **whole** of these documents as filed (**G 2/10**, OJ 2012, 376).

#### 1.1.2 Abstracts, priority documents, parallel applications

In **T 246/86** (OJ 1989, 199) the board decided that as the abstract was intended solely for documentation purposes and did not form part of the disclosure of the invention, it could not be used to interpret the content of the application for the purposes of Art. 123(2) EPC 1973 (confirmed in **T 606/06**).

For the purpose of Art. 123(2) EPC 1973, "the content of the application as filed" also does not include any priority documents, even if they are filed on the same day as the European patent application (see **T 260/85**, OJ 1989, 105); the same is true for the abstract (see **G 3/89**, OJ 1993, 117; **G 11/91**, OJ 1993, 125) and for parallel applications (see **J 16/13**).

#### 1.1.3 Reflection and imagination of skilled person

The board in **T 89/00**, citing **T 260/85** (OJ 1989, 105), **T 64/96** and **T 415/91**, held that, according to the case law of the boards of appeal, a distinction must be made between what the original documents of a patent directly and unambiguously disclosed to a skilled person and what said skilled person on the basis of this disclosure may do upon reflection and using his imagination. His thinking is **not part** of the content of the original documents of the patent.

#### 1.1.4 Interpretation of the content of the application as filed

The board in **T 1018/02** stated that although a claim was not to be interpreted in a way which was illogical or did not make sense, the description could not be used to give a

different meaning to a claim feature which in itself imparted a clear, credible technical teaching to the skilled reader. That also applied if the feature had not initially been disclosed in the form appearing in the claim (see also - all citing this decision - **T 396/01**; **T 1195/01**; **T 1172/06**; **T 1202/07**; **T 369/10**).

In **T 54/82** (OJ 1983, 446) the board held that an objection under Art. 123(2) EPC 1973 did not necessarily arise when an amendment was proposed which involved combining separate features of the original subject-matter of an application. When considering whether different parts of the description in an application could properly be read together, the state of the art might also be taken into account .

In **T 676/90** the board considered that the content of an application was defined not only by features mentioned or shown therein but also by their relationship to each other.

The board in **T 2619/11** took the view that the focus of the first-instance decision was disproportionately directed to the **structure of the claims** as filed to the detriment of what was really disclosed to the skilled person by the documents as filed. The application was directed to a technical audience rather than to a philologist or logician, for which audience an attempt to derive information from the structure of dependent claims would lead to an artificial result. **T 1363/12** considered that **T 2619/11** did not lay down a new test (namely, of what was "really disclosed" to the skilled person) different from the "gold standard" (see in this chapter II.E.1.2.1 below) (see also **T 938/11**).

In **T 23/02** the board said that although the claims as originally filed contained no reference to a **method of measurement** for the average particle diameter, that did not mean that any method could be used to determine that parameter. If anything, the claims raised doubts as to how the average particle diameter had to be determined, in particular because the skilled person would be aware of the fact that the method of measurement was of a decisive nature in particle size analysis. Therefore the skilled person would use the description and drawings when deciding how the average particle diameter was to be measured, and would come to the conclusion that when properly interpreted in the light of the original description, the claims as originally filed already contained restrictions as to the method of measurement for the average particle diameter of the various particles. Furthermore, the method of measurement for the average particle diameter did provide a technical contribution because it affected the actual value of that parameter. (For the case law on the necessity to include the measuring method of a parameter in the claim, see Chapter II.C.5.6.8 "Measuring methods".)

In **T 241/13** the board held that the description did not give a precise definition of the meaning of the expression "minimum intensity level"; the patentee's interpretation of this expression was not clearly excluded. However, that such an **ambiguous expression** as filed might be interpreted in a particular way was not sufficient to ensure the compliance of an amendment, based on that interpretation, with Article 100(c) EPC which required a direct and unambiguous disclosure in the application as filed. In the present case, no direct and unambiguous disclosure could be found for the patentee's interpretation.

### 1.1.5 Language issues

In **T 382/94** (OJ 1998, 24) a European patent application was filed with a description and claims in German, accompanied by 25 drawings. Three of the drawings contained so-called flow sheets with text matter in English. The application was published in this form. The amendment of the application, based on the English-language text matter in the drawings as filed, did not represent an infringement of Art. 123(2) EPC 1973 (see Chapter III.F. "Language regime").

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" 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 (decision cited in e.g. **T 1402/09**).

In **T 287/98** the original application in Dutch contained the word "schroot", which means scrap metal, as substantiated by the copies of various dictionaries provided by the appellant. According to the board, this word was not correctly translated into English by the word "scrap" and nothing other than "scrap metal" was meant in the application as originally filed. The board further decided that the replacement of the word "scrap" by "scrap metal" was allowable under Art. 123(2) EPC 1973 since Art. 70(2) EPC 1973 provided that in a case referred to in Art. 14(2) EPC 1973, i.e. in which the European patent application was filed in a language of a contracting state other than English, French or German, the original text had to be taken into account in proceedings before the European Patent Office, in order to determine whether the subject-matter of the application extended beyond the content of the application as filed. For a further case under Art. 14(2) EPC and Art. 123(2) and (3) EPC, see **T 516/12**.

### 1.1.6 Cross-references to other documents

In **T 6/84** (OJ 1985, 238) the board took the view that structural features of a means for performing a chemical process (here the catalyst "offretite"), which were not mentioned in the application documents themselves but in a document (here a Canadian patent specification) to which they referred, could be incorporated into a patent claim if they unequivocally formed part of the invention for which protection was sought (see **T 590/94**). However, it was not permissible to single out a particular one of their number (here a silica/alumina ratio) in the absence of evidence that this feature alone was a sufficient characterisation. It was instead necessary to recite fully the other essential components of the structure and the diffraction pattern figures which belonged together, as originally disclosed and defined in that document.

In **T 689/90** (OJ 1993, 616) the board decided that features disclosed only in a cross-referenced document which was identified in the description as filed were prima facie not within "the content of the application as filed". Only under particular conditions would adding them to a claim not be an infringement of Art. 123(2) EPC 1973, namely if the description of the invention as filed left the skilled reader in no doubt that protection was

sought for those features; that they helped achieve the invention's technical aim and thus formed part of the solution to the technical problem underlying the invention claimed; that they implicitly clearly belonged to the description of the invention contained in the application as filed and thus to the content of the application as filed; and that they were precisely defined and identifiable within the total technical information contained in the reference document. In the case at issue these requirements were not fulfilled. See also **T 196/92**, **T 558/03**, **T 1497/06**, **T 1415/07**, **T 1378/08**, **T 664/11**; see also **T 474/05** in which the reference in the application to a document was within a specific context, and the amendment went beyond this context and was thus not allowable; see also **T 2477/12**, applying **T 689/90** in the context of Art. 76(1) EPC where the priority application, containing sequence listings, had been "incorporated by reference" in the parent application.

#### 1.1.7 Different sets of claims for different contracting states

In **T 658/03** the board stated that any change of attribution of claimed subject-matter in an application or patent having different (sets of) claims for different contracting states, to a contracting state under which that subject-matter was not previously included, amounted to an amendment within the meaning of Art. 123 EPC 1973. Such an amendment was subject, in principle, to full examination as to its conformity with the requirements of the Convention.

### 1.2. Standard for assessing compliance with Article 123(2) EPC

#### 1.2.1 Gold standard: directly and unambiguously derivable

Any amendment to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) is subject to the mandatory prohibition on extension laid down in Art. 123(2) EPC and can therefore, irrespective of the context of the amendment made, only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (**G 3/89**, OJ 1993,117; **G 11/91**, OJ 1993, 125; **G 2/10**, OJ 2012, 376, "gold standard").

The subject-matter must be at least implicitly disclosed (**T 860/00**; see also **G 2/10**), see in this chapter II.E.1.2.2 "Implicit disclosure" below.

After the amendment the skilled person may not be presented with new technical information (**G 2/10**).

#### 1.2.2 Implicit disclosure

Subject-matter which is implicitly disclosed in the application as filed is part of its content (see **G 2/10**, OJ 2012, 376). As pointed out in **T 860/00**, the disclosure **implicit** in the patent application - i.e. what any person skilled in the art would consider was **necessarily** implied by the patent application as a whole (e.g. in view of basic scientific

laws) - is relevant for the requirements of Art. 123(2) EPC 1973 (see also **T 947/05**, **T 1772/06**, **T 1041/07**, **T 1125/07**).

It is essential to identify the actual teaching conveyed by the original disclosure. This approach might lead to the identification of subject-matter which has not been explicitly revealed as such in the application as filed, but nevertheless derives directly and unambiguously from its content. Literal support is not required by Art. 123(2) EPC (**T 667/08**, **T 801/13**).

In **T 823/96** the board observed that the term "implicit disclosure" should not be construed to mean matter that does not belong to the content of the technical information provided by a document but may be rendered obvious on the basis of that content. The term "implicit disclosure" relates solely to matter which is not explicitly mentioned, but is a **clear and unambiguous consequence of what is explicitly mentioned** (see also **T 1125/07**, **T 583/09**).

In **T 1107/06**, quoting **T 860/00**, the board took the view that when there is a generic disclosure of the invention together with a specific disclosure of an illustrative or preferred embodiment falling under the generic disclosure, it would normally be implicit for the skilled person that all the other embodiments comprised in the generic disclosure without being mentioned specifically also form part of the invention. The non-exemplified or **non-preferred embodiments** are thus implicitly disclosed as the logical complement of the exemplified or preferred embodiments.

In **T 917/94** the board decided that the omission of a feature of a claim did not contravene Art. 123(2) EPC 1973, if this feature was implicitly defined by two other features and, being therefore redundant, its omission created no subject-matter extending beyond that of the application as filed.

In **T 1171/08** the respondent (patent proprietor) submitted that there had been no inadmissible extension, if only because all the conditions needed to achieve selective COS removal were implicitly included in the claim by virtue of the **indication of purpose**. The board found that indicating the purpose as a functional feature in a use claim limited the claim to those embodiments whereby the purpose could be achieved. Only to that extent could the indication of purpose implicitly comprise features essential to achieving the desired selectivity. By no means, however, could the indication substitute the essential features specifically disclosed in that connection in an application. In the end, the board held that the skilled person could not derive the new combination of features directly and unambiguously from the application as filed.

In **T 494/09** the board observed that since the same subject-matter could be described using different terms, the fact that there were two differently worded definitions did not necessarily mean that the subject-matters defined were different.

In **T 598/12** the board held that the assessment of what information was implicitly disclosed in an application could not go beyond the limits of what the skilled person would objectively understand to be a direct and unambiguous consequence of the

explicit disclosure in the particular case. Going beyond that would allow the introduction of added matter, after the date of filing of the (parent) application, for which there was no unambiguous disclosure in the (parent) application as filed, contrary to the provisions of Art. 123(2) and 76(1) EPC. Moreover, when performing this assessment, the common general knowledge could not serve to enlarge or replace, in a subjective or artificial manner, the actual content of the specification.

### 1.2.3 Criteria not relevant for assessing compliance with Article 123(2) EPC

#### a) Obviousness

In **T 598/12** the board considered that the investigation of the actual disclosure in a patent application as filed could not turn into an investigation of obviousness or a search for obvious alternatives of the actual disclosure in the light of general prior-art documents. Such an investigation would be part of the assessment of inventive step under Art. 56 EPC, if the skilled person was looking to solve a certain technical problem without making use of his inventive skills, but it could not be taken as a valid approach for the investigation of implicit disclosure directly and unambiguously derivable from an application as filed within the meaning of Art. 123(2) and 76(1) EPC.

In **T 823/96** the board observed that, whilst common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document, the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implied by the disclosure of that document. On the contrary, these two questions must be strictly separated.

In **T 329/99** the board stated that a clear distinction had to be made between the questions whether a particular embodiment was disclosed by an application, be it explicitly or implicitly, or/and whether that embodiment was merely rendered obvious by the application's disclosure (referring to **T 823/96**; see also **T 1171/08**). A particular technical embodiment might be rendered obvious on the basis of the content of an application as filed without, however, belonging to its explicit or implicit disclosure and therefore without serving as a valid basis for amendments complying with the requirements of Art. 123(2) EPC 1973.

In **T 118/88** the board held that the obviousness of a feature was no replacement for the original disclosure.

#### b) Consistency with original disclosure

In **T 495/06** the appellant's argument that the amendments were "not inconsistent" with the original disclosure failed to persuade the board, since the applicant thereby invoked a less stringent criterion for compliance with Art. 123(2) EPC than that developed in the jurisprudence of the boards of appeal, namely the question whether the amendment was "directly and unambiguously derivable" from the application documents as originally filed.

In other words, the fact that an amendment was "not inconsistent" with the description was not a sufficient requirement for complying with Art. 123(2) EPC.

In **T 962/98** the appellant argued that the claimed subject-matter derived from Example 1D and the content of the application as originally filed. In particular, tests carried out on the composition of Example 1D showed that the "four surfactants" could be applied in a more general context, present claim 1 being, furthermore, consistent with the description. Contrary to the appellant's submissions, in order to assess whether an amendment complied with the requirements of Art. 123(2) EPC 1973, the question was neither whether or not a skilled person could design other compositions in the light of the directions given by the tests nor whether or not the amended subject-matter was consistent with the description.

In earlier decisions, such as in **T 514/88** (OJ 1992, 570) the boards observed that the relevant question was whether or not the amendment was "consistent with the original disclosure"; the boards clarified, however, that this meant direct and unambiguous derivability from and no contradiction of the totality of the original disclosure (see also **T 527/88** and **T 685/90**).

c) Relevance of technical information

In **T 1906/11** the board had considered that the only relevant question would be whether a skilled person faced with the amended version of the application or patent, as compared to a skilled person having seen only the version originally disclosed, would derive from that amended version any additional technically relevant information. Only if such additional information was derivable can there be an infringement of Art. 123(2) EPC. In **T 248/12** the board stated that in respect of the "technical relevance" of the added information, case **T 1906/11** could not be understood to define a new standard for judging amendments with respect to Art. 123(2) EPC since this would be at odds with the "gold standard" in **G 2/10**, OJ 2012, 376 (see also **T 1791/12** where the board considered that no divergent interpretations of the principles contained in **G 2/10** for judging amendments were apparent in **T 1906/11**). The board in **T 248/12** emphasised that "relevance", as such, of the technical information was not of importance for deciding upon the issue of Art. 123(2) EPC, rather simply whether this technical information received by the skilled person is new having regard to the content of the originally filed application.

d) Plausibility

In **T 824/06** the board stated that for an amendment to be allowable under Art. 123(2) EPC its direct and unambiguous disclosure was required; reasonable plausibility was insufficient.



- e) Mere comparison of amended and unamended subject-matter – mere semantic analysis

In **T 288/92** the appellant (applicant) contended that the amendment resulted in a limitation of the original claim. The board rejected this argument on the grounds that the expression "subject-matter which extends beyond the content of the application as filed" in Art. 123(2) EPC 1973 prohibited the introduction of any technical information which a skilled person would not have objectively derived from the application as filed, so that the examination of the allowability of an amendment according to Art. 123(2) EPC 1973 was directed to the process of "derivation" (see also **T 383/88**), as distinct from a simple comparison of the scopes of amended and unamended subject-matters.

The board in **T 1269/06** held that, for the assessment of whether, contrary to Art. 100(c) EPC 1973, the subject-matter of the patent extends beyond the content of the application as filed, the key question is whether the amendments made in the description, or - as in the case at issue - the claims, did indeed provide the skilled person with additional, technically relevant information which was not contained in the original application documents. This cannot be inferred from the fact alone that terms not present in the application documents were subsequently introduced, or from a purely semantic analysis of the contested passages. Instead, the party or department raising the objection must be able to identify clearly the technical teaching as such which has supposedly been added.

- f) Enabled to achieve result without undue difficulty

In **T 1724/08** the board held that the criterion of "direct and unambiguous disclosure" was quite different from the criterion submitted by the appellant, namely whether a person skilled in the art in view of the disclosure was enabled to achieve the envisaged result, i.e. the claimed functionality, without undue difficulty. This latter criterion would allow many different new definitions of subject-matter, none of which would need to be derivable "directly" and "unambiguously" from the earlier application as filed.

#### 1.2.4 The essentiality and the three-point test

For cases in which the amendment consists of the **replacement or removal of a feature** from an independent claim, the boards occasionally apply the essentially or the three-point test. This test is also set out in the Guidelines H-V, 3.1 - 2015 edition. In case **T 2311/10**, however, which concerned an intermediate generalisation, the board expressed the view that the three-point or essentiality test was unhelpful or even misleading (see also **T 1118/10**; compare also Guidelines H-V, 3.2.1 - June 2012 edition, which referred to the essentiality test in the context of an intermediate generalisation, and later versions, which no longer do). The board in **T 755/12** pointed out that, although some tests such as the essentiality test have been used as an aid in assessing the allowability of amendments, they could not replace the need to answer the question of what a skilled person would objectively have derived from the description, claims and drawings of a European patent application on the date of filing (**G 3/89**, OJ 1993, 117,

see in this chapter II.E.1.2.1 "Gold standard: directly and unambiguously derivable" above).

In **T 331/87** (OJ 1991, 22) the board held that the replacement or removal of a feature from a claim might not be in breach of Art. 123(2) EPC 1973 if the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the replacement or removal required no real modification of other features to compensate for the change. The board also observed that the feature in question might be inessential even if it was incidentally but consistently presented in combination with other features of the invention (frequently cited, see for example, **T 708/07**, **T 775/07**, **T 747/10**; but see also **T 910/03** where the board criticised, in the light of **G 2/98** (OJ 2001, 413), the distinction made between essential and non-essential features).

In **T 260/85** (OJ 1989, 105) it was stated that it was not permissible to delete from an **independent claim** a feature which the application as originally filed **consistently presented as being an essential feature** of the invention, since this would constitute a breach of Art. 123(2) EPC 1973. See also **T 496/90**, **T 415/91**, **T 628/91**, **T 189/94** and **T 728/98** (OJ 2001, 319; concerning the deletion of the feature "substantially pure"). See also **T 2202/08**, in which the board referred to the test in **T 260/85** and observed that it might not always be necessary or expedient to apply the test employing the three criteria of **T 331/87** in a case as simple as the one at issue.

The board in **T 648/10** confirmed that, where the replacement or removal of a feature from a claim is concerned, a feature consistently presented as an essential feature of the invention could not be deleted from an independent claim, since this would add subject-matter. However, it observed that **the EPC does not require the use of any particular tests** when assessing whether subject-matter has been added. Instead, such tests are **tools** which may be helpful, in certain situations, in the assessment of whether subject-matter has been added.

In **T 404/03** the board considered that the decisions of the boards of appeal describing and using the current palette of "tests" in connection with various types of amendments might lead to some confusion. As far as the disclosure of a group of features was concerned, as distinguished from their scope, the generalisation of a feature in a claim and the isolation of features from embodiments in the description essentially both involved a deletion of a feature, namely the specific feature and the remaining features of the embodiment respectively. The board therefore considered that these cases could be subject to the same criteria as a pure deletion, and hence, in principle, the three point test. Rather than requiring a specific statement or suggestion in the original disclosure, the three point test was more generous to the applicant because it essentially allowed the deletion of a feature if the skilled person realised from the common general knowledge in that field that the feature had nothing to do with the invention. Moreover, in the board's view, the cases of deletion of features and addition of features had to be distinguished with respect to the allowability of amendments under Art. 123(2) EPC 1973, since the former only removed elements that were originally

disclosed and hence might be judged by a skilled person to be inessential to the invention, whereas the latter added new elements lacking any basis whatsoever in the original disclosure (see also **T 2359/09**, which applied the three-point essentiality test, having regard to **T 404/03** and **T 331/87**, OJ 1991, 22).

**T 133/85** (OJ 1988, 441) concerned a case where a feature was described as an essential feature of the invention but was not contained in the claim. The claim was therefore not supported by the description (Art. 84 EPC 1973). An **amendment to the description** to provide support for the claim was, however, not allowable under Art. 123(2) EPC 1973, because the amended description would contain subject-matter which extended beyond the content of the application as filed - namely information that such feature was not an essential feature of the invention.

In **T 628/91** 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 236/95** the board held that if the problem could not be solved without the features concerned, they could not be considered unimportant.

In **T 396/95** the board considered that whereas it was not expressly mentioned that the deleted feature ("carbonation") was essential for the invention this followed implicitly from the whole presentation of the invention. This feature was seen by the board to be **indispensable** for the function of the invention in the light of the technical problem it served to solve.

In **T 374/93** the opponent argued before the board that the amount of polymer to be added to the suspension as defined in claim 1 of the original application was an essential feature, and that the deletion of this feature was not allowable under Art. 123(2) EPC 1973. The board did not agree. In the case at issue, the deleted feature of the originally filed claim 1 appeared to be inconsistent with the teaching of the original application. In any case, in the board's view, the skilled reader would not immediately and unambiguously recognise from the passage containing several relative terms and expressions such as "in some instances", "e.g.", "normally" and "usually", that the feature as deleted from the original claim 1 was a mandatory feature.

In **T 784/97** the patent proprietor alleged that a prior art document would have made the skilled person aware that the disputed feature was not essential. The board held that whether or not a feature of an independent claim had to be seen as "essential" could **not be a question of the prior art disclosure**. Rather, what had to be decided was what a skilled person was taught by the originally filed documents. In the present case, a skilled person having considered the originally filed documents was aware that the particle size was part of the alleged invention, so that this feature could not be omitted from an independent claim at a later stage without contravening the requirements of Art. 123(2) and Art. 100(c) EPC 1973.

In **T 583/93** (OJ 1996, 496) the board held that any attempt to interpret Art. 123(2) EPC 1973 such that the introduction into a claim of features previously described as non-essential would not be permissible, had to fail. The Convention contained no requirement that forbade the redefinition of an invention provided that Art. 123(2) and (3) EPC 1973 were complied with. Such a redefinition was often necessary in order to take into account prior art not known to the applicant at the priority date. It was therefore possible that features described as optional at the priority date later became essential in the sense that they were necessary to delimit the invention from the prior art. The introduction of such features was permissible provided that, first, the application as originally filed contained an adequate basis for such limitations and, second, the resulting combination of features was still in line with the teaching of the application as originally filed.

In **T 211/95** the examining division had refused a divisional application on the grounds that a set of features from the original claim of the parent application was entirely missing from the claim of the divisional application. The board was unable to accept this. It held that the requirements under Art. 76(1) EPC 1973 would be met if it was obvious for the skilled person that there were **two technically unconnected teachings** which could be claimed separately, and if the skilled person clearly saw that the set of features according to the subject-matter claimed in the parent application was **not essential** to the subject-matter claimed in the divisional application. In the case at hand, the subject-matter of the divisional application was directly and unambiguously disclosed in the parent application. On the issue of two technically unconnected teachings, see also **T 341/06**.

In **T 2300/12** the board held that the purpose of the essentiality test was to ascertain whether the replacement or removal of a feature in an originally filed independent claim resulted in an extension beyond the content of the application as originally filed. In the case at issue, however, the granted claim was for a process, whereas there had been no such process claim in the set of claims originally filed. For that reason alone, the essentiality test could not be directly applied to establish whether there had been such an inadmissible extension.

#### 1.2.5 The "novelty test"

In **T 201/83** (OJ 1984, 481) it was stated that the test for compliance with Art. 123(2) EPC 1973 was basically a novelty test, i.e. no new subject-matter may be generated by the amendment (see also **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. In **G 2/10** the Enlarged Board held that after the amendment the skilled person "may not be presented with new technical information".

The boards have seldom expressly applied the novelty test in their recent case law, but it was referred to in e.g. **T 60/03**, **T 1374/07**, **T 2202/08**, **T 2270/09**; according to **T 2537/10**, the novelty test is no longer relevant for the assessment under

Art. 123(2) EPC. However, reference is still made to this test in the 2015 version of the Guidelines (H-IV, 2.2), at least where the amendment is by way of **addition**.

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. The patentee had taken the view that the amendment was admissible because the original application could properly be cited against the novelty of a more generic claim to cellulose fibres. The board took the view that this approach was based on a misapplication of the novelty test. The test for additional subject-matter corresponded to the test for novelty only in so far as both required assessment of whether or not information was directly and unambiguously derivable from that previously presented in the originally filed application or in a prior document respectively. An amendment was not allowable if the resulting change in content of the application, in other words the subject-matter generated by the amendment, was novel when compared with the content of the original application or, looked at another way, if the said change in content would be novelty-destroying for a hypothetical future claim when the original content would not be. It was important that it was the change in content which was tested, i.e. the amended content minus the original content, so that the test was applicable to amendment by generalisation or omission of a feature.

**T 133/85** (OJ 1988, 441) pointed out that care was necessary when applying the law relating to novelty to questions which arose in relation to Art. 123(2) EPC 1973. In **T 177/86** the novelty test was described as "not very useful" for examining the admissibility of **broadening a claim** (see also **T 150/07** for a case where the preferred embodiments of an invention were combined with the more general teaching thereof).

**T 118/89** took a reserved attitude to the novelty test and observed 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.

In **T 187/91** (OJ 1994, 572) the board conceded that there was clearly a close conceptual correlation between the assessment of novelty and the assessment of what was an allowable amendment under Art. 123(2) EPC 1973. It further explained, however, that two considerations which underlay Art. 123(2) EPC 1973 were different from those that underlay Art. 54 EPC 1973: firstly, a reader of an application published pursuant to Art. 93(1) EPC 1973 after 18 months would be informed of the maximum extent of its subject-matter and therefore its maximum content some time before the text of the application including the claims was finalised, having regard to the drawing up of the European search report and the subsequent examination of the application. Secondly, the relationship between the claims and content of the European patent application was determined by the idea that, after appropriate amendment if necessary, the granted claims should give a fair protection for the inventive subject-matter contained in the application as filed.

In **T 288/92** the board considered that the examination of the allowability of an amendment according to Art. 123(2) EPC 1973 was directed to the process of "derivation" (see also **T 383/88**), as distinct from a simple comparison of the scopes of amended and unamended subject-matters. In the view of the board this provided a definitive method for deciding the allowability of an amendment. Any other "test", such as the "novelty test", necessarily posed hypothetical questions.

However, in **T 873/94** (OJ 1997, 456) the board pointed out that where a proposal for amending an application involved the **addition of a limiting feature** to a claim, applying a "novelty test" was not appropriate for determining whether or not the amendment complied with Art. 123(2) EPC 1973. Following **G 1/93** (OJ 1994, 541), the board pointed out that the underlying idea of Art. 123(2) EPC 1973 was clearly that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. In the light of these considerations the addition to a claim before grant of an undisclosed limiting feature might or might not violate Art. 123(2) EPC 1973, depending on the circumstances.

#### 1.2.6 Non-technical subject-matter

In case **T 619/05** the amendment concerned a feature not contributing to the solution of any technical problem by providing a technical effect. It was thus non-technical subject-matter. The term "subject-matter" in Art. 123(2) EPC, without a qualifier, seemed to indicate that this article applied to non-technical as well as technical subject-matter. Thus, any amendments concerning non-technical subject-matter should also be derivable from the patent application as filed. A difficulty in this connection was that a technically skilled person might not have the knowledge necessary in order to determine whether non-technical subject-matter had been added or not. Skills in a non-technical field might be required for deciding this issue. Since the members of a board of appeal were only required to be technically (or legally) qualified under Art. 21 EPC 1973, it would be up to the applicant (or patent proprietor) in such circumstances to provide evidence permitting a board to determine to its satisfaction how a person skilled in the relevant non-technical field would interpret the original patent application and the application (or patent) after amendment.

### 1.3. Ranges of parameters – setting upper and lower limits

#### 1.3.1 Forming a range by combination of end-points of disclosed ranges

The board in **T 925/98** noted that, according to the respondent, the range 30% to 50% given in claim 1 infringed Art. 123(2) EPC 1973, since such a range was not disclosed in the originally filed documents of the patent in suit, which only disclosed a general range of 30% to 60% and a preferred range of 35% to 50%. The board held, however, that, according to the established case law, in the case of such a **disclosure of both a general and a preferred range**, a combination of the preferred disclosed narrower range and one of the part-ranges lying within the disclosed overall range on either side of

the narrower range was unequivocally derivable from the original disclosure of the patent in suit and thus supported by it (see **T 2/81**, OJ 1982, 394; **T 201/83**, OJ 1984, 481; and **T 53/82**, **T 571/89**, **T 656/92**, **T 522/96** and **T 947/96** all referring to **T 2/81**). Thus claiming a range from 30-50% did not contravene Art. 123(2) EPC 1973. In the case in point, moreover, graphs indicated that the claimed range was in fact the most efficient one. This frequently cited decision was recently referred to, for example, in **T 328/10**, **T 2001/10**; see also **T 1107/06**.

In **T 1170/02** the board held that the combination of the lower limit of the general range with the lower limit of the preferred range, thus excluding the preferred range, did not fall under the principles developed in decision **T 2/81** (OJ 1982, 394). In such a case, it might be useful to ask whether the skilled reader of the parent application would **seriously contemplate** working in the range referred in the divisional application or alternatively whether there was anything in the parent application as filed or his common general knowledge which would cause him to exclude the possibility of working in that range (with reference to **T 187/91**, OJ 1994, 572). To the board, the skilled person would, in view of the data in the parent application, seriously consider working beyond the lower limit of the preferred range as well. Under these circumstances, the range could be directly and unambiguously derived from, and is consistent with, the parent application as originally filed.

In **T 612/09** the decision under appeal had found that the dose range from "3 to 10 mg/kg of daptomycin" could not be derived directly and unambiguously from the application as filed. The claims had disclosed a range from "3 to 75 mg/kg" and "10 to 25 mg/kg". The board observed that **T 2/81** had established a two step approach. In the first step, it had considered that the two part-ranges of the general range lying outside the preferred range would be unequivocally and immediately apparent to the person skilled in the art. It had then considered that no new matter was introduced by combining the preferred range with the upper part-range. The board in **T 612/09** considered that only the first step of the analysis carried out in decision **T 2/81** was necessary to arrive directly and unambiguously at the claimed range. Indeed, the board held that the two part-ranges lying within the overall range on either side of the narrower range (a dose of 3 to 10 mg/kg and a dose of 25 to 75 mg/kg) were directly and unambiguously disclosed to the person skilled in the art.

In **T 1919/11** the subject-matter of claim 1 of the main request related to silver at a concentration of at least 1 $\mu$ M to less than 200 $\mu$ M. In the description, it was stated in two separate consecutive sentences that "When silver is incorporated in the medium, it will be added at a concentration of less than 900  $\mu$ M, preferably less than 500  $\mu$ M, and more preferably less than 200  $\mu$ M" and "When silver is incorporated in the medium, it will be added at a concentration of at least 10 nM, preferably 100 nM, more preferably 1  $\mu$ M, and typically at 10  $\mu$ M". The board observed that the situation in the case at issue was not comparable with that in **T 1107/06** and dealt with in the settled jurisprudence of the boards of appeal. A general range, which means a lower limit which is unequivocally combined with an upper limit, and a preferred disclosed narrower range – equally consisting of a lower limit which is unequivocally combined with an upper limit – were simply missing. Even a kind of parallel structure in indicating the upper and lower limits

(less/at least, preferred or more preferred) implied no unequivocal correlation between a particular upper limit and a particular lower limit because there was no teaching that such an arrangement was intended. Therefore, one of the upper limits mentioned in the first sentence in the description of the parent application as originally filed (as cited above) and one of the lower limits mentioned in the second sentence were arbitrarily combined, which did not represent a direct and unambiguous disclosure.

### 1.3.2 Forming a range with isolated value taken from example

In **T 201/83** (OJ 1984, 481), the board came to the conclusion that the amendment of the concentration range for a claimed mixture, such as an alloy, was admissible on the basis of a value described in a specific example, provided that 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 as a whole in a unique manner and to a significant degree. In the case at issue, the new limit could be deduced from the original documents.

The board in **T 876/06** applied the principle established in **T 201/83** and came to the conclusion that the skilled person could have recognised in the application as originally filed that the weight ratio of liquid rubber to solid rubber was not so closely associated with the other features of the examples as to determine the effect of the invention as a whole in a unique manner and to a significant degree. Thus, it was permissible to use the particular value used in several examples to limit the range of the weight ratio of liquid rubber to solid rubber. The limitation of the claim represented merely a quantitative reduction of a range to a value already envisaged within the document and not an arbitrary restriction providing a technical contribution to the subject-matter of the claimed invention in accordance with point 10 of the Reasons in **T 201/83**. The board also found incorrect the argument of the respondent (opponent) that the amendment in **T 201/83** was only considered allowable because it represented the lowest value disclosed with regard to the then claimed invention. In the board's view this fact played no role at all. Nor did the board agree with the argument that decision **T 201/83** had been overruled by later decisions of the Enlarged Board of Appeal. The requirements of Art. 123(2) EPC 1973 were fulfilled.

In **T 612/09** the board considered that in the case underlying decision **T 201/83** the fact that the value was disclosed in an example was insofar of relevance as the board had first to establish that the value disclosed in the context of an example could be considered separately from the other features disclosed in the example. However, the board in **T 612/09** could not derive from decision **T 201/83** the requirement that the value on which a sub-range was to be based had necessarily to be disclosed in an example. Rather it appeared that what was required was that for the skilled person the value had to be recognisable as a singularity, as in decision **T 201/83**, within or at the end of a range of possibilities which may mark an end-point for a particular sub-range.

In **T 517/07** a newly introduced upper limit had been disclosed in the original application documents only as an isolated value in example 1. The board decided that singling out an individual value from a specific embodiment and applying it as a new upper limit in



claim 1 created a new – now capped – value range that was not disclosed in the original documents.

In **T 1188/10** the broadest general range relating to the concentration of LAE in food products, disclosed in the application as filed, was from 0,0001% to 1%. The new range of 0,006% to 0,015% was formed by taking, as end points, single values from examples 2 and 4 relating to the use of LAE as preservative in two different specific food products at different growth temperatures. In order to assess whether this new range complied with Art. 123(2) EPC it had to be considered whether a skilled person, in analogy to **T 201/83**, would generalise these values in the sense that he would recognise them as not only associated with the specific food products and temperatures used in the examples. In the case at issue, this was the case so that the range claimed complied with Art. 123(2) EPC.

The board decided in case **T 184/05** that an impurity concentration value of a product obtained under specific process conditions could not be taken in strict isolation from the examples unless it had been demonstrated that this value was not so closely associated via the applied process with specific (undisclosed) maximum values of all other impurities comprised in the product.

In **T 570/05** the proposed amendment was that the coating layer had a "thickness of from 220 to 500 nm", for which the only literal basis in the application as originally filed for the lower value of 220 nm of the claimed range was to be found in three examples. Thus, the formal disclosure of the value 220 existed. The issue to be decided was whether or not new subject-matter was added by forming a new range in a claim using said figure of 220 nm, it being evident that nowhere in the documents as filed did this value form the lower (or indeed any) endpoint of a range of thicknesses. Recalling the relevant case law namely, **T 201/83**, **T 1067/97** and **T 714/00** (see also in this chapter II.E.1.7. "Intermediate Generalisations – undisclosed combination of selected features"), dealing with extracting an isolated feature, the board examined whether or not there existed a functional or structural relationship between the coating layer thickness, in particular its lower limit, and the remaining features of the claim. The board concluded that the condition of absence of any clearly recognisable functional or structural relationship was not satisfied in the present case and that the amendment could thus not be allowed.

The board in **T 931/00** stated that although figures in examples might, under specific conditions, be used to limit a range which was already present in the original application, they could not be used to define an entirely new relationship between parameters which had never been linked before. Such arbitrary new links between existing parameters introduced new matter, contrary to the requirements of Art. 123(2) and Art. 100(c) EPC 1973.

The board in **T 1146/01** had to answer the question of whether one measurement of a selected characteristic or property of a sample disclosed only in an individual example could be relevant to the generality of the claimed subject-matter, separately from and irrespectively of the other parameters inherent to the same sample. The situation in this case was different from the case in **T 201/83**. In **T 201/83** an amendment was allowed on

the basis of a particular value described in a specific example, provided the skilled person could readily have recognised that value as not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention as a whole in a unique manner and to a significant degree. In **T 1146/01**, however, the board stated that formulating a new range on the basis of **individual values taken from selected examples**, which were not at all directly related to each other, meant that the reader was confronted with new information not directly derivable from the text of the application as originally filed.

In **T 1004/01** the question that arose before the board of appeal was whether or not there was a basis in the application as originally filed for a peel strength "of at least 24 grams" to define the claimed laminate. According to the application as filed, the peel strength of the laminate was defined by an open-ended range as an essential feature of the invention. In the general description and the claims there was no further mention of any preferred peel strength range. According to the board, the exemplified laminates and the peel strength thereof were disclosed only in a concrete technical context, without providing any preference for a peel strength of at least 24 grams. Nor was any such preference given in the description, which could justify the lower limit. Since, however, a peel strength of 24 grams was disclosed, the question arose as to the conditions under which such an exemplified feature could form the basis for a new range as claimed. The peel strength of 24 grams could not be detached from the exemplified laminates to form a basis for a generalised lower limit of the claimed peel strength range without taking into consideration the other particulars closely associated therewith. It followed that the claimed subject-matter in all requests could not be directly and unambiguously derived from the application as filed.

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. TBN values had not been originally disclosed as a (broad) range but only as single, punctate values; thus a new range was defined which had not been disclosed originally. Furthermore, the generic part of the original specification did not contain any information indicating that TBN played any role in the framework of the application in suit. This meant that there was also no information whatsoever concerning a TBN range, whether open-ended or not. Nor was there any information at all in the description regarding the contribution of a TBN to the solution of a technical problem. Moreover, it could not be concluded that the individual TBN values disclosed in the examples were representative of a TBN range starting at 235 and without any upper limit. The board held that if values of a parameter are only given in the examples, without the significance of this parameter becoming evident from the original specification, no range must be arbitrarily formed, which is open ended at one side and has one limit selected from the examples. This decision was approved and cited by **T 931/00** - also referring to **T 201/83** (OJ 1984, 481) - which concerned the creation of a new parameter range by defining its upper limit by selecting a single value from an example.

In **T 343/90** the additional feature of "a viscosity of 430 to 1300 dPa.s at 165°C" was added to the claim. The board observed that the specific viscosity range could not be found *expressis verbis* either in the specification as filed or in the disputed patent as granted. However, the lower and the upper limit of the viscosity range were specifically mentioned in the examples of the application as filed. The viscosity values taken from the examples as the end-points of the viscosity range could not be seen only in the context of all the other parameters given there. Therefore, the amendment complied with Art. 123(2) EPC.

### 1.3.3 Setting new end-point with not expressly disclosed value

**T 985/06** concerned amending the upper limit of a range, supported in the description as filed, to a new (lower) value not thus supported, by changing it from 1.05:1 to 1.4:1 to 1.05:1 to less than 1.4:1. The board acknowledged that "1.05:1 to 1.4:1" included all values within the stated range. However, the application as filed disclosed only the range in general; it did not specifically, and thus directly and unambiguously, disclose all values within it. The amendment therefore contravened Art. 123(2) EPC.

In **T 83/13** claim 1 as granted included the feature "an amount of less than 15% by weight", whereas the claim as filed and the original description had mentioned amounts of between 5% and 20% and between 8 and 15%. Claim 1 as granted therefore included an additional exclusion, namely that of the specific value of "15%". In the board's view, the wording "an amount of less than 15% by weight" included concentration values differing by one or more decimal places from which, depending on the precision of the measurement method or simply by applying rounding rules, the whole value of "15% by weight" could be arrived at. Replacing the concentration value of "15.0% by weight" with "an amount of less than 15% by weight" did not change the technical teaching or constitute a new technical function in relation to the claimed concentration range; from a technical perspective, the scope of protection remained the same even after the amendment (see **T 112/10**). The board added that its decision was consistent with the boards' case law on novelty and rounding values (see **T 234/09** or **T 1186/05**).

## 1.4. Lists and singling out combination of features

1.4.1 Combination of features pertaining to separate embodiments; application as filed is not a "reservoir"

The content of an application must not be considered to be a reservoir from which features pertaining to separate embodiments of the application could be combined in order to **artificially create a particular embodiment** (**T 296/96**; **T 686/99**; **T 1206/01**; **T 3/06**, and more recently see e.g. **T 1206/07**, **T 1239/08**, **T 1648/11**, **T 1799/12**, **T 1853/13**). In the absence of any pointer to that particular combination, this combined selection of features does not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed (**T 686/99**, **T 1853/13**). The fact that features in question have been mentioned in the description as "preferred" may act as a pointer (**T 68/99**, **T 1799/12**).

The same applies in the case of divisional applications in respect of the earlier application as filed, see **T 2118/08**, **T 961/09**.

In **T 1206/07** the board considered that, **in the absence of the least indication** concerning this particular combination, the selection of the two characteristics was not clearly and unambiguously evident from the application as filed. For a further case concerning an unallowable combination of features see **T 2044/07**.

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.

In **T 296/96** the board stated that, when assessing whether a feature had been disclosed in a document, the relevant question was whether a skilled person would seriously contemplate combining the different features cited in that document. That was not the case in the application as filed.

According to **T 1120/05**, the original drawings cannot be considered as a reservoir of features on which the applicant or a patent proprietor can draw when amending the claims.

In **T 2363/10** the board held that the selection of features disclosed in six out of one hundred and forty three bullet points represented a particular selection which was not disclosed as such. The skilled person had no hint or incentive to choose exactly such a combination of features. The general statement "any such apparatus, means or method has or may have any of the following features" did not change this conclusion, since for a combination of selected elements to form a disclosure, additional information was required which directed the skilled person to this combination.

#### 1.4.2 Selection from two lists and deletion of elements from two lists

In **T 727/00** the board held that the combination - unsupported in the application as filed - of one item from each of **two lists** of features meant that although the application might conceptually comprise the claimed subject-matter, it did not disclose it in that particular individual form. For that reason alone, claim 1 of the main request was not supported by the description and contravened Art. 123(2) EPC.

The board in **T 1511/07** held that although the selection of explicitly disclosed borderline values defining several (sub)ranges, in order to form a new (narrower) sub range, was not contestable under Art. 123(2) EPC when the ranges belong to the same list, the combination of an individual range from this list with another individual range emerging from a second list of ranges and relating to a different feature was not considered to be disclosed in the application as filed, **unless there was a clear pointer to such a combination**.

The board in **T 1374/07**, referring to **T 811/96**, said that a selection of two components (here: fat and enzymes) from one list is in fact equivalent to a twofold selection from two identical lists (see also **T 2375/09** **T 1506/13**). Thus, applying the novelty test, the board

concluded that the addition of the feature "fat and enzymes" to claim 1 infringed Art. 123(2) EPC.

According to the boards' consistent case law, the guiding principle is that **deleting** meanings of residues in a generic chemical formula must not lead to the selection, in the respective lists, of a particular combination of single, specific but originally undisclosed meanings of residues (see **T 615/95** and **T 859/94**).

In **T 942/98** precisely this had occurred through the deletion of all other meanings, residues X1, X2 and R5 had been narrowed down to a single meaning, leading to a combination of specific meanings of residues not disclosed in the application as filed. Consequently, claim 1 as filed did not in itself provide adequate support for claim 1 as amended (cited by **T 2013/08** in connection with the established case law concerning "**singling out**").

In **T 615/95** there were three independent lists of sizeable length specifying distinct meanings for three residues in a generic chemical formula in a claim. One originally disclosed meaning was deleted from each of the three independent lists. The board stated that the present deletions did not result in singling out a particular combination of specific meanings, i.e. any hitherto not specifically mentioned individual compound or group of compounds, but maintained the remaining subject-matter as a generic group of compounds differing from the original group only by its smaller size. Such a **shrinking of the generic group** of chemical compounds was not objectionable under Art. 123(2) EPC 1973, since these deletions did not lead to a particular combination of specific meanings of the respective residues which was not disclosed originally or, in other words, did not generate another invention (see also **T 948/02**, which refers in detail to this case law and which did not allow the amendment of a generic chemical formula; see also **T 659/97**, **T 894/05**, **T 888/08**).

In **T 1506/13** the board, referring to **T 948/02**, summarised that a deletion of genes from a list of specific genes was allowable if it fulfils two conditions: First, the deletion must not result in singling out any hitherto not specifically mentioned individual compound or group of compounds, but maintains the remaining subject-matter as a generic group of compounds differing from the original group only by its smaller size. Second, the deletion does not lead to a particular combination of a specific meaning which was not disclosed originally, i.e. it does not generate another invention, or in other words it merely restricts the required protection but does not provide any technical contribution to the originally disclosed subject-matter.

In the board's view in **T 686/99** the application as filed disclosed in an undifferentiated way different categories of base oils without any pointer regarding the selection of one particular category thereof. Priority was not given to ester oils from the original host of equivalent base oils. Therefore the board came to the conclusion that combining in claim 1 a base oil mandatorily comprising ester oils with the hydrofluorocarbons listed in claim 1 resulted from a multiple selection within two lists of alternative features, namely of ester oils from the list of base oils and of hydrofluorocarbons from the list of refrigerants, thereby generating a fresh particular combination. **In the absence of any**

**pointer to that particular combination**, this combined selection of features did not, for the person skilled in the art, emerge clearly and unambiguously from the content of the application as filed. (See also **T 1206/01**; and **T 1041/07** on assessing whether a particular combination of features was disclosed in a document.)

In case **T 209/10** the appellant (patent proprietor) alleged that claim 1 did not concern an unallowable selection but merely the deletion of some option(s) from one list. The board considered that the application as originally filed disclosed the technical effect of prevention of bone loss, which was not identical to the prevention of post-menopausal osteoporosis in a post-menopausal woman as described in claim 1 as granted. Post-menopausal women were selected from a list of several possible options for the patients to be treated. A further selection also took place in claim 1, namely that concerning the form of the medicament as a tablet or capsule. The oral route did not equate with the selection of tablets and capsules since other forms such as solutions and suspensions might also be possible. Moreover, the patient was identified as an aging human and there was no preference for post-menopausal women to be linked to a particular dosage form. The board concluded that claim 1 included technical information which was not directly and unambiguously derivable from the application as originally filed and singled out subject-matter which was not disclosed in an individualised manner in the application as originally filed.

In **T 98/09**, which concerned the "singling out" of combinations of active ingredients not originally disclosed from lists, the board held that, contrary to the appellant's view, a deletion from a list could also constitute an inadmissible extension if the singling out of one individual ingredient led to a selection of combinations which, even if conceivably covered by the application as filed, had not been specifically disclosed. It was the boards' settled case law that such a selection is to be regarded as an inadmissible extension and so as an infringement of Art. 123(2) EPC (see e.g. **T 727/00** and **T 686/99**). The case at issue concerned two lists (six elements and 47 elements). The applicant sought to individualise one of the lists to one element. The board held that this selection was contrary to Art. 123(2) EPC. For a similar case, in which the board found that the deletion of elements of two lists led to an unallowable selection, see **T 1808/08**.

In **T 197/08** the board observed that the feature "FIE as the sole active ingredient" was not as such mentioned in the original application. The respondent (opponent) had argued that the introduction of "as the sole active ingredient" in combination with FIE, which was selected from a group of compounds in which it was not its most preferred active ingredient, constituted an unallowable selection from two lists. The board considered that FIE was selected from a list of six particularly preferred active ingredients and combined monotherapy (as the sole active ingredient), which constituted de facto the only administration form envisaged in the original application. Under these circumstances, the feature was not the result of two selections from different lists, as basically only one selection, i.e. the selection of FIE, had to be made in order to arrive at the feature. As a consequence, the requirements of Art. 123(2) EPC were met.

In **T 1241/03** the board came to the conclusion that claims to formulations comprising compounds in specific concentrations did not need to have a literal basis in a single

passage of the application as originally filed, as long as the exact concentrations and ranges claimed for the specific substances were disclosed as such in the original application. The claims did not refer to a "patchwork" of parameters disclosed in non-connected parts of the description, nor had specific values been isolated from examples in a non-allowable way. The reference in a claim to a combination of compounds in specific concentrations, explicitly disclosed in different passages of the application, was not considered by the board to be an amendment of the patent which extended beyond the content of the application as originally filed.

In **T 783/09** the opposition division stated that the subject-matter of the claim 1 at issue was a selection from two lists and therefore contravened Art. 123(2) EPC. The board considered that the skilled person would directly and unambiguously recognise forty-four individual combinations, among them the three "basic" combinations referred to in claim 1. The board referred to the statement in decision **T 12/81** (OJ 1982, 296) that if "two classes of starting substances are required to prepare end products and examples of individual entities in each class are given in two lists of some length, then a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded for patent purposes as a selection and hence as new". The board noted that many boards had denied a direct and unambiguous disclosure for individualised subject-matter that was only derivable from a document by combining elements from lists. The board stated however that, given the term "can" in the citation from decision **T 12/81**, the absence of a direct and unambiguous disclosure for individualised subject-matter is not a mandatory consequence of its presentation as elements of lists. Thus, the "disclosure status" of subject-matter individualised from lists has to be determined according to the circumstances of each specific case by ultimately answering the question whether or not the skilled person would clearly and unambiguously derive the subject-matter at issue from the document as a whole.

In **T 1710/09** the board insisted, however, that, in line with established jurisprudence, "can" within the meaning of **T 12/81** was to be taken as a "is to". In view of the implications of freely interpreting this word "can" as in **T 783/09**, there was deep concern that in this way the uniformity of the disclosure assessment process could not be warranted.

In **T 10/97** not all the compounds listed in the original claim were included in amended claim 1. However, since the claimed group of compounds was obtained not by restricting an originally disclosed generic definition of a substituent in a generic formula to a specific one selected from worked examples, but by **deleting some members from a list** of individualised equally useful compounds in order to improve the chances of patentability over the available prior art, the board found that such deletions must be considered admissible in accordance with the case law of the boards of appeal (see **T 393/91**). For the remaining compounds, no particular technical effect was either disclosed or alleged.

In **T 783/09** the board referred to **T 10/97**. All forty-four combinations resulting from the combination of the elements of the two lists (one list with two elements, the other list with 22 elements) were directly and unambiguously disclosed. However, a further issue was whether or not the claiming of only three of the forty-four combinations disclosed

extended the content of the application as filed in an unallowable way. The forty-four combinations were referred to as "very preferred embodiments"; by this statement the skilled person was taught that each of the forty-four combinations had the same quality, i.e. they were all very preferred combinations in the context of the invention. Nothing else was derivable from the remainder of the application, i.e. a particular quality, for example a particular technical effect, was attributed neither to the three combinations of claim 1 nor to the remaining forty-one. Hence, the group of combinations in claim 1 could not be considered as the result of a selection of three qualitatively equal elements from a list of forty-four qualitatively non-equal elements - for which selection there would be no hint in the application as filed and the claiming of which group therefore would have to be considered as adding matter. Rather the group of claim 1 was to be considered as the result of the **deletion of forty-one elements from a list of forty-four qualitatively equal elements** (see **T 10/97**). In summary, the subject-matter of claim 1 complied with the requirements of Art. 123(2) EPC.

In **T 2273/09** the appellants argued that the same reasoning and conclusion of **T 783/09** applied to the case at issue, which related to the deletion of ten of sixteen directly and unambiguously disclosed individual combinations, with six combinations then remaining. The board referred to **G 2/10** where it was held that whether the skilled person was presented with new information depended on how he or she would understand the amended claim. Applying the technical assessment of the case under consideration with regard to the remaining subject-matter claimed, the board held that the subject-matter of the main request under consideration did not meet the requirements of Art. 123(2) EPC.

In **T 236/08** the feature "suitable for administration by inhalation" in claim 1 was not present in the claims as originally filed. A basis for this feature could however be found as part of a list in the description, where it was one way among different possible ways of administration. A consequence was however that the combination of the subject-matter of claim 1 with the subject-matter of any dependent claim which also resulted from a selection among different possibilities would constitute an unallowable selection from multiple lists. For example, the subject-matter of dependent claim 10 related to a singling out from a list of possibilities concerning specifically the use of insulin. Therefore, its combination with the subject-matter of claim 1, which resulted similarly from a selection of possible ways of administration, constituted a selection from multiple lists and had no basis in the application as originally filed.

In **T 407/10** the board at first concurred with the appellant that, whereas the combination of e.g. two features only originally disclosed in lists of equivalent alternatives was normally found to violate Art. 123(2) EPC, there might be other combinations of features which although not explicitly disclosed in the application as filed were nevertheless derivable from the presence of an (explicit or implicit) pointer thereto. For instance, the fact that certain features were disclosed as preferred in the original application acted as a pointer for the skilled person, as the combination of preferred features was obviously the best way of achieving the technical effects that the invention aimed to provide (see e.g. **T 68/99**). However, this jurisprudence did not consider the combination of a feature not originally disclosed as preferred with a plurality of further restrictions based on preferred features as an amendment in accordance with Art. 123(2) EPC.



In **T 1799/12** the board considered that the jurisprudence and **T 407/10** correctly referred to further circumstances that need to be taken into account, such as pointers to that selection or combination in the description and in the examples, for instance the fact that the features in question have been mentioned in the description as "preferred". Further, the circumstance that the list consists of equivalent alternatives could also play a role (see in particular **T 686/99**). In the case at issue, no pointer was available towards the choice of a square or rectangular base wall shape, but there was a clear pointer in the opposite direction, namely towards base wall shapes without any corners ("generally circular" or "oval"). By the same token, the five possible shapes mentioned in the parent application were not equivalent alternatives. The possible conditions in favour of allowing the currently claimed selection were therefore not fulfilled.

In **T 2273/10** the appellant (patent proprietor) argued that claim 1 was a combination of the invention's most preferred features, and did not involve a selection from various lists. The board disagreed. The application as filed disclosed several possibilities for each of the three features. To arrive at the claimed wording, the skilled person had to make a selection from various lists. In addition these selections related to preferred and non-preferred features.

In **T 1032/12** the board rejected the appellant's argument that the claimed polypeptide was defined by two features selected from two independent lists. For the appellant (opponent) the term "preferred polypeptides" encompassed a list of possible polypeptides. The board considered that, in the case at issue, the protein of SEQ ID NO:2 was singled out as the particularly preferred polypeptide, and when reference to fragments as the preferred sequences was made, they were always labelled as "particularly preferred fragments". Therefore, the reference in the description to "the preferred polypeptide" was a reference to the polypeptide of SEQ ID NO:2. It was this specific mention of the full-length molecule as the particularly preferred molecule that distinguished the case at issue from the case underlying decision **T 583/09**, referred to by the appellant, where different molecules had been presented as equivalent alternatives. Art. 123(2) EPC was not infringed.

## 1.5. Disclaimers

### 1.5.1 Notion of disclaimer

The term "disclaimer" is used in the decisions **G 2/10** (OJ 2012, 376) and **G 1/03** (identical to **G 2/03**) (OJ 2004, 413, 448), as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas.

According to **T 1870/08**, a disclaimer is only a proper disclaimer if the remaining legal subject-matter is **less** than that of the unamended claim. If any subject-matter can be identified which falls within the scope of the claim after amendment by the proposed disclaimer, but which did not do so before the amendment, the disclaimer is improper. For example, a negative formulation removing a restricting feature may look like a disclaimer, but may in fact extend the legal scope of protection.

### 1.5.2 Applicable law

#### a) Decisions of the Enlarged Board of Appeal on disclaimers in G 1/03, G 2/03 and G 2/10

The Enlarged Board of Appeal held in **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) concerning **undisclosed** disclaimers that an amendment to a claim by the introduction of a disclaimer may not be refused under Art. 123(2) EPC 1973 for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed. It considered that the following criteria were to be applied for assessing the allowability of a disclaimer which was not disclosed in the application as filed:

A disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against state of the art under Art. 54(3) and (4) EPC 1973;
- restore novelty by delimiting a claim against an accidental anticipation under Art. 54(2) EPC 1973; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and
- disclaim subject-matter which, under Art. 52 to 57 EPC 1973, is excluded from patentability for non-technical reasons.

In addition, a disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. On the other hand, a disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Art. 123(2) EPC 1973. And a claim containing a disclaimer must meet the requirements of clarity and conciseness of Art. 84 EPC 1973.

The Enlarged Board in **G 2/10** found that, subsequent to decision **G 1/03** (and **G 2/03**), different opinions had been expressed in the jurisprudence of the boards of appeal on whether decision **G 1/03** related to the disclaiming of embodiments which were **disclosed** as part of the invention in the application as filed or whether in that situation the jurisprudence as previously established following decision **T 4/80** (OJ 1982, 149) continued to apply (see **G 1/07**, OJ 2011, 134, point 4.2.3 of the Reasons). In **G 2/10** the Enlarged Board reformulated the question referred to it, stating that the question was construed as intending to ask whether an amendment to a claim by the introduction of a disclaimer infringes Art. 123(2) EPC if the subject-matter of the disclaimer was disclosed as an embodiment of the invention in the application as filed.

The Enlarged Board in **G 2/10** stressed that decision **G 1/03** did not support the conclusion drawn by **T 1050/99** that **G 1/03** also related to disclaimers for disclosed subject-matter. Further, in **G 1/03** it was not decided that an undisclosed disclaimer

would be always allowable under Art. 123(2) EPC. The wording of its answer, reading "a disclaimer may be allowable", indicated that with the criteria established in this answer the Enlarged Board in **G 1/03** did indeed not intend to give a complete definition of when a disclaimer violates Art. 123(2) EPC.

The Enlarged Board stated that neither decision **G 1/93** nor decision **G 1/03** intended to modify the general definition of the requirements of Art. 123(2) EPC established in opinion **G 3/89** (OJ 1993, 117) and decision **G 11/91** (OJ 1993, 125), which definition has become the generally accepted or "gold standard" for assessing any amendment for its compliance with Art. 123(2) EPC. As to the criteria to be applied, the principle that any amendment to an application or a patent, and in particular to a claim, must fulfil the requirements of Art. 123(2) EPC also applies to an amendment limiting the claim by disclaiming disclosed subject-matter. Therefore, as is the case for any other amendment, the test for an amendment to a claim by disclaiming subject-matter disclosed as part of the invention in the application as filed must be that after the amendment the skilled person may not be presented with new technical information. Hence, disclaiming subject-matter disclosed in the application as filed can also infringe Art. 123(2) EPC if it results in **the skilled person being presented with technical information** which he would not derive directly and unambiguously, using common general knowledge, from the application as filed.

The point of reference for assessing an amended claim for its compatibility with Art. 123(2) EPC is the subject-matter which the claim contains after the amendment. In other words, it is the subject-matter remaining in the claim after the amendment. The test to be applied is whether the skilled person would, using common general knowledge, regard the **remaining claimed subject-matter as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed**. This test is the same as that applied when the allowability of a limitation of a claim by a positively defined feature is to be determined. The Enlarged Board found that no convincing reason had been advanced for not applying the principles developed in the context of Art. 123(2) EPC for the assessment of amendments to claims by the introduction of positive limiting features in the same manner to limitations of claims by disclaimers which disclaim subject-matter disclosed in the application as filed. The Enlarged Board stressed in its decision **the importance of applying a uniform concept of disclosure** (with reference to Art. 54, 87 and 123 EPC; see **G 2/10**, point 4.6 of the Reasons, citing **G 1/03**, OJ 2012, 436, point 2.2.2 of the Reasons).

The Enlarged Board in **G 2/10** (OJ 2012, 376) answered the two questions referred to it by interlocutory decision in **T 1068/07** (OJ 2011, 256) as follows:

(1) An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Art. 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

(2) Determining whether or not that is the case requires a technical assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment.

According to **T 1676/08**, the principles set out in decision **G 2/10** with regard to the requirements to be met in order for amendments by the introduction of disclaimers for disclosed subject-matter to be allowable under Art. 123(2) EPC also apply with regard to the requirements for divisional applications under Art. 76(1) EPC; they also apply to the examination under Art. 100(c) EPC.

In **G 1/03** (and **G 2/03**), and then **G 2/10**, the Enlarged Board, having regard to the law established by it in relation to disclaimers, expressly identified those board decisions which should no longer be applied. Thus, in **G 1/03** it stated that the isolated decisions **T 170/87** and **T 313/86** were not to be followed, whilst also criticising **T 323/97** in the light of the new law applicable. In **G 2/10** it criticised the approach taken in **T 1050/99** and **T 1102/00**. Decisions issued prior to these Enlarged Board decisions and reported in the 6th edition of this case law report have been deleted from this edition.

With regard to the admissibility of disclaimers, reference should also be made to Chapter II.D.3.1.2 "Priority - Amendments and disclaimers".

b) Applying G 2/10 to undisclosed disclaimers

The case **T 1870/08** related to an undisclosed disclaimer. Decision **G 2/10** was therefore, *prima facie*, not concerned with the same situation, so it was questioned by the board whether that decision was applicable at all to the present case. It concluded, after its detailed reasoning, that the test of **G 2/10** (see **G 2/10**, part 1a of the Order, points 4.5.1 and 4.5.2 of the Reasons) also applied to an amendment involving an undisclosed disclaimer by means of which a claim had been rendered new over a European patent application according to Art. 54(3) EPC. The examination of the admissibility of the amendment for compliance with Art. 123(2) EPC must be made separately for the disclaimer *per se* and for the subject-matter remaining in the claim.

In **T 2464/10** the board noted that in decision **G 2/10** the Enlarged Board of Appeal did not consider that decision **G 1/03** was exhaustive as to the conditions that needed to be fulfilled for an amendment consisting of the introduction of an undisclosed disclaimer to be regarded as allowable under Art. 123(2) EPC (see also **T 336/12**). The board interpreted these remarks as an instruction to apply the further test developed in this decision, in addition to those set out in **G 1/03**, in order to carry out a full assessment of whether an undisclosed disclaimer meets the requirements of Art. 123(2) EPC. The further test to be applied was whether the skilled person would, using common knowledge, regard the remaining claimed subject-matter as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed (see also **T 748/09**). The case at issue concerned the introduction of the disclaimer "non-human animal" in claim

1. This did not infringe Art. 123(2) EPC since the description as filed provided an explicit support for non-human animals, and no new technical teaching was introduced.

In **T 74/11** the board observed that the negative technical feature did not disclaim embodiments which were disclosed as being part of the invention in the application as filed; the board held that it was thus not **G 2/10** but **G 1/03** which was relevant for assessing the possible introduction of the disclaimer.

In **T 1441/13** the board considered that, according to decision **G 2/10**, the subject-matter remaining in the claim after the introduction of the disclaimer must be – explicitly or implicitly – directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed. In fact, this is "the overriding principle for any amendment to be allowable under Art. 123(2) EPC ... that applies equally to the subject-matter of a claim the scope of which is determined by a disclaimer", be it an undisclosed or a disclosed disclaimer.

c) **G 1/03**, **G 2/03** not applicable to disclosed disclaimers

As stated in **T 1049/08**, it is permissible to restrict the subject-matter using a negative limitation, i.e. a disclaimer, if - as in the case at issue - adding positive features to the claim either would not define more clearly and concisely the subject-matter still protectable or would unduly limit the scope of the claim. Decision **G 1/03** referred to "undisclosed disclaimers", i.e. to disclaimers which do not have any basis in the application as filed. It was correct that such disclaimers are only allowable if they meet the conditions set out in **G 1/03**. Since the limitation introduced was derived literally from the original application it had a basis in it and did not represent an undisclosed disclaimer but a disclaimer of disclosed subject-matter. Hence, in the board's view, **G 1/03** was not relevant to the present case. Moreover, **G 2/10** pointed out that **G 1/03** referred exclusively to undisclosed disclaimers (see **G 2/10**, point 3, in particular point 3.9 of the Reasons). The board applied **G 2/10**.

d) Applicability of **G 1/03**, **G 2/03** to pending cases

The board in **T 500/00** and **T 740/98** ruled that the principle of good faith could not be invoked against the application of the principles concerning the allowability of disclaimers laid down in **G 1/03** to pending cases (see also **T 1045/09** and Chapter III.A.5.1 "Case law deviating from or overruling the practice").

### 1.5.3 Decisions applying the criteria established by the Enlarged Board

a) Accidental anticipation

In **G 1/03** (OJ 2004, 413) the Enlarged Board held that, when anticipation was taken to be accidental, this meant that it appeared from the outset that the anticipation had nothing to do with the invention. Only if this was established could the disclaimer be allowable (see also order in **G 1/03**).

In **T 500/00** the amendment was an undisclosed disclaimer introduced by the appellant into claim 1 during the examining proceedings in response to an objection of lack of novelty based on prior art document D1. The question that arose was whether or not the disclosure of D1 was accidental. In the case in point, the claimed solution showed an overlap with the teaching of D1. D1 and the application in suit concerned the same technical field, had, except for the disclaimed component, identical compositions and related to the same purpose of sufficient curing. Moreover, the same technical problem underlay both the patent in suit and D1. Since the skilled person would consider D1 as suitable prior art to make the invention, confirmed by the reference to D1 in the original application, the disclosure of D1 could not be considered as being accidental within the meaning of **G 1/03**. Furthermore, since D1 related to the same technical effect as the patent in suit, and since its starting polymers to be cured were structurally identical to those used in the claimed process, D1 could be considered as a suitable starting point for assessing inventive step.

The decision in **T 14/01** concerned the allowability of a disclaimer aimed at removing an overlap with prior art in view of **G 1/03**. According to the board in this case, the allegation that a teaching extracted from prior art led away from the invention implied that the skilled person had taken this prior art into consideration. Yet for an anticipation to be accidental it was necessary that the skilled person would have never taken it into consideration. The board then decided that the prior art in question was not accidental in the sense of **G 1/03**, and that the disclaimer was not admissible.

In **T 1049/99** the board concluded that, contrary to what the respondent (patent proprietor) claimed, the skilled person would have taken the teaching of document D21 into consideration when working on the invention in search of a solution to the technical problem defined by the respondent, using appropriate and relevant means to resolve his problem **in the same technical field** as that of the patent in suit. Moreover, contrary to the respondent's conclusions at the hearing, the board stressed that the fact that a document was difficult to find in published prior art or was difficult for the skilled person to access was not sufficient to justify the conclusion that it constituted an accidental anticipation.

In **T 217/03**, on the issue of whether document D1 was an accidental anticipation, the board stated that D1 did not deal explicitly with the technical problem underlying the claimed invention. However, that was not decisive for accepting D1 as an accidental anticipation. The board concluded that D1 related to the same general technical field as that of the subject-matter of claim 10 and was not from a technical point of view so unrelated and remote that the person skilled in the art would never have taken it into consideration when working on the invention (see **G 1/03**, OJ 2004, 413, point 2.2.2 of the Reasons). Thus the disclosure of D1 could not be considered to constitute an accidental anticipation. Therefore the disclaimer in claim 10 did not fulfil the conditions required to render it admissible.

Other decisions too have had to establish whether or not the anticipation was accidental. In **T 717/99**, for example, the board did not agree with the opponent's conclusion that the anticipation was not accidental. In the following decisions, the boards ruled that the

anticipation was not accidental and that the disclaimers were therefore inadmissible: **T 1086/99**, **T 584/01**, **T 506/02**, **T 285/00**, **T 134/01** (field of pharmaceuticals, same illness; findings summarised by the board in **T 1911/08**, in which account was also taken of **T 739/01**, **T 580/01** and **T 639/01**), **T 1146/01** (on comparative examples of a prior art document providing a teaching not to be followed).

b) Drafting of disclaimers - disclaimer shall not remove more than is necessary

Regarding the drafting of disclaimers, the Enlarged Board of Appeal stated in **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) that the disclaimer should not remove more than was necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. The need for a disclaimer was not an opportunity for the applicant to reshape his claims arbitrarily. In **G 2/10** (OJ 2012, 396) the Enlarged Board held that the requirement that "the disclaimer should not remove more than is necessary to restore novelty" was not suitable for the disclaiming of disclosed subject-matter, since in that case the wording of the disclaimer must be configured in accordance with the disclosure of the disclaimed subject-matter in the application as filed.

As to the relationship between the requirement that "the disclaimer should not remove more than is necessary to restore novelty" and the requirement of clarity and conciseness, see **T 2130/11** (summarised in subchapter d) "Drafting of disclaimers – clarity" below).

In **T 747/00** the board concluded that since, in the absence of a novelty-destroying disclosure, the disclaimer removed subject-matter without any need to do so, that disclaimer necessarily removed more than was necessary to restore novelty, which was not allowable (see also **T 201/99**). In **T 1050/99** the board concluded that the disclaimer covered more than was disclosed in the prior art and thus removed from the claim more than was necessary to restore novelty. See also **T 285/00** which concerned a disclaimer largely not based on the disclosure of a prior art document cited under Art. 54(3) EPC 1973, thereby rendering the remaining claimed subject-matter more distant from a relevant prior art document cited under Art. 54(2) EPC 1973.

In **T 8/07** the board observed that **G 1/03** had stated that a disclaimer may serve exclusively the purpose for which it is intended and nothing more. If a disclaimer had effects which went beyond its purpose, it was or became inadmissible. Further, the necessity for a disclaimer was not an opportunity for the applicant to reshape his claims arbitrarily (**G 1/03**, point 3 of the Reasons). Therefore the disclaimer should not remove more than was necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons. From that the board found that it could not be derived from the reasoning of **G 1/03** that a patent proprietor was permitted a degree of **discretion or latitude** concerning the "border" within which the disclaimer should be drafted with respect to the subject-matter to be excised. On the contrary, the existence of any discretion regarding the extent of the disclaimer as compared to the subject-matter to be excluded would inevitably introduce a degree of arbitrariness in the drafting of the disclaimer. This would conflict with the express findings of **G 1/03**. It was therefore concluded that in order to comply with the requirements following from **G 1/03** with

respect to the drafting of disclaimers it was necessary that these be formulated to excise only that subject-matter which could not be claimed. Further, the submission of the patent proprietor that it would derive no advantage was not necessarily and inevitably correct since a broad disclaimer, in addition to restoring novelty would have the further effect of "immunising" the subject-matter claimed against a potential attack of lack of novelty.

In **T 10/01** the scope of the disclaimer was broader than was necessary to restore novelty. The board nevertheless referred to point 3 of the Reasons for **G 1/03**, saying that it could also be inferred from that decision that a disclaimer that was broader than strictly necessary to restore novelty might be allowed, depending on the circumstances of the case, if that proved necessary to prevent any lack of clarity in the claim that might otherwise result. However, in the case at issue there was no apparent justification for the disclaimer being broader than the disclosure in document (1).

In **T 477/09** claim 1 was modified by addition of a negative feature or disclaimer with a view to restoring its novelty over document D1. It was undisputed that there was no basis for the disclaimer in the application as filed. The board observed that two conditions relating to the wording of disclaimers had been established in points 2.2 (disclaimer should not remove more than is necessary) and 2.4 (clarity and conciseness) of the order made in **G 1/03** and that those two conditions were equally applicable. The patent proprietor therefore could **not** be considered to have any **room for manoeuvre** in wording the disclaimer and thereby defining its scope: to satisfy the conditions set out in **G 1/03**, a disclaimer could not remove more than was necessary to restore novelty. In the case at hand, the board found that the scope of the disclaimer was greater than the actually novelty-destroying disclosure in D1.

In **T 1843/09** (OJ 2013, 502) the opponent argued that the disclaimer contravened Art. 123(2) EPC because the wording of the disclaimer that the claimed film "is other than a film of Comparative Example 4 of EP-A 0546184" did **not represent a technical feature**. The board did not accept this argument. Although it was true that technical information could not directly be extracted from the wording of the disclaimer in claim 1 as such, it should be noted that the disclaimer did not merely cite a published patent document, but clearly referred to a specific disclosure in D15, namely a single film described in comparative example 4. Table 4 of D15, characterised this film unambiguously by a number of technical features. The skilled person was therefore able to determine simply by reading the comparative example in D15 which technical embodiment should be excluded from the scope of the claim.

In **T 1836/10** the examination division had based its refusal of the application on Art. 53(a) in conjunction with R. 28(c) EPC, according to which biotechnological inventions using human embryos for industrial or commercial purposes are excluded from patentability. The applicant attempted to disclaim the relevant subject-matter. The board considered that an applicant could not amend his claims at will, and that any disclaimer needed should not exclude any more than was necessary to disclaim subject-matter excluded from patentability for non-technical reasons. The same applied to a disclaimer which served to disclaim subject-matter that was not comprised by the claim



in the first place. The amendment of a claim by introducing such a disclaimer did not meet the intended purpose and was therefore to be regarded as inadmissible under Art. 123(2) EPC.

c) Drafting of disclaimers - restoration of novelty

In case **T 440/04** the question was whether disclaiming example 1 of C63 was sufficient to restore novelty. Whereas on the one hand a disclaimer should not remove more than was necessary to restore novelty, it cannot, on the other hand, be considered to serve its intended purpose when **it excises less** than what is necessary to restore novelty. The disclosure in C63 of fibres having compositions and properties as required by the present claims 1 according to all requests was not strictly limited to the fibres described in example 1 of C63. "Cutting out" the latter fibres was thus not sufficient to exclude from the said claims 1 all those fibres disclosed in C63 having a composition and the inherent properties according to said claims. In the present case, the disclaiming of example 1 was thus not sufficient to restore novelty of the claimed subject-matter over C63.

In **T 285/03** the board found that the interpretation offered by the appellant amounted to a disclaimer although it was not phrased in the usual form. However, that disclaimer was not based on a particular prior art disclosure, whether accidental or not, but tried to delimit the claim against any **potential prior art** disclosure, contrary to the principles set out in **G 1/03**.

d) Drafting of disclaimers - clarity

The Enlarged Board of Appeal stated in **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) that the requirements of conciseness and clarity of Art. 84 EPC 1973 were also applicable to claims containing disclaimers. This meant that a disclaimer was not allowable if the necessary limitation could be expressed in simpler terms in positive, originally disclosed features in accordance with R. 29(1), first sentence, EPC 1973 (R. 43(1) EPC). In addition, a plurality of disclaimers might lead to a claim drafting which put an unreasonable burden on the public to find out what was protected and what was not protected. A balance had to be struck between the interest of the applicant in obtaining adequate protection and the interest of the public in determining the scope of protection with reasonable effort.

In the interest of transparency of the patent, it should be clear from the specification that there was an undisclosed disclaimer and why it had been introduced. The excluded prior art should be indicated in the description in accordance with R. 27(1)(b) EPC 1973 (R. 42(1)(b) EPC) and the relation between the prior art and the disclaimer should be shown.

The following rulings on the clarity of claims including a disclaimer were handed down after the decisions in **G 1/03** and **G 2/03**:

In **T 161/02** the board pointed out that the disclaimer combined features which arose from two different documents of prior art, the combination of these features resulting in a

disclaimer that corresponded to neither the disclosure of the first nor that of the second document, and which - as acknowledged by the appellant - did not make any technical sense. The board held that such a disclaimer rendered the claim unclear within the meaning of Art. 84 EPC 1973, as it did not allow the public to find out what was protected and what was not protected.

To justify the exclusion expressed by the formulation "non-therapeutic use" at the beginning of the disputed claim, the appellant in **T 67/02** had cited **G 1/03** and **G 2/03** (OJ 2004, 413 and 448), which had ruled that disclaimers were admissible for subject-matter not patentable under Art. 52 to 57 EPC 1973. However, the board found that in the present case it was not possible to identify a clear distinction between cosmetic use and therapeutic treatment. The board therefore took the view that the exclusion rendered the claimed subject-matter unclear.

In the claim at issue in **T 201/99** the appellants (patent proprietors) replaced the range of treatment times "1-10 minutes" by "1-6 minutes". They argued that the range of 1 to 6 minutes should be regarded as disclaiming a sub-range of more than 6 to 10, so as to remove the area of overlap between the claimed subject-matter and the prior art. The board, however, emphasised that Enlarged Board of Appeal decisions **G 1/03** and **G 2/03** (point 3 of the Reasons) explicitly ruled out the possibility of hiding a disclaimer by using an undisclosed positive feature defining the difference between the original claim and the anticipation, since this would affect the transparency of the patent (Art. 84 EPC 1973).

In **T 286/06** the board held that it derived from the purpose of Art. 84 EPC 1973 to ensure legal certainty, that the wording of a claim could not be interpreted by taking into consideration the teaching of further publications not referred to explicitly in the original documents of the application as being relevant for the interpretation of terms used in the description or in the claims. This applied also in the case of a disclaimer, as the only justification for its introduction in a claim was to exclude a novelty-destroying disclosure and it did not represent an opportunity for the applicant or patent proprietor to reshape its claims arbitrarily (see **G 1/03**, OJ 2004, 413). The board evaluated the clarity of claim 1, considering what the skilled person would have understood in reading the claim only, taking into consideration common general knowledge. The board concluded that the wording of claim 1 was unclear.

In **T 1695/07**, claims 1 to 8 of the main request were found by the board to be directed to a method for treatment of the human body by surgery which is excepted from patentability under Art. 53(c) EPC. Claim 1 of auxiliary request 2 included the feature "wherein the process is not a method for treatment of the human or animal body by surgery", i.e. a disclaimer. Concerning the admissibility of a disclaimer excluding subject-matter not eligible for patent protection, the board in this case first stressed that, with reference to **G 1/03** (OJ 2004, 413), the requirements of Art. 84 EPC are also applicable to claims containing disclaimers. A clear delimitation and distinction between excepted surgical applications and possibly allowable non-surgical applications of the claimed process requires that the two methods be distinct, i.e. separable, which means that they must be of a different nature and may be carried out in different ways. In the board's

view, it could not be seen how the claimed process would work without the surgical steps involved. The board concluded that the requirement of clarity was not met in the case at issue and that auxiliary request 2 was therefore not allowable.

In **T 1487/09** the board considered that all the requirements of the EPC had to be considered when examining a disclaimer, in particular those of Art. 84 EPC. The board observed that the uses excluded (namely, uses that "comprise or encompass an invasive step representing a substantial physical intervention on the body of a human or an animal which requires professional medical expertise to be carried out and which entail a substantial health risk even when carried out with the required professional care and expertise") were not explicitly defined, but rather must be derived from a condition which was to be fulfilled. Whether this condition was fulfilled or not would have to be established by the reader of the claim. Leaving room for such an assessment by the reader inevitably introduced uncertainty as to the matter for which protection was sought. Hence a lack of clarity arose, which was in breach of Art. 84 EPC. Further, the fact that the wording chosen for the disclaimer was the same as the one used in decision G 1/07 for describing a surgical method did not mean that the claim fulfilled the clarity requirements of Art. 84 EPC. This had to be handled on a case-by-case basis. A similar situation may occur when a disclaimer aiming at establishing novelty over subject-matter of a conflicting application under Art. 54(3) EPC was to be introduced.

In **T 447/10**, the board stated that according to the established case law of the boards of appeal, the characterisation of a product in a claim by reference to a **trade mark** lacked clarity because the product's composition could change over the term of the patent (see **T 762/90**, **T 270/11**). In the case at issue, the disclaimer excluding a composition sold under a trade mark was of an uncertain scope, such that the subject-matter of claim 1 in the requests in question lacked clarity.

In **T 2130/11** the board held that the difficulty in formulating an allowable disclaimer could not justify an exception to the application of Art. 84 EPC which was not foreseen in the EPC. The requirements of Art. 84 EPC must therefore apply for a disclaimer as for any other feature of a patent claim. However, the condition that the disclaimer should not remove more than is necessary to restore novelty (**G 1/03**) should be applied while taking into consideration its purpose, namely that the "necessity for a disclaimer is not an opportunity for the applicant to reshape his claims arbitrarily" (**G 1/03**). In this respect situations could be foreseen, in which, while fulfilment of the condition taken in a strictly literal way would not be possible, a definition of the disclaimed subject-matter, which satisfied the requirements of Art. 84 EPC and fulfilled the purpose of the condition (i.e. to avoid an arbitrary reshaping of the claims), might be achievable. In other words, a disclaimer removing more than was strictly necessary to restore novelty would not contradict the spirit of **G 1/03**, if it were required to satisfy Art. 84 EPC and it did not lead to an arbitrary reshaping of the claims.

e) No relevance for inventive step and insufficiency of disclosure

According to **G 1/03** (OJ 2004, 413), a disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Art. 123(2) EPC.

In **T 788/05** the undisclosed disclaimer was introduced by the appellant during the examination procedure with the purpose of establishing the novelty of the claimed subject-matter with respect to D1, which was then considered as a prior art document relevant under Art. 54(3) EPC 1973. In the case at issue, the relevant prior art was represented by documents D1 and D5. To be allowable the disclaimer had to fulfil the conditions in relation to both documents. As far as D1 was concerned, the disclaimer appeared to be appropriate. D5 represented the state of the art under Art. 54(2) EPC 1973. As D5 was not state of the art under Art. 54(3) and (4) EPC 1973 and was not an accidental disclosure, the disclaimer would only be allowable if it did not add subject-matter within the meaning of Art. 123(2) EPC 1973, i.e. if the disclaimer did not become relevant for the assessment of inventive step. Going into details, the board concluded that the subject-matter of claim 1 of the main and the first auxiliary requests was not acceptable under Art. 123(2) EPC 1973 (see also **T 761/08**).

f) Availability of remaining subject matter at filing or priority date

In **T 1441/13** the subject-matter remaining in the claims after the introduction of the disclaimer, namely a method for obtaining polypeptide-secreting cells which includes the culture of human embryonic stem (hES) cells derived only and exclusively from non-destructive methods, was not available at the priority date of the application (7 December 2001) and thus, was not directly and unambiguously disclosed to a skilled person as required by decision G 2/10. Rather, the methods available to the skilled person at the relevant date all included, at some point in time, the destruction of a human embryo. In view thereof, the board did not consider it necessary to examine whether the disclaimer fulfilled the other criteria established in decision G 1/03, such as, for instance, whether the disclaimer was complete, i.e. whether it actually excluded all subject-matter not allowable under Art. 53(a) EPC in combination with R. 28(c) EPC.

In **T 1808/13** the board endorsed its approach in **T 1441/13**, which had been to establish whether the subject-matter of the invention remaining in the claim was available at the filing date. In **T 1808/13** the appellant took the view that obtaining embryonic stem (ES) cells from human parthenotes was implicitly known to the skilled person as part of his common general knowledge. The board ruled that the patent application did not disclose directly and unambiguously for the skilled person, even drawing on his common general knowledge, that ES cell lines could be derived from human parthenotes. The skilled person was not able at the filing date to establish or use human ES cell lines from parthenotes.

## 1.6. Generalisations

### 1.6.1 Replacing specific feature with more general term - no inclusion of undisclosed equivalents

In **T 416/86** (OJ 1989, 309) it was held that the fact that a technical means (in this case an aperture of a special design) was known did not take away the novelty of its equivalents (in this case, apertures of a different design producing the same effect as the former) even if the equivalents were themselves well known. It followed that the equivalents of a disclosed technical means had to be considered new and therefore not disclosed if they were not mentioned in the original documents. In accordance with these principles, the board decided that the replacement of a specific feature disclosed in the invention by a broad general statement was to be considered as an inadmissible amendment under Art. 123(2) EPC 1973 when this general statement implicitly introduced for the first time specific features other than that originally disclosed. Therefore, the substitution in the claim of a structurally defined element of that claim by its **known** function (or **disclosed** function) was considered contrary to Art. 123(2) EPC 1973. See also **T 694/07** and **T 2537/10**.

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. Similarly, in **T 284/94** (OJ 1999, 464) the board stated that an amendment which replaced a disclosed specific feature either by its function or by a more general term and thus incorporated undisclosed equivalents into the content of the application as filed, was not allowable under Art. 123(2) EPC 1973.

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 685/90** the board stated that specific equivalents of explicitly disclosed features did not automatically belong to the content of a European patent application as filed, when this content was used as state of the art according to Art. 54(3) and (4) EPC 1973 against a more recent application. It therefore concluded that such equivalents could not belong to the content of a European patent application either, when this content was assessed to determine whether an amendment was admissible under Art. 123(2) EPC 1973. On the prohibition of including equivalents, see also **T 673/89**.

In **T 40/97** the board considered that in a case where a number of generally similar embodiments were discussed in equivalent terms, the person skilled in the art would, in normal circumstances and when nothing pointed to the contrary, notionally associate the characteristics of an element of one embodiment described in some detail with the comparable element of another embodiment described in lesser detail.

Concerning replacement by an equivalent, see the considerations raised in **T 747/10** with regard to **T 331/87** and the essentiality test. In **T 653/03**, the original term "diesel engine" in claim 1 was replaced by the term "combustion engine". Thus the suitability of the claimed method was generalised to any type of combustion engine. The board decided that the treatment of exhaust gas in the original application was always related to a diesel engine, and it could not be inferred by the skilled person that the subject-matter of the granted patent extended to a method which was suitable for any type of combustion engine. The technical contribution was that the amended method was suitable for any type of combustion engine, whereas in the original form it was suitable only for a diesel engine. The generalisation was not admissible.

In **T 868/07** the board allowed the replacement of an undisclosed feature by a more general feature disclosed in both parent and divisional applications. The board had objected to a specific feature and the applicant replaced this feature by a more general feature. The board found that the general feature had been disclosed in the same context in the description and in the figures of the parent application as filed; Art. 76(1) EPC had therefore been complied with. Since the more general feature was disclosed in the same context in the divisional application as filed, the board saw also no reason for an objection under Art. 123(2) EPC.

In decision **T 714/08**, with regard to the second auxiliary request, it was not disputed that the application as filed did not disclose in general terms the association of the three particular compounds. The appellant nonetheless asserted that amended claim 1 was supported in example 6 in the application as filed by the disclosure of a particular composition incorporating these three compounds. The board considered that, while example 6 in the application as filed certainly described a composition incorporating the three particular compounds defined in amended claim 1, it was still necessary to establish whether a specific example of that kind could constitute an adequate basis for the generalisation adopted in amended claim 1, which provided in particular that the three compounds could be present in any quantities and possibly in association with other couplers and oxidation bases. The board concluded that, in the light merely of the information made available to the skilled person by the disclosure in this example, the amendment introduced technical information which the skilled person would not have been able to derive, directly and unequivocally, just from the disclosure in example 6 in the application as filed. This was also in line with the conditions set out in **T 962/98**. The board concluded that Art. 123(2) EPC had been contravened.

#### 1.6.2 Generalisation and claim category

In **T 784/89** (OJ 1992, 438) the patent application as filed explicitly disclosed a computer-controlled method for producing a particular effect. 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 that method was considered an inadmissible extension of the application because the claim covered apparatus which could also be used in other methods and to achieve other effects. The only allowable claim was for an apparatus for

carrying out a method comprising a programmable component which could be suitably programmed to carry out the method.

### 1.6.3 No generalisation of an effect obtained for particular embodiments

In **T 3/03** the board decided that an amendment consisting in the generalisation of an effect obtained for particular embodiments was not admissible. In the case in point, the results obtained for particular embodiments could not be generalised since the particular circumstances of use, including the type of additive used, determined whether or not filterability was improved.

### 1.6.4 Amendments to preamble of claim by substituting general term for specific term

According to **T 52/82**, OJ 1983, 416), 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 is not apt to define that feature of the prior art (see also **T 285/07**).

## 1.7. Intermediate generalisation - undisclosed combination of selected features

According to established case law (as summarised e.g., in **T 219/09** or **T 1944/10**), it will normally not be allowable to base an amended claim on the extraction of isolated features from a set of features originally disclosed only in combination, e.g. a specific embodiment in the description (**T 1067/97**, **T 714/00**, **T 25/03**). Such an amendment results in an "intermediate generalisation" (sometimes also called intermediate restriction, see **T 461/05**, **T 879/09**, **T 2537/10**), i.e. an undisclosed combination of selected features lying somewhere between an originally broad disclosure and a more limited specific disclosure (**T 1408/04**, see also **T 461/05**). An intermediate generalisation is different from a simple generalisation, since in the former case a definition of the invention in general terms forms part of the original disclosure (**T 461/05**). In **T 1238/08** the board observed that it would be contrary to the purpose of Art. 123(2) EPC to allow undisclosed intermediate generalisations only because the application as originally filed had not been drafted to contain appropriate fall-back positions.

An intermediate generalisation is justified only **in the absence of any clearly recognisable functional or structural relationship** among the features of the specific combination (**T 1067/97**, **T 25/03**) or if the extracted feature is **not inextricably linked with those features** (**T 714/00**).

The board in **T 962/98** held that an intermediate generalisation was admissible only if the skilled person could recognise without any doubt from the application as filed that those characteristics were **not closely related** to the other characteristics of the working example and applied directly and unambiguously to the more general context (often cited, see e.g. **T 144/08**, **T 313/09**, **T 879/09**, **T 2185/10**). In other words, in order to be acceptable, this intermediate generalisation had to be the result of unambiguous

information that a skilled person would draw from a review of the example and the content of the application as filed.

In **T 1906/11** the board emphasised that whether an amendment constituted an intermediate generalisation was irrelevant for the purposes of assessing its admissibility. According to that decision, the only relevant question would be whether a skilled person faced with the amended version of the application or patent, as compared to a skilled person having seen only the version originally disclosed, would derive from that amended version any additional technically relevant information. Only if such additional information was derivable can there be an infringement of Art. 123(2) EPC. In **T 248/12** the board stated that in respect of the "technical relevance" of the added information, case **T 1906/11** could not be understood to define a new standard for judging amendments with respect to Art. 123(2) EPC since this would be at odds with the "gold standard" in **G 2/10**, OJ 2012, 376. See also **T 1791/12** where the board considered that no divergent interpretations of the principles contained in **G 2/10** for judging amendments were apparent in **T 1906/11**.

The board in **T 1471/10** considered that the ultimate standard for assessing compliance with the requirements of Art. 123(2) EPC in the case of an intermediate generalisation remains the "gold standard" (as set out in Chapter II.E.1.2.1; see also **T 2392/10**, **T 1791/12**).

In **T 2311/10** the board held that, in the case of an intermediate generalisation, the three-point or essentiality test was unhelpful or even misleading (compare also Guidelines H-V, 3.2.1 - June 2012 edition, which still referred to the essentiality test in the context of intermediate generalisation, and later versions, which no longer do).

According to the appellant in case **T 99/09**, the added feature was to be regarded as an invisible term without any additional technical content. The board observed that the feature had been disclosed in the application as filed only in combination with other structural or functional features. It was never disclosed in isolation. The application as filed provided no basis for a generalisation. Furthermore, the board pointed out that this feature had a generally established technical meaning in the relevant field. Finally, the board concluded that the term in question, although vague, did make a technical contribution to the claimed subject-matter and could not be regarded as "invisible" (in breach of Art. 123(2) EPC).

In **T 284/94** (OJ 1999, 464) the board stated that an amendment of a claim by the introduction of a technical feature taken in isolation from the description of a specific embodiment was not allowable under Art. 123(2) EPC 1973 if it was not clear beyond any doubt for a skilled reader from the application documents as filed that the subject-matter of the claim thus amended provided a complete solution to a technical problem unambiguously recognizable from the application (see also **T 1644/11**).

In **T 714/00** the board stated that extracting an isolated feature from an originally disclosed combination and using it to delimit claimed subject-matter could only be



allowable in connection with Art. 123(2) EPC 1973 if that feature was not inextricably linked with further features of that combination.

In **T 25/03** the board concluded that since claim 1 resulted from the extraction of isolated steps from the specific combination disclosed as essential in the embodiment of Figure 4, and since the appellant had not referred to other parts of the application as filed that could support the proposed amendment, and no such parts had been identified by the board, claim 1 as amended in accordance with the first auxiliary request did not meet the requirements of Art. 123(2) EPC 1973.

In **T 582/91**, the respondent (opponent) was of the opinion that when restricting a granted claim by introducing subject-matter from the dependent claims **all the features of the dependent claims** in question should be incorporated in the new independent claim. Contrary to this opinion the board considered that one feature of a dependent claim could be readily combined with a preceding independent claim as long as the skilled person recognised that there was clearly no close functional or structural relationship between the one feature of that dependent claim and its other features, or between that one feature and the teaching of other dependent claims referred to in that dependent claim. If this was the case, no objections under Art. 123(2) EPC 1973 arose (see also **T 938/95**; and **T 288/89** which concerns the combination of an independent claim with a dependent claim, without including the features of the higher dependent claim).

In **T 701/97** the board held that where, as in the case in suit, an independent claim present in the parent application as originally filed had been amended by the addition of features restricting the scope of the claim and taken from a number of parts of the original application which were not clearly related, it was not sufficient that all the individual added features were disclosed in the original application. Rather, the combination of features in question had to be clearly and unambiguously derivable from the document by a skilled person using common general knowledge. Multiple limitations generating specific subject-matter not derivable from the original application could not be allowed.

In **T 1408/04** the board stated that the terminology introduced into claim 1 according to the main request was not disclosed *expressis verbis* in the filed application. From the broad range of topsheet/backsheet structures within the scope of claim 1 as granted, a specific selection had now been made. The board considered that, to avoid an intermediate generalisation (i.e. an undisclosed combination of selected features lying somewhere between an originally broad disclosure and a more limited specific disclosure), all the necessary features of the specific selection must be included in the claim. The selection in this case came from the **drawings**, which, however, also showed a particular (albeit commonly used) type of topsheet/backsheet connection. This particular connection was lacking in the claim. Thus an intermediate generalisation was present. With regard to the third auxiliary request, the board considered that the particular definition of the topsheet/backsheet sealed connection was not a generalisation of the content of the originally filed application. Whilst it was correct that Figures 1 to 3 represented a preferred embodiment, it was clear that they represented

only a "preferred" embodiment of one way of assembling the topsheet, backsheet and core. In fact this was the only way which was clearly and unambiguously disclosed. The skilled person would immediately realise that the specific topsheet/backsheets sealed configuration as shown in the Figures was generally applicable also to other aspects of the invention and was not limited only to the set of features shown in Figures 1 to 3. The other elements present in these Figures were not inextricably linked to the topsheet/backsheets sealed configuration, as also confirmed by the description, which categorised these features as optional; thus, they could be omitted from the embodiment in Figures 1 to 3.

In **T 461/05** the board found that claim 4 as amended defined subject-matter which was less general than that defined by claim 1 in the original version but more general than the particular embodiment corresponding to case 2a as disclosed in the description and the subject-matter of claim 6 as originally filed. Claim 4 thus represented a generalisation, also referred to in patent jargon as an intermediate generalisation. The board emphasised that an intermediate generalisation was different from a simple generalisation (see e.g. **T 910/03**, **T 404/03**), since in the former case a definition of the invention in general terms formed part of the original disclosure. The expression intermediate generalisation conveyed the idea that the amended subject-matter was a generalisation of a particular embodiment, disclosed in the original application, which was at an intermediate point between that particular embodiment and the definition in general terms of the invention as originally disclosed. The case at issue the amendment comprised the omission of certain characteristics of the combination of features of the particular embodiment. The board held that the provisions of Art. 123(2) EPC 1973 precluded such an amendment only where the amendment presented the skilled person with new information which did not follow directly and unambiguously from the application as originally filed. A restriction of a claim by adding a number of features from a particular embodiment originally disclosed did not in itself introduce such new information. By contrast, the omission of the remaining features of the embodiment would introduce new information if the omitted features were necessary to carry out the particular embodiment of the invention. In this case, the omission of these features would present the skilled person for the first time with the information that, contrary to what had originally been disclosed, these features were not necessary in order to carry out the particular embodiment of the invention. The board found that the contested decision contained no reasons why these omitted features would be necessary to carry out the invention. Therefore, claim 4 as amended was in conformity with Art. 123(2) EPC.

In **T 1387/05** the parent application disclosed two different branches of video signal transmission. The appellant's (applicant's) argument was based on the underlying understanding that the parent application disclosed two distinct branches as alternatives, and that the claims of the divisional application at issue concerned only the first branch. The board stated, however, that the parent application did not directly and unambiguously present alternative apparatuses corresponding to these two alternative branches. Instead it disclosed a recording/reproducing processing apparatus with the functionality that a broadcast wave might be transmitted and/or received. The board accepted the appellant's argument that decision **G 1/06** (OJ 2008, 307) did not state that subject-matter had to be separately derivable from what was disclosed in each of the

preceding applications as filed. However, this did not mean that features which were disclosed in a given context might be claimed in a different context or specific features might be generalised without a proper basis in the parent application as filed. As the same principles were to be applied for both Art. 76(1) EPC and Art. 123(2) EPC 1973, it followed that it was normally not allowable under Art. 76(1) EPC 1973 to extract features from a set of features which were originally disclosed only in combination in a parent application and to claim such extracted features in a divisional application isolated from their context, namely the combination disclosed in the parent application.

In the consolidated cases **T 1500/07**, **T 1501/07** and **T 1502/07**, applying the established case law of the boards of appeal concerning Art. 123(2) EPC to the case of Art. 76(1) EPC 1973, the board stressed that where newly claimed subject-matter was based on the extraction of features in isolation from a set of features originally disclosed in combination (e.g. in a specific embodiment in the description) the above criterion was met, if there was no clearly recognizable functional or structural relationship between the features, i.e. when they were not inextricably linked. What is decisive is determining which specific combinations of features were originally taught by the parent, and whether the skilled person recognises immediately and unequivocally from the totality of the disclosure when read contextually and using his common general knowledge that, and which, certain features are incidental to the proper functioning of these specific embodiments, and that these can be dispensed with without consequence for the remaining features. In the case before the board, the fact that the claimed features were not given any special prominence, and that they were functionally and structurally bound to the other, remaining features indicated that these criteria were not met.

In **T 273/10** the proposed amendments consisted of adding to the subject-matter of claim 1 characteristics derived from a particular embodiment but, at the same time, omitting other characteristics which had been described in close combination with those added. It therefore had to be established whether those amendments were allowable even though they entailed a limitation of the subject-matter originally described. Referring to the boards' case law, in particular that established in **T 461/05**, the board concluded that, in the case before it, the omission of the characteristics from the claimed subject-matter was contrary to Art. 123(2) EPC since there was no indication in the application as filed that they served no purpose, were optional or could be replaced by other technically equivalent means.

In **T 879/09** the board stated that a patent application described an invention in general terms together with one or more detailed embodiments. In order to overcome an objection of lack of novelty and/or inventive step the applicant often adds some but not all the features from the detailed embodiments to the general disclosure. This results in an object that lies between the original general disclosure and the detailed embodiments. This is called an "intermediate generalisation" in patent jargon, although a better term would be "intermediate restriction" to make clear that it is in fact a restriction from the more general original disclosure (**T 461/05**). Such an intermediate restriction or generalisation is permissible under Art. 123(2) EPC only if the skilled person would recognise without any doubt from the application as filed that characteristics taken from a detailed embodiment were not closely related to the other characteristics of that

embodiment and applied directly and unambiguously to the more general context (**T 962/98**). Since the test mentioned above was fulfilled, Art. 123(2) EPC was not infringed.

In **T 500/11** the amendment in claim 1 at issue corresponded to the restriction of the range "between 50 to 10000 ppm of chromium" by the lower end value of 550 ppm. It was uncontested that there was a literal basis for this specific value in example 3 of the patent, however not in combination with the other features of amended claim 1. The appellant (opponent) argued that the amendment consisted of an inadmissible intermediate generalisation because the feature 550 ppm Cr was inextricably linked to the other features and thus this specific value could not be arbitrarily extracted from its context. The question to be answered was whether the feature "550 ppm Cr" was inextricably linked to the other features defined in the relevant example of the patent. The board observed that all the features were parameters which might be varied individually and each of these variations would necessarily lead to a different result on the selectivity to TCS. If the feature "550 ppm chromium" was inextricably linked to specific other parameters of example 3, this would mean that the selectivity to TCS would only be achieved in the definite combination of "550 ppm chromium" with the specific other parameters of example 3. This, however, was manifestly not the case here. In the case at issue the aim of the invention - namely increasing the selectivity to TCS - was merely achieved by the addition of selected amounts of chromium to silicon and thus this feature was not "closely related to the other characteristics of the working example and applies directly and unambiguously to the more general context" as required in **T 962/98**. The current decision was also in line with **T 273/10**. It followed that the picking out of the value 550 ppm was plainly acceptable in the case at issue, with the consequence that the requirements of Art. 123(2) EPC were fulfilled. (For cases when a **range** is formed by taking an isolated value from an example, see also Chapter II.E.1.3.2 "Forming a range with isolated value taken from example").

On the issue dealt with in this section, see also **T 1004/01** (summarised above in this chapter II.E.1.3.2 "Forming a range with isolated value taken from example"), **T 166/04**, **T 200/04**, **T 311/04**, **T 191/04**, **T 1164/04**, **T 98/05**, **T 876/05**, **T 300/06**, **T 1250/06**, **T 1001/01**, **T 1407/06**, **T 911/06**, **T 582/08**, **T 1582/08**, **T 1397/09**, **T 2085/09**, **T 88/10**, **T 2172/11**, **T 163/13**, **T 1162/13**.

## 1.8. Specific derived from generic

### 1.8.1 Specific term derived from generic term

In **T 367/92** the board rejected an amendment because it contained a specific term which could not be considered to be clearly and unambiguously derivable from the originally disclosed generic term. In this case the issue boiled down to the question whether the generic term "polyester" could be equated with the specific term "polyethylene terephthalate". The sole document added by the appellant (patent proprietor) in support of this interpretation proved only that polyethylene terephthalate was a polyester (which was never under discussion), but did not show that "polyester" could be interpreted as implicitly meaning "polyethylene terephthalate".

### 1.8.2 Component of entity derived from entity

In **T 1228/01** the appellant (applicant) inferred that the reference to a deposited phage in a claim, whose correct deposit was mentioned in the application as originally filed, was an implicit disclosure of a part of a nucleotide sequence contained in the phage, although the sequence was not disclosed per se. The board made reference to **T 301/87** (OJ 1990, 335), in which it had been decided that if an entity itself was disclosed to the skilled person, this did not necessarily mean that a component part was also disclosed for the purpose of priority if this could not be envisaged directly and unambiguously as such and required considerable investigation to reveal its identity. The board in **T 1228/01** held that these findings were also applicable to amendments. It stated that the disclosure in the application as originally filed of the deposition of the recombinant bacteriophage Lgt11-P3 was not considered to be a basis within the requirements of Art. 123(2) EPC 1973 for the disclosure of a DNA sequence designated as "the P3 coding sequence" which was allegedly contained in that bacteriophage, but which as such was not disclosed in the application as originally filed. Thus, the requirements of Art. 123(2) EPC 1973 were not met.

### 1.8.3 Restricting a generic definition of a substituent to a specific (individual) one

In **T 288/92** the board held that it was not permissible to amend a generic formula defining a class of chemical compounds by restricting an originally disclosed generic definition of a substituent to a specific (individual) one which was arbitrarily selected from chemical entities, such as in the examples, without some support for such restriction in the general part of the description (see also **T 1537/14**).

### 1.8.4 Isolation of one species

In **T 1919/11** the board observed that the subject-matter of amended claim 1 of the main request related to *Taxus chinensis* only. In contrast, the summarising text of the parent application described the subject-matter as relating to a plurality of *Taxus* species. In addition, any particular mention of *Taxus chinensis* was followed by an endorsement that *Taxus chinensis* might be the best in many issues, but that the important subject-matter of the application equally was the teaching to use any member of the list of *Taxus* species for producing taxanes. Some of the examples related to different *Taxus* species and some used *Taxus chinensis* as a model substance to show particular effects of the cultivation conditions. The board concluded that, on this basis, there was no direct and unambiguous disclosure that the subject-matter of the overall content of the application related to nothing else than a method using *Taxus chinensis*.

## 1.9. Additions

### 1.9.1 Addition to the claim of a feature taken from drawings

For examples concerning the insertion of additional features to the claim taken from **drawings**, see below in this chapter II.E.1.12.1 "Disclosure in drawings".

### 1.9.2 Addition to the claim of an isolated feature taken from description

For examples concerning the insertion of an **isolated** feature to the claim taken from the **description**, see above in this chapter II.E.1.7 "Intermediate generalisation - undisclosed combination of selected features".

### 1.9.3 Addition to the claim of features originally presented as prior art

In **T 912/08** the board held that an amendment that resulted in features originally presented as part of the prior art, being then presented as the invention could be damaging to the legal security of third parties relying on the content of the original application and added subject-matter contrary to Art. 123(2) EPC.

In **T 1652/06** the board drew a distinction as to whether in the application as originally filed the feature in question was disclosed as part of the background art or as part of the invention. In the case at issue, the feature was taken from the background art and could not serve as basis for the amendment (see also **T 626/11**).

### 1.9.4 Addition of advantages and effects

In **T 11/82** (OJ 1983, 479) the board stated that the addition of a discussion of the advantages of the invention with reference to the prior art did not necessarily constitute a contravention of Art. 123(2) EPC 1973. Whether Art. 123(2) EPC was infringed depended on the actual language used and on the circumstances of the individual case.

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.

### 1.9.5 Addition of new claim category

In **T 243/89** the applicant had originally claimed a catheter only for medical use; during examination proceedings he filed a further claim for its manufacture. The board of appeal saw no reason to refuse the filing of an additional method claim for forming the apparatus, in view of the similar wording and thus of the close interrelationship between both independent claims. Since the result of the activity was in itself patentable, such methods were also patentable unless the disclosure was insufficient.

### 1.9.6 Adding prior art citations to the description

In **T 2321/08** the board considered the question of whether R. 27(1)(b) EPC 1973 required that prior art known to the applicant be acknowledged in the application already at the time of filing it. The board came to the conclusion that R. 27(1)(b) EPC 1973, or equivalent R. 42(1)(b) EPC, does not put a stringent obligation on the applicant to acknowledge prior art known to him, and to cite documents known to him reflecting this prior art, already at the time of filing the application. Furthermore, no requirement of the

EPC prohibits amending an application in order to meet the provisions set out in R. 27(1)(b) EPC 1973 or R. 42(1)(b) EPC (endorsed by **T 1123/09** and cited in Guidelines F-II, 4.3 - November 2015 version).

In **T 11/82** (OJ 1983, 479) it was pointed out that the mere addition to the description of a reference to prior art could not reasonably be interpreted as the addition of "subject-matter", contrary to Art. 123(2) EPC 1973. Whether it did so would clearly depend on the actual language used and the circumstances of the case.

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

In **T 450/97** (OJ 1999, 67) the board confirmed that the mere addition of a reference to prior art did not contravene Art. 123(2) EPC 1973. It added that after limitation of the claims, also at the opposition stage, a document which subsequently proved not only to be the closest state of the art, but also to be essential for understanding the invention within the meaning of R. 27(1)(b) EPC 1973 was to be introduced in the amended description. See also **T 276/07**.

In **T 889/93** the appellant (patent applicant) explained that the closest prior art was shown in two figures of the contested application. In his reply to the board's objection of obviousness he submitted that these figures did not show the state-of-the-art device correctly as they were misleadingly oversimplified. The board allowed originally filed drawings to be replaced by better ones since this only removed an inaccuracy in the representation of the state of the art and did not affect the disclosure of the invention per se. **T 1039/93** found along similar lines. In the case at issue, certain figures of the application as filed had been erroneously labelled as prior art while in fact representing in-house technical knowledge of the appellant that had not been made available to the public. The board did not object to the deletion of the labels "prior art" from the relevant figures since such deletion neither infringed Art. 123(2) EPC 1973 nor affected the disclosure of the state of the art; on the contrary such amendment was necessary to avoid giving an inaccurate representation of the state of the art. After the amendment the description correctly indicated the prior art as required by R. 27(1)(b) EPC 1973.

#### 1.9.7 Insertion of an ambiguous feature in the claim

In **T 792/94** the board ruled that since the teaching of claim 1 as amended was ambiguous (Art. 84 EPC 1973), allowing scope for an interpretation which extended beyond the overall teaching of the initial application, the amendment contravened Art. 123(2) EPC 1973.

In **T 1067/02** the board came to the conclusion that the **unclear** nature of the amendment introduced upon grant in claim 1 as filed, i.e. the introduction of the term "complete", allowed two different interpretations and, although they were both technically sensible, neither of them was directly and unambiguously derivable from the general

disclosure of the application as filed. Consequently, claim 1 of the main request extended beyond the overall teaching of the application as originally filed.

In **T 2298/09** the board held that, although the alternatives g2 and g3 remained **without a clearly derivable meaning**, it was not disputed that their introduction into claim 1 added information to the teaching of this claim. The group of features (g) encompassing these alternatives could not be ignored when examining these amendments under Art. 123(2) EPC.

#### 1.9.8 Characteristic described for intermediate product added to the claimed end product

In **T 314/07** the question arose whether the amendment of the claim directed to the absorbent material was directly and unambiguously derivable from a passage of the application as filed not describing the final absorbent material as such but the preparation of the intermediate film used therefore. The particular characteristics of the intermediate film described in the application as filed could be automatically transferred to the final absorbent material only if these characteristics would remain unchanged throughout the process of preparing the absorbent material (see also **T 320/10**). The board concluded that Art. 123(2) EPC was infringed.

### 1.10. Deletions and replacement

#### 1.10.1 Replacement or removal of features from claim

The requirement of Art. 123(2) EPC as applied to the claims means that it is only permissible to delete features from an independent claim if there is a clear and unambiguous basis for a claim lacking these features in the application as originally filed (**T 1726/06**, referring to **T 66/85**, OJ 1989, 167).

In **T 331/87** (OJ 1991, 22) the board held that the **replacement or removal of a feature** from a claim might not be in breach of Art. 123(2) EPC 1973 if the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the replacement or removal required no real modification of other features to compensate for the change.

In **T 917/94** the board decided that the omission of a feature of a claim did not contravene Art. 123(2) EPC 1973, if this feature was implicitly defined by two other features and, being therefore redundant, its omission created no subject-matter extending beyond that of the application as filed.

In **T 910/03** the patent proprietor deleted the feature "heater element", which had been in the claims as filed, from claim 1 as granted. The board held that nowhere in the application documents as filed as a whole was it stated, suggested, or hinted at, that the presence of a heater element was optional, or that the heater element, or heater elements, could be omitted.



In **T 558/13** claim 1 according to the main request differed from claim 1 of the earlier application as filed in that the following feature had been omitted: "... a plurality of power sources are independently provided for each of the plurality of groups." Instead, claim 1 of the main request specified that the read out circuit comprised a plurality of sample and hold circuits. The board considered that the concept of the invention as consistently presented in the earlier application as filed required the provision of independent power sources. It accepted the appellant's argument that the shifted timing of the reset and sample and hold circuits provided the new technical advantage of "reducing a line noise caused by an external noise". Nevertheless, in the board's view, it was not sufficient to prove that the – now omitted – feature of providing a plurality of independent power sources was "not indispensable for achieving the effect of reducing line noise caused by external noise". Such reasoning did not take sufficient account of the information conveyed by the earlier application as a whole, which was primarily concerned with providing independent power sources and which only presented the additional technical effect caused by the shifted timing as a side issue. There was no room for speculation as to which features of the disclosed invention(s) might be omitted on further reflection, if there was no explicit or implicit disclosure of the generalised subject-matter remaining after the omission of these features. In other words, the disclosure of an independent technical effect that was achieved by some features of the subject-matter disclosed in the earlier application as filed did not suffice as proof of a direct and unambiguous disclosure of subject-matter comprising only the features which provided that independent technical effect.

For further case law on the deletion and replacement of features, see in this chapter II.E.1.2.4 "The essentiality and the three-point test" above.

#### 1.10.2 Broadening of claim by deleting a feature

The deletion of a feature in a claim as filed may lead to a broadening of the claim. According to **G 1/05** (OJ 2008, 271), the applicant has a right to amend the claims so as to direct them to subject-matter not encompassed by the claims as filed. It is only after grant that the interests of third parties are further protected by Art. 123(3) EPC and the patentee's right to amend the claims is limited by the scope of the granted patent.

In **T 133/85** (OJ 1988, 441) the board held that it was possible without contravening Art. 123(2) EPC to broaden a claim (i.e. to extend the protection conferred by it), provided that the subject-matter which was within the claims for the first time as a result of the amendment was already disclosed within the content of the original application as filed.

In **T 66/85** (OJ 1989, 167) it was pointed out that if a technical feature was deleted from a claim in order not to exclude from protection certain embodiments of the invention, the broadening of the claim did not contravene Art. 123(2) EPC 1973 as long as there was a basis for a claim lacking this feature in the application as originally filed. It was immaterial whether or not the feature in question was relevant to the inventive concept of the claimed subject-matter (see also **T 228/98**).

In **T 1724/08** the board held that the broadening of individual disclosed features, in particular those of an independent claim as filed, was not prohibited by Art. 76(1) EPC 1973; such amendments likewise required a direct and unambiguous disclosure in the earlier application as filed (see also **T 1727/09**).

#### 1.10.3 Deletion of feature, broadening the protection conferred by the claim, without providing a technical contribution

In **T 802/92** (OJ 1995, 379), an ex parte case decided prior to **G 2/98** (OJ 2001, 413) and **G 2/10** (OJ 2012, 376; see in particular point 4.3 of the Reasons), the board allowed the deletion of a feature in the method claims. It explained that the aim of the invention was to make photovoltaic cells with certain abilities. This aim was achieved by the use of three different semiconductor layers formed of at least four different elements. In the board's view, it followed from the description that the presence of ohmic contacts did "not provide a technical contribution to the subject-matter of the claimed invention". Therefore, the presence or absence of such ohmic contacts did not affect the carrying out of the described invention since they were not an essential part of it. The board invoked the principles underlying the interpretation of Art. 123(2) EPC 1973 set out by the Enlarged Board in **G 1/93** (OJ 1994, 541). According to the board in this case these considerations were equally applicable to cases where a feature had been removed from a claim or omitted, so as to broaden its protection. Thus the removal from a claim of a feature which did not provide a technical contribution to the subject-matter of the claimed invention and whose removal merely broadened the protection conferred by the claim did not contravene Art. 123(2) EPC 1973.

#### 1.10.4 Elimination of contradictions and inconsistencies

In **T 172/82** (OJ 1983, 493) the deletion of a feature in a claim was considered admissible because the sole purpose of such deletion was to clarify and/or resolve an inconsistency. And in **T 271/84** (OJ 1987, 405) it was stated that an amendment to a claim to clarify an inconsistency did not contravene Art. 123(2) or Art. 123(3) EPC 1973 if the amended claim had the same meaning as the unamended claim, on its true construction in the context of the specification.

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

In case **T 60/90** the applicant had deleted the lower limit of a temperature range in order to eliminate an inconsistency between the claims and the examples. Applying the three-point test, the board found that resolving this inconsistency was unobjectionable under Art. 123(2) EPC 1973 (referring to **T 2/80**).

In **T 609/95** the board took the position that where a drafting defect or inconsistency in an application would be evident to a reader skilled in the art, the person to whom the application is addressed, it is reasonable to suppose that he would, in the light of the content of the application, attempt to formulate a notional amendment which would enable him to make sense of what he reads, and to the extent that the amendment might be said to leap to the mind of the reader, although perhaps only after close study of the document, it can be regarded as implicit in the application and would not contravene Art. 123(2) EPC 1973, if effected in practice (see also **T 887/97** for such amendment during opposition appeal proceedings).

In **T 749/03** the respondent (patent proprietor) had made reference to **T 190/99**, which discussed the possibility of amending a granted claim to replace an inaccurate technical statement, which was evidently inconsistent with the totality of the disclosure of the patent, with an accurate statement of the technical features. According to that decision, the skilled person, when considering a claim, should rule out interpretations which were illogical or did not make technical sense. It appeared that in the present case **T 749/03** a similar situation arose - claim 5 as originally filed would, if taken alone, not make technical sense, and even the simple addition of its features to the features of claim 1 would result in an inadequately defined apparatus. However, by taking into account the whole disclosure of the patent the skilled person might arrive at a technically sensible interpretation of the claim.

In that context reference was also made to **T 371/88** (OJ 1992, 157), which concerned the admissibility of amending a granted claim to replace a restrictive term with a less restrictive term. The board in that case had ruled that such replacement was permissible under Art. 123(3) EPC 1973 if examination of the extent of protection conferred by the granted claim resulted in the following conclusions: (a) the restrictive term in the granted claim was not so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the description and the drawings of the patent; (b) it was quite clear from the description and the drawings of the patent and also from the examination procedure up to grant that the further embodiment belonged to the invention and that it had never been intended to exclude it from the protection conferred by the patent. In the present case (**T 749/03**), having regard to claim 1 alone, the features relating to the second (transmission) grating were perfectly clear in their technical meaning. However, in combination with claim 5 they would only make sense if reference were made to the description and drawings. Therefore requirement (a) was met. Further, there could be no doubt that the applicant had not waived that embodiment. Hence requirement (b) was also met.

In **T 1464/05** the board said that the further attempt of the respondent (patent proprietor) to see in the upper ends of range values a removable inconsistency in the application as filed could not, in the context of a wholly consistent and clear disclosure of the application, be accepted.

## 1.11. Errors in the disclosure

### 1.11.1 Calculation errors

In **T 13/83** (OJ 1984, 428), a case decided prior to **G 3/89** (OJ 1993, 117) and **G 11/91** (OJ 1993, 125) (see in this chapter II.E.4. "Correction of errors in the description, claims and drawings – Rule 139 EPC" below), the board held that R. 88 EPC 1973 (R. 139 EPC) did not apply to a non-obvious correction of an error in the description or claims which resulted from an erroneous technical calculation. A correction of such an error was allowable under Art. 123(2) EPC 1973 if the amendment would be regarded by the skilled reader as clearly implied by the disclosure of the application as filed. If more than one arithmetical possibility of correction could be envisaged, the correction chosen had to be the one which the application as a whole clearly implied (see also **T 784/96**, which cites **T 13/83**).

### 1.11.2 Incorrect structural formula

In **T 552/91** (OJ 1995, 100) the question arose as to whether and in what form protection could be obtained for groups of chemical substances and individual compounds whose originally disclosed structural formula proved incorrect. The applicant's main request was aimed at securing such protection by a further substance claim for the group of compounds with the structural formula subsequently found to be correct. This request was refused on the grounds that it would violate Art. 123(2) EPC 1973. The board held that 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 (for decisions referring to **T 552/91**, see **T 1074/97** and **T 2003/07**; for a further example of the correction of an error in a formula, see **T 1728/07**).

### 1.11.3 Amendment based on erroneous figure in the disclosure

In **T 740/91** the board allowed a change in the upper limit of a range from 5 % to 0.6 %. The value of 0.6 % was explicitly disclosed in example IV. However, the patentee conceded that this figure had been inserted in error in place of the true figure of 0.49 %. The board concluded that the fact that the figure was wrong did not alter the fact that it was actually and credibly disclosed. It could thus be relied on as the basis for the new upper limit. This interpretation of Art. 123(2) EPC 1973 was consistent with its underlying intention, which was to protect the public from being faced at a later stage with claims which were wider in their scope than what had been disclosed in the application as filed, and published for the information of the public, including the applicant's competitors. In this case, any such competitor who had read the application as first published had formed the view that the originally claimed range of 0.1 to 5 % was too wide in the light of the prior art, and had thought that the broad claim could not validly be sustained. He would have seen at once that the highest figure for the cured epoxy resin given in any

example was 0.6 %, as clearly disclosed in example IV, and therefore could not have been taken by surprise if the upper limit of 5 % were later to be reduced to 0.6 %. The fact that the figure was wrong would be unknown to competitors, and therefore could not influence their judgment.

#### 1.11.4 Incorrect information in earlier application as filed but correct information directly and unambiguously derivable

In **T 1088/06** an appeal was filed against the decision of the Examining Division refusing the European patent application, which had been filed as a divisional application on the ground that the application extended beyond the content of the earlier application as filed. Both the expression " $10^{-4}$  to  $10^{-9}$ " and the expression " $10^4$  to  $10^9$ " had occurred several times in the earlier application; the divisional application referred to a range between about  $10^4$  to  $10^9$  Ohm/cm<sup>2</sup>. The Examining Division held that the correct range could not be directly and unambiguously derived from the parent application as originally disclosed. The board could not agree. If information in the earlier application was **objectively recognisable** by the person skilled in the art as information that was **incorrect**, and if the person skilled in the art would derive the correct information directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents of the earlier application as filed, then the correct information belonged to the content of the earlier application and might be used to decide whether a divisional application extends beyond the content of the earlier application as filed (Art. 76(1) EPC). In the case before it, the board concluded that the range mentioned in the divisional application did not introduce subject-matter extending beyond the earlier application as filed.

## 1.12. Description and drawings

### 1.12.1 Disclosure in drawings

When examining whether there is support for a feature in a drawing the exact same standards must be applied as for the description: the crucial point is what the skilled person would derive directly and unambiguously from the drawing using common general knowledge (**T 2537/10**).

The case law according to **T 169/83** (OJ 1985, 193) - which has been frequently cited -, **T 523/88** and **T 818/93** shows that the EPC does not prohibit the amendment of claims to include **features from drawings**, provided the structure and the function of such features were clearly, unmistakably and fully derivable from the drawings by the skilled person and not at odds with the other parts of the disclosure. Nor could any element be dropped.

Indeed, in **T 169/83** (OJ 1985, 193), **T 465/88** and **T 308/90** it was pointed out that where drawings existed they were to be regarded as an integral part of the documents disclosing the invention. Drawings were to be **treated on an equal footing with the other parts of the application** (see also II.E.1.1.1 "Description, claims and drawings"). Further, the fact that features were disclosed solely in the drawings did not preclude

these features from becoming essential in the course of the proceedings (**T 818/93**). The features for which a skilled person could clearly derive the structure and function from the drawings could be used to define more precisely the subject-matter for which protection was sought (**T 372/90**).

In **T 398/92** the patent claims as amended contained features that had not been mentioned *expressis verbis* in the written part of the original application but had been derived from the figures for the application as filed. The drawings in question illustrated the curves in a system of Cartesian co-ordinates with a precise, defined scale. The curves therefore could not be compared to the schematised representation of an invention given by a graph. The board recognised that the points of these curves were not purely intellectual graphic constructions but, on the contrary, corresponded to real experimental values, representing the percentages of a particular drug released in solution. Although these percentages were not mentioned *expressis verbis* in the original document, the board was of the opinion that for a skilled person they would have been clearly and unambiguously derivable from the scale given on the Y-axis, since the figures were sufficiently precise for the ordinate values to be read exactly and thus for the same numerical features as introduced in the claims to be derived from them. The incorporation into the text of the claims of the numerical features derived from the curves therefore did not contravene Art. 123(2) EPC 1973 (as far as **a graph representing a mathematical equation** is concerned, see **T 145/87**). This case related to a process for regulating the print quality of printers which could only be carried out using statistical calculations. On the basis of a formula given *expressis verbis*, its representation as a graph according to the Cartesian co-ordinate system and a basic knowledge of statistics, the possible values of two parameters in the formula, though not expressly disclosed, could be deduced.

In **T 191/93** amendments were based exclusively on the original drawings and introduced only some of the features disclosed in the drawings. The board held that the subject-matter of the patent had been extended compared to the application as filed because it was not derivable from the drawings that the two newly introduced features could be **isolated from the other features** shown in the drawings. The subject-matter defined in the claims thus amended was ambiguous. In this case, however, the ambiguity could be removed by also introducing into the claim a third feature, disclosed in the drawings as filed, together with the other two features. (For a case where the isolation of features from a drawing amounted to an unallowable intermediate generalisation, see **T 1408/04**.)

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

content of an application was defined not only by features mentioned or shown therein but also by their relationship to each other.

In **T 497/97** the board noted that, since drawings were often approximate and therefore unreliable, they could only be used in interpreting amended claims if the description did not contain a more precise indication of what was meant. Moreover, in the case at issue, the drawings showed only a preferred embodiment of the invention, which did not rule out the possibility of other embodiments covered by the claimed subject-matter. The board concluded that the contested wording, inserted in the characterising portion of claim 1, had been validly based on the description according to the application, i.e. that the wording had been inferable from its context without extending its meaning.

In **T 748/91** the board reached the conclusion that size ratios could be inferred even from a **schematic drawing** as long as the delineation provided the relevant skilled person with discernible and reproducible technical teaching. In the board's view, schematic drawings depicted all the essential features.

In **T 614/12** the board found that the drawing did not show any measurements or scale or give any other indication that it was an exact engineering drawing reproducing the construction elements to scale. It was thus no more than a schematic illustration of the kind commonly found in patent documentation. The imprecision of such an illustration made it impossible to measure angle sizes.

In **T 170/87** (OJ 1989, 441) the board held that a figure which served only to give a schematic explanation of the principle of the subject-matter of the patent and not to represent it in every detail did not allow the sure conclusion to be drawn that the disclosed teaching purposively excluded a feature not represented. Such a **"negative" feature** (in this case, "with no internal fittings") could not subsequently be incorporated into the claim ( see also **T 410/91** and **T 1120/05**). Regarding the absence of a feature in a figure which served only to give a schematic explanation of the principle of the invention, see also **T 264/99**, in which the board found the circumstances to be different from those in **T 170/87**.

Likewise, in **T 906/97** the board held that the parent application as filed failed to disclose unambiguously the position of a door. The only indication of this position could be found in some figures, and in the board's view there was no suggestion whatsoever in the description itself that this detail of the schematic representation was actually meant to correspond to a technical feature of the apparatus shown in the figures, rather than being merely an expression of the draughtsman's artistic freedom.

In **T 1120/05** the invention concerned an "arrangement for and a method of managing a herd of freely walking animals" and the amendment introduced a **negative feature** namely "but not to the milking station". This negative feature was not expressly disclosed in the description and in the claims of the patent application as filed. Features could be taken from the drawings if their structure and function were clearly, unmistakably and fully derivable from the drawings. It was not possible to derive a negative or missing feature on its own, i.e. without the context of the other, existing features of the claim.

Moreover, **arbitrarily** choosing one of many possible negative features was not permitted (see also **T 777/07**), because the skilled person not only had to realise the possible negative features, but because they were derived from the drawings, he also had to establish which one of the features was essential to the invention and which ones were not. The board found that in the absence of a teaching from the description, the skilled person would be unable to establish the essential nature of a single negative feature, seen against a background of a multitude of potentially essential features, even if this selected single negative feature in the drawings could be recognised by the skilled person in the drawings.

In **T 1544/08** the board observed that, if **drawings** were originally filed **in colour** at the date of filing of an application, then the technical content of these original colour drawings should be determined taking into account the available evidence when establishing the content of the application as filed, for the purpose of examining compliance of amendments with Art. 123(2) EPC.

#### 1.12.2 Shift in the interpretation of claim by amending description

In **T 500/01** the board stated that a claim, the wording of which was essentially identical to a claim as originally filed, could nevertheless contravene the requirements of Art. 123(2) EPC 1973 if it contained a **feature whose definition was amended in the description** in a non-allowable way. The specific definition of a feature which according to the description was an overriding requirement of the claimed invention was applied by a skilled reader to interpret that feature whenever it was mentioned in the patent. Since in this case the definition had no basis in the application as filed, claim 1 did not meet the requirements of Art. 123(2) EPC 1973.

In **T 1239/03** it was not in dispute between the parties that no part of the patent contained a definition of the ethylene content of the elastomeric copolymer in terms of weight percent. Prior to the amendment, preference was given to the interpretation "mol percent", which, with the deletion of example 3, had shifted towards "weight percent". In such a case, where it was certain that a shift in the interpretation of the claims had occurred, but uncertain if this would lead to an addition of subject-matter, the board took the view that it should be incumbent upon the patent proprietor or applicant as the author of such amendment(s) to demonstrate that the requirements of Art. 123(2) EPC 1973 were complied with in making them. In the case at issue, the patent proprietor was unable to show that the percentage value could have been consistently interpreted as "weight percent" before and after the amendments.

In **T 1227/10** the claim as granted was similar to the claim as originally filed. However, other than in the patent as granted, the original application also contained a figure 1 labelled as prior art and a corresponding passage of the description. The board found that the original application did not include the possibility of using a filter as gas solid separator for further treating the underflow of the TSS before entering the wet scrubber, whilst the patent as granted encompassed such a possibility. Hence, the deletion of original figure 1 and of the related passage of the description had modified the



application in such a way that the granted claim 1 included subject-matter which was excluded from the originally filed invention.

#### 1.12.3 Shift in the information provided by the examples after amendment of claims

**T 97/05** concerned an amendment of a claim resulting in a shift in the information provided by examples. During the opposition proceedings, claim 1 was modified by replacing the term "chemically" with "covalently" in order to specify the nature of the bond between the anionic groups and the core. The information provided by the description was that the bonding between the core and the anionic group was "chemical" and that one type or species of "chemical" bonding was "covalent". The term "chemically bonded" as employed in the general description of the application as filed encompassed, but did not specifically disclose, compounds in which the anionic moieties were "covalently" bonded to the core. In the board's view a consequence of the amendment of the claims by replacement of the generic term "chemically bonded" by the specific term "covalently bonded" was that the examples of the patent acquired by association information, i.e. that the anionic groups were covalently bonded to the core, which was not - even implicitly - contained by the same examples in the application as filed. Thus there was a shift in the information provided by the examples in the patent as amended according to the main request compared to that provided by the same examples in the application as filed, even though the examples themselves had not been modified (by analogy with **T 1239/03**). Therefore the main request did not meet the requirements of Art. 123(2) EPC 1973.

#### 1.12.4 Replacement of complete description and drawings

In **G 2/95** (OJ 1996, 555) the Enlarged Board observed that a correction affecting the content of the application could only be effected within the limits of Art. 123(2) EPC (as defined in **G 3/89**, OJ 1993, 117). The complete documents forming a European patent application, that is the description, claims and drawings, could not be replaced by way of a correction under R. 88 EPC by other documents which the applicants had intended to file with their request for grant.

In **J 16/13** the board held that the *ratio decidendi* of **G 2/95** (and also of **J 5/06**) was also applicable to all cases where at least a complete description was sought to be exchanged.

### 1.13. "Comprise", "consist (essentially) of", "contain"

In **T 759/10** it had to be examined whether there was a clear and unambiguous implicit disclosure in the application as filed providing a basis for the amendment from "comprises" to "consists essentially of". The appellant argued that the term "**comprising**" encompassed three alternatives, namely (i) "comprising", (ii) "consisting of" and (iii) "consisting essentially of", and that each of these alternatives would immediately come to the skilled person's mind when reading the term "comprising". The term "comprises" was therefore in itself already a sufficient basis for the term "consists essentially of". The board could not accept this argument as each term had a different

technical meaning, namely (i) that any further component can be present ("comprises"), (ii) no further component can be present ("consists of") and (iii) specific further components can be present, namely those not materially affecting the essential characteristics of the texturizing agent ("consists essentially of"). Therefore the skilled person was not at liberty to choose whichever of the three terms he wished when reading the term "comprises". The board further refused the request for referral of questions to the Enlarged Board of Appeal. Although the board agreed with the appellant that the two boards in decisions **T 472/88** and **T 975/94** appeared to have considered the term "comprises" in itself to be a sufficient basis for the term "consists essentially of", the jurisprudence of the boards had further developed since these two decisions, in particular by way of the two later decisions of the Enlarged Board of Appeal in **G 2/98** (OJ 2001, 413) and **G 1/03**. In line with these decisions of the Enlarged Board of Appeal, more recent decisions of the boards of appeal, e.g. **T 868/04**, **T 725/08** and **T 903/09**, had applied the criterion of clear and unambiguous disclosure to decide on the allowability of the amendment of the term "comprises" to "consists essentially of". Consequently, a uniform approach had been developed by the jurisprudence, according to which an amended feature must, explicitly or implicitly, be directly and unambiguously disclosed to the skilled person using common general knowledge in the application as filed in order to be allowable under Art. 123(2) and 100(c) EPC.

In **T 56/08** the board rejected the respondent's argument that the verb "to contain" had a more restrictive meaning than the verb "to comprise"; the board pointed out that the general meaning of the verb "to contain" was "to have in it", "to hold", "to include", "to encompass" or "to comprise".

In **T 1170/07** it had to be established what the term "consisting essentially of", which could not be found in the original application, meant in the context. The board recalled on this occasion that claims should be read in a technically reasonable way. It concluded in this case that the substitution of "consisting essentially of" for "comprising" was allowable under Art. 123(2) EPC.

In **T 107/14** the appellant (opponent) argued that claim 1 extended beyond the content of the application as filed because it was directed to an alloy "consisting of" the given elements, whereas claim 1 as originally filed related to an alloy "comprising" the given elements. The board held that, since the originally filed claims were already directed to closed compositions, there was no doubt that the composition stipulated by claim 1, "consisting of" the given elements, was already disclosed in the application as originally filed. The board observed that in **T 725/08** and **T 759/10** the replacement of the word "comprising" by "consisting essentially of" was found to contravene Article 123(2) EPC, but the replacement of the word "comprising" by "consisting of" was actually allowed.

#### **1.14. Reformulating the technical problem**

Expanding on **T 13/84** (OJ 1986, 253), it was stated in **T 547/90** and **T 530/90** that reformulating the technical problem was not in breach of Art. 123(2) EPC 1973 provided the problem as clarified and the solution proposed could have been deduced from the application as a whole in the form originally filed (see **T 871/08**, **T 2076/09**).

## 2. Article 123(3) EPC – extension of the protection conferred

According to Art. 123(3) EPC the European patent may not be amended in such a way as to extend the protection it confers. This refers to the patent as a whole. The wording of Art. 123(3) EPC 1973 had referred only to the claims of the patent; however, already under the EPC 1973, the boards had held that amendments to the description and the drawings could also extend the protection conferred within the meaning of Art. 123(3) EPC 1973 (see **T 1149/97**, OJ 2000, 259).

Art. 123(2) EPC and Art. 123(3) EPC are mutually independent of each other, **G 1/93** (OJ 1994, 541); the same is true for Art. 76(1) EPC and Art. 123(3) EPC, **T 1736/09**.

### 2.1. Purpose of Article 123(3) EPC

Art. 123(3) EPC is directly aimed at protecting the interests of third parties by prohibiting any broadening of the claims of a granted patent, even if there should be a basis for such broadening in the application as filed (**G 1/93**, OJ 1994, 541). In accordance with the general intention of Art. 123(3) EPC, there should be legal certainty for the activities of third parties trusting that the protection conferred by a patent can only be restricted, but not extended (**T 1149/97**).

The object of Art. 123(3) EPC is to prevent any procedural situation where an act which does not infringe the patent as granted becomes an infringing act as a result of an amendment after grant (see **T 1149/97**, **T 1898/07** referring to **T 59/87** and **T 604/01**).

### 2.2. Totality of claims

In accordance with the established case law of the boards of appeal, the legal notion "protection conferred" in Art. 123(3) EPC refers to the **totality** of protection established by the claims as granted and not necessarily to the scope of protection within the wording of each single claim as granted (**T 579/01**, **T 1456/06**, **T 1544/07**, see also **T 49/89**, **T 402/89**).

Under Art. 123(3) EPC, the patentee is generally allowed to redraft, amend or delete the features of some or all claims and is not bound to specific terms used in the claims as granted as long as the new wording of the claims does not extend the scope of protection conferred as a whole by the patent as granted (and does not violate the requirements under Art. 123(2) EPC). Thus, in order to assess any amendment under Art. 123(3) EPC after grant, it is necessary to decide whether or not the totality of the claims before amendment in comparison with the totality of the claims after amendment extends the protection conferred (**T 579/01**, **T 1898/07**).

## 2.3. Extent of protection

### 2.3.1 Article 123(3) EPC and Article 69 EPC

In **T 325/95** the board pointed out that the assumption that the extent of protection referred to in Art. 123(3) EPC 1973 would depend not only on the actual wording of the claims, but also on their validity in view of the prior art, was not supported by the explicit statement in Art. 69 EPC 1973 that "the extent of the protection conferred by a European patent ... shall be determined by the terms of the claims". The appellant's submissions in effect implied that claims amended in opposition proceedings should always have a counterpart in the set of claims as granted. This was not in line with the consistent case law of the EPO either. Attention was drawn for instance to decision **G 2/88** (OJ 1990, 93), which ruled that replacement of a granted claim to a compound or composition by a claim directed to a new use of the compound or composition was admissible under Art. 123(3) EPC 1973.

In **T 177/08**, with reference to Art. 123(3) EPC, the board referred to Art. 69(1), second sentence, EPC, which provides that the description and the drawings are to be used to interpret the claims. The board said that it had therefore to be decided whether said interpretation of the claims by the content of the description was limited to cases where the claims were in need of interpretation, e.g. because of functional or unclear features, or whether it also applied to the case at issue, where a well-known and generally accepted meaning of a term was overthrown and replaced by a **new definition given in the description**. The board was of the opinion that the second sentence of Art. 69 EPC did not apply to cases where an unambiguous and generally accepted definition of a term figuring in the claims was to be superseded by a different definition found in the description. If it was intended that a term which was in no need of any interpretation be given a new meaning, then the definition for this new meaning had to be put into the claims. Third parties could not be expected to check every single term of the claims for a potentially different meaning that might be hidden somewhere in the description. As a consequence, the board concluded that the subject-matter of the main request extended the protection conferred and did not meet the requirements of Art. 123(3) EPC.

In **T 547/08** the board stated that the appellant's(opponent's) arguments relating to the rights of the patent proprietor to sue for indirect or contributory infringement were not relevant to the issue of extension of the scope of protection under Art. 123(3) EPC. In **G 2/88** (OJ 1990, 93) it was clearly ruled that it was **not necessary to consider the national laws of the contracting states** in relation to infringement and that this issue was not relevant when deciding upon admissibility of an amendment under Art. 123(3) EPC. With respect to the question of an extension of the scope of protection under Art. 123(3) EPC, it was, rather, appropriate to take into account the fact that the protection conferred by a patent was determined by the terms of the claims, and in particular by the categories of the claims and their technical features, in accordance with Art. 69(1) EPC and its protocol (**G 2/88**, OJ 1990, 93).

In **T 1172/08** the board considered that the interpretation of the protection conferred by a patent according to Art. 69 EPC was in general not one of the duties of the boards of

appeal (cf. **T 175/84**). For the purpose of establishing whether the amendments of the main request fell foul of the provisions of Art. 123(3) EPC, it was however necessary to do so. The board stated that claim 1 as granted and claim 1 of the main request, when read on their own, provided protection for different subject-matter. The patent proprietor agreed that normally such a shift in the extent of protection would not be allowable. It argued, however, that the case at issue was very particular because the claims as granted did not embrace the subject-matter of the only example of the patent specification. The board had no doubts and the parties did not dispute that dendritic cells and monocytes were different cell types characterised by different features. Thus, the skilled person would a priori not have had any reason to read a different technical meaning into the term "obtaining from a blood sample a solution of dendritic cells". Reading the patent proprietor's interpretation into claim 1 would require the skilled reader to completely ignore the wording of granted claim 1, which per se was not technically meaningless, with the consequence that the wording of claim 1 would merely serve as an empty shell. This was clearly not in the sense of Art. 69 EPC nor in the sense of the protocol on its interpretation. Moreover, the interest of third parties in legal certainty would be completely ignored, if the patent proprietor's interpretation were found to be acceptable. The board came to the conclusion that the main request did not meet the requirements of Art. 123(3) EPC.

In **T 2284/09** the effect of the amendment of claim 1 was to enlarge the scope of protection conferred by the claim as compared to the patent as granted. This contravened Art. 123(3) EPC. The appellant (patent proprietor) had relied upon decision **T 108/91** (OJ 1994, 228), according to which, in the case of inconsistency between the claim and the totality of the disclosure, it was permissible to refer to the description and, pursuant to Art. 69(1) EPC, to rely on the disclosure of the description to amend the claim. **T 108/91** was however not applicable in the case at issue, since there was no inconsistency between the claim of the granted patent and the description. Furthermore decision **G 1/93** (OJ 1994, 541) ruled that in the case of a non-disclosed limitation being introduced during examination proceedings (as was the case here), it was not permissible to remove it when so doing would extend the scope of protection. In **G 1/93** the role of Art. 69(1) EPC was also considered and it was concluded that the description was to be used for assessing in particular sufficiency of disclosure and in determining the scope of protection conferred by the claims. However, there was no finding in **G 1/93** that supported the position of the appellant that the description might be used as a repository from which amendments to the claims could be derived even if such amendments would contravene Art. 123(3) EPC. Accordingly there was no basis in the EPC or in the case law of the Enlarged Board to support the position and approach of the appellant in relying on the description in order to render permissible an amendment to the claims of the patent as granted that resulted in a change of the scope of protection. The second auxiliary request was refused.

In **T 1736/09** the board held that, in determining whether amendments made in opposition proceedings complied with the requirements of Art. 123(3) EPC, the protection conferred by European patent was determined by the claims of the granted patent, the description and drawings of the granted patent being used to interpret the claims in accordance with Art. 69(1) EPC and its Protocol. For the purpose of

examination under Art. 123(3) EPC it was irrelevant whether the granted patent met the requirements of Art. 123(2) EPC or Art. 76(1) EPC.

### 2.3.2 Cut-off point

The decisions reported below, while likewise looking at the extent of protection, additionally address the question of whether the grant of the patent constitutes a cut-off point for making amendments to the application documents.

In **T 1149/97** (OJ 2000, 259) the board decided that, without opposition, issue of a decision to grant a European patent normally constituted a cut-off point for making amendments to the application documents in the European proceedings. If an opposition has been filed, cut-off effects due to the grant of a patent might be seen in the restrictions which R. 57a, R. 87 and Art. 123(3) EPC 1973 imposes on further amendment of the patent specification. Although Art. 123(3) EPC 1973 addressed only the claims of the European patent, amendments to the description and the drawings might also extend the protection conferred in accordance with Art. 69(1) EPC 1973. If, in view of Art. 84 and Art. 69 EPC 1973, the application documents were adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule subject-matter deleted for this reason could not be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) EPC 1973. An analogous finding applied to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention. The findings in **T 1149/97** are, for example, summarised in **T 1481/05**. The outcome in **T 1481/05** is different since the facts were substantially different from **T 1149/97**.

Dealing with the allowability of amendments in **T 81/03**, the board detailed why it considered that the facts of the case dealt with in **T 1149/97** (OJ 2000, 259) differed from those of the case in point, contrary to the opponents' allegation of a substantive cut-off effect of the grant of a European patent. In reply to the opponents' second line of argument it further stressed that Art. 69 EPC 1973 and its Protocol were to be applied in proceedings before the EPO whenever it was necessary to determine the protection conferred (see for example **G 2/88**, OJ 1990, 93). Equivalence considerations obviously often played a prominent role in national infringement proceedings, and although equivalents were not mentioned in the EPC 1973, they would be in the Protocol on Art. 69 of the revised Convention, EPC 2000 (OJ SE 1/2003, 73). Nevertheless, in spite of the indisputable importance of the concept of equivalence for the determination of the scope of protection, if the opponents had been right in their allegations, it would never be possible to amend a claim during opposition proceedings - although this was provided for in the Convention - since the addition of any new feature to some extent necessarily reduced the weight of the features in the claim as granted. This was particularly true when the subject-matter of the granted claim was not new, the situation in which amendments were most called for. For that reason the argument could not be accepted. The board thus found that the general, abstract concern that the addition of a feature to a claim after grant led to an extended scope of protection because the resulting

combination of features might give rise to a different evaluation of equivalents in infringement proceedings was not in itself a sufficient reason for not allowing the addition of limiting features under Art. 123(3) EPC 1973.

The board agreed with the patent proprietor that there was no basis in the EPC 1973 for the idea that amendments after grant had to be based on subject-matter contained in the patent specification. The wording of Art. 123(2) EPC 1973 was unambiguous. It was Art. 123(3) EPC 1973 which was intended to protect the interests of third parties, as pointed out by the Enlarged Board in **G 1/93** (OJ 1994, 541). In the board's view it followed that amendments to a European patent could be based on the whole reservoir of features originally disclosed in the corresponding application, provided that Art. 123(3) EPC 1973 was not infringed by such amendments, due account being taken of the provisions of Art. 69(1) EPC 1973.

In **T 241/02** in the board's view neither the fact that the appellant (proprietor) approved the text of the patent in suit nor considerations with respect to legal certainty added to the requirements relating to amendments in R. 57a or Art. 123(2) EPC 1973. The grant of a patent therefore did not necessarily constitute a final and automatic cut-off point ruling out any reinsertion of deleted subject-matter (in the case at issue, reinsertion of portions of the description relating to the process claimed). The said reinsertion complied in this case with both R. 57a and Art. 123(2) EPC 1973. It remained therefore for the board to examine whether the requested reinsertion satisfied Art. 123(3) EPC 1973. The opposition division had concluded on the basis of **T 1149/97** (OJ 2000, 259) that reinsertion would not be possible, since it would contravene Art. 123(3) EPC 1973, but without referring to any specific parts or making any connection between parts to be reinstated and any concrete conclusion as to how the product claims would be extended in contravention of Art. 123(3) EPC 1973. The board decided that, by contrast with the situation in **T 1149/97**, in the case in point the appellant had deleted too much of the description, overlooking the relevance of parts of it to these remaining claims. According to the board, **T 1149/97** did not lay down a strict rule. It required that an examination of a request for reinsertion be carried out with a view to establishing whether or not Art. 123(3) EPC 1973, on the facts of each case, was indeed infringed. Since the requested reinsertion had to be examined in detail, in the case at issue the opposition division's decision was not sufficient to reject the reinsertion as a whole. Since at that point it was uncertain which parts of the requested reinsertion still might violate one or more requirements of the Convention and the further patentability criteria had not yet been examined in the opposition proceedings, the board decided to remit the case for further prosecution.

In **T 975/03** the appellants/opponents referred to decisions **T 420/86** and **T 61/85** in support of their argument, regarding the reintroduction of the feature of claim 1 deleted before the grant of the patent, that the appellant (patent proprietor) could not reinsert into the patent a feature it had deleted during the examination procedure, as such deletion was equivalent to abandonment. In the board's view, however, no legal grounds for the latter assertion were indicated in **T 420/86** (or in **T 61/85**). This decision had also preceded the ruling in **G 7/93** (see point 2.1 of the Reasons). The board even held that the grant of a patent did not necessarily establish an automatic and final cut-off point

which ruled out any reintroduction of deleted subject-matter. The amendment in the case at issue was therefore allowable, provided that it did not breach the requirements of R. 57a and Art. 123(2) and (3) EPC 1973. The feature in question was introduced by the appellant (patent proprietor) in order to counter a novelty objection; therefore, the amendment complied with the requirements of R. 57a EPC 1973. The feature was contained in the application as filed, e.g. in claim 1, so the requirements of Art. 123(2) EPC 1973 were also met. Since the feature limited the extent of protection conferred by the claim, the requirements of Art. 123(3) EPC 1973 were met, too. The board therefore concluded that inserting the feature of claim 1 was allowable with respect to the formal requirements of the EPC. The board also decided to refuse the request for referral of a point of law to the Enlarged Board of Appeal. After analysing the case law, the board concluded *inter alia* that none of the cases involved the constellation in which a feature was allowable under Art. 123(3) EPC 1973 but was then disallowed because of a supposed cut off effect or an abandonment.

### 2.3.3 General claim interpretation

Decision **T 190/99** gives guidance on how to interpret a claim as granted for the purpose of Art. 123(3) EPC. The skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity, i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent (Art. 69 EPC). The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding (this frequently cited decision was recently referred to, for example, in **T 1084/10**, **T 1190/11**, **T 1009/12**, **T 640/14**).

In **T 287/11** the question to be answered was whether the claims of the main request covered any compositions or methods which were not covered by the claims as granted. The board considered decision **T 999/10**, which had been cited by the appellant, where it was stated that in view of the sequential ("cascade") formulation of the claim, there was no doubt as to the "intention" of the patent proprietor that no other block copolymers other than the specific SIS-type might be present in the adhesive. The board in the case at issue held that the scope of protection should **not be interpreted**, however, **in the light of the intention of the drafter of a claim**, since this was a subjective criterion, but rather on the basis of the meaning generally accepted by the person skilled in the art to the technical features defined in said claim. The board was thus not convinced by argumentation based on any alleged intention of a drafter of a claim.

## 2.4. Deletions and replacements

### 2.4.1 Deletion of a feature in a claim

In **T 666/97** the product claim of the auxiliary request no longer included a process feature which was included in the product claim as granted. In the board's view, it followed from the fact that the subject-matter for which protection was claimed in the auxiliary request was a product that it could only be characterised by features manifest in/on the product itself. That meant that manipulations taking place during product



manufacture but not resulting in product features were of no relevance to the definition of the claimed product and hence to the scope of protection of the claim. That was an unavoidable implication of the established case law of the boards of appeal, under which the subject-matter of a product-by-process claim derives its novelty not from new procedural steps but purely from structural features (see **T 205/83**, OJ 1985, 363). Thus, to resolve the issue of compliance with the requirements of Art. 123(3) EPC 1973, what had to be decided was whether the omitted product-by-process feature was technically significant for the definition of the claimed product, i.e. whether it was a product feature. The board found that in the present case the omitted feature was not a product feature. Thus the claim had not been extended within the meaning of Art. 123(3) EPC 1973.

In **T 1407/05** the board considered that claim feature A described essential technical characteristics of the claims as granted. Feature A was removed from the wording of the claims in all pending requests; all other claim features remained essentially the same. The board held that the removal of a positive technical feature from an independent claim *prima facie* resulted in a broadening of the scope of protection afforded by it and therefore contravened Art. 123(3) EPC.

#### 2.4.2 Deletion of important feature from description where claim remains unchanged

In **T 142/05** the board found that, even where the wording of the granted claims was unamended and clear, the mere **deletion from the description of an important desired property** of the patented subject-matter led to an extension of the scope of protection which contravened Art. 123(3) EPC 1973 (this is different in the case of an optional, hence not important feature, see **T 71/10**). The question arose whether, although the wording of the granted claims remained unchanged, the mere fact of deleting the above sentence from the description could extend the protection conferred by the patent and lead to a violation of Art. 123(3) EPC 1973. Construed literally, this provision could be taken to mean that amendments to the description were not affected by this restriction, since only the patent claims were mentioned. The board concluded that, although the claims were the most important element in determining the extent of protection, **the wording of the claims should not be seen as the sole relevant factor**; instead, the description and drawings were to be used in interpreting the claims. From this, it followed that even if the wording of a claim was clear and unambiguous, i.e. where the scope of its literal meaning was clear, reference was still to be made to the description and claims. This could lead to a different interpretation of the claim, diverging from that obtained by considering only its literal meaning. Amendments to the description and drawings could modify the content of the claims and thereby extend the scope of protection according to Art. 69(1) EPC 1973, even where the wording of the claims was clear and remained unamended. In the board's view, the deletion in the case at issue had the effect of generalising the teaching of the patent. Art. 123(3) EPC 1973 had therefore been contravened.

#### 2.4.3 Deletion of examples for a general feature

The board in **T 1052/01** took the view that deleting examples given in claim 1 as granted (here "valve, restrictor, etc.") for a general feature (here "hydraulic functional unit") did

not extend the protection conferred, as these examples were embraced by the general feature which determined the extent of the protection conferred.

#### 2.4.4 Deletion of disclaimer referring to trade names

In **T 532/08** the board held that, in the case at issue, the disclaimer could only be omitted without extending the scope of protection if it was beyond doubt that the components identified by trade names did not comprise any of the claimed tensides. However, it could not be unequivocally established what was excluded by a disclaimer referring to trade names.

#### 2.4.5 Deletion of a drawing

In **T 2259/09**, whilst the patent as granted comprised a set of Figures, in the amended patent according to the main request all drawings were deleted to comply with the requirements of Art. 123(2) EPC, and the description was correspondingly adapted. Concerning the examination of Art. 123(3) EPC, with the deletion of the drawings from the patent specification, technical information was undoubtedly lost. Whilst this loss of information might also introduce some uncertainties about certain details of the preferred embodiments depicted in the drawings, it could not be concluded, as in the impugned decision, that it automatically broadened the protection conferred by the patent. In the case at issue, the claims were not limited to any of the details, dimensions or features specifically depicted in the (deleted) drawings. Moreover, under Art. 69(1) EPC, reference to the drawings of a patent specification may be helpful or even necessary if an ambiguity exists in the granted claim. However, in the case at issue, the impugned decision did not identify any such ambiguity; nor could the board see any. Therefore, the deletion of the drawings did not extend the scope of the protection conferred by the main request.

#### 2.4.6 Deletion of feature in a claim mentioned "in particular"

In **T 260/10** the feature "having at least one optical display unit and in particular at least one operating unit ..." in claim 1 as granted had been replaced and the words "**and in particular** at least one operating unit" thereby deleted. The board found that it generally depended on the specific context whether a feature following the expression "in particular" had to be regarded as optional. As a rule, an optional feature in the main claim was one which was not essential to the claimed teaching but instead served as an example illustrating other features. The wording used in claim 1 as granted meant that the claimed domestic appliance included not only an optical display unit but also an operating unit, the expression "in particular" having to be construed in the sense of "above all" or "especially". The operating unit was specified not as an example of a possible component, but rather as an essential part of the domestic appliance. In this case, "in particular" gave special emphasis to the operating unit as part of the appliance. The scope of protection was limited by this non-optional feature and its deletion therefore infringed Art. 123(3) EPC (see also **T 916/08**).

#### 2.4.7 Reducing scope of claim by adding embodiments to a negative feature

In **T 363/11** the board considered that the feature concerned was a negative feature, in the sense that it defined embodiments which were excluded from the claim. Since after the amendment more embodiments were excluded from claim 1 of the request than from claim 1 as granted, its scope was reduced vis-à-vis granted claim 1 and the requirements of Art. 123(3) EPC were satisfied.

#### 2.4.8 Replacement of a restrictive term by a less restrictive term

In **T 371/88** (OJ 1992, 157) the board held that Art. 123(3) EPC 1973 was not contravened if a restrictive term in a granted claim which in its strict literal sense did not embrace an embodiment set out in the description was replaced by a less restrictive term clearly embracing also this embodiment. The restrictive term should not, however, be so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the description and drawings. Moreover, it had to be quite clear from the description and drawings and also from the examination procedure up to grant that the further embodiment belonged to the invention and that it was never intended to be excluded from the protection conferred by the patent (see also **T 673/89**, **T 738/95**, **T 750/02**, **T 749/03**).

In **T 824/08** the board observed that the rationale of **T 371/88** could not be applied in the case at issue since the limiting feature was clear in itself and did not pose any problems when determining the extent of protection conferred by the claim.

In **T 795/95** the board did not share the appellant's view that deleting the feature "preferably polyvinyl or polyethylene" from the preamble of granted Claim 1 extended the protection conferred. The formulation "preferably polyvinyl or polyethylene" had no bearing on the scope of protection, which was determined by the more general term "plastic" and not the specific preferred substances polyvinyl or polyethylene. Deleting a "preferred" feature did not extend the scope of protection if such feature was encompassed by an earlier and general one (in this case, "plastic") which determined the protection conferred.

#### 2.4.9 Replacement of "cell of a plant" by "plant"

In **T 579/01** independent claim 1 and dependent claims 2 to 6 of the new main request were directed to a "vegetable plant", while the respective claims as granted were directed to a "cell in a vegetable plant". The board decided that **any** plant as subject-matter of claim 1 of the new main request fell within the protection conferred by a claim to "a cell of a plant", and finally that the "plant" now claimed was characterised by the same genetic features as recited in the granted claim to "a cell of a plant". Also taking account of legislative developments in Europe in respect of the legal protection of biotechnological inventions (i.e. Articles 8.1 and 9 of Directive 98/44/EC), the board concluded that the amendment of the "cell of a plant" claim to a "plant" claim was not contrary to the requirements of Art. 123(3) EPC 1973.

#### 2.4.10 Replacement of drawings

In **T 236/12** the drawings published in the patent specification had been replaced by those originally filed. Although the published drawings had disclosed technical information not derivable from those originals, their replacement did not broaden the scope of the patent. The technical features of the claims were explained in sufficient detail in the description, as read together with the originals, so the skilled person could still get a clear idea of the protected subject-matter and how it should look.

#### 2.4.11 Replacement of substance by device containing substance

In **T 1898/07** the appellant (patent proprietor) argued that a claim referring to a packaged kit containing the liquid composition of claim 1 as granted was in fact narrower in scope than a claim referring to the liquid composition, as this claim encompassed the liquid formulation in any possible container, vessel, package or reservoir. The board agreed with the appellant in so far as the scope of protection covered by a claim referring to a physical entity should be considered to encompass the physical entity in any possible package or container. However, it was self-evident that "a packaged kit" was a different physical entity than "a liquid composition". It must not be overlooked that claim 1 of the main request is not directed to "a liquid composition contained in a packaged kit" but to "a packaged kit containing a syringe pre-filled with a liquid composition." In the board's view the content of a package is not a characterising feature of the package per se. Thus, a procedural situation was created where an act, for instance the production of the box, package or other container, which did not infringe the patent as granted, became an infringing act as a result of an amendment after grant. It is precisely this situation which should be prevented by the requirements of Art. 123(3) EPC. A referral under Art. 112(1)(a) EPC was not justified since the board, which examined the teaching of cases **T 579/01** and **T 352/04** (amendment from cosmetic agent to agent including mechanical device) referred to by the appellant, concluded that they did not apply in this case.

#### 2.4.12 Replacement by aliud

In **T 547/08** the appellant's argument that the scope of protection had been shifted to an "aliud", i.e. from a user interface and screen display apparatus to a dialysis machine, and was thus in breach of Art. 123(3) EPC, was not accepted by the board. The board observed that a change from a (granted) claim, directed to a first physical entity, to a second, more complex physical entity (an "aliud") in opposition proceedings was a common and usual procedure entirely in line with the requirements of Art. 123(3) EPC: adding one or more limiting technical features to a claimed device naturally renders the claimed entity more complex and results in a restriction rather than an extension of scope.

#### 2.4.13 Narrowing down a generic class or list of chemical compounds; open claims ("comprising"); sequential drafting ("cascade")

In **T 2017/07** the board stated that a composition which is specified in a claim to comprise a component in an amount which is defined by a numerical range of values is characterised by the feature which requires the presence of the component within that range, as well as by the implicit proviso which excludes the presence of that component in an amount outside of that range. Consequently, the amount of that component present in the composition must not exceed the upper limit of the numerical range indicated. An amendment restricting the breadth of that component, for instance by narrowing down a generic class or a list of chemical compounds defining that component, has the consequence of no longer requiring the presence within that numerical range of those chemical compounds no longer encompassed by the restricted definition of that component and, thus, of limiting the scope of this implicit proviso. A composition which is defined as comprising the components indicated in the claim is open to the presence of any further components, unless otherwise specified. Thus, in a claim directed to an openly defined composition, the restriction of the breadth of a component present therein may have the effect of broadening the scope of protection of that claim, with the consequence that in opposition/appeal proceedings such amended claim may extend the protection conferred by the granted patent (Art. 123(3) EPC).

With reference to **T 2017/07**, the board in **T 9/10** held that the use of the term "comprising" in connection with a numerical range defining the amount of a component implicitly meant that the protection conferred by the claim did not extend to compositions containing that component in amounts outside the defined range.

In **T 999/10** the board considered that sequential drafting (formulation "en cascade") in an open claim ("comprising"), i.e. retaining in an amended claim the broad definition of claim 1 and adding, by means of the expression " and in which ...", an additional limitation, avoided the situation contemplated in **T 2017/07**, where an amendment initially made with a view to limiting a claim in fact extended the scope of protection it conferred (Art. 123(3) EPC).

**T 1360/11** concerned a case where a granted claim, directed to a composition defined in an open manner, typically by means of the term "comprising", and including the presence of a component belonging to a class or list of compounds in a quantity defined by a range, was later amended by limiting the definition of the class or list of compounds. In such a case, in spite of the apparent limitation due to the explicit or implicit deletion of some members of the class or list of compounds, the wording of the granted and amended claims might be such that the deleted compounds were required to be present in an amount within a defined range according to the granted claim, while they might still be present, but with no limitation in quantity, according to the amended claim, therefore resulting in an extension of the protection conferred contrary to the requirements of Art. 123(3) EPC. The problem was well known in the case law, see e.g. **T 172/07**, **T 2017/07**, **T 832/08**, **T 1312/08**, **T 869/10**, **T 287/11**. The board observed that by means of inserting a **double condition** the claim may not extend the protection conferred by the patent. Where, as in the case at issue, a granted claim directed to a composition defined

in an open manner and including the presence of a component belonging to a class or list of compounds in a quantity defined by a range was later amended by limiting the definition of the class or list of compounds, a possible infringement of the requirements of Art. 123(3) EPC might be avoided by including in the amended claim a quantitative condition on the limited class or list of compounds and an additional constraint on the total amount of compounds belonging to the broader class or list.

## 2.5. Transposition of features within claims

In **T 16/86** the board pointed out that it was the subject-matter of the claim as a whole which embodied the invention. Therefore, in so far as a change in the position of a feature inside a claim did not alter its meaning, the extent of protection conferred remained unchanged and such an amendment contravened neither Art. 123(2) nor Art. 123(3) EPC 1973.

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

In **T 96/89** the board again allowed the transposition of features from the preamble of a claim to its characterising portion. This did not alter the subject-matter claimed, and thus did not extend the scope of protection. Nor was it in breach of Art. 123(3) EPC 1973 if terms were first generalised in the preamble, then trimmed back in the characterising portion to the subject-matter originally disclosed. R. 29(1) EPC 1973 required that claims be delimited against the nearest prior art; before the preamble to an independent claim could be drafted at all it was often necessary to select from two restrictive terms (the subject-matter claimed and the closest prior art) a general term covering both.

In **T 49/89** the subject-matter of granted claim 1 had been limited during opposition proceedings to a special embodiment according to granted dependent claim 2. The board of appeal held that the protection had not been extended because new claim 1 indicated all the features in granted claim 1 and the newly incorporated features were merely elaborations on those contained in granted claim 1. The extent of protection conferred by a European patent was determined by the content of all claims, not that of one or several only. Thus, for example, even though an independent claim lacked novelty a claim dependent on it could still be valid and the patent proprietor could restrict himself to that claim. It was, moreover, irrelevant when determining the extent of protection whether features were referred to in the prior art portion or characterising portion. The transposition of information from one to the other did not therefore contravene Art. 123(3) EPC 1973 (**T 579/01**, **T 411/02**, **T 250/02**, **T 1898/07**).

## 2.6. Change of claim category

### 2.6.1 From product claim to a claim directed to the use of the product

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, which the Enlarged Board allowed. It stated that a change of category of granted claims in opposition proceedings was not open to objection under Art. 123(3) EPC 1973, if it did not result in extension of the protection conferred by the claims as a whole, when they were interpreted in accordance with Art. 69 EPC 1973 and its Protocol. In this context, the national laws of the contracting states relating to infringement should not be considered, for there was a clear distinction between the protection which was conferred and the rights which were conferred by a European patent. The **protection conferred by a patent** was determined by the terms of the claims (Art. 69(1) EPC 1973), and in particular **by the categories of such claims and their technical features**. In contrast, the rights conferred on the proprietor of a European patent (Art. 64(1) EPC 1973) were the legal rights which the law of a designated contracting state might confer upon the proprietor. In other words, in general terms, determination of the "extent of the protection conferred" by a patent was a determination of what was protected, in terms of category plus technical features; whereas the "rights conferred" by a patent were related to how such subject-matter was protected. When deciding upon the allowability of an amendment involving a change of category, the considerations were, in principle, the same as when deciding upon the allowability of any other proposed amendment under Art. 123(3) EPC 1973.

An amendment of granted claims directed to "a compound" and to "a composition including such compound", so that the amended claims were directed to "the use of that compound in a composition" for a particular purpose, was not open to objection under Art. 123(3) EPC 1973. For it was generally accepted as a principle underlying the EPC that a patent which claimed a physical entity per se, conferred absolute protection upon such physical entity, for all uses of such physical entity, whether known or unknown. It followed that if it could be shown that such physical entity (e.g. a compound) was already part of the state of the art, then a claim to the physical entity per se lacked novelty. It also followed that a claim to a particular use of a compound was in effect a claim to the physical entity (the compound) only when it was being used in the course of the particular physical activity (the use), this being an additional technical feature of the claim. Such a claim therefore conferred less protection than a claim to the physical entity per se.

In **T 912/91** the appellant (patentee) claimed the use of graphite for obtaining a sintered composite ceramic body having certain characteristics. The board held that the change of claim category from the granted product claims for composite bodies to these use claims did not broaden the scope of protection of the granted claims. Even if it were considered that the use claim was notionally equivalent to a claim to a process including the step of using the graphite in the sintered body and that the effect of Art. 64(2) EPC 1973 was to confer protection on the product resulting from this process as well, this would not represent an extension of protection within the meaning of Art. 123(3) EPC 1973, since the sintered composite body was defined in the use claim in a more restricted way than the composite body of the granted claim (narrower range of the graphite content, etc.).

In **T 134/95** a patent had been granted in respect of a "container for medical use", designed for the separate storage and the mixing of compounds. The protection

conferred therefore related to the apparatus and, necessarily, to its use at least for the purposes of storage and mixing. After amendment, the claim became a use claim, covering only the use of the container and no longer protecting the apparatus as such. Having pointed out that inventions of this kind were designed with a particular object in mind and could not normally be used for other purposes, the board noted that in this case, the change of category, replacing the granted claim with a claim for the use of the container, had the effect of limiting the scope of protection. The two stages of the process therefore in no way had the effect of modifying the starting solutions with a view to obtaining or manufacturing a product. This use therefore fell into the category "use of a physical entity to obtain an effect or result", and on this basis the change of category was allowable.

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**, **T 879/91**, **T 568/94**, **T 78/97**, **T 977/02**, **T 794/03**.

#### 2.6.2 From product claim to a claim directed to using that product for producing another product

In **T 282/09** the claims of the main request as amended comprised only use claims, which had replaced the product claims directed to a physical entity of the patent as granted. The board held that according to EPO practice (see **T 401/95**) a claim directed to "the use of a physical entity to produce a product" was to be considered as a process claim comprising physical steps for producing the product using the physical entity, with the consequence that this type of use claim was a process claim within the meaning of Art. 64(2) EPC. Pursuant to that article of the EPC, the product, insofar as it was directly obtained by that process, was also protected. Hence, the product, when obtained by that process, was within the scope of protection conferred by that type of use claim (see decision **G 2/88**, OJ 1990, 93, point 5.1 of the Reasons). In the case at issue, the protection conferred after amendment extended beyond that conferred before, contrary to the requirements of Art. 123(3) EPC, because the product obtained using the physical entity was not protected before the amendment of the claims, but was now protected as a result of the amendment.

#### 2.6.3 From product or product-by-process claim to a claim directed to a process for manufacturing/preparing the product, and vice versa

According to established case law, a product claim confers protection to all processes for making that product, such that the replacement of a claim directed to a product by a claim directed to a specific process or method for making that product does not extend the protection conferred thereby (**T 674/02** with reference to **T 54/90**, **T 28/92**, **T 468/97**, **T 554/98**; see also **T 191/90**, **T 762/90**, **T 153/91**, **T 601/92**, **T 646/98**, **T 425/02**, **T 1139/06**).

In **T 423/89** the change in category from a product-by-process claim to a manufacturing process claim was admissible. In **T 402/89**, however, the board pointed out, in passing, certain difficulties in interpreting the term "protection conferred".



In **T 5/90** the patent was granted with a claim in the form "a product having product features x and product-by-process features characteristic of process steps y". This claim, however, turned out not to be novel. The patentee finally claimed "a process of making a product having product features x by using process steps y and process steps z". The board interpreted such a claim as covering the process steps only in so far as a product having product features x actually resulted. This was called a process-limited-by-product claim by the board. The direct product of this process would also be protected under the provisions of Art. 64(2) EPC 1973, but such product inevitably fell within the scope of the product claim originally granted. The board regarded a process-limited-by-product claim of this type as clearly complying with the requirements of Art. 123(3) EPC 1973 because it would only be infringed if the product fell within the originally granted product claim and in addition the particular form of manufacture using process steps z was used (decision see also **T 562/04**).

In **T 20/94** the patent in suit in the form as granted exclusively comprised process claims for preparing a product. In the form as amended it comprised a product claim relating to the product per se. The board stated that the protection conferred by a claim directed to a process for preparing a product covered that process. Pursuant to Art. 64(2) EPC 1973, a product directly obtained by that process was also protected, but it was not protected when obtained by any other process. However, the protection conferred by a claim directed to a product per se was absolute upon that product. The product claim thus conferred protection on that product regardless of the process by which it was prepared. The appellant attempted to overcome this objection by formulating the product claim as amended in the form of a product-by-process claim using the term "directly obtained". The board did not agree with this line of argument, stating that a product-by-process claim was interpreted as a claim directed to the product per se, since the only purpose of referring to a process for its preparation was to define the subject-matter for which protection was sought, which was a product. Whether or not the term "directly obtained" or any other term, such as "obtained" or "obtainable", was used in a product-by-process claim, the category of that claim did not change. Thus amended claim 1 in the case in question contravened Art. 123(3) EPC 1973.

In **T 1206/01** the board pointed out that according to the established case law of the boards of appeal a product claim conferred protection on the claimed product, regardless of the process or method by which it was prepared. Therefore a change of category from a granted product claim to a process claim restricted to one or more methods of preparing the product did not extend the protection thereby conferred.

#### 2.6.4 From method claim for treating the human body by therapy to product claim

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. 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". Claim 1 as granted was already a product claim containing a functional definition of a pacemaker. So the seeming change of category did not alter the content of the claim but simply served to clarify it (see also **T 378/86**, OJ 1988, 386).

In **T 82/93** (OJ 1996, 274) the granted patent contained a claim 1 relating to a method of operating a pacer. The board found that this claim defined a method for treatment of the human body by therapy and therefore was not allowable under Art. 52(4) EPC 1973. It held that the device claim of the auxiliary request was not allowable under Art. 123(3) EPC 1973. The subject-matter protected by the granted claim was a pacer, **when in use**; in contrast, the claim of the auxiliary request only included technical features which defined physical characteristics of the pacer device itself. The board explained that in general terms, if a patent as granted only included claims defining the operation of a device and therefore containing both "device features" and "method features", and the proposals to amend the patent during opposition proceedings included claims which only contained "device features", the proposed amendment was not allowable having regard to Art. 123(3) EPC 1973, because the patent as granted conferred protection upon the device only when it was in use so as to carry out the method, whereas the proposed amended patent would confer protection upon the device whether or not it was in use, and would therefore confer additional protection compared to the patent as granted. In contrast to the findings in **T 426/89**, in the case at issue the board held that claim 1 as granted was clear, defined the use of a device to carry out a method of treatment of the human body by therapy and was not a pure "device claim" since it also included method steps. Thus, under such circumstances, Art. 52(4) and Art. 123(3) EPC 1973 might operate in combination as an "inescapable trap".

#### 2.6.5 From use claim to process claim, and vice versa

In **T 279/93** the board found that a claim to the use of a compound A in a process for preparing compound B had no broader scope than a claim to a process for preparing compound B from compound A. It had already been stated in **G 2/88** (point 2.5 of the Reasons) that the technical features of a claim to an activity were the physical steps which defined such activity. In this case, the board considered that process claim 1 as filed, process claim 1 as granted and use claim 1 filed on appeal all related to the same physical steps, and that the claims were therefore of the same scope. On this view, the scope of protection conferred by this use claim was not broader than that conferred by the granted process claim (see also **T 619/88**).

In **T 420/86** a change from a claim for a process for treating soil, in which X was used, to a claim for the use of X for treating soil was allowed. In **T 98/85** on the other hand, a change from a "process for the preparation of a ... composition" to the "use of this ... composition as a ..." was seen as a breach of Art. 123(3) EPC 1973.

In **T 276/96** the board decided in view of **G 5/83** (OJ 1985, 64) that the change of claim of the type "Method of fabricating item A using item B providing effect C" to a claim of the type "Use of item B in a method of fabricating item A to provide effect C" did not extend

the protection conferred, since with both formulations the same activity would be forbidden to competitors.

#### 2.6.6 From use claim to Swiss-type claim

**T 1635/09** (OJ 2011, 542) was concerned with the conversion of a use claim to the so-called Swiss form of claim. In this case, claim 1 in the 23rd auxiliary request differed from claim 1 in the granted text in that the originally granted use claim was converted to the so-called Swiss form of claim, in other words a claim for the use of a substance or mixture of substances for manufacturing a medicament for a specific therapeutic use. Under the established jurisprudence of the boards of appeal, the process of establishing whether the scope of protection was extended by this amendment must take all the granted claims into consideration. It was therefore necessary to determine whether the reformulation of a claim for the "use of an oral dosing form comprehensively ... for contraception ..." into a claim for the "use of a composition comprehensively ... for manufacturing an oral ... dosing form for contraception ..." complied with the requirements of Art. 123(3) EPC. A crucially important question here was whether the Swiss-type claim was to be regarded as for (a) the use of a substance or mixture of substances for a specific purpose or (b) the manufacture of a medicament. Citing **G 5/83** (OJ 1985, 64) and **G 2/88** (OJ 1990, 93), the board in **T 1635/09** ruled that the conversion of a claim for the use of a substance or mixture of substances for a specific purpose into a Swiss-type claim or a product claim limited to a specific use in accordance with Art. 54(5) EPC results in an extension of the scope of protection.

#### 2.6.7 From Swiss-type claim to purpose related product claim under Article 54(5) EPC

In **T 250/05** the board held that, apart from the fact that Art. 54(5) EPC (entry into force 13 December 2007) did not apply to a patent granted in 2001, Art. 123(3) EPC would not allow the change of category of a granted use claim into a product claim, even if drafted as a purpose-related product claim. Therefore, in the case at issue, the amended claims had to remain in the "Swiss form" in order not to contravene Art. 123(3) EPC.

In **T 1780/12** the board understood that the board in **T 250/05** had considered that the scope of protection conferred by a purpose-related product claim was in fact larger than the scope of protection conferred by a Swiss-type claim.

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

#### 3.1. Inescapable trap

In **T 384/91** (OJ 1994, 169) the question was referred to the Enlarged Board whether, given the requirements of Art. 123(2) and (3) EPC 1973, a patent could be maintained in opposition proceedings if its subject-matter extended beyond the content of the application as filed, whilst at the same time the added feature limited its scope of protection. The conflict here was that the "limiting extension" had to be deleted as a breach of Art. 123(2) EPC 1973, but to do so would broaden the scope of the patent and thus contravene Art. 123(3) EPC 1973 (see **G 1/93**, OJ 1994, 541).

This problem had been extensively discussed for the first time in **T 231/89** (OJ 1993, 13), where the board held it to be inappropriate to take Art. 123(2) and 123(3) EPC 1973 as independent of each other while applying them in conjunction to revoke the patent.

In **G 1/93** (OJ 1994, 541) the Enlarged Board of Appeal ruled as follows:

If a European patent as granted contained subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973 and which also limited the scope of protection conferred by the patent, such patent could not be maintained in opposition proceedings unamended, because the ground for opposition under Art. 100(c) EPC 1973 prejudiced the maintenance of the patent. Nor could it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which was prohibited by Art. 123(3) EPC 1973. Therefore, in principle, if the European patent as granted contained a "limiting extension", it had to be revoked. Art. 123(2) and 123(3) EPC 1973 were mutually independent of each other (**T 1736/09**: by analogy, Art. 76(1) EPC and Art. 123(3) EPC must also be regarded as mutually independent of each other). In this sense, it had to be admitted that Art. 123(2) EPC 1973 in combination with Art. 123(3) EPC 1973 could operate rather harshly against an applicant, who ran the risk of being caught in an **inescapable trap** and losing everything by amending his application, even if the amendment was limiting the scope of protection. However, this hardship was not per se a sufficient justification for not applying Art. 123(2) EPC 1973 as it stood in order to duly protect the interests of the public. Nor did it, in principle, matter, that such amendment had been approved by the examining division. The ultimate responsibility for any amendment of a patent application (or a patent) always remained that of the applicant (or the patentee).

### 3.2. Attempts to resolve the conflict

The Enlarged Board in **G 1/93** (OJ 1994, 541) mentioned three instances where the patent could be maintained:

- If the added feature could be replaced by another feature disclosed in the application as filed without breaching Art. 123(3) EPC 1973, the patent could be maintained (in amended form). This might turn out to be a rare case in practice (see below **T 166/90**).
- An added undisclosed feature without any technical meaning could be deleted from a claim without violating Art. 123(3) EPC 1973.
- An added feature, which did not provide a technical contribution to the subject-matter of the claimed invention but merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, was not considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973. In this case also the patent could be maintained. See below, chapter II.E.3.3 "Addition to the claim of an undisclosed feature limiting protection conferred, without providing a technical contribution".

The board noted in **T 335/03** that, according to **G 1/93**, there was no basis in the Convention for providing a claim with a footnote to the following effect; "This feature is the subject of an inadmissible extension. No rights may be derived from this feature"; in other words, in cases of conflict between Art. 123(2) and Art. 123(3) EPC 1973 the **footnote solution is inadmissible** (see also **T 307/05** and **T 614/12**).

In **T 10/91** a neutral feature of no particular value for the skilled person was added during the examination proceedings. The feature had no technical significance. It could therefore stay in the claim, but could not be taken as delimiting when examining for novelty and inventive step.

In **T 938/90**, however, the addition was technically significant and it had to be taken into account in the examination for novelty and inventive step. The board therefore declined to apply the principles developed in **T 231/89** and dismissed the patent proprietor's appeal against the revocation of the patent (see **T 493/93**).

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.

Decisions **T 673/89** and **T 214/91** followed **T 271/84** (OJ 1987, 405), **T 371/88** (OJ 1992, 157) and **T 438/98**, in ruling that amending a claim to remove an inconsistency did not contravene Art. 123(2) or Art. 123(3) EPC 1973 if the claim as corrected had the same meaning as the correct interpretation of the uncorrected claim in the light of the description. For another case concerning the conflict between Art. 123(2) and (3) EPC, see **T 1202/07**, which refers to **T 1018/02** (extent of protection conferred by a claim feature not consistent with the description). The latter decision dealt in detail with interpretation of claims and can thus be distinguished from, in particular, **T 438/98** (correction of an obvious clerical error).

In **T 553/99** the board stated that if a claim as granted contained an undisclosed, limiting feature in contravention of Art. 123(2) EPC 1973 it could be maintained in the claim without violating Art. 123(2) EPC 1973 provided that a further limiting feature was added to the claim which further feature was properly disclosed in the application as filed, and deprived the undisclosed feature of all technical contribution to the subject-matter of the claimed invention.

**T 942/01** held it to be a principle in patent law (see for example **G 1/93**, OJ 1994, 541) that a patent could not be maintained unamended in opposition procedure if a violation of Art. 123(2) EPC 1973 had occurred during the examination procedure. A cancellation of unallowable amendments during the opposition proceedings was normally possible under the provisions of the Convention, except where the unallowable amendment was a "limiting extension", so that its cancellation would extend the protection conferred by the patent and therefore contravene the requirements of Art. 123(3) EPC 1973 (**G 1/93**). However, the case at issue dealt with an unallowable extension only. The feature, which was present in the claim of the application as filed and now reintroduced in the claim, did not extend the protection conferred by the claims but rather restricted it.

**T 567/08** gives an example of a "limiting extension" adding subject-matter contrary to Art. 123(2) EPC but at the same time limiting the scope of protection vis-à-vis what could have been claimed, so that its removal infringed Art. 123(3) EPC.

In **T 250/05** the board, following the principles set out in **G 1/93**, came to the conclusion that the patent could not be maintained unamended **and** that the patent could only be maintained if there was a basis in the application as filed **for replacing** such subject-matter without violating Art. 123(3) EPC. The sixth auxiliary request (which contained only one claim) met both prerequisites.

In **T 195/09**, on the conflict between Art. 123(2) and (3) EPC, the appellant referred to **T 108/91** in which it had been decided that an inaccurate technical statement in a granted claim, which statement was evidently inconsistent with the totality of the disclosure of the patent and would contravene the requirements of Article 123(2) EPC, could be replaced with an accurate statement of the technical features involved without infringing Article 123(3) EPC. The board in **T 195/09** pointed out that this decision had been clearly overruled by **G 1/93** (on **T 108/91**, see also **T 1202/07**).

On the basis of decisions **G 1/93** and **G 1/03** dealing with Art. 123(2) and (3) EPC 1973 and with disclaimers, the board in **T 1180/05** came to the conclusion that the deletion of a feature in a granted claim, which feature extended beyond the content of the application as filed, and its reintroduction in the form of a disclaimer, so that the subject-matter of the claim remained the same, was not suitable to overcome the potential conflict between paragraphs 2 and 3 of Art. 123 EPC 1973. The board decided not to refer the question to the Enlarged Board of Appeal as requested by the patent proprietor. The decision of the opposition division maintaining the patent in amended form was set aside and the patent revoked.

### **3.3. Addition to the claim of an undisclosed feature limiting protection conferred, without providing a technical contribution**

**G 1/93** (OJ 1994, 541) stated that the underlying idea of Art. 123(2) EPC 1973 was clearly that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. If, however, an added feature merely excluded

protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such a feature could not reasonably be considered to give any unwarranted advantage to the applicant. Nor did it adversely affect the interests of third parties. Therefore, a feature which had not been disclosed in the application as filed but which had been added to the application during examination was not to be considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC 1973, if it **merely limited the protection conferred** by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, **without providing a technical contribution** to the subject-matter of the claimed invention (see also **T 112/95**).

These principles were in general confirmed in **G 2/98** (OJ 2001, 413) and **G 2/10** (OJ 2012, 376). Pursuant to **G 2/10** it was, however, evident from the context that by introducing the "technical contribution" criterion in **G 1/93** the Enlarged Board had not intended to amend the definition concerning when an amendment was allowable under Art. 123(2) EPC generally, but that it only had sought a way of avoiding the potentially fatal consequences of the patentee being caught in the "inescapable trap" between the requirements of Art. 123(2) and (3) EPC.

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

In **T 384/91** of 27.9.1994 (OJ 1995, 745) it was held that the added feature did make a technical contribution. This decision was based on the following considerations: the example mentioned by the Enlarged Board illustrated a case where the feature was clearly not merely a limitation. However, the borderline beyond which a feature was no longer to be considered as making a technical contribution to the subject-matter of the claimed invention and was merely limiting the protection conferred, was not co-terminous with this example but lay between it and the limit of complete technical irrelevance. According to the board this view was consistent with the fact that the Enlarged Board had rejected relevance as a criterion for novelty and inventive step, which would also have implied a comparison with the cited prior art documents. The board explained that the term "invention" did not necessarily imply the presence of novelty and inventive step, as was apparent from the wording of Art. 52, 54 and 56 EPC 1973. The board concluded that there was no need to take into account the prior art documents, but that the assessment of whether the exception for mere limitations applied in a particular case should depend only on the technical relationship of the added feature to the content of the application as originally filed, as understood by a skilled reader. At the least, a feature went beyond providing a mere limitation not involving a technical contribution to the invention if it interacted with the way in which the other features of the claim solved the technical problem, as it was understood from the application as originally filed.

In case **T 64/96**, a patent relating to a cover for automobile sun visor mirrors comprising rectangular plates overlapping and connected together in chain-like succession was revoked by the opposition division. The third auxiliary request of claim 1 was amended in that it was included as an additional feature that lugs were "integrally formed in said

plates". The board came to the conclusion that applying the criterion, as set out in **G 1/93** (OJ 1994, 541) and **T 384/91** (OJ 1995, 745), to the case at issue, it could be seen that the feature in question did indeed make a technical contribution to the subject-matter of the claim since forming the lugs integrally with the plates led to a simpler and cheaper construction of cover which, at least by implication, was the technical problem which the invention set out to solve. Thus the addition of this feature to claim 1 of the third auxiliary request offended against Art. 123(2) EPC 1973.

In **T 1779/09** the board considered that the appellant had found itself exactly in the situation envisaged in decision **G 1/93**. The board considered that a limiting feature which generally would not be allowable under Art. 123(2) EPC could, under certain conditions, nevertheless be maintained in the claim of an opposed patent in the particular situation addressed in decision **G 1/93**. It then complied with Art. 123(2) EPC by way of a legal fiction. In the case at issue, the term "only" was introduced during the examination proceedings and successfully objected to under Art. 100(c) EPC in proceedings before the opposition division by the former respondent. Since the board considered the term to be truly limiting, its deletion would extend the protection conferred and thereby infringe Art. 123(3) EPC. However, the board held that the exclusive limitation did not influence the solution of the technical problem as understood from the application as originally filed, and hence provided no technical contribution to the claimed invention (see also decision **T 384/91**, Headnote II). It merely excluded protection of part of the invention described in the application, thus not giving any unwarranted advantage to the applicant. Claim 1 of the appellant's sole request was therefore deemed to comply with Art. 123(2) EPC.

In **T 592/99** the board observed that in the case of a product claim concerning a composition defined by its components and their relative amounts given in terms of ranges, it could not be accepted that such ranges, which constituted essential features, did not provide a technical contribution to the subject-matter of the claimed invention, as suggested by the appellant. Any amendment to the ranges had to have the effect of modifying the claimed subject-matter, and thus also provided a technical contribution. If the newly claimed limited range were allowed even though unsupported, any subsequent selection invention based on the new range would have to be refused as not novel, which would otherwise not necessarily be the case. To allow this would, of course, give an unwarranted advantage to the patentee, contrary to the purpose of Art. 123(2) EPC 1973. In the board's view, that was exactly what was meant in the "typical example" given in point 16 of **G 1/93**, "where the limiting feature is creating an inventive selection not disclosed in the application as filed or otherwise derivable therefrom". Obviously, in the quoted text, such an "inventive selection" could not mean anything other than a potential (inventive) selection. Therefore the new feature constituted added subject-matter.

In **T 1004/01** the question that arose before the board of appeal was whether or not there was a basis in the application as originally filed for a peel strength "of at least 24 grams" to define the claimed laminate. According to the application as filed, the peel strength of the laminate was defined by an open-ended range as an essential feature of the invention. In the general description and the claims there was no further mention of any



preferred peel strength range. According to the board, the peel strength of 24 grams could not be detached from the exemplified laminates to form a basis for a generalised lower limit of the claimed peel strength range without taking into consideration the other particulars closely associated therewith. Furthermore, the board pointed out that the general criteria of **G 1/93** (OJ 1994, 541) had to be met, namely that the limitation did not involve a technical contribution to the subject-matter of the claimed invention and did not provide an unwarranted advantage. Since the claimed peel strength led to a technical contribution of the claimed subject-matter, the question whether or not the limiting feature created an inventive selection could be left unanswered. Consequently, the added feature could not be regarded as a mere limitation of the protection.

The invention in **T 2230/08** concerned a method of regenerating a catalyst/absorber. The undisclosed modification contained in claim 1 as granted and still present in claim 1 of the auxiliary request would therefore be prejudicial to third parties relying on the invention as described in the application as originally filed, as that undisclosed modification which was technically sensible might possibly be the basis for a valuable invention. Claim 1 of the auxiliary request was not restricted to any specific method which would deprive the definition of the temperature of the regenerating gas of all technical contribution within the context of that claim. In the absence of any additional disclosed restricting feature to that effect, the temperature of the incoming regenerating gas was therefore considered to interact with the remaining features of the claim in such terms that it influenced the solution of the technical problem which could be understood from the application as originally filed. It followed that the condition that no missing technical contribution be provided, set out in decision **G 1/93** (OJ 1994, 541) and on the basis of which added matter can be considered as not extending beyond the application as filed, was not met in the case at issue (violation of Art. 123(2) EPC).

In **T 108/12** the formulation "correspondent A maintaining said first signature private to itself" in claim 1 as granted had been replaced by "correspondent A avoiding transmission of said first signature". The board observed that keeping something private, i.e. secret, involved more than merely not transmitting such information. Claim 1 as granted encompassed realisations where signatures were transmitted, but were maintained private, for example by transmitting signatures in a secure way. This was no longer required by the amended claim 1. On the other hand, amended claim 1 encompassed signatures which were not transmitted but were nevertheless made public, which was in contrast to claim 1 as granted. Therefore, the features replaced by the amendment did not merely limit the scope of protection of claim 1, but – in contrast to the requirements set out in decision **G 1/93** – had a technical effect and contributed to the limitation of the scope of protection of claim 1. Those features could not be deleted from claim 1 without extending the scope of protection of claim 1 and thus infringing Art. 123(3) EPC.

#### **4. Correction of errors in the description, claims and drawings – Rule 139 EPC**

According to R. 139 EPC, linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request; however, if the request for such correction concerns the description, claims or drawings, the 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 wording does not differ in substance from the former R. 88 EPC 1973; only some editorial changes have been made in the three languages. Hence, the jurisprudence with regard to R. 88 EPC 1973 is applicable to R. 139 EPC (**T 1460/10**).

Relevant for the present chapter on amendments is R. 139, **second sentence**, EPC, which concerns corrections to the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings). Other aspects related to corrections can be found under Chapters II.F.4.3 "Correction of errors in a divisional application"; IV.A.5.2.2 "Correction of designation of applicant (Rule 139 EPC)"; IV.A.5.5 "Corrections under Rule 139 EPC"; IV.A.7.3 "Correction of designation of states (Rule 139 EPC)"; IV.B.3.8.2 "Correction of the withdrawal of the application under Rule 139 EPC". As to the corrections under the **first sentence** of R. 139 EPC, the boards of appeal, in particular the Legal Board of Appeal, have developed a large body of case law on corrections, namely that the correction must introduce what was originally intended, the error to be remedied may be an incorrect statement or an omission, and the request for correction must be filed without delay (see **G 1/12**, point 37 of the Reasons).

#### **4.1. Relationship of Rule 139 EPC with Article 123(2) and (3) EPC**

In opinion **G 3/89** (OJ 1993, 117) and decision **G 11/91** (OJ 1993, 125) the Enlarged Board held that corrections under R. 88, second sentence, EPC 1973 (now R. 139, second sentence, EPC) were special cases of an amendment within the meaning of Art. 123 EPC and fell under the prohibition of extension laid down in Art. 123(2) EPC.

The parts of a European application or patent relating to the disclosure (description, claims and drawings) can be corrected only within the limits of what the skilled person would derive directly and unambiguously, using common knowledge and seen objectively and relative to the date of filing, from the whole of these documents as originally filed. Such a correction was of a strictly declaratory nature and thus did not infringe the prohibition of extension under Art. 123(2) EPC 1973.

For case law on these issues prior to **G 3/89** and **G 11/91**, see the summary of facts and submissions of those decisions, and "Case Law of the Boards of Appeal", 7<sup>th</sup> ed. 2013, II.E.4.1. For a summary of the findings in **G 3/89** and **G 11/91**, see also **G 2/95** (OJ 1996, 555, point 2 of the Reasons).

In **T 195/09** the invention related to mechanical warewashing compositions containing scale inhibiting polymers. With regard to **Art. 123(3) EPC**, the appellant (patent proprietor) submitted, inter alia, that, by considering the description, the skilled person would have understood that the granted claim 1 referred erroneously to copolymerizable sulfonated polymers instead of copolymerizable sulfonated monomers and that the amended claim 1 according to the auxiliary request, by reporting the truly intended technical features of the invention, would not extend the scope of the granted patent. However, the finding of the decision under appeal on the question of common general

knowledge and the board's reasoning in respect of the application of Art. 69(1) EPC led it to conclude that claim 1 as granted would have been understood by the skilled person as it stood. Therefore, this argument of the appellant (patent proprietor) could also not justify the allowability under Art. 123(3) EPC of the auxiliary request. The board also noted that the decisions **G 3/89** and **G 11/91**, cited by the appellant (patent proprietor) during oral proceedings, concern only the allowability of a request for correction of an error and the relationship between R. 88 EPC 1973 and Art. 123(2) EPC. Therefore, these decisions could not apply to the case at issue where the allowability of the amended patent under Art. 123(3) EPC had to be decided on.

#### 4.2. Obviousness of the error and the correction

In order for a correction in the description, the claims or the drawings to be allowable under R. 139, second sentence, EPC, the boards apply a two-step approach. It must be established (i) that it is obvious that an error is in fact present in the document filed with the EPO, the incorrect information having to be objectively recognisable by the skilled person using common general knowledge (**G 3/89**, OJ 1993, 117 and **G 11/91**, OJ 1993, 125, point 5 of the Reasons), and (ii) that the correction of the error is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction (**G 3/89** and **G 11/91**, point 6 of the Reasons).

Since the prohibition of extension under Art. 123(2) EPC also applies to a correction under R. 139, second sentence, EPC (**G 3/89** and **G 11/91**, point 1.4 of the Reasons), the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may be corrected under R. 139, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of these documents as filed (**G 3/89** and **G 11/91**, point 3 of the Reasons).

##### 4.2.1 Documents to be taken into account for the assessment of obvious error and correction

Before a correction can be made under R. 139, second sentence, EPC it has to be established what a skilled person would derive, on the date of filing, from the parts of the European patent application relating to the disclosure. As a result of the prohibition of extension under Art. 123(2) EPC, documents other than the description, claims and drawings may only be used insofar as they are used for proving the common general knowledge on the date of filing. On the other hand, documents even if they were filed together with the European patent application, such as priority documents and the abstract may not be used. Documents not relating to the disclosure could, under certain circumstances, be included partially or wholly in the disclosure by means of reference. Evidence of what constituted such knowledge on that date could be furnished in any suitable form (**G 3/89** and **G 11/91**, points 7 and 8 of the Reasons).

In **T 1008/99** the board held that, for the purposes of R. 88 EPC 1973, the error had to be **apparent from the divisional application itself**, and the parent application could not

be used to demonstrate that the error was obvious. Even if it was apparent from the filed description, claims and drawings that they did not belong together, it was not immediately clear from the divisional application itself which of these parts was incorrect.

#### 4.2.2 Obvious error – incorrect information objectively recognisable

In **G 3/89** (OJ 1993, 117) and **G 11/91** (OJ 1993, 125) the Enlarged Board of Appeal specified that, for a correction under R. 88, second sentence, EPC 1973 to be allowed, the respective part of the European patent application or patent had to contain such an obvious error that a skilled person was in no doubt that the information was not correct and could not be meant to read as such. The skilled person must be in a position objectively and unambiguously to recognise the incorrect information using common general knowledge. If, on the other hand, it was **doubtful** whether any information at all was incorrect, then a correction was ruled out. The same applies if incorrect information only becomes apparent in the light of the proposed correction.

In **T 664/03** the board held that, even if it considered an interpretation of granted claim 1 in the broader context of the description, it was at least doubtful that the skilled person would come to the conclusion that the feature in question was incorrectly defined in that claim. Therefore, the precondition for correction under R. 88, second sentence, EPC 1973 had not been met.

In **T 829/05** the board held that, even if the skilled person were aware of an inconsistency between the claim and the drawing, he would have no cause to believe that the claim was incorrect. The drawing was stated to be diagrammatic and, in the absence of any evident technical reason to suspect that the claim was incorrect, the skilled person would simply accept the inconsistency as being characteristic of a schematic drawing.

In **T 2230/08** the board considered that the definition of the range of temperature for the incoming stream of regenerating gas in claim 1 did not appear to the skilled person as an error, even less as an obvious one. Furthermore there was no evidence that an error of transcription occurred in the case at issue. Consequently, the request for correction under R. 139 EPC was rejected.

In **T 1436/12** the applicant sought the correction of a reference to a document (a US patent application identified by its docket number) incorporated by reference in the European application. Given that the incorporation by reference of features from a cross-referenced document fell under a different regime before the EPO than before the USPTO, the board deemed it to be conceivable that the incorporation of the reference was meant only for the prosecution before the USPTO and was, therefore, deliberately not amended when the International application was filed at the EPO. Thus the board was not convinced that the reference to a docket number in an application filed at the EPO must generally be considered to have been made in error. For that reason alone, the amendment could not be allowed under R. 139 EPC.

In **T 1702/12** the board held that the skilled person had no reason to doubt the value of 500 when reading granted claim 1 at face value, since this value made technical sense. Even when taking the description and dependent claims of the granted patent into account, the skilled person could not be sure that the value of 500 was erroneous, or whether an error occurred in the description or said dependent claims. The board rejected the argument that any relevant evidence must be taken into account. Rather, if it was necessary to study the prosecution history of the case in order to determine whether an error had been made and what the correction should be, then the criterion of immediacy in R. 139 EPC was not met.

#### 4.2.3 Immediately evident that nothing else would have been intended than what is offered as the correction

In **G 3/89** and **G 11/91** the Enlarged Board held that the parts of a European patent application as filed which relate to the disclosure must further allow a skilled person - using the common general knowledge on the date of filing - directly and unequivocally to ascertain the precise content of the information the person making the request actually meant to give, instead of the incorrect particulars, on the date of filing or when making an amendment under Art. 123 EPC, so that, for said skilled person, "it is immediately evident that nothing else would have been intended than what is offered as the correction" (R. 139, second sentence, EPC). However, if there is any doubt that nothing else would have been intended than what is offered as the correction, a correction cannot be made.

Already prior to **G 3/89** and **G 11/91**, the boards had allowed corrections under R. 88, second sentence, EPC 1973 (now R. 139, second sentence, EPC) 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 in the application at issue to a parallel application enabled the skilled person to establish without difficulty the correct limit values. In **T 365/88** it was ruled that an abbreviation in the claim could be corrected because it appeared correctly in the description; an additional Roman numeral I in the abbreviation of an enzyme was implicitly disclosed because at the time of filing only one enzyme of this type was known, and clarification prevented confusion with enzymes of the same type discovered at a later date.

In **T 990/91** the board allowed the correction of a chemical name on the grounds that an obvious error had been made in naming a salt which was the subject-matter of the application - the molecular formula of this salt was clear from the application. However, the molecular formula corresponding to the name was different. Guided by the content of the application and taking into account cited documents which were published before the priority date of the application in question, the correction required would be immediately evident to the skilled person.

In **T 417/87** the board of appeal allowed the number of a publication cited in the original description to be corrected under R. 88, second sentence, EPC 1973, since it was

immediately evident that nothing else could have been intended other than the corrected number of the patent.

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 (see also **T 200/89**, **T 15/09**).

In **T 3/88** the board allowed the correction of a transposition error in a figure given for a melting range because it would be immediately evident to the skilled person that only the corrected figure obtained by switching the last two digits round could have been intended.

In **T 606/90** the board allowed a correction pursuant to R. 88, second sentence, EPC 1973, in the opposition proceedings although the correction was not so obvious from the published text of the patent that it was immediately evident that nothing other than the proposed correction could have been intended. The applicant had filed typed amendments to the claims and the description and had also submitted the "working document" with the handwritten corrections for the dossier. The typed version of claim 1 omitted the detail which was now the subject of a request for correction pursuant to R. 88 EPC 1973; the same detail was present in the corresponding passage in the description. When the text was being prepared for publication of the patent, the detail in question was also omitted from the description owing to an error by the EPO. The board concluded that the omission in the description should not be taken into account when considering the admissibility of the correction. It stated that it was therefore clear that the phrase in question had been omitted from the typed version of claim 1 as a result of an error by the applicant and that the reader of the patent would immediately have noticed the need for correction of this error if a transcription error had not likewise been committed by the EPO. The correction requested was therefore admissible within the terms of R. 88 EPC 1973.

In **T 955/92** the board accepted that there was obviously a mistake and that the interpretation according to the correction sought by the appellant was more likely than the alternative. However, the reasons given by the appellant to show that only the requested correction could have been intended were not based on the level of general knowledge on the date of filing. In order to arrive at the conclusion that the requested correction was the only physically meaningful one, experiments had had to be performed which needed more than common general knowledge, and the results thereof would not have been available on the date of filing.

In **T 438/99** the board held that the fact that a term or phrase could not be interpreted or construed because it was unresolvably ambiguous did not necessarily mean that its deletion was a permissible amendment under Art. 123(2) EPC 1973. There remained a residual clear meaning in the ambiguous term, e.g., as in this case, that a specific direction was taught, and suppressing that fact resulted in a different technical teaching.

Therefore, the second condition of R. 88 EPC 1973 (immediately evident that nothing else would have been intended than what is offered as the correction) was not met by the offered correction of deleting the feature without replacement.

**T 1728/07** concerns the correction of an error in a formula. The sole objection raised under Art. 100(c) EPC in this case concerned the question of whether or not the amendments to the structural formulae representing oxazoline derivatives, found to be allowable under R. 88 EPC 1973 (now R. 139 EPC) during examination proceedings, introduced subject-matter extending beyond the content of the application as filed. According to R. 139 EPC, second sentence, it must be immediately apparent to the skilled person that (i) an error has occurred and (ii) how it should be corrected. With respect to requirement (ii), it must be decided whether the corrected feature is directly and unambiguously derivable from the content of the application as originally filed taken as a whole. This requirement was also found by the board to be fulfilled. Hence the amendment to formula (I) was allowable.

In **T 423/08** there was an obvious mistake in the original wording of one of the claims, in that either "gemäß" (according to) or "vor" (before) was superfluous. The mistake was corrected by deleting "vor". The board found that, purely linguistically, it could have been corrected in two ways (either by deleting "gemäß" or by deleting "vor"). Although deleting "gemäß" made sense when considered in isolation, it was incompatible with the wording of claim 1. Deleting "vor" was thus not open to objection under Art. 100(c) EPC.

In **T 1508/08**, the board concluded that the second condition for allowability of a correction under R. 139 EPC was not met. In its view, not only did the correction fail to solve the existing problems of a lack of clarity, but it actually made things **even less clear**. That was one reason why the skilled person would not have contemplated the correction made by the appellant proprietor. Even if it were assumed in the appellant's favour that the skilled person would have contemplated this correction, it was not the only one possible, but rather one of at least three conceivable corrections.

In **T 455/09** the board held that in the case at issue the skilled person could not exclude one of two options with certainty, so that it was not directly and unambiguously evident that nothing else could have been intended other than the proposed correction.

In **T 2303/10** the board held that it would be obvious to the skilled person that the first of the two alternative corrections mentioned by the examining division was totally incompatible with what was disclosed in the application as originally filed, whereas the second was technically feasible and entirely consistent with the disclosure and therefore allowable.

**T 163/13** concerned the correction of "72EF" to "72°F". The opponent argued that this was not the only possible correction since, instead of the temperature, the correction could for instance concern the pressure. The board, however, held that the only possible correction having a technical meaning in the present context was the temperature, as it was an essential parameter for the test in question. Consequently, the skilled person

would immediately consider that "F" meant "Fahrenheit" and make the correction accordingly.

In **T 657/11** the board held that the requested correction was obvious. It could not accept the argument of the respondent that the correction was not obvious because the wrong wording of the claim was also to be found in one passage of the description as filed. In fact, apart from this one passage, the rest of the description, the working examples and the figures were in line with the perceived correction. The board also excluded another possible correction because, although theoretically and technically possible, the skilled person would immediately reject it.

In **J 16/13** the applicant sought to replace the description and the claims (leaving the drawings as filed). The board held that if two parts do not match (here the drawings and the description/claims), that alone was not enough to determine which one was wrong. Even if it were obvious in this case that the description/claims were the wrong ones, the provisions of R. 139, second sentence, EPC were not met. A practically infinite set of perfectly plausible replacements could be imagined when a complete description and corresponding claim set turn out to be erroneous. A description completely corresponding to that of the priority document (as in the case at issue) was only one plausible alternative, admittedly one with a relatively high probability, but still not approaching absolute certainty. So, even a replacement with the priority document could not be regarded as "immediately evident" in the sense that "nothing else would have been intended".

#### **4.3. Correction of errors in the description, claims and drawings after grant, and in opposition proceedings**

In **J 42/92** the board had to decide whether a request under R. 88, second sentence, EPC 1973 could be made after grant. It came to the conclusion that a request under R. 88 EPC 1973 for amendments to the description or claims **could only be filed during the pendency of application or opposition proceedings**. Under Art. 97(4) EPC 1973, the decision to grant a European patent took effect on the date on which the European Patent Bulletin mentioned the grant. After this date, R. 88 EPC 1973 could only be applied while opposition proceedings were pending. In the case at issue, the decision to grant the patent had already taken effect, and no opposition had been filed. The appeal had therefore been dismissed, since the EPO had ceased to have jurisdiction to consider a request under R. 88 EPC 1973 at the time when the request was filed. The board also pointed out that there was no reason why, once no application or opposition proceedings were pending before the EPO, decisions on the question of corrections (bearing in mind the requirement of obviousness to a skilled person) should not fall within the sole jurisdiction of the national courts or other authorities responsible for proceedings in which this question might arise (see also **J 23/03** and **T 493/08**).

Note that **G 1/10** (OJ 2013, 194) deals with the different fields of application of various provisions as compared with R. 140 EPC (formerly R. 89 EPC 1973), in particular R. 139 EPC (points 9 and 11 of the Reasons) and Art. 123 EPC (see point 13 of the Reasons).



In **T 657/11** the board observed that according to **G 1/10** R. 140 EPC was not available to correct the text of a granted patent and a request for such a correction was inadmissible whenever made, including after the initiation of opposition proceedings. However, in the case at issue, the amendments went beyond the mere removal of an error; namely by limiting the claims to those granted as (process) claims 6-11. Hence the basis for the decision on the appeal (and, thereby, on the opposition) was no longer that for the decision to grant the patent-in-suit, which decision would definitely lose its effect and be replaced by a new decision. In such a situation any (further) amendment of the claims, even if it aimed at the removal of an obvious mistake in the claims as granted, did not constitute a correction of an error or a mistake in a decision of the EPO within the meaning of Rule 140 EPC. The board held that in opposition proceedings mistakes or errors concerning the claims, the description or the drawings of the patent as granted could be removed either by an amendment occasioned by a ground of opposition under Art. 100 EPC (see R. 80 EPC) or, insofar as the mistakes or errors concerned texts or drawings which remained unamended, by way of a correction pursuant to R. 139 EPC (which applied independently from R. 80 EPC).

## **5. Evidence and standard of proof for allowing amendments and corrections**

In accordance with the established case law of the boards of appeal of the EPO, in the case of a proposed amendment under Art. 123(2) EPC or of a correction under R. 139 EPC, the factual disclosure of a European patent application as originally filed has to be established to a rigorous standard, namely the standard of certainty "beyond reasonable doubt". In **T 1248/08** the board recalled this case law, in particular as established in **T 113/86**, **T 383/88**, **T 581/91**, **T 723/02** and **T 1239/03**. According to **T 307/05** and **T 370/10**, the same standard of "beyond reasonable doubt" applies when assessing the allowability of amendments under Art. 123(3) EPC. The burden of proof that amendments comply with Article 123(2) EPC rests with the party making the amendment (**T 910/06** with reference to **T 1239/03**; see also **T 222/05** and **T 1497/08**).

In **T 383/88** the board held that the normal standard of proof in proceedings before the boards of appeal, namely "the balance of probability", was inappropriate for determining the allowability of an amendment under Art. 123(2) EPC 1973. Instead, a rigorous standard, i.e. one equivalent to "beyond reasonable doubt" was considered by the board to be the right one to apply in such a case, since applying a lower standard could easily lead to undetected abuse by allowing amendments on the basis of ostensibly proven common general knowledge.

**T 383/88** also considered that the issue of the allowability of an amendment under Art. 123(2) EPC 1973 had to be decided by reference to what could be derived from the patent application as filed in the light of common general knowledge and not vice versa. Moreover, 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. 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 (see also **T 1046/96**).

In **T 795/92** the board stated that Art. 123(2) EPC 1973 clearly precluded allowing an amendment if there was any doubt as to whether or not it was derivable from the original application. In the case at issue, in spite of a certain probability in favour of the appellant's (patentee's) position, the amendment was not allowable because there were various known methods for calculating the value in question, not all leading to identical results, and the application did not directly and unambiguously disclose which method had to be used.

The board in **T 307/05** stated that, as indicated in the decision **T 64/03**, it was established case law that a **very rigorous standard**, namely that of "beyond reasonable doubt", was to be applied when checking the allowability of amendments under Art. 123(2) and 123(3) EPC. A similar rigorous standard was also expressed in the decision **T 581/91** relied on by the board in its communication by reference to the decision **T 113/86**, in which it was stated that the **slightest doubt** that the unamended patent could be construed differently to the patent as amended would preclude the allowability of the amendment (see also **T 370/10**, **T 2285/09**). While it was true that, as argued by the appellant, decision **T 113/86** referred to voluntary amendments requested by the patentee and not necessitated by any ground of opposition, the fact that the amendment would be, as in the present case, necessitated by a ground of opposition (i.e. Art. 100(c) EPC) could not, in the board's view, justify the application of a lower standard of proof than the one mentioned in that decision. On the contrary, a very rigorous standard was even more justified in the case in question, since allowing such amendments while using a lower standard of proof might give an unwarranted advantage to the patentee in the overcoming of a ground of opposition. The board also said that it could not be deduced from the decision **T 166/90** relied on by the appellant that a lower standard of proof could be applied when checking the allowability of amendments.

In **T 1248/08**, in the application as filed, a number pertaining to a value used in example 1 was illegible and indecipherable. It was not clear whether it should read "0.08" or "0.09", or even "0.05". The board was not persuaded by the appellant's arguments that the actual disclosure of that figure was unequivocal and that it read "0.09". The board held that the arguments of the appellant adopting proof "on the balance of probability", in particular **a survey**, had to fail. According to this survey - conducted amongst partners and staff at the firm of the appellant's representative - a total of 67 out of 72 test persons had indicated the relevant entry in Table 1 to be "0.09" without qualification. However, it was also found that two respondents had indicated another figure ("0.08") and that three further respondents who indicated "0.09" had also considered other possibilities. In the board's opinion, therefore, these results demonstrated that the value in question could not be considered to be "0.09" with a certainty "beyond reasonable doubt".

In any event, a question of accuracy and disclosure could not be decided by a poll. With reference to **G 11/91** (point 7 of the Reasons), the board also decided that the disclosure of the priority document could not be used to dispel doubts as to the meaning of an ambiguous part of the application. The same applied to the family documents, for the reason that the text of another patent application based on the same priority document did not need to be identical to the European patent application.

## F. Divisional applications

1.	Introduction	492
2.	Subject-matter of a divisional application	493
2.1.	Subject-matter extending beyond content of the earlier application	493
2.1.1	Directly and unambiguously derivable from content of earlier application as filed	493
2.1.2	Sequence of divisionals - derivable from each of the preceding applications as filed	494
2.1.3	Language issues	495
2.2.	Amendments to divisional applications	495
2.3.	Subject-matter of a patent granted on a divisional application	496
2.3.1	Findings of G 1/05 and G 1/06 also applicable to granted patents	496
2.3.2	Ground for opposition under Article 100(c) EPC	496
2.4.	Link between subject-matter of earlier application and of divisional application	497
2.4.1	No abandonment of subject-matter in earlier application if divisional is filed	497
2.4.2	No effect on content of divisional application if earlier application has lapsed	497
2.4.3	Final decision on subject-matter in the parent application - res judicata	497
2.4.4	Re-filing of same subject-matter	498
3.	Filing a divisional application	499
3.1.	Right to file a divisional application	499
3.1.1	Applicant of earlier application entitled to file divisional application	499
3.1.2	Filing of divisional application during stay of proceedings	499
3.1.3	Joint applicants	499
3.1.4	Announcing the filing of a divisional application	500
3.2.	Filing date attributed to divisional application	500
3.3.	Divisional application to be filed with EPO	501
3.4.	Requirement of pending earlier application	501
3.4.1	Changes to Implementing Regulations	501
3.4.2	Requirement of pending earlier application sets no time limit	501
3.4.3	Pendency before the EPO	502
3.4.4	Pendency after grant of earlier application	502
3.4.5	Pendency after refusal of earlier application against which no appeal was filed	502
3.4.6	Pendency after refusal of earlier application against which an appeal was filed	503
3.4.7	Pendency after deemed withdrawal of earlier application and request for re-establishment	503
3.4.8	Pendency after withdrawal of earlier application	504
4.	Procedural questions	505
4.1.	Procedural independence of divisional application	505
4.2.	Designation of contracting states in a divisional application	506

4.2.1	Deemed designation of all states designated in earlier application at the date of filing of divisional	506
4.2.2	Payment of fee for each designated State – case law concerning situation prior to 1 April 2009	506
4.3.	Correction of errors in a divisional application	507
4.4.	Search fee for a divisional application	508
5.	Double patenting	508
5.1.	No legitimate interest in grant of a second patent claiming same subject-matter	509
5.2.	Different subject-matter and scope of protection; overlapping subject-matter	509
5.3.	Double patenting objection in opposition	512

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## 1. Introduction

A divisional application is a new application which is separate and independent from the earlier application. Therefore, divisional applications are to be treated in the same manner as ordinary applications and are subject to the same requirements, unless specific provisions of the EPC require something different (see **G 1/05**, OJ 2008, 271, points 3.1, 8.1, 9.1 of the Reasons). The most important provisions on European divisional applications are Art. 76 EPC and R. 36 EPC (R. 25 EPC 1973).

According to Art. 76(1), second sentence, EPC, the divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed. The divisional application is accorded the same filing date as the parent (earlier) application and benefits from any right of priority of the parent (earlier) application in respect of the subject-matter contained in the divisional application. When determining whether the subject matter of a divisional application extends beyond the content of the earlier application as filed (Art. 76(1), second sentence, EPC) exactly the same principles are to be applied as for extension of subject-matter under Art. 123(2) EPC (**G 1/05**, point 5.1 of the Reasons) (see in this chapter II.F.2.1).

Divisional applications may be amended like any other application. If a divisional application is amended, it must meet the requirements of both Art. 76(1) EPC and Art. 123(2) EPC, so as to preclude the introduction of new subject-matter into the proceedings (see in this chapter II.F.2.2).

A divisional application (of whatever generation) can be the "earlier application" within the meaning of Art. 76(1) EPC for a further divisional (**G 1/06**, OJ 2008, 307, point 10.2 of the Reasons). According to R. 36(1) EPC the earlier application must still be pending (see in this chapter II.F.3.4).

It is a ground of opposition and a ground of revocation if the subject-matter of a patent granted on a divisional application extends beyond the content of the earlier application as filed, see Art. 100(c), 138(1)(c) EPC.

The question whether a European parent application may be novelty-destroying state of the art under Art. 54(3) EPC for a divisional application filed from it, or a European divisional application may thus anticipate its parent, is treated in the context of partial priority in **T 557/13** (referral **G 1/15**). For this and previous relevant decisions see Chapter II.D.5.3. "Multiple priorities for one claim".

## 2. Subject-matter of a divisional application

### 2.1. Subject-matter extending beyond content of the earlier application

The wording of Art. 76(1) EPC and the wording of Art. 123(2) EPC is so similar (in all three languages) that it is clear that **exactly the same principles** are to be applied for both types of cases when determining what extends beyond the content of the earlier application (**G 1/05**, point 5.1 of the Reasons). The mere fact that the wording of the French version differs (Art. 76(1), second sentence, EPC: "éléments"; Art. 123(2) EPC: "objet") does not justify a different interpretation (**T 276/97**). The case law on added subject-matter is summarised in Chapter II.E.1 "Article 123(2) EPC – added subject-matter".

Art. 76(1) and Art. 123(2) EPC have the **same purpose**, i.e. to create a fair balance between the interests of applicants and patentees, on the one hand, and competitors and other third parties on the other. The idea underlying these provisions is that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (**G 1/93**, OJ 1994, 541; **T 873/94**, OJ 1997, 456; **T 276/97**, **T 701/97**). Both Art. 76(1) EPC 1973 and Art. 123(2) EPC 1973 enshrine the principle that before grant the legal security of third parties is sufficiently protected by the prohibition of extending the content of the application by amendment beyond what was originally disclosed (**T 1387/05**).

Since the underlying requirements of Art. 123(2) and 76(1) EPC are the same, there is no harm done if the examining division incorrectly refers to Art. 123(2) EPC (instead of Art. 76(1) EPC) when refusing a divisional application on the grounds that its subject-matter extended beyond the parent application (**T 542/94**).

According to the EPO practice, an unamended description identical to that contained in the parent application is normally accepted. In **T 441/92**, therefore, the board took the view that there was nothing in the EPC to prevent an applicant from repeating the earlier description in a divisional application and that Art. 76(1) EPC 1973 had not been contravened in this respect in the case in point.

#### 2.1.1 Directly and unambiguously derivable from content of earlier application as filed

The subject-matter of a divisional application must be **directly and unambiguously derivable** from the earlier application as filed (see **G 1/06**, OJ 2008, 307, headnote). More specifically, subject-matter of the divisional must be directly and unambiguously

derivable by the skilled person from the disclosure of the earlier, parent application as filed, as determined by the totality of its claims, description and figures when read in context (see consolidated cases **T 1500/07**, **T 1501/07**, **T 1502/07**; see also **T 961/09**).

Subject-matter claimed in the divisional application has to be compared with the content of the earlier (parent) application as filed, whereby the content of an application comprises the whole disclosure, express or implied, that is directly and unambiguously derivable from the application including information which is implicit and immediately and unambiguously apparent to a person skilled in the art reading the application (**T 423/03**). In other words, it has to be established whether technical information has been introduced into the divisional application which a skilled person would not have objectively and unambiguously derived from the earlier application as filed (**T 402/00**).

The "content" within the meaning of Art. 76 EPC is to be interpreted as the **whole technical content** of the earlier application (**G 1/05**, point 9.2 of the Reasons). Art. 76 EPC does not require that the content be disclosed in the claims of the earlier application. It only requires that the subject-matter be disclosed as such anywhere in the whole disclosure of the earlier application (**T 211/95**, **T 1026/03**, **T 314/06**).

#### 2.1.2 Sequence of divisionals - derivable from each of the preceding applications as filed

In **G 1/06** (OJ 2008, 307) the Enlarged Board ruled that Art. 76 EPC 1973 also applied to divisionals from divisionals, because – if not specifically provided otherwise – divisionals must be treated just like any other application. Therefore a divisional (of whatever generation) could be the "earlier application" within the meaning of Art. 76(1) EPC 1973 for a further divisional. In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it was a necessary and sufficient condition for a divisional application of that sequence to comply with Art. 76(1) EPC 1973, second sentence, that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in **each of the preceding applications as filed** (see **G 1/06**, headnote).

The subject matter has to be still present (i.e. it was not unequivocally and definitively abandoned by that time, see **J 2/01**, OJ 2005, 88; **J 15/85**, OJ 1986, 395) in each earlier predecessor application at the time the - further - divisional application was filed so that it was thereby existing at all times throughout after its disclosure in the root application as filed up to and including the date of filing the divisional application under consideration. Content which had been omitted on filing a member higher up the sequence could not be re-introduced into that member or in divisional applications lower down the sequence from it. Conversely, content which has been added on filing of a divisional application a sequence higher up could not be claimed in a divisional application down the sequence because according to Art. 76(1) EPC such added matter did not benefit from the filing date of the root application in which it was not disclosed (see **G 1/06**, point 11.2 of the Reasons).

In **T 2175/09** the appellant accepted that Art. 76(1) and 100(c) EPC 1973 prohibited adding subject-matter beyond the content of the immediately preceding application from which a divisional application was derived, and that it was the purpose of these articles to prohibit extending the subject-matter beyond the root application as filed. However, the appellant argued that an infringement of Art. 76(1) EPC 1973 in the case of an intermediate higher-generation divisional application (here the grandparent application) did not constitute a ground for opposition under Art. 100(c) EPC 1973. The board held that Art. 100(c) EPC 1973 gave the public the possibility of opposing a patent on the ground that its subject-matter extended beyond the content of the earlier application as filed if an infringement of Art. 76(1) EPC 1973 had been overlooked in examination proceedings. This also applied in the particular case of an infringement of Art. 76(1) EPC 1973 in an intermediate higher-generation divisional application. The grandparent application too is "the earlier application" within the meaning of Art. 100(c) EPC.

### 2.1.3 Language issues

In **T 1076/12** the board held that it was the text of the application as originally filed, even if the text was not in an official language of the EPO, that had to be used, together with any other non-text portions of the application as filed, in order to determine the "content of the earlier application as filed" as referred to in Art. 76(1) EPC.

## 2.2. Amendments to divisional applications

Divisional applications are new applications which are separate and independent from the earlier applications. Amendments to a divisional application are thus allowed under Art. 123(2) EPC to the **same extent as amendments of any other non-divisional application (G 1/05, OJ 2008, 271, points 9.1-9.2 of the Reasons)**.

Amendments may be allowed even if the divisional application as filed contains – contrary to Art. 76(1), second sentence, first half sentence, EPC – subject-matter extending beyond the earlier application as filed. Such a divisional application is **not** to be considered "**invalid**" (**G 1/05, OJ 2008, 271, point 2.9 of the Reasons**). It may still be amended during examination proceedings so that it complies with the requirements of Art. 76(1) EPC, provided always, however, that the amendment complies with the other requirements of the EPC (see **G 1/05, OJ 2008, 271, point 7 of the Reasons**). Even if the **earlier application is no longer pending**, it remains possible to amend a divisional application to bring it in line with the requirements of Art. 76(1) EPC (**G 1/05, OJ 2008, 271, points 8.1-8.2 of the Reasons**).

If a divisional application is amended, it must meet **both the requirements of Art. 76(1) EPC and those of Art. 123(2) EPC**, so as to preclude the introduction of new subject-matter into the examination proceedings (see, among many others, **T 284/85, T 441/92, T 873/94, OJ 1997, 456; T 1221/97, T 1008/99, T 561/00, T 402/00, T 423/03**).

### 2.3. Subject-matter of a patent granted on a divisional application

#### 2.3.1 Findings of G 1/05 and G 1/06 also applicable to granted patents

The findings of the Enlarged Board of Appeal in **G 1/05** (OJ 2008, 271) and **G 1/06** (OJ 2008, 307), although made in regard to patent applications, are also valid for **granted patents**. This can be derived from the fact that the Enlarged Board of Appeal relied on a direct correspondence between Art. 76(1) and 123(2) EPC, both articles enshrining the same principles, and that Art. 123(2) EPC applied to both patent applications and patents (**T 265/05**). Thus, in order to meet the requirements of Art. 100(c) EPC 1973, it was a necessary and sufficient condition that anything disclosed in the granted patent had to be directly and unambiguously derivable not only from the application on which the patent had been granted, but also from what was disclosed in each of the preceding applications as filed (**T 687/05**, **T 549/09**, **T 2175/09**).

#### 2.3.2 Ground for opposition under Article 100(c) EPC

In **T 475/02** the board had to decide whether the patent application fulfilled the requirements of Art. 100(c) EPC. Since the opposed patent was granted on a divisional application, for the subject-matter of any claim as granted to be allowable, it had to pass both of the two tests of this provision: (i) the subject-matter must not extend beyond the content of the divisional application as filed; and, (ii) it must not extend beyond the content of the earlier application as filed. Whether the first test was passed depended only on the particular claim and on the content of the divisional application as filed. That the subject-matter of a claim passed the second test did not necessarily mean that it passed the first, and vice-versa. The two tests needed separate consideration, in particular where the divisional application as filed did not include the complete text (both description and claims) of the parent application.

The opposition division in **T 806/03** decided that Art. 123(2) EPC had not been complied with applying the test to "the application as originally filed, which is the parent application". The board stated that the first test under Art. 100(c) EPC was governed by Art. 123(2) EPC, and the second by Art. 76(1) EPC. The board held that the wrong reference made no difference with regard to the substance of the opposition division's decision, since the descriptions of the parent application and of the divisional application as filed were identical.

In **T 2233/09** the board held that Art. 100(c) EPC contained two distinct legal grounds: Art. 76(1) EPC and Art. 123(2) EPC. Since no objections with respect to Art. 76(1) EPC had been raised during the opposition proceedings, such a new legal ground could be introduced in the appeal proceedings only with the consent of the patent proprietor.

In **T 1975/09** the board held that Art. 100(c) EPC - and not Art. 76(1) EPC - would have been the correct provision to cite in the decision of the opposition division when the claims of the granted patent were considered. With respect to amendments made to the claims in the course of the opposition proceedings, Art. 101(3)(a) and (b) EPC required the opposition division to form an opinion on whether or not the patent and the invention



to which it related met the requirements of the Convention. Art. 76(1) EPC related to a requirement for filing a divisional application, which was not a requirement under the Convention for an (amended) patent. Therefore, the requirement of Art. 123(2) EPC, although not explicitly referring to the content of the "earlier application(s)", was the corresponding requirement of the Convention within the meaning of Art. 101(3) EPC, to be met by the patent in relation to amendments made thereto, with respect to the content of the earlier and of the divisional application(s) as filed.

#### **2.4. Link between subject-matter of earlier application and of divisional application**

##### **2.4.1 No abandonment of subject-matter in earlier application if divisional is filed**

In **T 118/91** the respondent argued that since a divisional application was filed, the subject-matter of the divisional must be considered to have been abandoned in the parent application. The board held that there was nothing in Art. 76 EPC 1973 or any other provision of the EPC to support that contention: the content of the application as filed cannot, as a matter of logic, be reduced by the subsequent filing of a divisional application.

##### **2.4.2 No effect on content of divisional application if earlier application has lapsed**

In **T 441/92** the parent application lapsed irrevocably after the divisional application had been filed. The board held that the lapse of the parent application cannot have the effect of reducing the content of a previously filed divisional application.

##### **2.4.3 Final decision on subject-matter in the parent application - res judicata**

In **T 51/08** the appellant had submitted with the statement of grounds of appeal amended claims corresponding to the second auxiliary request of the parent application which had already been refused on appeal. The board held that subject-matter on which a final decision had been taken by a board of appeal in the parent application became res judicata and could not be pursued in the divisional application (see also **T 790/10**).

In **T 1643/10** the board left open the question of whether, or to what extent, decisions regarding a parent or a sibling application represent res judicata for a divisional application.

In **T 2084/11** the appellant (opponent) had argued that the invention's reproducibility was res judicata, a final decision having already been taken on the parent application. The board noted that the EPC did not mention res judicata, let alone regulate its applicability in the context of separate proceedings on parent and divisional applications or any resulting patents. EPO proceedings on a divisional were essentially independent of those on its parent (see **T 1254/06**). The board therefore doubted that a final decision taken in opposition appeal proceedings (here revocation of the patent) could have any "cross-procedural" res judicata effect at all on separate opposition (or opposition appeal) proceedings concerning a patent granted on a divisional. **T 167/93** had already said that res judicata, whilst a generally recognised principle, was of extremely narrow scope and

would only "involve something" where (amongst other criteria) "the issues of fact are the same". But it had said nothing about any "cross-procedural" application. In the case in point, the board anyway took the view that the above criterion from **T 167/93** was clearly not fulfilled, because the subject-matter (the "something" in the sense of **T 167/93**) requiring the division's or board's decision was not the patent granted for the parent application; rather, it was the divisional-derived patent and whether the requests submitted were legally sustainable in view of the objections raised, and – in contrast to **T 51/08** – the requests (sets of claims) for decision in the two sets of proceedings were also not identical. Moreover, the underlying facts were different since further evidence had been submitted. The board's conclusion was that an appeal decision on the parent patent could have no *res judicata* effect in opposition (or opposition appeal) proceedings as regards the reproducibility, and thus the validity, of the divisional-derived patent in suit.

In **T 1155/13** an objection of lack of sufficiency was raised by the appellant against the patent based on a divisional application. The board considered, however, that **T 468/09** had dealt with an insufficiency objection in relation to the patent granted on the basis of the parent application. Since decision **T 468/09** was *res judicata* and dealt with insufficiency of disclosure in relation to the same embodiments, and the facts were the same, the current board had no power to examine this objection again (with reference to **T 51/08**).

#### 2.4.4 Re-filing of same subject-matter

In **T 1287/07** the appellant had submitted before the board that re-filing the same subject-matter comprised in an earlier divisional application which had been withdrawn and converted into a national right was an abuse of procedure. The board clarified that this re-filing did not fall within the grounds for opposition exhaustively listed in Art. 100 EPC, and there was no legal basis for revoking the patent in suit on this basis. Therefore, the alleged re-filing of the same subject-matter could not result in the revocation of the patent in suit.

In **T 1437/10** the appellant filed new requests during oral proceedings which claimed subject-matter essentially identical to the scope of protection of the granted European patent for which the appellant was the proprietor and for which the application at issue was the earlier application in accordance with Art. 76(1) EPC. Consequently, the subject-matter of the new requests had already been decided in favour of the appellant and a second decision on the same subject-matter was superfluous. The board therefore exercised its discretion under Art. 13(1) RPBA so as not to admit the new requests into the procedure.

### 3. Filing a divisional application

#### 3.1. Right to file a divisional application

##### 3.1.1 Applicant of earlier application entitled to file divisional application

In **J 20/05** the board held that only the applicant of the earlier (parent) application was entitled to file the divisional application. It stated that, fundamentally, it is the entitlement acquired by virtue of the parent application that gives the right to file a divisional application. This means that the rights in respect of the divisional application derivable from the parent application extend to, but are also limited to, the rights existing in the parent application at the filing date of the divisional application. The entitlement to file a divisional application under Art. 76 and R. 25 EPC 1973 (now R. 36 EPC) was a procedural right that derived from the applicant's status as applicant in the earlier application (with reference to **J 2/01**).

In **J 34/86** the Legal Board of Appeal allowed an application to be filed as a divisional application by a party other than the registered applicant for the parent application. This case concerned, however, a particular set of circumstances. The applicant for the parent application had been ordered by a US court to assign all property rights in the invention to the person who became the applicant for the divisional application, and the applicant for the parent application had already signed an assignment to that effect.

##### 3.1.2 Filing of divisional application during stay of proceedings

In **J 20/05** application proceedings had been suspended under R. 13 EPC 1973 (now R. 14 EPC) because of pending national entitlement proceedings. The Legal Board decided that the applicant was not entitled to file a divisional application relating to that application while the proceedings remained suspended (confirmed in **G 1/09**, OJ 2011, 336).

In **J 9/12** the Legal Board added that to allow the filing of a divisional application by an applicant whose entitlement was challenged would be inconsistent with and contrary to the fundamental objective of R. 14(1) EPC, which was to preserve any potential rights a third party might have to the grant of a patent for the earlier application in dispute.

##### 3.1.3 Joint applicants

In **J 2/01** (OJ 2005, 88) the board held that joint applicants could not acquire a procedural status different from that of a single applicant, because otherwise each of them could perform different and contradictory procedural acts, including the filing of different versions of the patent to be granted. Therefore, where an application (the "earlier application") had been filed jointly by two or more applicants and the requirements of Art. 61 or R. 20(3) EPC 1973 (now R. 22 (3) EPC) had not been met, the right to file a divisional application in respect of the earlier applications under Art. 76 EPC 1973 was only available to the registered applicants for the earlier application jointly and not to one of them alone or to fewer than all of them.

### 3.1.4 Announcing the filing of a divisional application

In **T 1184/03** the appellant requested during the oral proceedings before the board that the delivery of the decision be postponed with a view to filing a divisional application. Since the case was ready to be decided at the oral proceedings, the board held that **postponing the decision** of the board to allow the filing of a divisional application would run counter to the public interest in having the matter decided as expeditiously as possible, because the matter ready to be finally decided by this board would be pending again.

In **T 591/05** the applicant had declared during the examination proceedings that he **reserved the right** to file a divisional application. The board found that this declaration created no obligation for the examining division to check the status of any possible divisional application or to postpone the grant of the patent. It was incumbent on the applicant, and not on the EPO, to undertake the appropriate measures to ensure that any possible divisional application was filed in due time before the grant procedure was closed.

### 3.2. Filing date attributed to divisional application

According to Art. 76(1), second sentence, EPC, in so far as the subject matter of the divisional application does not extend beyond the content of the earlier application as filed, the divisional application shall be deemed to have been filed on the date of filing of the earlier application.

The characterising feature of a sequence of divisional applications each divided out from its predecessor is that each member of the sequence claims as filing date the date of the originating or root application in which the subject-matter divided out in sequences of divisional applications was first disclosed. The filing date of the root application is the **only filing date** which can be attributed to a divisional application, by way of the legal fiction contained in Art. 76(1), second sentence, second half sentence, EPC 1973, irrespective of whether the divisional application is a first divisional or a divisional further down in a sequence of divisionals (**G 1/06**, point 11.1 of the Reasons).

In **T 600/08**, the Receiving Section had granted the request that the applicant's name in the divisional application be corrected (under R. 88 EPC 1973) on the ground that the wrong firm had been named as applicant by mistake. Before the board, the appellant (opponent) asserted that the request for correction under R. 88 EPC 1973 ought not to have been granted and that the divisional application was therefore invalid. As a result, the filing date relevant for the patent at issue was the date of receipt of the application on which it was based. The board found that there were only two alternatives for a European patent application filed as a divisional application: either it was not treated as a divisional application, in which case the grant procedure would not even start, or it was treated as a divisional application, in which case it could only be accorded the filing date of its parent application. Since the application on which the patent was based had been filed as a divisional application and then treated as such, there was no choice but to accord it the filing date of the parent application.

### 3.3. Divisional application to be filed with EPO

Divisional applications must be filed with the EPO in Munich, The Hague or Berlin (R. 36(2), third sentence, EPC). If a divisional application is sent to a national authority, the latter does not have to transmit it to the EPO. However, if it does, this application will have as date of receipt the date on which it reaches the EPO (**T 196/10**).

### 3.4. Requirement of pending earlier application

R. 36 EPC (former R. 25 EPC 1973) requires that a divisional application only be filed if it is in relation to any **pending** earlier patent application. In **G 1/09** (OJ 2011, 336) the Enlarged Board of Appeal decided that a "pending (earlier) European patent application" in the specific context of R. 25 EPC 1973 (R. 36(1) EPC) was a patent application in a status in which substantive rights deriving therefrom under the EPC were (still) in existence.

As to the related question whether a divisional application can be validly filed during proceedings that have been stayed, see above in this chapter II.F.3.1.2, "Filing of divisional application during stay of proceedings".

#### 3.4.1 Changes to Implementing Regulations

In the original version of R. 25 EPC 1973 of 1.10.1988, a divisional application could be filed only up to the date on which the applicant approved the text in which the patent was to be granted under R. 51(4) EPC 1973 (in the version which entered into force on 1.09.1987). For a brief overview of the case law in respect of the version of 1.10.1988 see "Case Law of the Boards of Appeal of the EPO", 6th edition 2010, p. 389-390, summarising the decisions **G 10/92**, **J 36/92**, **J 27/94**, **J 29/96** (for more detailed information, see "Case Law of the Boards of Appeal of the EPO", 4th edition 2001, p. 463 ff). Under R. 25(1) EPC 1973 in the amended version of 2.1.2002, the applicant could file a divisional application in respect of any pending earlier European patent application (see "Case Law of the Boards of Appeal of the EPO", 6th edition 2010, p. 390-391). This requirement of pendency was adopted into R. 36(1) EPC.

#### 3.4.2 Requirement of pending earlier application sets no time limit

The wording "to any pending earlier European patent application" in R. 36(1) EPC does **not set a period/time limit**, but rather sets a condition (**J 29/10**, referring to **J 10/01**; **J 24/03**, OJ 2004, 544; **J 18/04**, OJ 2006, 560; **J 7/05**, **G 1/09**, OJ 2011, 336, **J 10/12**). Therefore, the provision on the re-establishment of rights does not apply to the filing of a divisional application because R. 25(1) EPC 1973 does not establish a time limit within the meaning of Art. 122 EPC 1973 (**J 24/03**, see also **J 21/96** and **J 10/01**). R. 134(2) EPC, concerning the effects on periods of a general dislocation in the delivery of mail, does also not apply (**J 29/10**).

In **J 18/04** (OJ 2006, 560) the board held that the term "pending ... patent application" in R. 25(1) EPC 1973 did not set a time limit, but rather established a **substantive**

**requirement** which had to be fulfilled at the point when a divisional application was filed. A board had no power to exempt an applicant from compliance with this substantive requirement. No substantive rights were established in a divisional application before the actual filing date of the divisional application. Substantive rights which were lost in the parent application could not be re-established in the divisional application by applying Art. 122 EPC 1973.

#### 3.4.3 Pendency before the EPO

In **J 18/09** (OJ 2011, 480) the Legal Board of Appeal decided that an international application which did not fulfil the requirements according to Art. 22 PCT for entering the European phase was not pending before the European Patent Office and therefore could not be considered a pending earlier European patent application pursuant to R. 36(1) EPC. The term "pending earlier European patent application" under R. 36(1) EPC included the requirement that the application must be pending before the European Patent Office acting as patent-granting authority according to the EPC. On the basis of the provisions of the PCT and the EPC, a Euro-PCT application not having entered the European phase was not a pending earlier European application within the meaning of R. 36(1) EPC. See also **G 1/09**, point 3.2.5 of the Reasons.

#### 3.4.4 Pendency after grant of earlier application

An application is pending up to (but not including, see **J 7/04**, **J 24/10**) the date on which the European Patent Bulletin mentions the grant of the European patent or up to the date on which the application is refused, withdrawn or deemed withdrawn (**J 28/03**; for the situations of refusal and (deemed) withdrawal of the earlier application, see in this chapter II.F.3.4.5 to 3.4.8). By way of an obiter dictum, the Enlarged Board of Appeal held in **G 1/09** (OJ 2011, 336) that, in the case of a decision to grant, the pending status of the European patent application normally ceased on the day before the mention of its grant was published since from that point in time substantive rights under the EPC were no longer derived from the patent application, but now derived from the granted patent.

#### 3.4.5 Pendency after refusal of earlier application against which no appeal was filed

In **G 1/09** (OJ 2011, 336) the Enlarged Board of Appeal decided that, in the case where **no appeal is filed**, a European patent application which has been refused by a decision of the examining division is thereafter pending within the meaning of R. 25 EPC 1973 (R. 36(1) EPC) until the expiry of the time limit for filing a notice of appeal. It stated that a "pending (earlier) European patent application" in the specific context of R. 25 EPC 1973 (R. 36(1) EPC) was a patent application in a status in which substantive rights deriving therefrom under the EPC were (still) in existence. A patent application which had been refused by the examining division was thereafter still pending within the meaning of R. 25 EPC 1973 (R. 36(1) EPC) until the expiry of the period for filing an appeal and, on the day after, was no longer pending if no appeal was filed.

### 3.4.6 Pendency after refusal of earlier application against which an appeal was filed

In **J 5/08** the Legal Board had to decide whether the parent application was pending at the date of filing of the divisional application which took place **after the appeal** in the parent application had been filed but before the **interlocutory decision** by the Examining Division **revised** the appealed decision. This "reformatory" revision decision was restricted to the correction of the decision to grant without any exhaustive statement in respect of the patentability of the subject matter. According to the Legal Board, a revision decision pursuant to Art. 109 EPC 1973 as such opened up the possibility that the patentability of the claimed subject matter would be completely re-assessed. In the case at issue, the grant proceedings which had been terminated by the revision decision were still pending up to that date of the revision decision. The Legal Board concluded that in general where a decision is taken on the **allowability of an appeal**, an application was pending within the meaning of R. 25 EPC 1973 (now R. 36(1) EPC) at least up to the point in time when the decision was taken.

The Legal Board in **J 5/08** noted that there appeared to be diverging case law on the question of whether the suspensive effect of an appeal always had the consequence that the grant proceedings remained pending within the meaning of R. 25 EPC 1973 (now R. 36(1) EPC) during the appeal proceedings. One line of decisions appeared to say that this was indeed the case (**J 28/94** and **J 3/04**). However, a different view was taken in **J 28/03**, where the Legal Board had decided that the grant proceedings were to be considered as not having been pending during the appeal proceedings if the appeal was dismissed as inadmissible; the status of a divisional application filed while an appeal against the decision to grant a patent on the parent application was pending depended on the outcome of that appeal.

In **J 23/13** the applicant had filed the divisional application after the filing of the notice of appeal against the decision refusing the parent application, but **before the time limit for filing the statement of grounds of appeal** had expired; since no statement of grounds was filed, the board rejected the appeal against the refusal of the parent application as **inadmissible**. The board observed that the divisional application had been filed while the time limit for filing the grounds of appeal was still running. The fact that the appeal was later rejected as inadmissible could not change the fact that, on the date when the divisional was filed, substantive rights were still in existence.

In **J 22/13** the applicant had filed the divisional application, in contrast to the situation in **J 23/13**, **after expiry of the time limit for filing the statement of grounds of appeal**. The application could thus not be treated as a divisional application.

### 3.4.7 Pendency after deemed withdrawal of earlier application and request for re-establishment

In **J 4/11** (OJ 2012, 516) the board held that an application which had been deemed to be withdrawn for non-payment of a renewal fee was not pending within the meaning of R. 25(1) EPC 1973 in the period for filing a request for re-establishment of rights under Art. 122 EPC 1973 in respect of such non-payment, or in the period after which such a

request was filed in the event of such request being refused. The mere existence of the right to file a request for re-establishment of rights in respect of a deemed withdrawn application did not mean that the application was still pending while the period for filing such a request was running. Likewise, the fact that a request for re-establishment of rights was actually filed could not make the application become pending again. The board stated that the point in time when the application was deemed to be withdrawn was the point when the due time for payment of the renewal fee expired; the loss of rights occurred on the expiry of the time limit that had not been observed and, as such, was final in itself. Filing a request for re-establishment did not provisionally revive a deemed withdrawn application. As to whether the applicant enjoyed substantive rights in respect of the earlier application which were (still) subsisting when the later application was filed (see **G 1/09**, OJ 2011, 336), the Legal Board held that in the case at issue the substantive rights under Art. 64 EPC were no longer subsisting. As to other possible rights, the right of the inventor under Art. 60 EPC was held to be no longer subsisting when the divisional application was filed, since the right ceased to exist if and when the application was finally refused, or was withdrawn or deemed to be withdrawn. The board also rejected the appellant's argument that the right to request re-establishment was a substantive right.

#### 3.4.8 Pendency after withdrawal of earlier application

The case underlying **J 20/12** concerned a parent application which had been unconditionally withdrawn but the appellant had filed a request to correct this withdrawal. This request was ultimately refused by the Legal Board of Appeal (in decision **J 1/11**). After the request for correction, the appellant had filed a divisional application, which the Receiving Section decided not to process because the parent application had been withdrawn and, according to R. 36(1) EPC, an applicant could only file a divisional application relating to any pending earlier European patent application. The Legal Board saw no difference between the case of an application deemed to be withdrawn due to the non-payment of fees (which had been dealt with in **J 4/11**, OJ EPO 2012, 516) and an application that had been voluntarily withdrawn by a communication from the applicant (as in the case at issue). In neither case was the withdrawal the result of a decision taken by the Office. From the wording of Art. 67(4) EPC ("withdrawn" in contrast to "finally refused"), and the further clarification given in decision **J 4/11**, it could be concluded that an application was no longer pending as from the moment it had been withdrawn. This was not altered by the possibility of filing a request for correction of a withdrawal under R. 139 EPC, nor by the actual filing of such a request. In other words, an application was not pending because a correction of a withdrawal under R. 139 EPC had been requested. It was not necessary for the board to decide what the position would have been if the request for correction pertaining to the parent application had been allowed.



## 4. Procedural questions

### 4.1. Procedural independence of divisional application

The procedure defined in the EPC for the filing of divisional applications is self-contained and complete (see e.g. **T 587/98**, OJ 2000, 497). The procedure concerning the divisional application is, in principle, independent from the procedure concerning the parent application. Although there are some connections between the two procedures (e.g. concerning time limits), actions (or omissions) occurring in the procedure concerning the parent application after the filing of the divisional application should not influence the procedure concerning the latter (**G 4/98**, OJ 2001, 131, point 5 of the Reasons). The parent application also does not have any procedural priority over the divisional application, which is like any other application and in particular does not have subordinate procedural status (**T 1177/00**, **T 1176/00**).

The consequence of the procedural independence of the divisional application can be seen in **T 1254/06**. In this case, the examining division refused the divisional application and the applicant did not appeal. In the appeal proceedings concerning the parent application (in which the applicant had made the same requests as in the proceedings concerning the divisional application) the question arose whether the legal force of a **refusal decision** in respect of the divisional application also affected the parent application procedure to the extent that it could prevent the EPO (including the boards of appeal) from dealing with the substance of identical requests. The board stated that the principle that both proceedings were independent meant that a decision to remit in one procedure did **not** have a **preclusive effect** with respect to identical requests in the other procedure. This applied in particular when, as in this case, the decision to remit was made not by the board of appeal but by the examining division, because the first-instance administrative decision – unlike the final decision of a judicial body – did not have true *res judicata* effect.

In case **J 5/07** the appellant had failed to file observations according to Art. 96(2) EPC 1973 (now Art. 94(3) EPC). The appellant's request for further processing was rejected on the ground that the omitted act was not completed in due time (Art. 121(2) EPC 1973; now R. 135(1) EPC). The appellant filed an appeal against this decision, arguing that the omitted act was in fact completed because in response to the communication a divisional application was filed by the appellant. The Legal Board held that, as a consequence of the principle that a divisional application was legally and administratively separate and independent from the grant proceedings concerning the parent application, the filing of a divisional application could not constitute a response to the invitation by the Examining Division in the parent application within the meaning of Art. 96(3) EPC 1973 (now Art. 94(4) EPC). The filing of a divisional application left the text of the patent application objected to unamended. Therefore, there was no logical or legal basis for treating an act during the grant procedure for one application (the divisional) as the procedural step required to make up for a failure to comply with a time limit to be observed in entirely separate grant proceedings (the parent).

The board in **T 591/05** could not see how the filing and the status of a divisional application might have had any bearing on the admissibility of the appeal against the parent. In particular, any allegation relating to the circumstances under which the divisional application had been filed might have been pertinent to the legal status of the divisional application, but was irrelevant to the issue of the admissibility of the appeal.

In **T 1705/11** the board held that facts, evidence and requests or submissions made or filed in the parent procedure were not automatically part of the divisional procedure. A general citation or a mere reference to facts and/or evidence, such as to prior art documents, filed in the parent procedure but not physically filed or incorporated into the divisional application procedure did not constitute a reservoir upon which a party might draw at its convenience and at any time in the divisional application procedure.

## **4.2. Designation of contracting states in a divisional application**

### **4.2.1 Deemed designation of all states designated in earlier application at the date of filing of divisional**

According to Art. 76(2) EPC 1973, the European divisional application shall not designate contracting states which were not designated in the earlier application. Pursuant to Art. 76(2) EPC all the contracting states designated in the earlier application at the time of filing of a divisional application are deemed to be designated in the divisional application. For divisional applications filed after 1 April 2009, only one designation fee has to be paid (Art. 2(1), item 3 RFees); if this designation fee is not paid in due time, the application is deemed to be withdrawn (R. 36(4) EPC, R. 39(2) EPC).

### **4.2.2 Payment of fee for each designated State – case law concerning situation prior to 1 April 2009**

The following case law concerns the situation regarding divisional applications filed before 1 April 2009, where designation fees had to be paid for each designation of a contracting state (see Art. 2(2), item 3 RFees).

In **G 4/98** (OJ 2001, 131) the Enlarged Board of Appeal found that there was no support under the European patent system for the view that a failure to pay designation fees in due time had the effect that the designations disappeared retroactively as if they had never existed. On the contrary, the board pointed out that the wording of Art. 78(2) and Art. 79(2) EPC 1973 and the European patent system clearly indicated that up to the due date for payment of the designation fees, the designations had full effect. Only if the designation fees were not paid in due time would the designations not have any effect with respect to acts to be performed after that date, such as the filing of a divisional application. Retroactivity of the effects of non-payment of designation fees would occur only where the EPC explicitly provided for it, i.e. in the case of provisional protection (Art. 67(4) EPC 1973). The applicant might designate all contracting states designated in the parent application in the divisional application, and he might proceed with all of them even if in respect of the parent application he later paid only some or no designation fees. This was in line with the fact that the procedure concerning the divisional

application was in principle independent from the procedure concerning the parent application and that the divisional application was treated as a new application. **G 4/98** supersedes the decision in **J 22/95** (OJ 1998, 569), according to which failure to pay a designation fee rendered the designation void ab initio.

In **J 40/03** the applicant sought to designate a contracting state in a divisional application filed after the time limit for payment of designation fees on the parent application had expired. This contracting state was designated in the parent application as filed but no designation fee for that state had been paid. The board confirmed the established case law (**G 4/98**, OJ 2001, 131; **J 25/88**, OJ 1989, 486; **J 19/96**) on this issue. The designations in a parent application, all or some of which may be designated in a divisional application, were those in the parent at the time of filing of the divisional application. If the time limit for paying the designation fees had expired and designation fees had been paid for fewer states than those originally designated in the parent, then the divisional could only designate some or all of those states which remained designated in the parent; other states formerly designated in the parent were deemed withdrawn by virtue of Art. 91(4) EPC 1973 (now R. 39 (2) EPC), and thus deemed never to have benefited from any provisional protection by virtue of Art. 67(4) EPC 1973. The board concluded that the interpretation of Art. 76(2) EPC 1973 in its proper context could be summarised as "all states **validly** designated in the parent may also be designated in the divisional" (emphasis by the board).

In **J 1/05** the applicant had paid the designation fee only in respect of one contracting state. After the time limit for the payment of designation fees for the parent application had expired, he filed a divisional application designating all the EPC contracting states. The board confirmed **G 4/98** (OJ 2001, 131), in which it was held that only such states as were already designated in the parent application could be designated in a divisional application, or, in the event that the designation fee for the parent application had not been paid, those for which the normal period for payment of the designation fee had not yet expired. After expiry of that period, the provisional designation of any other contracting states was deemed to be withdrawn and the right to designate further states was lost. Moreover, no right to the valid designation of new states in the divisional application could be derived from the fact that an appeal was pending against a notification of a loss of rights under R. 69 (2) EPC 1973 (now R. 112 (2) EPC) in relation to the parent application.

### 4.3. Correction of errors in a divisional application

In **J 17/97** and **J 18/97** the representative had filed the divisional application under a different name than the parent application. The Receiving Section had thus refused to treat the application as a divisional application. The representative filed a request for correction of errors pursuant to R. 88 EPC 1973 (now R. 139 EPC) to replace the name of the applicant of the divisional application with the name of the applicant of the parent application. The Legal Board rejected the request as the appellant had not proved that the divisional application had been filed in error under the wrong name. R. 88 EPC 1973 may not be used to enable a person to give effect to a change of mind or to a subsequent development of plans.

In **T 1008/99**, the request for correction of errors concerned a divisional application which had been filed with a wrong description unrelated to the earlier (parent) application. The wrongly filed description was therefore to be replaced by the description of the parent application. The board rejected the request and held that, for the purposes of R. 88 EPC 1973, the error had to be **apparent from the divisional application itself**, and the parent application could not be used to demonstrate that the error was obvious. Even if it was apparent from the filed description, claims and drawings that they did not belong together, it was not immediately clear from the divisional application itself which of these parts was incorrect.

#### 4.4. Search fee for a divisional application

It was confirmed in **J 7/13** that the relevant provisions for determining the amount of the search fee to be paid for a European divisional application are R. 36(3) EPC and Art. 2(1), item 2, RFees. The time limit for payment in R. 36(3) EPC can only refer to the actual date on which the divisional application documents were received at the EPO. The amount payable does not depend, as contended by the appellant, on the fictitious date of filing accorded to the application under Art. 76(1) EPC, which is conditional on the fulfilment of substantive requirements and likewise has substantive effects.

#### 5. Double patenting

This chapter deals with double patenting arising from the filing of a divisional application. The leading decisions on the issue are **G 1/05** and **G 1/06**, OJ 2008, 271 and 307, in which the Enlarged Board held that the principle of the prohibition on double patenting was based on the idea that the applicant had no legitimate interest in proceedings that gave rise to the grant of a second patent in respect of the same subject-matter for which he already held a patent, see in this chapter II.F.5.1.

The technical boards have several times considered the notion of the "same subject-matter". A mere (partial) overlap does not prejudice the grant of a patent (see **T 587/98**, OJ 2000, 497; **T 877/06**; **T 1491/06**; **T 1391/07**; **T 2402/10**; **T 2461/10**; **T 1780/12**), see in this chapter II.F.5.2.

Some technical boards have sought to identify the legal basis for this prohibition in the EPC and have suggested Art. 125 EPC (**T 587/98**, OJ 2000, 497; but see **T 307/03**, OJ 2009, 422), or Art. 60 EPC (**T 307/03**; but see **T 1423/07**). As noted in **T 2461/10**, the EPC only contains a provision relevant to the prohibition on double patenting in the context of European and national applications and patents (see Art. 139(3) EPC). These decisions are summarised in this chapter II.F.5.2.

For the matter of double patenting arising not from the filing of a divisional application but from **internal priority** see **T 1423/07**, in which the board held that double patenting was not prohibited for European applications claiming a European priority because of the applicant's clear legitimate interest in the longer term of protection possibly available with the later filing, in view of the fact that the filing date and not the priority date was the

relevant date for calculating the 20-year term of the patent (see also **T 2461/10**, which also concerned a case of internal priority and which left this point open).

### **5.1. No legitimate interest in grant of a second patent claiming same subject-matter**

The principle of the prohibition of double patenting is based on the idea that the applicant has no legitimate interest in proceedings that give rise to the grant of a second patent in respect of the same subject-matter for which he already holds a patent. There is therefore nothing objectionable in the established EPO practice that amendments to divisional applications are objected to and refused, when the same subject-matter is claimed in the amended divisional application as in a pending parent application or a granted parent patent. However, this principle could not be applied with a view to preventing the filing of identical applications, because that would infringe the prevailing principle that an assessment of the EPC requirements is made on the basis of the final version put forward (**G 1/05** and **G 1/06**, OJ 2008, 271 and 307, point 13.4 of the Reasons).

### **5.2. Different subject-matter and scope of protection; overlapping subject-matter**

In **T 118/91** and **T 80/98**, care was taken to avoid any risk of double patenting by ensuring that the subject-matter of the divisional application differed from that of the parent application. In **T 118/91**, in particular, the board stated that it could find nothing to support the contention that features forming part of the subject-matter of the divisional application could not be the subject of a dependent claim in the parent application. The board agreed with the Guidelines that, as a general rule, one application may claim its own subject-matter in combination with that of the other application. This approach does not lead to "double patenting" in its normal sense. In this particular case, the board was satisfied that any danger of "double patenting" had been eliminated by extensive restriction of the claims in the divisional application.

In **T 58/86** it was decided that the independent claims in a divisional application impermissibly exceeded the disclosed content of the original application, an essential feature of the relevant subject-matter of the original application being omitted in each of them. Reinstating this feature would have resulted in subject-matter that was already protected in the original application.

In **T 587/98** (OJ 2000, 497) the examining division, relying on the Guidelines prohibiting "conflicting" claims, had refused a European patent application, filed as a divisional application, on the grounds that its subject-matter overlapped with that of the parent application and that in the overlapping region the same subject-matter was claimed; as legal basis for the refusal it invoked Art. 125 EPC. The board held that Art. 125 EPC was not applicable to the case at issue since this article required "the absence of procedural provisions in the Convention" but the provisions governing divisional applications were self-contained and complete. In addition a prohibition of "conflicting" claims in the wide sense applied by the examining division would be a matter of substantive law rather than a matter of procedure - and Art. 125 EPC was not applicable to substantive law. The

board also found that there was no express or implicit provision in the EPC which prohibited the presence in a divisional application of an independent claim - explicitly or as a notional claim arrived at by partitioning of an actual claim into notional claims reciting explicit alternatives - which was related to an independent claim in the parent application (or patent, if it had already been granted) in such a way that the "parent" claim included all the features of the "divisional" claim combined with an additional feature.

In **T 307/03** (OJ 2009, 422) the board understood **T 587/98** to have found that there was no basis in the EPC prohibiting "conflicting claims" within the meaning of the guidelines; it could not follow **T 587/98** on this point. The board in **T 307/03** relied on Art. 60 EPC 1973, concerning the fundamental right to a patent, to deduce the principle of the prohibition of double patenting, and did not seek to import a principle of procedural law solely under Art. 125 EPC 1973. The board emphasised that the principle of the prohibition of double patenting, namely that the inventor (or his successor in title) has a right to the grant of one and only one patent from the EPO for a particular invention as defined in a particular claim, can be deduced from Art. 60 EPC 1973. Once a patent had been granted, this right to a patent had been exhausted and the EPO was entitled to refuse to grant a further patent to the inventor or his successor in title for the subject-matter for which he had already been granted a patent. Furthermore, a double patenting objection can also be raised where the subject-matter of the granted claim is encompassed by the subject-matter of the claim later put forward, that is where the applicant is seeking to re-patent the subject-matter of the already granted patent claim, and in addition to obtain patent protection for the other subject-matter not claimed in the already granted patent. In particular, where the subject-matter which would be double patented is the preferred way of carrying out the invention both of the granted patent and of the pending application under consideration, the extent of double patenting cannot be ignored as *de minimis*. To avoid the objection of double patenting the claims of the pending application should be confined to other subject-matter that is not already patented, to allow the examination procedure to focus on whether a claim to this other subject-matter meets the requirements of the EPC.

According to the board in **T 1423/07**, Art. 60 EPC provides no basis for refusing a European application for double patenting. The purpose of Art. 60 EPC is only to define to whom the right to a European patent belongs. Art. 60 EPC could not be interpreted such that the inventor or his successor in title had a right to the grant of one and only one patent from the EPO for a particular invention, with the consequence that claims comprising subject-matter included in the claims of an already granted patent of the same applicant were refused no matter whether or not the applicant had a legitimate interest in the grant of the subsequent application.

In **T 1391/07** the board noted that the practice of prohibition of "double patenting" was confined to patents and applications relating to the same invention as defined by the subject-matter of the corresponding claims and therefore confined to claims conferring notionally the same scope of protection. It saw no basis for extending this practice to cover claims not defining the same subject-matter but conferring - as in the case before it - a scope of protection overlapping with each other only partially in the sense that some,

but not all of the embodiments notionally encompassed by one of the claims would also be encompassed by the other one of the claims. In particular, the lack of legitimate interest of an applicant in obtaining two patents for the same subject-matter - as invoked by the Enlarged Board of Appeal in decisions **G 1/05** and **G 1/06** (see above) - cannot be invoked when the scopes of protection conferred by the respective subject-matters **overlap only partially** with each other as there is no manifest objective reason to deny the legitimate interest of the applicant in obtaining a protection different from - although partially overlapping with - that of the parent patent already granted. Accordingly, the board concluded that the mere fact that the scope of protection notionally conferred by the claim in suit would partially overlap with that of the granted parent patent did not prejudice the grant of a patent (see also **T 587/98**, OJ 2000, 497; **T 877/06**; **T 1491/06**; **T 1780/12**, **T 2461/10**).

In **T 1708/06** the board held that, notwithstanding the question of whether the principle of the prohibition on double patenting applied under the EPC, the two applications did not relate to the same invention and so the issue of "double patenting" did not arise.

In **T 2402/10** the respondent raised an objection of double patenting, since claim 1 had been amended during the opposition/appeal proceedings in such a manner that its scope fully encompassed the scope of the claims of the patent granted from the grand parent application. The board recalled the well-established case law that a principle of prohibition of double patenting existed on the basis that an applicant had no legitimate interest in proceedings leading to the grant of a second patent for the "same subject-matter" (**G 1/05**, OJ 2008, 271; **G 1/06**, OJ 2008, 307; see also **T 1391/07**, **T 877/06**, **T 1708/06**, **T 469/03**). In the case at issue, claim 1 contained technical features not required by any claim of the patent granted from the grant parent application. Since the patent granted from the grant parent application and the patent in suit claimed different subject-matter, the question of double patenting could not arise. The board noted that the respondent also referred to the headnote of **T 307/03**, according to which a double patenting objection could also be raised where subject-matter of the granted claim was encompassed by the subject-matter of the claim later put forward. The board, however, saw this as no reason to depart from the mandatory requirement of "same subject-matter" invoked in decisions **G 1/05** and **G 1/06** and in the established case law.

In **T 1766/13** the board held that, with respect to the case at issue, a product and a method for its manufacture were not "the same subject-matter" in the sense of **G 1/05** and **G 1/06**. According to **T 1765/13**, the same was true for the use of a product and a method of fabricating it.

In **T 1780/12** the board held that the category of a claim and its technical features constituted its subject-matter and determined the protection conferred (see **G 2/88**, OJ 1990, 93). The claims in question were of different categories: **Swiss-type claims** were purpose-limited process claims (Use of X for the manufacture of a medicament for the treatment of Y) and **claims formulated in accordance with Art. 54(5) EPC** were purpose-limited product claims (X for use in the treatment of Y). As regards the technical features, the board concluded that both sets of claims defined the same compound and the same therapeutic use, but that the Swiss-type claims comprised in addition the

feature of manufacturing a medicament whereas the claim in accordance with Art. 54(5) EPC did not. The claimed subject-matter was thus different. The board also considered that the scope of protection was noticeably different. It was generally accepted as a principle underlying the EPC that a claim to a particular physical activity (e.g. method, process, use) conferred less protection than a claim to the physical entity per se (see decision **G 2/88**). It followed that a purpose-limited process claim also conferred less protection than a purpose-limited product claim. (See also **T 879/12**, **T 13/14** and **T 15/14** agreeing with the conclusions in **T 1780/12**.)

In **T 2461/10** the board noted that the EPC contained only a provision relevant to the prohibition on double patenting in the context of European and national applications and patents (see Art. 139(3) EPC). But double patenting issues could also arise with two European patent applications of the same filing or priority date. There were three possible scenarios: two applications filed by the same applicant on the same day; parent and divisional applications; and (European) priority applications and subsequent (European) applications claiming this priority. In light of decisions **G 1/05** and **G 1/06**, the reason for the prohibition was the lack of a "legitimate interest" (i.e. need for legal protection), which was in turn a general procedural requirement (see **T 9/00**, OJ 2002, 275) and one of the principles of procedural law generally recognised in the contracting states (Art. 125 EPC).

### **5.3. Double patenting objection in opposition**

According to the board in **T 936/04**, "double patenting" is not a ground of opposition. It is, however, within the discretion of the departments of the EPO to raise the objection in opposition or opposition appeal proceedings against proposed amended claims, but this should be done only in clear cases. The purpose behind the principle of the prohibition of double patenting is to avoid unnecessary duplication of effort, and not to impose on the departments of the EPO an obligation to make a complex comparison between the case before them and the claims that may have been granted in some other proceedings. In the case at issue, at the time of the decision by the opposition division, a patent had not yet been granted on the divisional application. For this reason alone the opposition division was correct to disregard the objections of double patenting raised before it. At that stage it would only be a matter for the Examining Division, in the proceedings on the divisional application before it, to avoid double patenting by again allowing claims already granted in the parent patent.



### III. RULES COMMON TO ALL PROCEEDINGS BEFORE THE EPO

#### A. The principle of the protection of legitimate expectations

1.	Applicability of the principle of the protection of legitimate expectations	514
1.1.	Sources of legitimate expectations	514
1.2.	Limits of the legitimate expectations principle	515
1.2.1	Knowledge of the relevant legal provisions and the case law	515
1.2.2	Interpretation of substantive patent law	516
1.2.3	Weighing of interests in inter partes cases	516
1.2.4	Area of party's own responsibility	517
1.2.5	Administrative notice with no legal consequences	517
1.3.	Causal link and the requirement of proof	517
2.	Information provided by EPO	518
2.1.	Clear and unambiguous communications and forms	518
2.2.	Information provided as courtesy service	518
2.3.	Contradictory acts	519
2.4.	Information provided by telephone	520
2.5.	Decisions of the department of first instance	520
2.6.	Correction of already issued decision	520
2.7.	Information provided in the Guidelines	521
3.	Obligation to draw attention to easily remediable deficiencies	521
3.1.	General principle	521
3.1.1	Deficiency correctable within the relevant time limit	522
3.1.2	Obligation to set new time limit	522
3.2.	Examples of cases addressing the obligation to draw attention to easily remediable deficiencies	522
3.2.1	Language issues	522
3.2.2	Missing or insufficient fee payments	523
3.2.3	Electronic filing of documents	524
3.2.4	Further examples involving easily identifiable deficiencies	524
3.3.	Limits of the obligation to draw attention to easily remediable deficiencies	525
3.3.1	Area of party's own responsibility	525
	a) Filing of valid appeal	525
	b) Filing of divisional application	525
	c) Bank account information	526
3.3.2	No obligation to scrutinise submissions for deficiencies	526
4.	Obligation to enquire in case of unclear nature of request	526
5.	Legitimate expectation and case law	527
5.1.	Case law deviating from or overruling the practice	527
5.2.	Point in time from which a new decision which deviates from existing practice becomes generally applicable	528

The principle of the protection of legitimate expectations is a general principle well established in European Community law and generally recognised in the EPC contracting states and board of appeal case law (**G 2/97**, OJ 1999, 123; see also **R 4/09**). Its application to procedures before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (**G 5/88**, **G 7/88**, **G 8/88**, OJ 1991, 137). The term "good faith" is also used to describe this concept (**J 10/84**, OJ 1985, 71; **J 38/97**).

The protection of the legitimate expectations of users of the European patent system has two main principles. It requires that the user must not suffer a disadvantage as a result of having relied on erroneous information or a misleading communication received from the EPO (see in this chapter III.A.2). It also requires the EPO to warn the applicant of any loss of right if such a warning can be expected in good faith. This presupposes that the deficiency can be readily identified by the EPO (see in this chapter III.A.3).

Users of the European patent system, who are parties in proceedings before the EPO, must also act in good faith (**G 2/97**, **R 4/09**). An alleged violation of the principle of the protection of legitimate expectations is in itself not a ground for a petition for review under Art. 112a EPC (**R 13/11**).

## **1. Applicability of the principle of the protection of legitimate expectations**

The principle of the protection of legitimate expectations applies to all procedural actions – whether formal or informal – taken by EPO employees vis-à-vis parties to proceedings (**T 160/92**, OJ 1995, 35; see also **T 343/95**; **T 460/95** of 16.7.1996; **T 428/98**, OJ 2001, 494). It applies to both ex parte and inter partes proceedings (**T 923/95**). The requirements in connection with the principle of good faith to be observed by the EPO are the same vis-à-vis all parties involved in proceedings before the EPO, be they applicants, patent proprietors or opponents (**T 161/96**, OJ 1999, 331, see also **J 12/94**). The principle of the protection of legitimate expectations also applies to acts performed by other authorities concerned in Euro-PCT proceedings during the international phase such as the US Patent Office acting as receiving Office or as International Preliminary Examining Authority (**J 13/03**). It applies also to the conduct of national authorities when dealing with European patent applications filed with them under Art. 75(1)(b) EPC (**J 34/03**).

### **1.1. Sources of legitimate expectations**

Sources of legitimate expectations include information provided by the EPO in individual cases (e.g. in the form of communications to the party), information contained in official statements of general applicability and published by the EPO (e.g. the Guidelines and the Official Journal), established practice of departments of the EPO, and decisions taken by the Enlarged Board because of its special role (see **J 25/95** and the decisions given on the same day, namely **J 14/95**, **J 15/95**, **J 16/95**, **J 17/95** and **J 24/95**; see also **T 905/90**, OJ 1994, 306, Corr. 556). The case law of the boards of appeal may also be a source of legitimate expectation, in particular, if it is established case law which has become enshrined in the consistent practice of the department of first instance (see

**J 27/94**, OJ 1995, 831; see also in this chapter III.A.5). Courtesy services provided by the EPO may also be a source of legitimate expectation (see **J 1/89**, OJ 1992, 17; see also in this chapter III.A.2.2).

## 1.2. Limits of the legitimate expectations principle

### 1.2.1 Knowledge of the relevant legal provisions and the case law

Parties to proceedings before the EPO - and their representatives - are expected to know the relevant provisions of the EPC, even when such provisions were intricate (**J 27/92**, OJ 1995, 288), as well as all notices published by the EPO which are relevant to patent practice (**T 267/08**). In general, the parties to EPO proceedings are presumed to know the law relating to the EPC, including the relevant decisions of the boards of appeal (**R 17/09**).

The board decided in **J 17/98** (OJ 2000, 399) that the principle of protection of legitimate expectations according to which communications of the EPO, including official forms, must be clear and unambiguous, did not extend so far as to require comprehensive legal advice to be contained in such forms. While forms must be clear and unambiguous, they need **not contain detailed explanations of the law**. This was especially true for legal issues which directly follow from the provisions of the EPC (see also **T 778/00**, OJ 2001, 554).

The board decided in **J 5/02** that it was not a violation of the principle of the protection of legitimate expectations if the EPO provided a professional representative with incorrect information on the basis of which he concluded that the relevant legal provisions - in this case Art. 122 EPC 1973 - were no longer applicable. If he did not realise the information was incorrect, he was guilty of **fundamentally inexcusable ignorance of the law**; if he did realise it was incorrect, he was not misled.

In **T 267/08** the board held that professional representatives must be expected to be acquainted with all notices published by the EPO which are relevant to patent practice. The new representative should have realised that the Decision of the President of the European Patent Office dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, L.1) explicitly required an original version of the authorisation to be filed and that the decision of the President of the European Patent Office dated 12 July 2007 concerning the filing of patent applications and other documents by facsimile (OJ SE 3/2007, A.3) forbade the filing of authorisations by fax. The fact that the new representative had previously been notified that the change of representative had been registered should not have misled him into believing that a faxed version of an authorisation would suffice. Only a "fundamentally inexcusable ignorance of the law" (referring to **J 5/02**) could lead him to this conclusion.

The Enlarged Board held in **R 4/09**, in the context of an alleged breach of the principle of legitimate expectation, that a party to the proceedings, at least where it was represented by an authorised representative, was deemed to know the case law, and cannot plead lack of such knowledge as an excuse, "Ignorantia legis non excusat". According to

**J 19/10**, the professional representative could be expected to be familiar with procedural matters in general, and the boards' detailed and consistent jurisprudence in particular.

In **T 1086/09** the board held that the representative's expectation that a refund of 50% of the appeal fee would be available was not legitimate as it was the consequence of an error in law, i.e. an incorrect reading of the new R. 103(2) EPC, which did not apply to the appeal in question.

### 1.2.2 Interpretation of substantive patent law

In **G 2/07** and **G 1/08** (OJ 2012, 130 and 206) the Enlarged Board of Appeal held that there could be no "legitimate expectation" that an interpretation of a substantive provision governing patentability given in a decision of the boards of appeal will not be overruled in the future by the Enlarged Board, since recognising such an expectation as legitimate would undermine the function of the Enlarged Board of Appeal. This holds particularly true for issues on which there is no solid body of decisions all to the same effect but where instead the relevant jurisprudence consists only of a very limited number of individual decisions.

### 1.2.3 Weighing of interests in inter partes cases

In **T 1644/10**, the EPO had published an incorrect patent specification B1 and subsequently corrected it as B9. The appellant had relied on the accuracy of the published specification B1 and consequently failed to file notice of opposition within the prescribed period. The board held that whether the protection of legitimate expectations could be applied in an inter partes procedure where there had been a failure to meet the opposition deadline was subject to a weighing-up of interests. There was no general rule that the patentee's legitimate expectation that the grant decision had become final had to be considered subordinate to the opponent's legitimate expectation that the content of the published patent specification was correct. That would run counter to the rule of equal procedural treatment of the parties. In the case at hand, the appellant could not rely on the applicability of the principle of legitimate expectations in relation to its failure to meet the opposition deadline.

In **T 595/11** the appellant had enclosed a debit order for a reduced appeal fee with the notice of appeal. The board held that the time frame within which the payment of the fee needed to be checked by the EPO and the party be warned was shorter than the four years that had passed in the present case between the expiry of the time limit for filing the appeal and the time when the Office first made the appellant aware of this issue. The legitimate expectations of the appellant that the fee payment was in good order and would not be objected to, were indeed established. After weighing up the legitimate interests of all the parties the board concluded that the original error might have had serious and inequitable consequences through the Office's failure to discover it. Therefore, it was equitable that the Office' failure was made good and the error was now allowed to be remedied, as far as possible. Seeing that some adverse effect was inevitable, the board considered that the possibility of a real, but otherwise in itself not necessarily decisive setback for a party (here the non-occurrence of an immediate

success) was more preferable than a certain decisive loss of all rights for another party, in particular given the fact that for a long time none of the parties did expect the latter (see also **T 1037/11**).

#### 1.2.4 Area of party's own responsibility

The EPO is generally obliged to draw the party's attention to easily remediable deficiencies. However, the principle of good faith does not impose an obligation to warn a party of deficiencies within the area of the party's own responsibility (for more information, see in this chapter III.A.3.3.1).

#### 1.2.5 Administrative notice with no legal consequences

The Enlarged Board observed in **G 2/97** (OJ 1999, 123) that the notice sent by the registry of the boards of appeal was a standard form, nothing more than an administrative notice to inform the parties of the reference number of the appeal proceedings. It had no legal consequences; it was not a "communication" within the meaning, for example, of Art. 110(2) EPC 1973 (now R. 100(2) EPC). Such a notice could not be considered to give rise to any misunderstanding.

In **T 642/12** the board held that in inter partes appeal cases, the completion of EPO Form 2701 by the formalities officer of the department of first instance does not establish the legitimate expectation that formal requirements of the appeal have already been checked by the EPO.

### 1.3. Causal link and the requirement of proof

For applicants to be able to claim that they have relied on incorrect information in accordance with the principle of good faith, it has to be established that the erroneous information from the EPO was the direct cause of the action taken by the applicants and objectively justified their conduct (**T 460/95**, interlocutory decision of 16.7.1996; **G 2/97**, OJ 1999, 123; **J 5/02** and **J 5/07**). According to **J 27/92**, it must be established that, on an objective basis, it was reasonable for the appellant to have been misled by the information. Whether or not this was the case would depend on the individual circumstances of each case.

In **T 321/95** the board stated that the alleged oral agreement was not mentioned anywhere in the communications between the primary examiner and the appellant and was not derivable from the content of the file either. Thus, arguments supporting the allegation of a violation of good faith could only be considered as the appellant's personal opinion, which did not convince the board because there was no evidence that there had been any agreement in the sense mentioned by the appellant instead of simply a "miscommunication" between the primary examiner and the applicant.

In case **T 343/95**, dealing with the content of a telephone call on which the appellant based its allegation in respect of principle of good faith, the board was of the opinion that even if it was not possible to establish the call's content beyond any reasonable doubt a

posteriori, in a case like the one at hand it was sufficient that the board was satisfied on the basis of a balance of probabilities (i.e. that one set of facts was more likely to be true than the other). In the case at issue the conditions for the application of the principle of legitimate expectations were fulfilled (but see **T 188/97**, where the board could not establish the facts surrounding a telephone conversation with sufficient certainty to invoke the principle of legitimate expectations).

## **2. Information provided by EPO**

### **2.1. Clear and unambiguous communications and forms**

According to the case law of the boards of appeal, the principle of the protection of legitimate expectations governing procedure between the EPO and applicants requires that communications addressed to applicants must be clear and unambiguous, i.e. drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee. A communication from the EPO containing erroneous information which misleads the applicant into taking action causing the refusal of his patent application is null and void in its entirety (**J 2/87**, OJ 1988, 330). An applicant must not suffer a disadvantage as a result of having relied on a misleading communication (**J 3/87**, OJ 1989, 3). On the contrary, if his actions were based on a misleading communication he is to be treated as if he has satisfied the legal requirements (**J 1/89**, OJ 1992, 17).

The Legal Board of Appeal suggested in **J 17/04** that it was the EPO's responsibility to provide **forms** which catered for all procedural possibilities in a clear and unambiguous manner. In the case in point the applicant was allowed to rely on a possible interpretation of the text of the EPO form in accordance with the principle of the protection of legitimate expectations even if another interpretation was more current.

### **2.2. Information provided as courtesy service**

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; **G 2/97**, OJ 1999, 123), or on the fact that the communication was not sent to the correct addressee (**J 23/10**).

In **J 1/89** the board held that the applicant was entitled to rely on the accuracy and completeness of information provided as a courtesy service. He could not, however, rely on courtesy services not required by the Convention being systematically provided. If an applicant paid a renewal fee late as a result of a misleading reminder, he had to be treated as if he had paid in time.

In **J 34/92** the fifth-year renewal fee had not been paid in full. The professional representative did not receive the communication the EPO usually issues drawing attention to the fact that late payment of the renewal fee was possible upon payment of

an additional fee. The loss of rights communication under R. 69(1) EPC 1973 made, however, reference to such communication. The board held that the communication drawing attention to the possibility of a late payment plus surcharge was only a courtesy service of the EPO. The applicant could not draw any conclusions in his favour from the fact that this communication was not sent.

In **J 27/92** (OJ 1995, 288) the appellant's representative had relied on the advice given by the Information Office by telephone as to the amount of the examination fee payable. The board held that where such a service had been rendered, an applicant was entitled to rely upon its content if the - written or oral - 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.

### 2.3. Contradictory acts

In **J 27/94** (OJ 1995, 831) the board decided that if a declaration which was subject to a condition and therefore invalid was treated as a valid procedural act by the EPO, the EPO was not allowed later to go back on its own earlier conduct which served as a basis for the applicant's decision on how to proceed, because this would have represented "venire contra factum proprium" and thus offended against a generally recognised legal maxim.

In **J 14/94** (OJ 1995, 825), the applicant had failed to pay the third renewal fee. Nevertheless, the EPO continued the examination procedure for several years without informing the applicant of any loss of rights. The board held that if, during a long period of time, the EPO by its conduct led the parties and the public to the legitimate belief that no loss of rights had taken place, the EPO could not later refer to a loss of rights which occurred several years previously as this would constitute "venire contra factum proprium" and therefore contravene the principle of legitimate expectations. In such circumstances, the late payment of a renewal fee might - by way of exception - be considered as having been made in time if the EPO had not informed the applicant of the outstanding payment, had accepted later renewal fees without objection and had continued the examination proceedings for several years.

In **J 1/08**, the Legal Board of Appeal concluded that the mere fact that for an admittedly extremely long time period (from August 2004 to March 2007) the EPO had simply not dealt with the application was not sufficient to justify a legitimate expectation on the applicant's side that the application would be regarded by the EPO as still pending. The situation before the board therefore differed from the facts in **J 14/94**, where the EPO had actively continued the examination proceedings for several years.

In **J 18/96** (OJ 1998, 403) the board accorded a filing date to protect an applicant's legitimate expectations, although he had not fulfilled a requirement under Art. 80 EPC 1973. By issuing a communication under R. 85a EPC 1973 (deleted in EPC 2000), the Receiving Section had given him the impression that his application was validly filed (see also **J 5/89**). In **T 926/09** the board treated the claims in question as if they had been originally filed with the application whereas they had in fact been filed in

the period before receipt of the European search report and thus in breach of R. 86(1) EPC 1973. The appellant was entitled to rely on the communication by the Receiving Section indicating that the set of claims was admitted.

In **T 2364/12** the board set aside the opposition division's decision holding the opposition inadmissible on the grounds that the notice of opposition was deemed not to have been filed in due time. The board found that the opponent could, on the basis of the opposition division's communication informing the appellant that the opposition fee was considered to have been validly filed, reasonably assume that the opposition had been validly filed. (see also Chapter III.B "Right to be heard").

In **T 2246/13** the board held that the letter by which the EPO cancelled the oral proceedings and announced that the procedure would be continued in writing in itself resulted in a legitimate expectation on the part of the appellant that it would have the opportunity to file observations, if only to be able to react to the changed situation resulting from the other party's withdrawal of its request for oral proceedings. The appellant thus could not expect that a decision revoking the patent would be issued on the same date. The board set the opposition division's decision aside.

#### **2.4. Information provided by telephone**

Both **T 160/92** (OJ 1995, 35) and **T 428/98** (OJ 2001, 494) concerned information provided by EPO employees by telephone. In **T 160/92** the board did not deny that the principle of legitimate expectations should govern all the actions of EPO employees towards parties to the proceedings, including telephone conversations which were not provided for in the Convention and did not, as such, form part of the formal procedure before the EPO. However, since telephone conversations did not form part of the said formal procedure, the board did not consider it necessary to conduct a detailed investigation seeking to clear up what had been said in the relevant telephone conversations, the sequence of procedurally relevant facts having been clearly established in the file. In **T 428/98** (OJ 2001, 494) the board held that an appellant might rely on information which the board's registrar could be proved to have provided by telephone concerning the method for calculating a time limit the appellant had to observe before the board if the point of law on which that information was based had at that time not yet been clarified in the case law of the boards of appeal.

#### **2.5. Decisions of the department of first instance**

In **T 1448/09**, the board held that the appellant was not at fault in failing to address, in its statement of grounds of appeal, a reason which, in the circumstances, could genuinely have been misunderstood. The principle of good faith required adverse decisions not to contain any ambiguity that could affect their comprehensibility.

#### **2.6. Correction of already issued decision**

In **T 1081/02**, the board held that the communication issued by the opposition division's formalities officer during the period for appeal, stating that the decision already issued



had been sent by mistake and should therefore be disregarded, could not constitute a legally sound basis for regarding the decision's validity as so doubtful that it could be considered void. According to the applicable principle of the protection of legitimate expectations, however, the parties could not be deemed to have failed to comply with the time limit for filing a notice of appeal (Art. 108 EPC 1973) (see also **T 466/03**).

In **T 830/03** the opposition division had issued a second written decision together with a communication which suggested that the first written decision was superseded. The opponent filed a notice of appeal outside the period of four months after the date of the notification of the first decision, but within the time limit after the notification of the second decision. The board held that the only legally valid written decision was the first decision but that, in application of the principle of protection of legitimate expectations, the appeal was deemed to have been filed in time (see also **T 993/06**).

In **T 124/93** the opposition division, after having delivered its decision, re-delivered the same with an additional enclosure under a new mailing date. This had misled the parties about the time limit for filing the notice of appeal and statement of grounds. Applying the principle of the protection of legitimate expectations, the board ruled that the appeal was to be considered as filed in due time (see also **T 972/05**, for another example of re-dating the decision).

## 2.7. Information provided in the Guidelines

The board in **T 1607/08** recalled that the Guidelines published by the EPO were one of the sources of legitimate expectations. Therefore, where the Guidelines gave the clear indication that the continuation of the opposition proceedings had to be communicated to the patent proprietor, the latter was entitled to expect that such information would be given before a decision on the substantive issues was issued. Otherwise, as in the case at issue, the decision to revoke the contested patent would come as a surprise to the patent proprietor.

## 3. Obligation to draw attention to easily remediable deficiencies

### 3.1. General principle

In accordance with the principle of good faith, the EPO is obliged to warn users of the European patent system of omissions or errors which could lead to a final loss of rights. A warning would always be necessary when one could be expected in all good faith (**G 2/97**, OJ 1999, 123). This would presuppose that the deficiency could be **easily identified** by the EPO and the applicant was in a position to **correct the deficiency** and thereby avoid the impending loss of rights (**J 13/90**, OJ 1994, 456). In other words, the EPO can only be expected to warn a party of a deficiency if the deficiency is readily identifiable by the EPO, and the party can still correct it within the relevant time limit (**G 2/97**, **J 13/11**).

The principle of good faith does not impose an obligation to warn a party of deficiencies **within the area of the party's own responsibility** (**G 2/97**; see in this chapter III.A.3.3).

### 3.1.1 Deficiency correctable within the relevant time limit

In **J 13/11** the appellant requested re-establishment in respect of the time limit for paying the third renewal fee on the last day for doing so and after EPO office hours. The board held that there was no time for the EPO to warn the appellant about the non-payment of the third renewal-fee and surcharge even if the EPO had been in a position to spot this deficiency. The board distinguished the case at issue from **T 14/89** (OJ 1990, 432) where the EPO had had ample time, about six weeks before the expiry of the time limit for requesting re-establishment, in which to inform the proprietor of the deficiencies of his request.

See also **T 1764/08** (concerning the electronic filing of the notice of appeal on the last day of the time limit) and the cases referred to therein, in this chapter III.A.3.2.3. See also in this chapter III.A.3.2.2 (missing or insufficient fee payment).

### 3.1.2 Obligation to set new time limit

The Legal Board held in **J 13/90** (OJ 1994, 456) that if the applicant could expect to receive a communication warning him of an impending loss of rights, but that communication was not issued in due time, the EPO must set a new period allowing the applicant to remedy the deficiency and perform the omitted procedural act in due time (see also **T 14/89**). However, this only applies to non-absolute time limits, as an absolute time limit (such as the one year time limit under Art. 122(2), third sentence, EPC 1973, R. 136(1) EPC), by definition, is non-extendable (**J 34/92**, but see also **J 6/08**).

## 3.2. Examples of cases addressing the obligation to draw attention to easily remediable deficiencies

### 3.2.1 Language issues

In **J 3/00** the appellant filed an international patent application at the EPO as receiving Office under the PCT (RO/EPO). The description and claims were filed, by mistake, in Swedish, a language which the RO/EPO did not accept for filing international applications. The board held that this deficiency in the application was immediately and readily identifiable by the receiving Office on the face of the application in the course of the Art. 11(1) PCT check. The appellant could in good faith have expected a warning.

In **T 1152/05** the notice of appeal was filed in Dutch and thus not in one of the official language of the EPO; this document was, in accordance with Art. 14(4) EPC, deemed not to have been filed. In the board's view, there was prima facie no reason for the formalities officer to consider that the patent proprietor would not be entitled to file its notice of appeal in Dutch. As the deficiency was not readily identifiable, the EPO was not obliged to warn the patent proprietor of the fact that it could not benefit of the provisions of Art. 14(4) EPC.

In **T 41/09** the appellant (patent proprietor), a legal entity having its principal place of business in Spain, filed the notice of appeal in Dutch. The appellant argued before the

board that, since the EPO was aware of its nationality, the language deficiency was readily identifiable. The board held that there was no breach of the principle of legitimate expectations of the appellant. It distinguished the situation in the case at issue from the facts of **J 13/90**. In this decision, the deficiency had been readily apparent from the request itself whereas in the case at issue it was not readily apparent from the notice of appeal, which only referred to the name of the appellant, without any indication of the location of its principal place of business.

### 3.2.2 Missing or insufficient fee payments

**J 2/94** involved a letter comprising a request for re-establishment without the necessary payment. According to the board the appellant could not have expected to be informed of the missing fee immediately after receipt of his request for re-establishment by the EPO. There had been no evident indication in the appellant's submission which made a clarification or reminder necessary. Indeed, the EPO could, in practice, often establish whether a specific fee had been paid only after the relevant time limit had expired, once the complete data on all payments made during that period was available.

In **G 2/97** (OJ 1999, 123) the Enlarged Board of Appeal held that the principle of good faith did not impose any obligation on the boards of appeal to notify an appellant that an appeal fee was missing when the notice of appeal was filed so early that the appellant could react and pay the fee in time, if there was no indication - either in the notice of appeal or in any other document filed in relation to the appeal - from which it could be inferred that the appellant would, without such notification, inadvertently miss the time-limit for payment of the appeal fee.

Prior to **G 2/97**, the boards had held in a number of decisions that the EPO had a duty to warn the parties of missing or insufficient fee payments. These included **T 14/89** (OJ 1990, 432), **J 13/90** (OJ 1994, 456), **J 15/90** of 28.11.1994 and **T 923/95** (for further detail the reader is referred to the "Case Law of the Board of Appeal", 7<sup>th</sup> ed. 2013, III.A.3.2.2). The Enlarged Board held with regard to **T 14/89** that the case turned on its particular facts and that there was no generally applicable principle to be derived therefrom. The board in **T 642/12** suggested that the approach in **T 923/95** was no longer tenable as it plainly contradicted the findings of **G 2/97**.

In **T 296/96**, only 50% of the appeal fee was paid before the expiry of the time limit under Art. 108, first sentence, EPC 1973. However, since the formalities officer invited the appellant to pay the remainder of the appeal fee and accepted its subsequent payment without comment, the appellant could assume in all good faith that the appeal was deemed to have been filed (Art. 108, second sentence, EPC 1973) and that, as a consequence, it was not necessary to file a request for re-establishment. The appellant should thus have been invited by the EPO to file such a request before the expiry of the one-year time limit under Art. 122(2), third sentence, EPC 1973. The appellant, who was misled by the action of the formalities officer, must, in accordance with the principle of the protection of legitimate expectations, be treated as having paid the appeal fee in time. The appeal was thus deemed to have been filed.

In **T 161/96** (OJ 1999, 331) the board came to the conclusion that there was no basis for assuming an obligation on the part of the EPO to warn the party of an impending loss of rights relating to an underpayment of 40% of the opposition fee.

In **T 445/98**, the board considered that, because the department which cashed the fee was not the same as the one which received the notice of appeal, the deficiency was not easy to identify and the time between payment of the appeal fee and expiry of the non-observed two-month time limit for filing the notice of appeal was too short, so that the opponent could not expect a warning.

In **T 642/12** the board held that a potential possibility of discovering the error (80% instead of 100% of the appeal fee had been paid) was not sufficient to establish the legitimate expectation that a registrar of the boards of appeal would warn an appellant within seven working days before the expiry of the time limit that a reduced appeal fee had been relied on in error. The appeal fee was thus deemed not to have been paid (but see **T 595/11** in this chapter III.A.1.2.3).

### 3.2.3 Electronic filing of documents

Under the EPO Notice dated 3.12.2003 concerning the electronic filing of documents (OJ 2003, 609) the electronic filing of documents was not admissible in opposition and appeal proceedings. This is no longer applicable, see Decision of the President of the EPO dated 12 July 2007 (OJ SE 3/2007, 12 ff) and subsequent decisions of the President in this regard. There are numerous cases which deal with the electronic filing of the appeal before this became permissible. In the earlier cases, the boards accepted that the appeals were admissible on the basis of the principle of legitimate expectation, see **T 781/04** and **T 991/04** (for more details see "Case Law of the Boards of Appeal of the EPO", 6th ed. 2010, VI.A.2.2.); this changed once a warning had been built into the *epoline*®-system that the filing of appeals by electronic means was not permitted (**T 331/08**). Pursuant to the Decision of the President dated 10 November 2015 (OJ 11/2015, A91) also appeals may now be filed in electronic form.

In **T 1764/08**, the appellant filed its statement setting out the grounds of appeal via *epoline*® on the very last day of the period specified in Art. 108, third sentence, EPC. The board held that, even if the EPO had warned the appellant, the warning would not have allowed the appellant to re-file the statement of grounds of appeal by an acceptable means within said period. Therefore, under the principle of good faith, there was no duty on the part of the EPO to warn the appellant. To that extent, the case at issue differed from cases **T 781/04**, **T 991/04**, **T 514/05** and **T 395/07**, where the deficiency could have been identified in good time before the expiry of the relevant period.

### 3.2.4 Further examples involving easily identifiable deficiencies

In **T 460/95** (interlocutory decision of 16.7.96) the board found that in the case in point the irregularity was obvious and easy to identify, and the appellant could easily have put it right during the time remaining. The registrar, when he received the request for an

extension, could and indeed should have seen that it was based on a misunderstanding during a telephone conversation.

The principle of legitimate expectations was applied in **J 11/89** where the Receiving Section failed to take any particular action upon the receipt of patent documents intended to be considered as priority documents, but whose priority was not claimed in the request for grant.

### 3.3. Limits of the obligation to draw attention to easily remediable deficiencies

#### 3.3.1 Area of party's own responsibility

The case law demonstrates that the principle of good faith does not impose an obligation to warn a party of deficiencies within the area of the party's own responsibility (**G 2/97**, OJ 1999, 123; see also **J 41/92**, OJ 1995, 93; **J 4/96**, **T 690/93**, **T 861/94**, **T 161/96**, OJ 1999, 331; **T 445/98**; **T 778/00**, OJ 2001, 554; **T 267/08**; **R 4/09**). The reason for this is that users of the European patent system, who are parties in proceedings before the EPO must act in good faith, and have the responsibility to take all necessary procedural actions to avoid a loss of rights (**G 2/97**, **R 4/09**).

##### a) Filing of valid appeal

The Enlarged Board of Appeal held in **G 2/97** that the appellant's responsibility for fulfilling the conditions of an admissible appeal could not be devolved to the board of appeal. There can be no legitimate expectation on the part of users of the European patent system that a board of appeal will issue warnings with respect to deficiencies in meeting such responsibilities. To take the principle of good faith that far would imply, in practice, that the boards of appeal would have to systematically assume the responsibilities of the parties to proceedings before them, a proposition for which there was no legal justification in the Convention or in general principles of law.

In **T 267/08** the board made it clear that it was under no obligation to warn a party of deficiencies in the filing of an authorisation; rather, the party itself had the responsibility to take all necessary steps to avoid a loss of rights. Responsibility for filing a valid authorisation could not be devolved to the board.

##### b) Filing of divisional application

In **J 2/08** (OJ 2010, 100), the appellant (applicant) contended that the EPO had violated the principle of good faith on several occasions (omission to inform in respect of filing a divisional application; publication of the divisional application; late noting of loss of right). As a result, in the appellant's view, by taking no action (instead of proactively warning the appellant) the EPO induced the appellant into believing that everything was in good order with the divisional application, until it became too late to file an appeal against the decision refusing the parent application. In the board's view it was exclusively the responsibility of the applicant and his representative to decide on the factually and legally most appropriate filing actions to be taken. Furthermore no legitimate expectations

concerning the validity of an application may be based on the fact that an application has been published. Finally, the loss of rights communication under R. 69 EPC 1973, which is not just a warning but a procedural act, had to be sent after the end of the appeal period.

c) Bank account information

The board in **T 1029/00** decided that the appellant could hardly cite the lack of bank account information on EPO correspondence as the reason for making an incorrect cash payment. Applicants had to ascertain such bank account information for themselves.

### 3.3.2 No obligation to scrutinise submissions for deficiencies

**J 7/97** concerned a European patent application filed with the EPO by fax. One page of the description was missing, whilst another was transmitted twice. The board took the view that a single page missing from a lengthy description was not an "obvious error" under the case law, at least in the circumstances of this particular case. The applicant could not in good faith expect the EPO to check application documents for completeness on the very day it received them. Nor could any such obligation be inferred from the President's decision on fax transmissions (OJ 1992, 299), in which Art. 3 (now Art. 6, Decision of the President of the EPO of 12 July 2007, OJ SE 3/2007, 7) required the filing office to notify the sender as soon as possible "where a document transmitted ... is illegible or incomplete"; the latter adjective clearly referred to the transmission rather than the actual document.

In **T 585/08** the board found that the deficiency in the request for re-establishment (insufficient statement of grounds and facts, R. 136(2) EPC) had not been readily identifiable. First, a number of letters had been filed, and second, it would only have been possible to detect the deficiency if these letters had been studied carefully. In the board's view, the principle of good faith did not impose any obligation on the EPO to scrutinise several letters on file to establish whether grounds and facts with respect to a request for re-establishment were missing. The board distinguished this case from **T 14/89** (OJ 1990, 432) in which the lack of substantiation of the request for re-establishment had been readily identifiable.

## 4. Obligation to enquire in case of unclear nature of request

In **J 15/92** the Legal Board of Appeal held that in the case of a request whose true nature was uncertain (here it was unclear whether it was a request for re-establishment or a request for a decision), the EPO should clarify the matter by asking the requester. It would have been sufficient in the case in point for the EPO to invite the applicant to define his request more precisely. For the EPO to interpret the request arbitrarily constituted an error rendering the impugned decision null and void (see also **J 25/92** and **J 17/04**).

In **J 6/08** the board added that a request (for a decision or re-establishment) filed with a view to obtaining the redressal of a loss of rights within the meaning of

R. 69(1) EPC 1973 had to be interpreted by the EPO in the light of the **requester's objectively discernible will** and taking account of the particular circumstances of the case. In case of doubt the Office is obliged to establish what the requester really wanted and may also be obliged to point out any still outstanding procedural steps in connection with this request (in this case, observance of the period of one year under Art. 122(2) EPC 1973).

Though not expressly relying on the principle of legitimate expectation, the Enlarged Board of Appeal held in **R 14/10** that in cases where a request of a party during oral proceedings was considered unclear, it was the duty of the deciding body to ask for clarification before deliberation. However, if the requests as read out before the debate was declared closed did not correspond to the petitioner's intention, it was the petitioner's duty to intervene at that point.

## 5. Legitimate expectation and case law

There might be cases in which the public has a legitimate expectation that the department of first instance will not deviate from the **established case law** which has become enshrined in the consistent practice of the department of first instance (see **J 27/94**, OJ 1995, 831). A **single decision** of a board of appeal cannot, however, create a legitimate expectation that it will be followed in future (**J 25/95**, **T 500/00**). The users' confidence in the continuity of a practice based on a decision of the **Enlarged Board** might be considered particularly legitimate since all boards of appeal were expected to follow the Enlarged Board's interpretation of the EPC (**J 25/95**).

### 5.1. Case law deviating from or overruling the practice

In **J 27/94** (OJ 1995, 831) the board stated that there might be cases in which the public had a legitimate expectation that the department of first instance would not deviate from the established case law. This might apply if the relevant case law had become enshrined in the consistent practice of the department of first instance, and in particular if this had been made known to the public in published Guidelines, Legal Advice or Notices from the EPO. In such a situation, an applicant might legitimately expect that a practice allowing or even recommending a particular way of proceeding would not be changed without appropriate advance information. In the case at issue, the board held that 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** (OJ 1994, 28), to allow the filing of a divisional application after the approval of the text intended for grant until opinion **G 10/92** (OJ 1994, 633) was made available to the public.

In **J 25/95** the board stressed that the publication of **J 11/91** in the Official Journal of the EPO (OJ 1994, 28) as well as in the publication "Case Law of the Boards of Appeal of the EPO" did not create a legitimate and reasonable expectation that a divisional application could be filed up until the decision to grant. There was no case in which legitimate expectations had been accepted only on the basis of the publication of a single decision of a board of appeal. If there was any doubt whether the established practice in this respect existed, it was up to the appellants to seek clarification by means

of an enquiry to the EPO which would have revealed quickly that the department of first instance did not apply **J 11/91**.

In **T 740/98** the appellant submitted that the disclaimer had been allowed by the examining division in conformity with the Guidelines for Examination (1994 version) and the then established case law of the boards of appeal. Consequently the standards set out in the subsequent decision **G 1/03** (OJ 2004, 413) could not be applied, since this would offend against the principle of good faith and the protection of the legitimate expectations of the users of the EPO. The board noted that the legal system established under the Convention did not treat either the Guidelines or established case law as binding. Thus, any principle of protection of legitimate expectations could not be based on earlier Guidelines or case law. The board held that the standards set out in **G 1/03** were applicable to the case. In **T 500/00** the board added that what counted was not whether the opposition division had acted in accordance with the Guidelines, but whether it had acted in accordance with the Convention. The principle of good faith could not be invoked against the application of principles concerning the allowability of disclaimers laid down in **G 1/03** to pending cases.

## **5.2. Point in time from which a new decision which deviates from existing practice becomes generally applicable**

In three decisions the Enlarged Board of Appeal reached the conclusion that these decisions overturning earlier rulings would not be applied up to the date on which they were made available to the public (**G 5/88**, OJ 1991, 137, concerning an administrative agreement; **G 5/93** OJ 1994, 447 concerning the possibility for Euro-PCT applicants to have their rights re-established with regard to the time limit for paying the national fee provided for in R. 104b EPC 1973; and **G 9/93**, OJ 1994, 891, holding that a European patent cannot be opposed by its own proprietor, thereby overturning **G 1/84**). These three decisions do not, however, form the basis of a general rule (as proposed by the appellant in **J 8/00**) that new case law must never be applied "retrospectively".

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. The situation in the case at issue was not analogous to the situation in **G 9/93**, where the Enlarged Board of Appeal had held that it was inequitable to apply the law as interpreted in **G 9/93** to pending cases. 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.

In **T 739/05**, the board saw no reason to suspend the further prosecution and the final decision of the case until a decision of the Enlarged Board of Appeal was issued on an important point of law which might have been of importance for the case under consideration. The board held that the decision of the Enlarged Board of Appeal could not affect the outcome of the case because of the principle of the protection of legitimate expectations relating to pending cases. Where existing long-standing practice laid down in publications of the EPO is overruled by a new decision, consistent case law (**G 5/93**, **G 9/93**, **T 905/90**, **J 27/94**, **J 25/95**) allows the applicants of pending cases a transitional



period during which they may rely on the previous practice until the modifying decision is made available to the public.

The decision **G 2/08** (OJ 2010, 456) stated that in order to ensure legal certainty and to protect legitimate interests of applicants, the interpretation of the law given by the Enlarged Board in this decision should have no retroactive effect, and an appropriate time limit of three months after publication of the present decision in the Official Journal of the EPO was set in order for future applications to comply with this new situation.

In **G 2/07** and **G 1/08** (OJ 2012, 130 and 206) the Enlarged Board of Appeal held that, in the past, it had granted a transitional period in cases in which its decision had brought about a change in relation to an established procedural practice, which change the parties could not be expected to foresee. By contrast, the existence of "legitimate expectations" has never been acknowledged for issues before the Enlarged Board concerning the correct application, i.e. interpretation, of **substantive patent law**.

## **B. Right to be heard**

1.	Introduction	531
2.	The right to be heard under Article 113(1) EPC	532
2.1.	Violation of the right to be heard examined ex officio	532
2.2.	Causal link between the violation of the right to be heard and the final decision	532
2.2.1	Appeal proceedings	532
2.2.2	First instance proceedings	532
2.3.	Surprising grounds or evidence	533
2.3.1	General principles	533
2.3.2	The meaning of "grounds or evidence"	534
2.3.3	Opportunity to comment on evidence	534
2.3.4	Documents supplied by applicants but used against them	534
2.3.5	Document cited containing information already known	535
2.3.6	Reliance on the IPER	535
2.3.7	Change of provisional opinion after oral proceedings	535
2.3.8	Statement of grounds of appeal not received by respondent	535
2.4.	Consideration of the parties' arguments in the written decision	536
2.4.1	General principles	536
2.4.2	Submissions made after communication	537
2.4.3	Failure to consider evidence	538
2.4.4	Mere reference to jurisprudence	539
2.5.	The right to be heard and the timing of decisions	540
2.5.1	Decision could not be expected	540
2.5.2	Issuing of decision before expiry of time limit to comment	541
2.5.3	Immediate refusal after communication	541
2.5.4	Invitation to oral proceedings at short notice	542
2.6.	The right to be heard in oral proceedings	542
2.6.1	Introduction of a new claim or relevant document	543
a)	Cases in which Article 113(1) EPC was violated due to introduction of new claims or relevant documents	544
b)	Cases in which Article 113(1) EPC was not violated even though new claims or relevant documents were introduced	545
c)	Cases where no new claims or relevant documents were introduced	546
2.6.2	Introduction of new arguments	546
2.6.3	Introduction of a new ground of opposition by the opposition division	547
2.6.4	Hearing witnesses	547
2.6.5	Oral submissions of an accompanying person	548
2.7.	The right to be heard in case of the non-attendance of oral proceedings	548
2.7.1	Facts and evidence put forward for the first time during oral proceedings in inter partes cases – G 4/92	548

2.7.2	Non-attendance at oral proceedings before the boards - case law on G 4/92	549
2.7.3	Non-attendance at oral proceedings before the boards - Article 15(3) RPBA	551
2.8.	Changes in the composition of the opposition division after oral proceedings	552
3.	Text submitted or agreed by applicant (patent proprietor) - Article 113(2) EPC	553
3.1.	General	553
3.2.	The requirement of a text agreed by the applicant	553
3.3.	Cases where the EPO is uncertain or mistaken about the approval of the text	555

## 1. Introduction

The right of parties to a fair trial is a generally recognised procedural principle under Art. 125 EPC (**T 669/90**), and to be observed in all proceedings before the EPO (**R 2/14**). The predictability and verifiability of all state action are indispensable elements of the rule of law and respect for fundamental procedural rights (**G 3/08**, OJ 2011, 10). The right to be heard under Art. 113 EPC is an embodiment of these fundamental principles.

Under Art. 113(1) EPC the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The right to be heard under Art. 113(1) EPC is a fundamental principle (**J 13/10**) and of fundamental importance for ensuring a fair procedure between the EPO and a party to proceedings before it (**J 20/85**, OJ 1987, 102; **G 4/92**, OJ 1994, 149). In inter partes proceedings Art. 113(1) EPC reflects the principle that each party should have a proper opportunity to reply to the case presented by an opposing party (**G 4/95**). Under Art. 113(2) EPC the EPO may examine 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. Art. 113(2) EPC also enshrines a fundamental procedural principle and is part of the right to be heard (**T 647/93**, OJ 1995, 132).

A violation of the right to be heard in first instance proceedings may constitute a fundamental deficiency under Art. 11 RPBA that justifies the remittal of the case to the department of first-instance (see Chapter IV.E.7.4.), as well as a substantial procedural violation under R. 103(1)(a) EPC that may, if equitable, justify the reimbursement of the appeal fee (see Chapter IV.E.8.4.3); see, for example, **T 820/10**, **T 623/12**, **J 13/10**.

A fundamental violation of Art. 113 EPC in appeal proceedings can be the basis for filing a **petition for review** to the Enlarged Board of Appeal (Art. 112a(2)(c) EPC; see Chapter IV.F.3.13). A petition for review can also be based on the failure to arrange requested oral proceedings, and on the failure to decide on a party's request. Both of these additional grounds also reflect an aspect of the right to be heard (see Chapter IV.F.3.14 "Article 112a(2)(d) EPC - any other fundamental procedural defect"). In the present chapter, the case law of the Enlarged Board of Appeal under Art. 112a EPC is only

referred to with regard to principles generally applicable to proceedings before the EPO; references to individual "R-decisions" are to be found in Chapter IV.F.3.13. Decisions on the right to be heard taken by the Legal Board of Appeal and by technical boards of appeal are, on the other hand, almost exclusively dealt with in the present chapter, and only exceptionally referred to in Chapter IV.F.3.13.

For the right to be heard in **examination proceedings**, see Chapter IV.B.2. (in particular Chapter IV.B.2.5 on the refusal of an application after a single communication and Chapter IV.B.2.8 on issuing a further communication). In **opposition proceedings** the right to be heard is inextricably linked to the principle of **equal treatment**, see Chapter IV.D.5.1 and, with regard to opposition appeal proceedings, Chapter IV.F.3.13.6; as to the opposition division's obligation to invite the parties as often as necessary to file observations, see Chapter IV.D.5.2; as to the opportunity to comment on new grounds of opposition, see Chapter IV.D.3.4.6. With regard to the observance of the right to be heard in the context of the taking of **evidence**, see Chapter III.G.3.3. The right to be heard may also play a role in the decision whether to accept **late filed submissions** (see Chapter IV.C.1).

## **2. The right to be heard under Article 113(1) EPC**

### **2.1. Violation of the right to be heard examined ex officio**

The boards of appeal can examine the facts of the case of their own motion pursuant to Art. 114(1) EPC and verify whether or not Art. 113 EPC has been complied with by the departments of first instance (see e.g. **T 186/02**).

### **2.2. Causal link between the violation of the right to be heard and the final decision**

#### 2.2.1 Appeal proceedings

When reviewing appeal proceedings, the Enlarged Board's review is limited to 'fundamental' violations of the right to be heard. This requires a causal link between the alleged violation and the final decision. Such a causal link does not exist when, even if a procedural violation can be demonstrated, the same decision would have been taken for other reasons (see Chapter IV.F.3.13.2 "Fundamental violation of Art. 113 EPC – causal link").

#### 2.2.2 First instance proceedings

When reviewing first instance proceedings the boards' review is, in principle, not limited to 'fundamental' violations of the right to be heard (see above). However, remitting a case to the department of first-instance under Art. 11 RPBA also requires a 'fundamental' deficiency, and under R. 103(1)(a) EPC the appeal fee is only reimbursed in case of a 'substantial' procedural violation. In **T 689/05** the board linked these concepts by stating that a 'fundamental' deficiency within the meaning of Art. 11 RPBA is not caused by all procedural violations but only by a 'substantial' procedural violation. In **J 7/83** a substantial procedural violation was defined as an objective deficiency **affecting** the

entire proceedings, in **T 682/91** as a deficiency adversely **affecting** the rights of the parties (see Chapter IV.E.8.4.1.b) "Violation must be substantial and affect the entire proceedings").

In **T 990/91** the board held that since there had been no need for the examining division to put forward the new argument - which was supererogatory and incidental - in order to refuse the application, the lack of opportunity to reply to it could not be considered to be a violation of the right to be heard.

### 2.3. Surprising grounds or evidence

#### 2.3.1 General principles

Art. 113(1) EPC requires that decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

According to the Enlarged Board of Appeal (see Chapter IV.F.3.13.8 "Reasons for a decision allegedly surprising"), this implies that a party may not be taken by surprise by the reasons of a decision, referring to unknown grounds or evidence (see also **T 1378/11**). A purely subjective surprise, however, has no bearing on whether a party had an adequate opportunity to comment. 'Grounds or evidence' within the meaning of Art. 113(1) EPC need not emanate from the board. If the reason given in a decision corresponds to an argument put forward by the other party (see also **T 405/94**), the petitioner was aware of it and thus not taken by surprise, unless the board clearly indicated that it regarded those arguments as not convincing.

In **T 996/09** the board held that the right to be heard was a fundamental guarantor for the parties that proceedings before the EPO will be conducted fairly and openly (with further reference to **J 20/85** and **J 3/90**) and is intended to ensure that the parties to the proceedings are not taken by surprise by grounds mentioned in an adverse decision (following **T 669/90**, **T 892/92**, **T 594/00** and **T 343/01**; see also **T 197/88**, **T 220/93**). In **T 435/07** the board held that the grounds on which a decision were based had to be communicated to the applicants in such a way that they are put in the position to defend their rights. An objection against the grant of a patent had to be raised in such a way that the applicants were able to understand its factual basis and to react accordingly without having to guess first what the examining division might have had in mind.

Although parties may not be taken by surprise by the reasons for a decision, it is also settled case law of the Enlarged Board of Appeal under Art. 112a EPC that a board of appeal is not required to provide the parties in advance with all foreseeable arguments in favour of or against a request. In other words, parties are not entitled to advance indications of all reasons for a decision in detail (see Chapter IV.F.3.13.5 "No obligation to provide detailed reasons for a decision in advance"). In **T 1634/10**, **T 2405/10** and **T 1378/11** the boards explicitly applied this case law of the Enlarged Board of Appeal under Art. 112a EPC to first instance proceedings.

### 2.3.2 The meaning of "grounds or evidence"

"Grounds or evidence" under Art. 113(1) EPC are to be understood as meaning the essential legal and factual reasoning on which the decision is based (**T 532/91**, **T 105/93**, **T 187/95**, **T 1154/04**, **T 435/07**, **T 1898/11**, **T 305/14**). In **T 951/92** (OJ 1996, 53) the board ruled that the term "grounds or evidence" should not be narrowly interpreted and was to be understood as referring to the legal and factual reasons leading to refusal of the application, and not in the narrow sense of a requirement of the EPC.

In **T 375/00** the appellant (opponent) considered that the technical problem mentioned by the opposition division in its decision was different from that discussed in the preceding proceedings. The board held that the appellant's right to be heard had not been violated, because the definition of the objective problem was part of the arguments, not part of the grounds as specified in Art. 113(1) EPC 1973.

In **T 33/93** the board stated that the citation of a board of appeal decision for the first time in the decision under appeal was not a fresh ground or piece of evidence within the meaning of Art. 113(1) EPC 1973, but a mere repetition of arguments, since it only confirmed the position duly brought to the appellant's attention.

In **T 1634/10** the examining division had issued a reasoned communication setting out its objections in the light of two prior art documents, to which the appellant responded with a new claim and new arguments as to why the examining division had been wrong in its interpretation of the documents. Refusing the application, the examining division held that the amendments submitted by the appellant were not substantial. The board decided that the examining division had introduced neither new grounds of refusal nor new evidence. The mere fact that the examining division had not agreed with the submission of the appellant did not amount to a breach of the right to be heard.

### 2.3.3 Opportunity to comment on evidence

In **J 20/85** (OJ 1987, 102) the board pointed out that a decision on an issue of fact could only properly be made by the EPO after all the evidence on which such decision was to be based had been identified and communicated to the party concerned. In **T 820/10** the examining division had cited a document on which the finding of lack of inventive step was based for the first time in the appealed decision. The board held that the decision therefore relied upon evidence on which the applicant did not have an opportunity to present its comments. Furthermore, in **J 3/90** (OJ 1991, 550) the Legal Board of Appeal held that where the EPO had examined the facts, Art. 113(1) EPC 1973 was not complied with unless the parties concerned had been fully informed about the enquiries made and the results and then given sufficient opportunity to present their comments before any decision was issued (see also **J 16/04**).

### 2.3.4 Documents supplied by applicants but used against them

The right to be heard has not been observed if a decision to refuse an application is based essentially on documents which, though supplied by the applicant in support of his

case, are used against him to produce an effect on which he has not had an opportunity to make observations (see **T 18/81**, OJ 1985, 166 and **T 188/95**).

#### 2.3.5 Document cited containing information already known

In **T 643/96** the examining division relied in its decision on a document for which it gave only incomplete bibliographic data. The board held that the examining division's failure to provide the applicant with a copy of the document did not amount to a substantial procedural violation (regarding the right to be heard) because the document added nothing to the case, and contained only information already known to the applicant.

#### 2.3.6 Reliance on the IPER

If the only communication preceding the decision to refuse an application merely draws attention to an International Preliminary Examination Report (IPER), the requirements of Art. 113(1) EPC are met provided the IPER constitutes a reasoned statement as required by R. 51(3) EPC 1973, using language corresponding to that of the EPC; in the case of an inventive step objection this requires a logical chain of reasoning which can be understood and, if appropriate, answered by the applicant. In **T 587/02**, the IPER did not fulfil these requirements, and the board held that the applicant's right to be heard had been violated (see also **T 1020/15**).

In **T 1065/99** the board stated that when an IPER drawn up by the EPO under the PCT was relied on by the examining division, such reliance should not be presented to applicants in such a manner as to suggest that the examining division had not given objective consideration to the patentability requirements of the Convention. In this case, the IPER had been adopted by the examining division as the only basis for its opinion that the application did not meet the requirements of the Convention. The board came to the conclusion that there were three objections which were only obliquely touched upon in the IPER, and thus in the communication under R. 51(2) EPC 1973. Therefore, the party had had no opportunity to contest those objections.

#### 2.3.7 Change of provisional opinion after oral proceedings

In **T 68/94** the appellant submitted that the opposition division had violated Art. 113 EPC 1973 by changing its provisional opinion after the oral proceedings without giving the appellants an opportunity to comment on the grounds on which the contested decision was based. The board pointed out that provisional opinions were never binding. The purpose of oral proceedings was to summarise and discuss the parties' arguments. All arguments in the case had been known to both parties.

#### 2.3.8 Statement of grounds of appeal not received by respondent

For the EPO's failure to deliver the opponent's statement of grounds of appeal to the patentee (respondent) see Chapter IV.F.3.13.19 "Successful petitions under Article 112a(2)(c) EPC".

## **2.4. Consideration of the parties' arguments in the written decision**

### **2.4.1 General principles**

The right to be heard under Art. 113(1) EPC requires that those involved be given an opportunity not only to present comments (on the facts and considerations pertinent to the decision) but also to have those comments considered, that is, reviewed with respect to their relevance for the decision on the matter (see, with regard to Art. 112a EPC, Chapter IV.F.3.13.10 "Consideration of the parties' arguments in the written proceedings" and, with regard to R. 111(2) EPC, Chapter III.K.4.2 "Reasons for the decision").

The deciding department must demonstrably hear and consider the comments (**T 206/10**, with further reference to **T 763/04**, **T 246/08**; see also **T 1709/06**, **T 645/11**). Merely repeating the parties' submissions is not enough; rather, it has to be clear from the reasons that the substance of their core arguments has been addressed in arriving at the decision (**T 2352/13**).

A decision which fails to take into account the arguments submitted by a party and which is based on a ground on which the party had had no opportunity to present its comments, contravenes Art. 113(1) EPC and constitutes a substantial procedural violation (see **J 7/82**, OJ 1982, 391; **T 1039/00**, **T 778/98**, **T 1312/10**). When a decision refusing an application is based on several grounds supported by respective arguments and evidence, it is of fundamental importance that the decision as a whole meets the requirements of Art. 113(1) EPC (**T 1034/11**).

In **T 763/04** the board held that Art. 113(1) EPC is contravened if facts and arguments which according to the appellant are clearly central to his case and could present a challenge to the decision in question were completely disregarded in that decision. See also **T 1898/11**, **T 2227/09** and **T 1206/12**. According to **T 740/93**, in addition to the logical chain of facts and reasons, the decision should include some motivation on the crucial points of dispute. In **T 1557/07** the board held that the examining division had commented on the crucial points of dispute, giving the applicants a fair idea of why their submissions were not considered convincing.

Provided that the reasons given enable the parties concerned to understand whether the decision was justified or not, the deciding organ is under no obligation to address each and every argument presented by the party concerned (see Chapter IV.F.3.13.10 "Consideration of the parties' arguments in the written decision"; see also **T 1898/11** and **T 1557/07** quoted in **T 1969/07**, **T 698/10**, **T 1199/10** and **T 1961/13**). Moreover, a party has no absolute right to be heard separately on each and every one of its auxiliary requests (see Chapter IV.F.3.13.12 "No right to be heard separately on all requests").

In **T 238/94** the board considered that, although the opposition division's decision indeed contained no direct reference to the appellants' submissions concerning lack of inventive step, the opposition division had considered in its decision the disclosures of all the documents cited by the appellants and respondents, and also the possible combinations



of their teachings. Thus, in the board's view, the appellants' submissions had actually been taken into account, albeit indirectly, in the process of arriving at the contested decision (see also **T 1004/96**).

In **T 1843/11** the appellant alleged that a substantial procedural violation had occurred because it had raised an argument concerning sufficiency of disclosure that had not been addressed in the decision of the opposition division. The board recalled that, according to R. 111(2) EPC, decisions of the EPO which are open to appeal must be reasoned. Although the opposition division was not required to address each and every argument of a party (see above), the important question was whether the party concerned could objectively understand whether the decision was justified or not. The decision should contain at least some reasoning on crucial points of dispute, in order to give the party concerned a fair idea of why its submissions were not considered convincing and to enable it to base its grounds of appeal on relevant issues (see **T 70/02**). The points to be addressed were, in particular, arguments which might militate against or cast doubt on the decision in question (see **T 246/08**). According to the board, the fact that no reasons were given in the decision of the opposition division why the appellant's argument was not an answer to the crucial objection under Art. 83 EPC amounted to a substantial procedural violation. It was not sufficient for the requirements of Art. 113(1) EPC to be met that the appellant had been given the opportunity to (and in fact had) put forward the argument. What was additionally important was that the opposition division demonstrably heard and considered this argument (see **T 763/04**). As this condition had not been met, a substantial procedural violation had occurred. In the case at issue in **T 1411/07**, the patent proprietor had challenged the admissibility of the opposition on the ground of lack of substantiation, but the opposition division had found it admissible without stating any reasons. The board considered the opposition division's failure to make any reference to the patent proprietor's submissions a breach of R. 68(2) EPC 1973 (R. 111(2) EPC) and a substantial procedural violation.

#### 2.4.2 Submissions made after communication

In **T 1709/06** it was held that, in accordance with established case law (see Chapter III.B.2.4. above), not only must an opportunity to present comments be given, but these comments must actually be taken into account. The decision "on the state of the file" expressly stated that the applicant had filed no submissions after the final communication, which was incorrect. The board held that, because the examining division had ignored potentially significant arguments presented in a reply following a communication containing a new objection, the applicant had been denied its right to comment on all the grounds for refusing the application. The applicant's right to be heard enshrined in Art. 113(1) EPC had therefore been infringed.

The board in **T 1997/08** held that for an examining division not to violate an applicant's right to be heard, its decision had to actually address the arguments put forward by the applicant in its reply to the communication. It may be assumed that the right to be heard has been contravened if the reasons given for the examining division's decision merely repeat the reasons given for the communication issued before the said reply (see also **T 116/12**).

In **T 921/94** the board held that the appellant's bona fide submissions and the technical information provided in reply to a communication substantially changed the points at issue, and that the examining division had an obligation under Art. 96(2) and 113(1) EPC 1973 to inform the appellant of the objections arising in the new situation and to invite it to file further observations before refusing the application. A decision which only comprises a mere formal acknowledgement of the applicant's submissions, without dealing with them in substance, contravenes the general principle of good faith and fair proceedings that reasoned decisions contain at least some reasoning on the crucial points of dispute in order to give the party concerned a fair idea of why his submissions were not considered convincing (see also **T 1154/04**).

In **T 296/96** the applicant had submitted unconvincing arguments in his reply to the first and only communication. The examining division refused the application on the basis of the objections mentioned in the first communication, and did not issue a second one. Since, however, the main arguments for refusing the application were a mere repetition of those mentioned in the first communication, the contested decision was based on grounds on which the applicant had had an opportunity to present his comments. Consequently, Art. 113(1) EPC 1973 was not contravened (see also **T 2316/10**).

#### 2.4.3 Failure to consider evidence

According to **T 1536/08** it is well-established in the jurisprudence of the boards of appeal (**J 7/82**, **T 94/84** and **T 135/96**) that the right to be heard enshrined in Art. 113(1) EPC also guarantees the right to have relevant grounds that could potentially influence the outcome taken into account in the written decision (see in this Chapter III.B.2.4). A decision rejecting the opposition must therefore take into account the ground(s) for opposition raised as well as facts and evidence put forward in support of these grounds, including the cited prior art documents. Failure to consider evidence will normally constitute a substantial procedural violation of this fundamental right as it deprives the party of the right to have its case fully heard (see also **T 1098/07** below). In the case at issue, the opposition division had completely ignored the unambiguous offer by the opponent in the notice of opposition to provide the original printed versions of crucial prior art documents. The failure to consider this offer constituted a violation of the right to be heard.

In **T 1110/03** the board held that Art. 117(1) EPC and Art. 113(1) EPC enshrined a basic procedural right generally recognised in the contracting states, i.e. the right to give evidence in appropriate form, specifically by the production of documents (Art. 117(1)(c) EPC), and the right to have that evidence heard (see also **T 2294/12**).

In **T 21/09** the board held that the opposition division had either (i) disregarded the experimental evidence submitted by the appellant as late-filed, or (ii) considered the evidence, but failed to give proper reasons why it did not support the alleged technical effects. In the first case, the patent proprietor had not been heard on the admission of the evidence, and, more importantly, the decision was absolutely silent about it. In the second case, the decision under appeal suffered from a severe deficiency in the reasons

given by the opposition division for the adverse findings on inventive step. In either case, the decision could not be regarded as being in conformity with R. 111(2) EPC.

In **T 1098/07** the board stated that failure to consider evidence will normally constitute a substantial procedural violation in that it deprives a party of basic rights enshrined in Art. 117(1) and Art. 113(1) EPC. In the board's opinion, certain factors may nevertheless mitigate the severity of the violation. Thus, whether or not a failure of the decision to expressly mention material offered by a party in support of its case constitutes a substantial procedural violation will depend on the (*prima facie*) significance and evidential value of such material. The questions to be asked are: what facts is it intended to prove, how relevant is it to these facts and how likely is it that it will prove them? In the case at issue, the failure to consider the evidence was a pardonable error that had not deprived the appellant of any fundamental rights.

The appellant (patent proprietor) in **T 2415/09** argued that new documents and experiments submitted by the respondent had only been transmitted to the appellant six weeks before the oral proceedings before the opposition division. The board said it could not comment on the exact period needed to conduct comparative experiments. Even if the periods specified in R. 132(2) EPC did not apply in the case in point (R. 116(1) EPC), they showed that a party could not be required to conduct comparative experiments in a period as short as six weeks. The board concluded that the opposition division had failed to respect the appellant's right to be heard.

The right to be heard 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 2541/11** the appellant (opponent) submitted that the non-admission of a document without a full discussion as to its relevance violated its right to be heard. The board stated that a right to present all arguments as if the document had been admitted, instead of arguments as to why it should be admitted, amounted to a *de facto* admittance of the document, implying, contrary to Art. 114(2) EPC, that the board had no discretion to disregard a late-filed document. According to the board, the right to respond is not absolute but must be balanced *inter alia* against the need for procedural economy and due diligence that underpins Art. 114(2) EPC, which affords the board discretionary power to disregard evidence not submitted in due time.

#### 2.4.4 Mere reference to jurisprudence

In **T 1205/12** the board stated that according to established jurisprudence of the boards of appeal Art. 113(1) EPC is contravened where facts and arguments, which from the appellant's submissions are clearly central to his case are completely disregarded in the decision. The board held that the applicant's arguments had not been dealt with in the impugned decision and stated that the mere reference to jurisprudence of the boards of appeal does not, by itself, constitute or replace an argument in a first instance decision. If a deciding body, in a decision, wants to rely on an argument put forward in a decision of the boards it is insufficient merely to refer to it or to recite it. The deciding body must also

make clear that it adopts the argument and explain why, in what respect and to what extent this argument applies to the case at hand (see also **T 1206/12**).

## **2.5. The right to be heard and the timing of decisions**

### 2.5.1 Decision could not be expected

In **T 849/03** the board held that a decision should not catch the parties unawares. In the examination procedure the right to be heard is therefore violated not only in the event of failure to inform the applicant beforehand of the reasons forming the basis of a rejection but also if, at the time the decision is issued, the applicant had no reason to expect such a decision (see also **T 1022/98** and Chapter IV.F.3.13.9 "Timing of a decision allegedly surprising").

In **T 611/01** the board decided that a substantial procedural violation was occasioned by the examining division holding out to the appellants the prospect of a further opportunity to file arguments before any decision would be issued, and then issuing the decision without providing for that opportunity (regarding a false impression raised concerning amended claims, see also **T 309/94**).

In **T 966/02** the opponent had filed two notices of opposition in due form and time. The board stated that it had been clear that the appellant (patent proprietor) had regarded both notices of opposition as inadmissible and had thus felt that there was no sense in commenting on the facts until the situation had been clarified. The appellant could not have foreseen that the opposition division would give a final decision without first clarifying the procedural situation, and it came as a complete surprise to it that it did so.

In **T 922/02** (ex parte) the board stated that the provisions of Art. 113(1) EPC 1973 were only complied with in a case where the decision was taken after remittal for further prosecution, if the notification and invitation was made after the remittal, typically by announcing the resumption of the proceedings, setting out the objections, if any, and asking the appellant whether or not he wished, within a fixed period of time, to present his comments or modify his request(s). Otherwise any final decision would come as a surprise to the appellant, which was contrary to the principle of good faith and fair hearing established by Art. 113(1) EPC 1973. The board followed in this respect the case law developed in **T 892/92** (OJ 1994, 664) and **T 120/96** for opposition proceedings, which was equally applicable to examination proceedings, because the right to be heard was an essential procedural principle governing both procedures.

In **T 281/03** (17 May 2006) the issue of inventive step was not discussed at the oral proceedings and the opposition division, after deliberating and announcing its decision on novelty, immediately announced the decision to reject the oppositions. The board held that, in order to guarantee the right to be heard, there should have been an explicit step, recorded in the minutes, giving the opponent the opportunity to comment on inventive step before the final deliberation, or alternatively an opportunity after the deliberation to comment on the opposition division's conclusion.

In **T 451/06** the board distinguished the situation at hand from that in decision **T 281/03**. In the case underlying **T 281/03**, the opposition division had failed to give the opponent an opportunity to comment on lack of inventive step, thereby depriving the opponent of any possibility of substantiating a ground of opposition (see **G 1/95**). By contrast, in the case in point, the opponent had been given that opportunity.

In **R 3/10** the Enlarged Board of Appeal allowed the petition for review. The petitioner had had no opportunity to comment on the inventive step of its main request before the chairman informed the parties that the board would decide on "patentability" of the main request. The board had then held that the main request was novel but lacked an inventive step. According to the Enlarged Board of Appeal, the term "patentability" covered a variety of potential objections and the chairman could not have meant to address all of them. The petitioner had had no reason to assume that the board's decision would address more than what had been previously discussed, i.e. novelty.

#### 2.5.2 Issuing of decision before expiry of time limit to comment

In **T 663/99** the board decided that the patent proprietor's right to be heard was violated if the time limit fixed under R. 57(1) EPC 1973 for presenting comments on the opposition had not expired by the date of handing over a revocation decision to the EPO's internal postal service (see also **T 804/94**).

In **T 1081/02** the board of appeal decided that the principle of the right to be heard had been violated, since the opposition division, after inviting the patent proprietor to file within two months the documents considered necessary to maintain the patent, did not wait until this time limit had expired but issued an interlocutory decision prior to its expiry.

In **T 685/98** (OJ 1999, 346), the board held that the phrase "fails to reply in due time to any invitation under ... paragraph 2" in Art. 96(3) EPC 1973 had to be construed in the light of the purpose of the invitation pursuant to Art. 96(2) EPC 1973 and R. 51(2) EPC 1973, which was to afford the applicant an opportunity to exercise his right to present comments in accordance with Art. 113(1) EPC 1973. Hence, a letter from the applicant which neither exercised nor waived that right was not a reply for the purposes of Art. 96(3) EPC 1973. In the case in point, the examining division believed erroneously that the applicant, by making a simple procedural request, had forfeited his right to present comments during the remainder of the term set for reply. The precipitate refusal, while there were still some two months of the term for reply unexpired, did contravene Art. 113(1) EPC 1973.

#### 2.5.3 Immediate refusal after communication

It is well-established in the jurisprudence of the boards of appeal that an examining division does not exceed its discretionary power by immediately refusing an application after only a single communication. However, the decision must comply with Art. 113(1) EPC, i.e. must be based on grounds on which the applicant has had an opportunity to present comments (see **T 201/98** and **T 1002/03**; see also **T 84/82**, OJ 1983, 451 and **T 300/89**, OJ 1991, 480; see Chapter IV.B.2.4 "Refusal after a single

communication"). If the factual basis is not sufficiently given in the single communication so that the applicant has to speculate about the examining division's assessment and thus is not put in the position to properly defend its rights, the requirements of Art. 113(1) EPC cannot be considered to be met; coming to a final decision after such a single deficient communication results therefore in a substantial procedural violation (**T 435/07**).

In **T 305/14** the board stated that only if a preceding communication pursuant to Art. 94(3) EPC sets out the essential legal and factual reasoning to support a finding that a requirement of the EPC has not been met, can a decision based on such a finding be issued without contravening Art. 113(1) EPC. In the case at hand, the board held that the decisive statement had been put forward in the communication in an abstract way only, without the necessary logical chain between the given statement and the particular technical facts of the case. Because the appellant learnt about the essential reasoning for the first time in the impugned decision, it did not have an opportunity to present its comments with respect to that reasoning.

#### 2.5.4 Invitation to oral proceedings at short notice

In **T 166/04** the examining division had refused the patent application at the end of oral proceedings which the applicant had not attended. In the appellant's opinion, a gross procedural violation had occurred in that the examining division had used an invitation to oral proceedings issued at short notice to introduce additional prior art documents in a complex technical field. The examining division should have issued another communication to safeguard the applicant's right to be heard. The board held that even if the prior art documents had formed part of a critical argumentation, their late introduction was not necessarily improper. Apart from the non-extendable time limit, the appellant had had an opportunity to respond to the summons in writing as if he had responded to a communication under Art. 96(2) EPC 1973, which he had actually done by submitting amendments and further arguments. In addition, the board pointed out that the applicant had decided not to participate in the first-instance oral proceedings in the course of which he could have made further submissions.

### 2.6. The right to be heard in oral proceedings

The right to oral proceedings regulated by Art. 116(1) EPC forms a substantial part of the right to be heard granted by Art. 113(1) EPC (**T 209/88**, **T 862/98**, **T 1050/09**). The right to be heard in oral proceedings subsists so long as proceedings are pending before the EPO (**T 598/88**, **T 556/95**, **T 114/09**).

The right to present comments enshrined in Art. 113(1) EPC does not need to be exercised in writing but may be satisfied by way of oral proceedings (**T 1237/07**). This does not mean, however, that it is for the boards to ensure, of their own motion, that all points raised at some point in the proceedings are discussed at the oral proceedings. Rather, it is for the parties to address any point they consider relevant and fear may be overlooked and to insist, if necessary by way of a formal request, that it be discussed (**R 17/11**). This also applies in oral proceedings before the opposition division (**T 7/12**).

Conversely, Art. 113(1) EPC cannot be interpreted in a way that a party's right to be heard is already satisfied if a party, having requested oral proceedings according to Art. 116 EPC, has had the opportunity to argue in writing. If this interpretation of Art. 113(1) EPC were to be followed, the parties' right to oral proceedings under Art. 116 EPC would be redundant, with the unacceptable consequence that an opposition division or a board of appeal would be entitled, with regard to a controversial issue discussed during written procedure, to give a decision right at the beginning of oral proceedings without hearing the parties (**T 1077/06**).

Non-compliance with a request for oral proceedings deprives the party of an important opportunity for presenting its case in the manner it wishes and using the possibilities open to him under the EPC. By virtue of its request for oral proceedings, the party can rely on such proceedings being appointed before an adverse decision is issued, and therefore has no reason to submit further arguments in writing (see **T 209/88**, **T 1050/09**; and also Chapter III.C.1 "Right to oral proceedings").

An effective and efficient conduct of oral proceedings, although subject to the discretionary power of the chairman, must nevertheless guarantee that the fundamental procedural rights of each party in adversarial proceedings, i.e. the right to fair and equal treatment, including the right to present comments in oral proceedings (Art. 113(1) and 116 EPC) are respected (**T 1027/13**; see also Chapter IV.D.5.1 "Principle of equal treatment").

There is no infringement of the right to be heard where an examining division refuses to minute a party's submissions during oral proceedings (**T 1055/05**).

A party's right to be heard under Art. 113(1) EPC does not imply a separate right of the party's representative to be heard and therefore does not imply a right to have oral proceedings before the EPO held by video conference (**T 2068/14**; see also Chapter III.C.4.6 "Oral proceedings conducted by video conference").

#### 2.6.1 Introduction of a new claim or relevant document

In a case where an opposition division or a board of appeal feels bound by Art. 114(1) EPC to examine new facts or evidence submitted for the first time during oral proceedings, it must, in accordance with Art. 113(1) EPC, give the other parties the opportunity to comment before issuing a reasoned decision based on such facts or evidence (**G 4/92**, OJ 1994, 149; see also **T 484/90**, OJ 1993, 448; with regard to late submissions see **T 330/88**, **T 356/94** and Chapter IV.C.1 "Late submission"). The same principle has also been applied to decisions of examining divisions (see e.g. **T 376/98**). The applicant does not have a right in principle to continuation in writing; the party's right to be heard under Art. 113(1) EPC is also observed if the applicant is given an adequate amount of time to study the document and present comments. How much time is sufficient depends on the nature of the newly introduced document and the preceding procedure (**T 2434/09**).

- a) Cases in which Article 113(1) EPC was violated due to introduction of new claims or relevant documents

In **T 951/97** (OJ 1998, 440) the examining division introduced document D4 for the first time during oral proceedings. D4 had been mentioned in the European search report but had not been cited at any stage in the examination procedure prior to the oral proceedings. The board found that the half an hour adjournment of the oral proceedings had been too short a period for an adequate analysis of the complex text of D4. As D4 was essential to the finding of the examining division in relation to inventive step, the decision was based on evidence on which the applicants had not had a sufficient opportunity to present their comments as required by Art. 113(1) EPC 1973 (see also **T 492/03**).

In **T 783/89** the opposition division had proposed a new version of the main claim at the start of the oral proceedings, giving the opponents ten minutes to consider it. The board ruled that this had taken the opponents by surprise, and that the time given had not been sufficient to study the allowability of the amendments.

In **T 2235/12** the examining division had introduced, two days before the oral proceedings, two additional documents and a new objection into the procedure. The appellant's request for a postponement of the oral proceedings was rejected, and the appellant did not attend the oral proceedings. The board held that the new objection was not related to the points indicated in the summons and that the appellant should have been given an adequate opportunity to react to the new objection. In view of the short timeframe it had been impossible for the representative to get appropriate instructions from the client. Attending the oral proceedings would not have changed the fact that the timeframe was too short to get instructions and to prepare for oral proceedings with a new focus. The board concluded that rejecting the appellant's request for a postponement of the oral proceedings infringed the appellant's right to be heard.

In **T 75/10** the board saw no reason to overturn the opposition division's admission of late-filed documents that appeared highly relevant for novelty. However, the board considered that the opposition division should have granted the patentee's request for postponement of the oral proceedings, after deciding to admit these. The board stated that there was an essential difference between a prima facie assessment of the possible relevance and publication date of a late-filed document for deciding upon its admission into the proceedings and the full in-depth assessment of novelty vis-à-vis such a document, which required determining whether the document was made available to the public before the effective filing date. In the case at hand, the documents were generated from an archive different from the databases commonly used for a prior-art search. Therefore, the difficulties encountered by the patentee at the oral proceedings when trying to verify the origins of the late-filed documents were plausible.



- b) Cases in which Article 113(1) EPC was not violated even though new claims or relevant documents were introduced

In **T 608/08** the board agreed in principle with the appellant (opponent) that when the patent proprietor submits new claims an opponent must be afforded an opportunity to familiarise itself with the new situation, which must at least involve a - sufficiently long - interruption of the oral proceedings. However, that applies only to requests incorporating new content. In the case at issue, the auxiliary request consisted of a combination of features from sub-claims belonging to the main request. The technical features of the sub-claims were straightforward and did not put the subject-matter of the main request in a new and more complex technical context. Consequently, the admission of the auxiliary request did not entail a surprisingly new procedural situation requiring the opposition division to interrupt the oral proceedings (in contrast to **T 783/89**, in which a completely reformulated text of the claim introduced a new feature; see above).

In **T 484/89** the board held that the opposition division was empowered under Art. 114(1) EPC 1973 to take account of and refer to all relevant documents cited. In the case in question the opposition division had considered it necessary to refer to a 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. Since no such request was made, according to the decision and the record of the oral proceedings, Art. 113(1) EPC 1973 had not been breached.

In **T 1031/12** the appellant claimed that a new document had unexpectedly been mentioned for the first time at the end of the oral proceedings before the examining division, without its being given an opportunity to present counter-arguments. The board noted that the representative had been afforded the time he himself had identified as necessary for a reply. Therefore he had had not only the opportunity but also sufficient time to comment.

In **T 376/98** the examining division had referred to document D4 for the first time during the oral proceedings, and had stayed the oral proceedings to give the applicant time for consideration. When the oral proceedings were resumed, the appellant requested a decision based on the documents on file. Regarding the introduction of D4 at the oral proceedings, the board noted that no procedural limitations were placed upon the examining division to cite relevant documents during any stage of the examination procedure, as long as the applicant was given a fair chance to comment on the objections raised before a final decision was taken (see **T 1198/97**). In the board's opinion, the appellant's request for a decision could only be taken to mean that the appellant was not interested in a further debate about the relevance of D4.

In **T 566/91** the opposition division based its decision to revoke the patent on a version of a citation which was more complete than the version which had been cited by the opponents when filing the opposition. The decision of the department of first instance was thus based, albeit inadvertently, on evidence on which the parties had not had the opportunity to comment. In order to comply with Art. 113 EPC 1973 in the appeal proceedings, the board offered the parties a half-hour suspension of the oral

proceedings to enable them to study the fuller version of the document with the help of the interpreters.

c) Cases where no new claims or relevant documents were introduced

In **T 195/84** (OJ 1986, 121) the appellant (patentee) objected at the oral proceedings that new grounds on inventive step were presented to which he had not had an opportunity to reply. The board did not share this opinion as the appellant had been aware that such prior art existed, and had thus had sufficient time to consider it in full. Furthermore, he had not requested any additional time and had not asked for an adjournment.

In **T 327/92** the opposition division, at oral proceedings, had relied on a document as closest prior art against an amended main claim, which had been cited in the opposition against a dependent claim only. The board did not consider this a substantial procedural violation, as the patentee was dealing with a document which had always been part of the opposition, and could further examine this document at the oral proceedings.

#### 2.6.2 Introduction of new arguments

In **T 248/92**, the examining division had based its decision on arguments submitted for the first time during oral proceedings. The board held that the examining division's decision had not been taken contrary to Art. 113(1) EPC 1973. Although one of the purposes of oral proceedings was to settle as far as possible all outstanding questions relevant to a decision, they did not have a constraining effect in the sense of requiring an immediate decision to be taken at the end of those proceedings. If the appellant had felt the need for further reflection, he could have asked for the oral proceedings to be adjourned or for the proceedings to be continued in writing so that he could study carefully the newly introduced arguments, which had obviously been crucial to the decision.

In **T 623/12** the opposition division had found, on the basis of an argument first submitted by the opponent during the oral proceedings, that several auxiliary requests did not comply with Art. 123(2) EPC. The opposition division gave the patent proprietor only one opportunity to file a new claim, based on one of the previous auxiliary requests, and warned that "other requests may suffer from other deficiencies under Art. 123(2) EPC". It then decided that the new auxiliary request still did not comply with Art. 123(2) EPC. According to the board, the opposition division's warning did not provide the patentee with a basis for an informed choice since neither the objections nor the requests affected by them were specified. By acting in this manner, the opposition division did not exercise its discretion in respect of the admissibility of the patentee's late-filed request but arbitrarily decided not to allow the request. This arbitrary decision deprived the patent proprietor of a proper opportunity to comment on the admissibility of its further request and to reply to the objections of the opposing party.

In **T 1014/10** the appellant (patent proprietor) argued that during the opposition proceedings it had been given no opportunity to study the opponent's submissions because they were delivered to its office only on the day of the oral proceedings. The

board observed that it was the duty of the parties - and of the board - to check the content of the electronic file in order to make sure that no submission had been added in the days before the oral proceedings. Moreover, the proprietor could have requested an interruption of the oral proceedings to study the submissions, or even asked the opposition division not to admit them into the proceedings. As shown by the minutes, the proprietor did not make use of these procedural options. Under these circumstances, the late-filed submissions, which furthermore did not contain any new facts, were to be put on the same footing as new arguments which might have been put forward and discussed anyway during the oral proceedings. The board did not see any violation of Art. 113 EPC.

#### 2.6.3 Introduction of a new ground of opposition by the opposition division

In **T 515/05** the appellant had based its opposition only on the grounds of Art. 100(a) EPC 1973. In the summons to the oral proceedings the opposition division itself introduced a further ground for opposition under Art. 100(b) EPC 1973. At the beginning of the oral proceedings the chairman of the opposition division stated that no discussion of the ground of opposition under Art. 100(b) EPC 1973 would take place because it had not been sufficiently substantiated by the opponent. Denying the appellant the opportunity to comment on this ground, albeit introduced by the opposition division itself, was considered a substantial procedural violation. The fact that the appellant did not file written arguments in response to the summons to attend the oral proceedings did not deprive it of its right to be heard. The appellant was entitled to expect that it would still have an opportunity to comment on this new ground during the oral proceedings.

#### 2.6.4 Hearing witnesses

In **T 142/97** the board held that the opposition division had violated the opponent's right to be heard under Art. 113(1) EPC 1973 by not hearing the witness offered in connection with a prior use that had been adequately substantiated in the notice of opposition.

In **T 269/00** the board held that the case before it differed from **T 142/97** because the ground of prior use was not adequately substantiated during the opposition period, but completed piecemeal during the opposition proceedings. The board concluded that not hearing the witness did not amount to a substantial procedural violation.

In **T 959/00** the opposition division had not replied to the opponent's offer to hear a witness with respect to the alleged prior use. The board held that the opposition division's failure to hear the witness and the absence in the decision under appeal of any reference to a reason why it had not been necessary to hear the witness amounted to a fundamental procedural violation of the right to be heard.

In **T 474/04** (OJ 2006, 129), the board held that if assertions made in an unsworn witness declaration remained contested, a request to hear the witness had to be granted before these assertions were made the basis of a decision against the contesting party.

In **T 909/03** the hearing of a witness took place in the morning and the oral proceedings continued in the afternoon. The board held that it was not necessary for a party to be given a copy of the minuted testimony before commenting on that testimony. During the oral proceedings the party had been given sufficient opportunity to comment. No substantial procedural violation had thus occurred.

In **T 716/06**, the board confirmed that where oral evidence of a witness was requested by a party the competent department should grant this request only if it considered this oral evidence necessary to clarify matters that were decisive for the decision to be taken. However, where an opponent requested that a witness be heard on an alleged public prior use and on the disclosure of a certain feature by this prior use, the competent department as a rule had to grant this request before deciding that the alleged public prior use was neither established nor constituted a novelty-destroying state of the art. In the case at issue, the opponent's right to be heard was violated. See also **T 1100/07**.

#### 2.6.5 Oral submissions of an accompanying person

For the denial of a request for an accompanying person to present oral submissions see Chapter IV.F.3.13.18 "Further examples of unsuccessful petitions". See also Chapter III.R.5 "Oral submissions by accompanying person".

### 2.7. The right to be heard in case of the non-attendance of oral proceedings

The proceedings may continue without the duly summoned but non-attending party (R. 115(2) EPC, R. 71(2) EPC 1973). The case law of the boards demonstrates, however, that the non-attending party's right to be heard under Art. 113 EPC must not be ignored.

#### 2.7.1 Facts and evidence put forward for the first time during oral proceedings in inter partes cases – G 4/92

In **G 4/92** (OJ 1994, 149), which explicitly relates to inter partes proceedings only, the Enlarged Board held that, in view of the right to present comments, a decision against a party who had been duly summoned but who failed to appear at oral proceedings could not be based on facts put forward for the first time during those oral proceedings. Evidence put forward for the first time during oral proceedings could not be considered unless it had been previously notified and it merely supported the assertions of the party which had submitted it. New arguments, on the other hand, did not constitute new grounds or evidence, but were reasons based on the facts and evidence already put forward. As regards new arguments the requirements of Art. 113(1) EPC could thus be satisfied even if a party who chose not to appear did not have the opportunity to comment on them during oral proceedings.

According to Art. 15(3) RPBA (Art. 11(3) RPBA 2003), "the Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying on its written case." The preparatory documents to this Article state that this provision

does not contradict the principle of the right to be heard pursuant to Art. 113(1) EPC since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity (CA/133/02 dated 12 November 2002). This RPBA provision superseded the findings of **G 4/92** with regard to the non-attendance at the oral proceedings before the boards (**T 706/00**). To the extent that **G 4/92** supports the general admissibility of new arguments in appeal proceedings, it was also modified by the amendments to the RPBA introduced with effect from 1 May 2003 which make the introduction of new arguments subject to the discretion of the boards (**T 1621/09**, summarising previous case law). **G 4/92** still applies for the departments of first instance (see Guidelines E-II, 8.3.3.2 – November 2015 version). With regard to proceedings before the examining divisions, see also the notice published in OJ 2008, 471.

#### 2.7.2 Non-attendance at oral proceedings before the boards - case law on G 4/92

In **T 341/92** (OJ 1995, 373) the board held that it was possible to base a decision on a ground discussed for the first time during oral proceedings, 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 of the actual basis on which it would be judged. The board did not consider itself prevented by reasons of procedural law from rendering a decision on the basis of Art. 123(3) EPC 1973, on an issue brought up by the board for the first time at 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 claims, and therefore not from facts that had only been introduced during oral proceedings.

In **T 802/12** the board likewise dismissed the appeal on the basis Art. 123(3) EPC, which had been discussed for the first time at oral proceedings. The board referred to **T 341/92** and found that the appellant could have expected the amendments it had made to be examined at the oral proceedings as to their conformity with the requirements of the EPC (**G 9/91**, OJ 1993, 408). A party duly summoned to oral proceedings could not rely on the proceedings being continued in writing or the case being remitted to the department of first instance simply because he had not attended the oral proceedings (Art. 15(3) and (6) RPBA, see Chapter III.B.2.7.3.

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 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**. The board in **T 771/92** held that the submission of restricted claims was neither a fact nor could it be evidence. The appellant could not be taken by surprise by the amendment made, because he had reasonably to expect that the respondent would try to overcome the objections made by the appellant during the written procedure. In cases **T 912/91**,

**T 202/92, T 856/92, T 890/92**, (see also **T 673/06** and **T 235/08**), which were based on similar facts, the board also concluded that Art. 113(1) EPC 1973 had been satisfied.

In **T 1448/09** refusal of the European patent application was based on the common general knowledge as illustrated by document D3. That stance was first taken in the oral proceedings before the examining division, which the appellant did not attend. According to **G 4/92**, arguments could be presented at any time, even during oral proceedings in the absence of a party, but the same did not apply to new facts forming the basis for a decision. A reference to the common general knowledge could be presented as an argument, but the existence of that knowledge was a matter of fact. If its alleged existence was disputed, the facts relevant in that regard had to be established. That meant that the party against which this knowledge was cited had to have the opportunity to dispute or accept it. In the case in point, the appellant had neither been aware of the examining division's invocation of the common general knowledge nor of the existence of document D3 until the decision was announced. This violated the appellant's right to be heard on the relevance of document D3 and, by extension, on the existence of the invoked common general knowledge.

In **T 1049/93** the board held that, where a duly summoned respondent (opponent) chooses not to attend oral proceedings, a board can still consider prior art which might be an obstacle to the maintenance of the patent in suit. The opportunity to be heard is offered by summoning the parties to a hearing before the board. If the respondent chooses not to avail himself of this opportunity, his right to be heard is exhausted to the extent that it concerns facts and arguments in support of his position. **G 4/92** should not be construed as extending or prolonging the rights of a voluntarily absent party.

In case **T 414/94** the board stated that there was no general prohibition on amending requests during a party's absence from oral proceedings. An absent party (here, the opponent) must expect reactions of the opposing party (here, the patentee) within the legal and factual framework of the case established prior to oral proceedings, and the possibility of decisions taking account of, and being based on, such reactions.

In **T 501/92** (OJ 1996, 261) the board ruled that if a new ground for allowing the appeal based upon the file record (here, the patentee's failure to file a formal request to maintain the patent) was raised by the appellant (opponent) for the first time during oral proceedings from which the respondent (patentee) was voluntarily absent, it would be contrary to Art. 113(1) EPC 1973 and the principles underlying **G 4/92** to allow the appeal on the basis of this new ground without giving the respondent an opportunity to comment.

In **T 892/94** (OJ 2000, 1) the board held that the right to be heard of a party absent from oral proceedings as expounded in **G 4/92** could, in appropriate circumstances, be surrendered by a party. The respondents'/patentees' declaration, before the oral proceedings, that they would take no further part in the proceedings could only be construed as an unequivocal decision to surrender, voluntarily, their rights according to Art. 113(1) EPC 1973 and no longer to avail themselves of the opportunity to present their comments on any objections, facts, grounds or evidence which could be introduced

into the proceedings by the appellants or the board and which could turn out to be decisive.

In **T 191/98** the board referred to **G 4/92** and considered that the respondent (patentee), when informing it of its non-appearance, should have expected that the board would decide in substance on the patent in its granted form, taking into account any piece of evidence filed by the appellant (opponent) and arguments based on that evidence, including a line of argument further developed during the oral proceedings.

### 2.7.3 Non-attendance at oral proceedings before the boards - Article 15(3) RPBA

The introduction of Art. 11(3) RPBA 2003 (now Art. 15(3) RPBA) superseded the findings of **G 4/92** for the non-attendance at the oral proceedings before the boards (**T 706/00**). For cases in which the applicant files **amended claims** in appeal proceedings after the oral proceedings have been arranged and then does not attend them, see Chapter IV.E.4.2.6 d) "Applicant (proprietor) absent from oral proceedings".

The appellant can reasonably expect that during the oral proceedings the board will consider the objections and issues raised in its communication. By not attending the oral proceedings, the appellant effectively chooses not to avail itself of the opportunity to present its observations and counter-arguments orally but instead to rely on its written case (Art. 15(3) RPBA; see e.g. ex parte cases **J 15/10**, **T 1625/06**, **T 628/07**; see also **T 55/91**).

In the ex parte proceedings **T 991/07** the board decided, with reference to Art. 15(3) and 12(2) RPBA, that it could base its decision on objections which would be new to the appellant, but which could not be communicated to it due to the fact that the appellant was not present at the oral proceedings, without infringing the appellant's right to be heard (Art. 113(1) EPC). The board observed that in line with established case law (cf. e.g. decisions **T 823/04** and **T 1059/04**; see also **T 1704/06**, **T 532/09**, **T 1278/10** - all ex parte cases), the appellant who decided not to attend oral proceedings had nonetheless had the opportunity to do so and that the requirements of Art. 113 EPC were thus met. A further justification for such an approach was that a party who filed substantive amendments to its case and then deliberately absented itself from oral proceedings in order to avoid any adverse decision being reached would infringe the general principle that it is incumbent on both the EPO and users of the European patent system to act in good faith (**G 2/97**). This was especially true in situations where the appellant had initially requested that oral proceedings be held.

In the ex parte proceedings **T 1367/09** the board did not raise Art. 84 EPC in its communication pursuant to Art. 15(1) RPBA. When reconsidering the case in preparation for the oral proceedings, the board noted that Art. 84 EPC should also be addressed. The oral proceedings were held in the absence of the appellant. In its decision, the board stressed that a board's communication has a preliminary character and does not have to be exhaustive. In general, new grounds for refusal have to be discussed during the oral proceedings. However, if a duly summoned appellant does not attend the scheduled oral proceedings, it waives the opportunity to present its comments on new grounds which

were not mentioned in the communication under Art. 15(1) RPBA but are decisive for the decision. In view of the principle of procedural economy, the board is not obliged to delay its decision. A board's decision dealing with new grounds, on which the appellant has not presented its comments, does not contravene the right to be heard (Art. 113(1) EPC) in such a case.

In the inter partes case **T 986/00** (OJ 2003, 554) the board held, with reference to Art. 113(2) EPC and Art. 11(3) RPBA 2003 (Art. 15(3) RPBA), that a patent proprietor who chooses not to be represented at oral proceedings should ensure that he has filed all the amendments he wishes to be considered. All the more when, as in the case at issue, the proprietor had been expressly warned about the possible necessity of amending the claims and the description.

In **T 1000/03** (ex parte) the board held that the appellant had been duly summoned, and at the oral proceedings could easily have corrected the minor deficiencies in the description. To delay the decision pending their correction was uncalled for (see Art. 11(3) RPBA 2003, Art. 15(3) RPBA). Under Art. 113(2) EPC, the board had to keep to the text submitted by the appellant (applicant), who by not appearing at the oral proceedings had taken the risk of the application being refused even for easily remediable deficiencies (see also the ex parte case **T 1903/06**).

## **2.8. Changes in the composition of the opposition division after oral proceedings**

In **T 960/94** the composition of the opposition division had changed between the decision announced orally and the written decision. The board decided that issuing the written decision on behalf of an opposition division whose first member was not present at the oral proceedings amounted to a substantial procedural violation of both Art. 113(1) and 116 EPC 1973, as it had been issued on behalf of a first member before whom the parties had been given no opportunity to present their comments at oral proceedings.

In **T 862/98** the decision of the department of first instance was signed by an opposition division different from that before which the oral proceedings had taken place. Oral proceedings being a fundamental expression of the right to be heard (see e.g. **T 209/88**), any findings at oral proceedings relevant to the final decision should be made in the presence and with the involvement of those members giving the final decision. The board decided that changes in the composition of an opposition division after oral proceedings should generally be avoided, even if no final substantive decision had been given orally. Where changes were unavoidable, new oral proceedings must in general be offered to the parties (see the analogous rule in Art. 7(1) RPBA 2003 (Art. 8(1) RPBA)). Such offers might be forgone in exceptional cases.

In **T 837/01**, the final decision of the opposition division had only been signed by three members of the division, whereas the copy sent to the parties bore the name of all four members, including the legally qualified examiner. Upon enquiry by the board, it turned out that the legally qualified member had not simply forgotten to sign the decision but had not been involved in taking the decision which constituted a substantial procedural violation (see also **T 990/06**).



For further cases, also with regard to changes in the opposition division's composition **prior** to the oral proceedings, see Chapter III.K.2.2.2 "Change in composition of opposition division during opposition proceedings".

### **3. Text submitted or agreed by applicant (patent proprietor) – Article 113(2) EPC**

#### **3.1. General**

Under Art. 113(2) EPC 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. See also Chapter IV.B.3.2.3 "Decisions with no text submitted or agreed by the applicant (Art. 113(2) EPC)".

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 in their content or interdependency from those submitted by the applicant (**T 32/82**, OJ 1984, 354). Art. 113(2) EPC 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, has, in principle, to be considered to be a substantial procedural violation (**T 647/93**, OJ 1995, 132; see also **T 996/12**, **T 690/09**, **T 32/82** and **J 19/84**). In any case, such violation occurs when the examining division does not make use of the possibility of granting interlocutory revision under Art. 109 EPC 1973 after the mistake has been pointed out in the grounds of appeal (**T 647/93**).

According to the board in **T 996/12**, Art. 113(2) EPC guarantees the fundamental principle of party disposition (*ne ultra petita*; see also **R 14/10**).

Art. 113(2) EPC does not give any right to an applicant in the sense that the EPO is bound to consider a request for amendment put forward by the applicant. The effect of the provision is merely to forbid the EPO from considering and deciding upon any text of an application other than that submitted to it or agreed by the applicant or proprietor (**G 7/93**, OJ 1994, 775; see also Chapter IV.F.3.13.17 "Alleged violation of Article 113(2) EPC").

#### **3.2. The requirement of a text agreed by the applicant**

In **T 73/84** (OJ 1985, 241) the board held that the European patent was to be revoked if the patent proprietor stated in opposition or appeal proceedings that he no longer approved the text in which the patent was granted and would not be submitting an amended text (see also **T 655/01**, **T 1526/06** and the cited case law). According to **T 1244/08**, such a statement immediately terminates the appeal proceedings, and it is not possible to retract it and continue the proceedings (see Chapter IV.C.5.2. "Requests for revocation during opposition and opposition appeal proceedings").

The board in **T 706/00** pointed out that the EPO cannot depart from a request once made. It can only grant or deny the request; it cannot grant more, less or even something different. Unless a grantable text is submitted, at least auxiliarily, the request is rejected in full. In **T 549/96**, the board noted that an applicant had to unambiguously indicate, at the end of the proceedings, which text he proposed. Otherwise, the examining division would be unable to decide on the basis of which version it should proceed and the application would eventually have to be refused, since there would be no clear request at all. Thus, if an applicant failed to indicate his approval of the text of an allowable subsidiary request, e.g. by express disapproval or by maintaining one or more unallowable higher-preference requests, the examining division could refuse the application under Art. 97(1) EPC 1973 (see also **T 976/97**).

In **T 237/96** the board held that Art. 113(2) EPC 1973 could not be interpreted in the sense that the examining division was bound to accept any amendment which the applicant might propose, only to ensure that there was a version approved by him. In circumstances in which, as in the case in question, amendments proposed by the applicant after the R. 51(4) EPC 1973 communication were with good reason not allowed by the examining division by virtue of R. 86(3) EPC 1973 and the applicant did not give its agreement to any other version, the established practice of the EPO, sanctioned by consistent case law, was to refuse the application on the ground that there was no version approved by the applicant within the meaning of Art. 113(2) EPC 1973.

In the inter partes case **T 917/95** a patent proprietor had submitted a new claim but no amended description or drawing. The descriptions and drawings relating to the previous claims were incompatible with the new claim. Because the proprietor failed to appear at the oral proceedings, no documents were available on the basis of which the patent could have been maintained (see also **T 725/00** and **T 1174/01**).

In **T 255/05** the board held that under Art. 113(2) EPC 1973, it is the applicant's responsibility to define the text on the basis of which it requests a patent to be granted. When the appellant, even after having been invited to do so by the board, does not clearly indicate the order in which its requests are submitted and what the exact content of each of these requests is, there is no text submitted or agreed by the applicant within the meaning of Art. 113(2) EPC 1973, and no request which could be considered by the board.

In **T 690/09** the examining division had refused to consent to the latest submitted set of claims under R. 137(3) EPC. The board held that this would not automatically revive the previous set of claims that the examining division had consented to consider, unless the applicant had indicated that he was relying on these as an auxiliary request. According to the board, deciding to refuse an application on the ground that claims are not allowable contravenes Art. 113(2) EPC 1973 if the applicant is no longer putting forward these claims. Similarly, in **T 996/12** the board held that, unlike the situation in which an applicant submitted one or more auxiliary requests, submitting a new main request automatically leads to the replacement of any previous main request(s). By basing its decision explicitly on an earlier set of claims, the examining division decided upon a text to which the appellant (no longer) agreed.

### 3.3. Cases where the EPO is uncertain or mistaken about the approval of the text

In **T 382/10** the board held that, to avoid any misunderstanding, in particular when requests were amended during oral proceedings, the examining division should clarify the final requests before pronouncing its decision at the conclusion of oral proceedings (see also Chapter IV.F.3.14.2 "Rule 104(b) EPC - failure to decide on a party's request"). In accordance with prevailing case law (**T 666/90**, **T 552/97** and **T 1439/05**, see below), the fact that the final requests were not established contravened Art. 113(2) EPC and was considered a substantial procedural violation.

In **T 666/90** the status of the requests was not clarified during oral proceedings before the opposition division. This resulted in a disagreement between the patentee and the opposition division in the period between oral proceedings and the drafting of the decision. According to the board, the appropriate action would have been to request, prior to the decision being issued, a written copy of the final version of the requests and a clarification of their order. In **T 552/97** the opposition division had taken no decision on the main request, incorrectly assuming that it was no longer in the proceedings. The board pointed out that EPO departments should clarify the position before issuing decisions, especially if requests had been amended in oral proceedings. In **T 355/03** it was unclear which text the applicant wished to have as the basis for grant. The board held that the examining division should have established what the applicant really wanted.

In **T 1439/05** it was held that if there were several requests in the form of a main request and successive auxiliary requests submitted in order of relevance, the examining division was bound in its decision by the order in which the requests had been submitted.

In **T 425/97**, the text of the single claim attached to the written decision of the opposition division was different from the text apparently held patentable at the oral proceedings. From the original minutes of the oral proceedings, the history of the case and further circumstances, the board concluded that the opposition division, in violation of Art. 113(2) EPC 1973, had taken a decision on the patent on the basis of a text which had neither been submitted nor agreed by the proprietor of the patent.

In **T 543/92** and **T 89/94** the opposition division unintentionally failed to take account of a document introducing amended claims. In both cases the patent was revoked. The board ruled that once an item of mail had been received at the EPO it had to be considered to have been received by the organ deciding the case. Responsibility for the correct processing of mail thereafter lay with the relevant departments within the EPO. The decision under appeal was thus in breach of Art. 113(2) EPC 1973.

In **T 1351/06**, the main request had not been withdrawn and had therefore remained pending. As a result, the decision to grant the patent on the basis of the text approved by the applicant as an auxiliary request was contrary to Art. 113(2) EPC 1973.

## C. Oral proceedings

1.	Right to oral proceedings	558
1.1.	Right to oral proceedings in examination, opposition and appeal proceedings	558
1.1.1	General principle	558
1.1.2	Consequences of the general principle	558
	a) Right to oral proceedings even after a Rule 71(3) EPC communication	558
	b) Right to oral proceedings even if no new arguments are presented	559
	c) No right to telephone conversation	559
1.1.3	Obligation to attend oral proceedings which take place at the instance of the EPO	560
1.2.	Right to oral proceedings before the Receiving Section	560
2.	Request for oral proceedings	560
2.1.	Doubt as to the nature of the request for oral proceedings	560
2.2.	Wording of request	561
2.2.1	Wording constituting a request	561
2.2.2	Wording not constituting a request	562
2.3.	Withdrawal of request for oral proceedings	562
2.3.1	Announcing non-attendance	562
2.3.2	Silence in response to communication	563
2.4.	Further oral proceedings before the same department	563
2.4.1	Same subject of proceedings	563
2.4.2	Not the same subject of proceedings	564
2.5.	Auxiliary request for oral proceedings	565
2.6.	No oral proceedings in spite of unconditional request	565
2.7.	Request for oral proceedings in relation to further prosecution proceedings after remittal	566
2.8.	Request for oral proceedings as a reply to a communication of a board of appeal	566
3.	Non-attendance at oral proceedings	566
3.1.	Right to present comments and non-attendance of a party by choice	567
3.2.	Non-attendance of party who filed new claims without amended description before oral proceedings; no reason for postponement of ruling	567
3.3.	Obligation to give notice if not attending oral proceedings	567
4.	Preparation and conduct of oral proceedings	568
4.1.	Fixing or changing the date for oral proceedings	568
4.1.1	Legal provisions and notices	568
4.1.2	Request for changing the date of oral proceedings	568
4.1.3	Request or reasons for postponement filed too late	569
4.1.4	Grounds for postponement	569
	a) Illness and other medical issues	570
	b) Booked holidays	571
	c) Speaking at a conference	572
	d) Business engagements	572
	e) National holiday	572

---

f)	Newly appointed representative	572
g)	No legal representative appointed	572
h)	Absence of duly represented party	573
i)	Postponement because of late receipt of board's communication	573
4.1.5	Obligation to give reasons why representative cannot be substituted	573
4.1.6	New evidence or requests	574
4.1.7	Proceedings before a national court	574
4.1.8	Postponement in order to avoid adverse decision of the board	574
4.1.9	Continuation of oral proceedings on the next day	575
4.2.	Notice of two months in the summons	575
4.3.	Communication under Article 15(1) RPBA	576
4.3.1	Purpose of communication under Article 15(1) RPBA	576
4.3.2	Boards not bound by communication under Article 15(1) RPBA	577
4.3.3	Boards' discretion to send communication under Article 15(1) RPBA	577
4.4.	Late submission of new facts and evidence in the preparation for oral proceedings - Rule 116 EPC (Rule 71a EPC 1973)	577
4.4.1	Examination and opposition proceedings	578
4.4.2	Appeal proceedings	580
4.5.	Location of oral proceedings	580
4.6.	Oral proceedings conducted by video conference	581
4.7.	Computer-generated presentations and other visual aids	582
4.8.	Sound recording	583
4.9.	Minutes of oral proceedings (Rule 124 EPC)	583
4.9.1	Content of minutes	583
4.9.2	No recording of statements for use in subsequent national proceedings	586
4.9.3	Correction of minutes	586
4.9.4	Signing of minutes	587
4.9.5	Refusal to record statement not an infringement of the right to be heard	588
4.10.	Speaking time during oral proceedings	588
4.11.	Interpreting in oral proceedings	588
4.12.	Oral submissions by an accompanying person	588
4.13.	Excluding the public from oral proceedings	588
4.14.	Presence of assistants during deliberations of the board	589
4.15.	Handwritten amendments during oral proceedings before the board	589
5.	Costs	589
5.1.	Apportionment of costs	589
5.2.	Interpreting costs during oral proceedings	590

## 1. Right to oral proceedings

### 1.1. Right to oral proceedings in examination, opposition and appeal proceedings

#### 1.1.1 General principle

The right of parties to oral proceedings in examination, opposition and appeal proceedings is enshrined in Art. 116(1) EPC, according to which oral proceedings take place either at the instance of the EPO if it considers this to be expedient or at the request of any party to the proceedings. In other words, oral proceedings are not held automatically in each case. The right to an oral hearing is an extremely important procedural right which the EPO should take all reasonable steps to safeguard (T 19/87, OJ 1988, 268, T 663/90, T 808/94, T 911/04). If a request for oral proceedings has been made, such proceedings have to be appointed. This provision is mandatory and leaves no room for discretion (T 283/88, T 795/91, T 556/95, T 1048/00, T 740/15). Parties have an **absolute right** to oral proceedings (T 552/06, T 189/06, T 263/07, T 1426/07, T 653/08, T 1251/08, T 1829/10). Considerations such as the speedy conduct of the proceedings, equity or procedural economy cannot take precedence over the principle of the right to oral proceedings. The right to be heard in oral proceedings subsists so long as proceedings are pending before the EPO (T 598/88, T 556/95, T 114/09). The refusal of a request for oral proceedings normally constitutes a violation of the right to present comments. Thus, if the request for oral proceedings is ignored, even due to an oversight, the decision must be set aside as null and void (T 19/87, OJ 1988, 268; T 93/88, T 560/88, T 663/90, T 766/90, T 740/15).

Where several parties are involved, e.g. in opposition proceedings, the EPC provides only for oral proceedings to which all the parties are invited, so as to respect the principles of judicial impartiality and the equal rights of parties T 693/95 .

The failure by the board to arrange for the holding of oral proceedings requested by a party may be a fundamental procedural defect on which a petition for review can be filed, see Art. 112a(2)(d), R. 104(a) EPC.

Besides Art. 116 EPC, there are also other provisions relevant for the preparation and conduct of oral proceedings: R. 115 EPC - summons to oral proceedings (see in this chapter III.C.4.2), R. 116 EPC (R. 71a EPC 1973) - preparation of oral proceedings (see in this chapter III.C.4.4), R. 124 EPC - minutes of oral proceedings (see in this chapter III.C.4.8), as well as various notices concerning the practice for fixing the date of oral proceedings (see in this chapter III.C.4.1.1). For the boards of appeal, see also Art. 15 RPBA.

#### 1.1.2 Consequences of the general principle

##### a) Right to oral proceedings even after a Rule 71(3) EPC communication

The board in T 556/95 (OJ 1997, 205) held that the discretion of an examining division to allow amendments up to the decision to grant the patent did not mean that that

department had discretion to refuse a request for oral proceedings dealing with such amendments. The examining division had to have regard to Art. 116(1) EPC 1973 when exercising its discretion under R. 86(3) EPC 1973 in case of amendments requested after the issue of a communication under R. 51(6) EPC 1973 (equivalent in substance to R. 71(3) EPC). The Enlarged Board of Appeal - which in **G 7/93** (OJ 1994, 775) had given some guidance as to how an examining division should exercise such discretion - could not limit the application of Art. 116(1) EPC 1973 by means of such guidance.

b) Right to oral proceedings even if no new arguments are presented

In **T 383/87** the board pointed out that Art. 116(1) EPC 1973 guaranteed the right of any party to request oral proceedings, i.e. to argue its case orally before the relevant department of the EPO. A party might feel that it could present its case better orally than in writing, even if it had no new arguments. It was then its genuine right to request oral proceedings without being inhibited by the fear of having to pay additional costs, unless the request for oral proceedings was a clear abuse of the law. In **T 125/89** the board also emphasised that Art. 113(1) and 116(1) EPC 1973 were clearly not restricted to "new and substantial arguments". Parties also had the right to repeat known arguments or to stress arguments which had already been brought forward or to link such arguments in a specific combination or series.

c) No right to telephone conversation

As a matter of principle, the EPC foresees the absolute right to oral proceedings under Art. 116(1) EPC, but not the right to a telephone interview or an informal telephone consultation. This applies to the procedure before the examining division (see **T 98/88** and Chapter IV.B.2.8 "Informal communications"), as well as to the proceedings before the boards of appeal (see decisions cited below).

In **T 552/06** the board held that a board was not required to contact the appellant by holding a telephone interview, for instance with the rapporteur, either after receipt of the response to the summons, in which the appellant had indicated his wish for a discussion with the board, or on the day of the oral proceedings.

In **T 263/07** the appellant had requested that the rapporteur of the board telephone the appellant's representative to discuss the case so that the oral proceedings could possibly be cancelled. The board held that it was important that the same case was presented to all the board's members. For one of the board's members to be privy to evidence or arguments not available to the other members would be a breach of the principle of collective decision-making and in conflict with Art. 21 EPC 1973 (see **T 1109/02**). Since the requested telephone interview could have led the rapporteur to take a position on an issue where a collective decision would have been required, or to commit the board without preliminary discussion, the request was refused. See also **T 653/08**, **T 1251/08**, and **T 911/10**.

In **T 1984/07** the board did not rule out that there may be circumstances in which a telephone call may be appropriate: for example, if only minor objections remain which

could be easily attended to by straightforward amendments. However, in the case at issue, the objections were of such nature that any further amendments were likely to entail more than just a simple modification to the wording of the claims or a straightforward adaptation of the description.

### 1.1.3 Obligation to attend oral proceedings which take place at the instance of the EPO

The purpose of oral proceedings is to settle as far as possible all outstanding questions relevant to the decision and to speed up the procedure. If oral proceedings take place at the instance of the EPO because it considers this to be expedient (see Art. 116(1) EPC), the party has an obligation to attend the oral proceedings. There is no right to a solely written procedure (**T 1500/10**).

## 1.2. Right to oral proceedings before the Receiving Section

Under Art. 116(2) EPC oral proceedings must take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application. A board can refuse a request for oral proceedings made by an applicant in the course of an appeal against a decision of the Receiving Section for the same reasons, Art. 116(2) EPC 1973, Art. 111(1) EPC 1973 (**J 20/87**, OJ 1989, 67). Although according to Art. 116(2) EPC the Receiving Section is entitled not to grant a request for oral proceedings, the applicant has the right to a decision on that request (**J 16/02**).

The decision confirming a loss of a right (R. 69(2) EPC 1973, R. 112(2) EPC) is not a case in which the Receiving Section "envisages refusing the European patent application" within the meaning of Art. 116(2) EPC 1973, (**J xx/xx=J 900/85**, OJ 1985, 159). This was confirmed by **J 17/03** where the Legal Board also decided that a decision refusing a request for re-establishment of rights was not to be equated with the refusal of an application. The Receiving Section had thus discretion in dealing with the appellant's request for oral proceedings; this discretion was not without limits and had to be exercised in light of recognised procedural principles such as the right to be heard set out in Art. 113(1) EPC.

## 2. Request for oral proceedings

A party's right to oral proceedings is subject to a clear and unambiguous request for such proceedings (**T 299/86**, OJ 1988, 88; **T 352/89**; see also **T 598/88**, **T 95/04**, **T 777/06**, **T 1976/08**).

### 2.1. Doubt as to the nature of the request for oral proceedings

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**; **T 344/88**; **T 668/89**; **T 494/90**; **T 872/90**; **T 870/93**; **T 417/00**; **T 1829/10**; **T 2373/11**; **T 2557/12**).



If an EPO department has any doubt as to whether a party has requested oral proceedings (e.g. if the request is for a "hearing"), it must clarify the matter in order to avoid committing a substantial procedural violation (**T 2373/11**).

Nevertheless, in **T 528/96**, the board explained that, although the opposition division might reasonably have been expected to query whether such a request was in fact intended, the fact that it failed to do so did not constitute a procedural violation, since the onus to make a clear request was on the party itself (see also **T 26/07**). The board in **T 1606/07** held that if the applicant requested an "interview" but in fact later alleged that his intention was to request oral proceedings, there would be no need for the examining division to clarify the request since the request was unambiguous (see also **T 1976/08**).

## 2.2. Wording of request

### 2.2.1 Wording constituting a request

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 (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. In **T 494/90** the wording "We request that we be given the opportunity to attend an oral hearing which may be appointed" was accepted as request for oral proceedings in the circumstances of the case.

In the ex parte case **T 95/04** the appellant's request for a telephone call from the examiner was followed by a further request "in any event" for an opportunity to be heard before an adverse decision was taken. In the board's view, the expression "in any event" implied that, if the examiner was to exercise his discretion and not to communicate further with the applicant, then the applicant wished to have a further opportunity to be heard which under the circumstances could only be provided by appointing oral proceedings.

In **T 1829/10** the applicant's response to the examining division's first communication was that a hearing would be "useful" (German: "sachdienlich") if basic concerns regarding patentability persisted. The board of appeal held that the term "hearing" was synonymous with "oral proceedings". Whether or not the formal term "request" was used was immaterial in this context (see also **T 263/91**). The applicant's use of the expression "sachdienlich" (useful) in a request for oral proceedings, as opposed to a request for interview, did not imply that the examining division had any discretion with respect to its grant.

In **T 2557/12** the examining division had considered that the following phrase did not constitute a request for oral proceedings: "In the case of the Examining division would decide to reject the application, an oral proceeding would be requested pursuant to

article 116 EPC". The board held that the phrase in question left little doubt about the applicant's intention to avoid an immediate refusal of its application. Any risk of procedural deviance could have been easily avoided if the examining division had sought clarification from the applicant before issuing its decision.

### 2.2.2 Wording not constituting a request

In **T 528/96**, the final paragraph of the patentee's response to the opposition - the last document on the file before the opposition division took its decision - read as follows: "Should the opposition division feel that further information is required, the patentee will be pleased to respond in due course, either in writing or during the oral hearing". The statement did not constitute a formal request for oral proceedings.

In **T 299/86** (OJ 1988, 88) a party "reserved the right to request oral proceedings". This was interpreted as meaning that the party had not yet decided whether to request oral proceedings (see also **T 263/91**).

In **T 433/87** the board interpreted the patent proprietor's request "to conclude the opposition proceedings and if necessary arrange oral proceedings as soon as possible" to mean that oral proceedings were requested only in the event of their being considered necessary by the opposition division (see also **T 650/94**). 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 (**T 88/87**, see also **T 454/93**).

## 2.3. Withdrawal of request for oral proceedings

A party's request for oral proceedings can be withdrawn only by virtue of a clearly expressed intention not to proceed with the request, for example in the form of an unambiguous written statement to that effect on the file. If there is no unequivocal proof of the withdrawal of the request, it has to be assumed that the request, once submitted, is still valid and was therefore also valid at the time of the contested decision (see **T 283/88**, **T 663/90**, **T 879/92**).

For the question of whether a withdrawal of a request for oral proceedings can lead to a different apportionment of costs under Art. 104 EPC, see Chapter IV.C.6.2.2 "Acts or omissions prejudicing the timely and efficient conduct of oral proceedings".

### 2.3.1 Announcing non-attendance

In **T 3/90** (OJ 1992, 737) oral proceedings were appointed as a result of a party's request. The party subsequently stated that it would not be represented at the oral proceedings. The board held that such a statement should normally be treated as equivalent to a withdrawal of the request for oral proceedings (see also **T 696/02**, **T 1027/03**, **T 1482/05**, **T 871/07**). By stating that he will not attend oral proceedings and by requesting a decision on the record, the appellant (applicant) unequivocally expressed that he was interested in an immediate decision on the file as stood and that

he did not wish to present his arguments orally in the requested oral proceedings (**T 1482/05**).

In **T 910/02** the board of appeal remitted the case to the department of first instance for further prosecution without oral proceedings, since all the parties who had presented their comments in the appeal proceedings had either withdrawn their request for oral proceedings or had stated that they would not attend oral proceedings. In such a case the board has discretion either to abide by the date for the oral proceedings in order to announce a decision, or to cancel the oral proceedings and issue a decision based on written proceedings. **T 663/10** confirmed **T 910/02**, adding that the board was not obliged to hold oral proceedings in the absence of the party, even if the appellant had explicitly maintained its request for oral proceedings.

### 2.3.2 Silence in response to communication

Silence on the part of the appellant cannot be interpreted as withdrawal of the subsidiary request for oral proceedings. A request within the meaning of Art. 116(1) EPC 1973 could only be withdrawn by a declaration to that effect (**T 35/92**). Silence following a communication from the opposition division, asking whether the appellant was maintaining the request for oral proceedings, can also not be interpreted as a withdrawal of that request (**T 686/92**). A withdrawal requires an unambiguous expression of the party's wish to withdraw (**T 795/91**, see also **T 766/90**, **T 879/92**).

In **T 1042/07** the board stated that in the absence of anything that can be regarded as a statement of grounds of appeal, the lack of any substantive response to a notification of the inadmissibility of the appeal is considered as equivalent to an abandonment of a request for oral proceedings initially made in the notice of appeal.

## 2.4. Further oral proceedings before the same department

According to Art. 116(1), second sentence, EPC the EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

### 2.4.1 Same subject of proceedings

In **T 298/97** (OJ 2002, 83) the board observed that as a matter of law, the right to oral proceedings was not to two oral proceedings on the same subject. Any further oral proceedings on the issue of admissibility would therefore be a matter for the board's discretion.

If no substantially new situation has arisen, no further oral proceedings is justified (see **T 748/91**, **T 692/90**, **T 755/90**, **T 25/91** and **T 327/91**).

In **T 547/88** too the board rejected the request for further oral proceedings since the parties and the subject were the same. The purpose of continuing the proceedings in writing after the first oral hearing was merely to provide further clarification of the same

facts. In **T 614/90** the board rejected the request for further oral proceedings. In addition, the board also rejected the request to comment in writing on the board's reasons for refusing further oral proceedings because the reasons for the refusal had already been given in a communication.

In **T 529/94** the examining division, in exercising its discretionary power under R. 86(3) EPC 1973, had considered newly filed claims 3 and 4 as inadmissible. The board held that the legal consequence of this was that claims 3 and 4 were never integrated into the text of the application and never became part of it. For this reason, refusing to hold oral proceedings a second time, during which proceedings it was intended to discuss the allowability of proposed amendments already judged as inadmissible, could not constitute a procedural violation.

#### 2.4.2 Not the same subject of proceedings

In **T 194/96** new citations were submitted after the first oral proceedings that were more pertinent than the documents on file and which could and in fact did radically change the nature of the decision. The board held that in such a case the subject of the proceedings could no longer be the same (see also **T 441/90**).

In **T 731/93** the board stated that where fresh evidence had been admitted into the proceedings, the "subject" of such proceedings, as construed by reference to the text of Art. 116(1) EPC 1973 in all three official languages, could no longer be the same.

In **T 1880/11** after the board had in a first decision ordered a patent to be granted on the basis of the main request and the description to be adapted accordingly, the examining division refused the application a second time without holding oral proceedings. The board held that there had been a new subject before the examining division, namely how to adapt the description and the figures in order to fulfil the board's order. It could at least have been discussed during oral proceedings whether the section of the first appeal decision on which there was disagreement between the division and the applicant belonged to the ratio decidendi of that decision and how this section should be interpreted.

In **T 2106/09** the board had in a previous decision (**T 990/06**) remitted the case to the opposition division. In its statement of grounds for the earlier appeal, the appellant had changed the subject of the proceedings by introducing a new citation and claiming a lack of inventive step on the basis of a combination of the teachings of various citations. The opposition division had thus been wrong to consider that the subject of the proceedings was the same and, by issuing the contested decision without holding oral proceedings, as requested by the appellant, it had infringed the right to be heard.

In **T 1775/12** the board held that the procedural issue of admission under R. 137(3) EPC of amendments filed in response to a communication under R. 71(3) EPC constituted a "subject of the proceedings" within the meaning of Art. 116(1) EPC, second sentence, EPC which was distinct from the discussion of matters of substantive law that had previously taken place at oral proceedings.

In **T 1548/11** the board observed that during the oral proceedings held before the opposition division before issuing the first decision only the question of novelty had been discussed. Since the opposition division found the contested claim to lack novelty, it revoked the patent without touching upon the issue of inventive step during the oral proceedings. By contrast, the decision now under appeal dealt exclusively with the question of inventive step. Its subject was therefore not the same as the subject of the oral proceedings held before the first decision was taken.

### **2.5. Auxiliary request for oral proceedings**

There is no requirement in the EPC or in the case law that only unconditional requests to oral proceedings are admissible; it is normal practice to request oral proceedings e.g. only for the eventuality of an imminent adverse decision (**T 1136/10**, see also **T 870/93**). According to the established practice of the boards of appeal, a request for oral proceedings on an auxiliary basis is interpreted as a request for oral proceedings unless the board intends to decide the case in favour of this party (see **T 3/90**, OJ 1992, 737).

In **T 344/88** the appellants requested that oral proceedings be held if the opposition division intended to maintain the patent in whole or in part. The opposition division rejected the opposition as inadmissible without appointing oral proceedings. The board found that while it was true that, in rejecting the opposition as inadmissible, no formal decision had been taken to maintain the patent, this was nevertheless the consequence of the decision.

In **T 42/90** the board remitted the case to the department of first instance. It held that the patent proprietor was not adversely affected by this decision so that there was no need to grant the auxiliary request for oral proceedings (see also **T 166/91**, **T 47/94**, **T 808/94**). In **T 924/91** the board explained that in case of a remittal to the department of first instance there was no need to appoint oral proceedings because remittal meant that the decision under appeal was being set aside, and not that the application was being refused.

In **T 902/04** the board held that, since the opponent's request was allowed, there was no need to hold the oral proceedings which only the opponent had requested on a purely auxiliary basis.

### **2.6. No oral proceedings in spite of unconditional request**

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. In the case underlying **T 1050/09** the opposition division, referring to **T 494/92**, had treated the opponent's unconditional request for oral proceedings as merely conditional as it had decided in favour of the opponent. The board agreed and added that a successful party had no reason to doubt the correctness of the procedure leading to the decision in its favour.

In **T 147/84** the respondent had limited its claims on appeal and requested (unconditionally) oral proceedings. The board remitted the case for further prosecution and held that the respondent was not adversely affected by this decision so that there was no need for oral proceedings.

### **2.7. Request for oral proceedings in relation to further prosecution proceedings after remittal**

In **T 892/92** (OJ 1994, 664) the board held that "further prosecution" proceedings on remittal by the board of appeal were to be regarded as a continuation of the original 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 (see also **T 742/04**, **T 1425/05**).

In **T 1866/08** the board considered that the appeal procedure was separate from the examination procedure (see, for example, **G 8/91**, **T 34/90**). It followed that a request for oral proceedings to be held before the examining division could not validly be made during the appeal proceedings. As a consequence, the appellant would have to file a new request for oral proceedings after the procedure was resumed by the examining division. See also **T 901/10**, where the board confirmed this case law and added that, a fortiori, a request for oral proceedings in possible further appeal proceedings in the future would have to be requested again during those appeal proceedings.

### **2.8. Request for oral proceedings as a reply to a communication of a board of appeal**

In **T 1382/04** the appellant had been invited to file observations on the board's communication under R. 100(2) EPC. Failure to reply to such an invitation in due time would result in the application being deemed withdrawn (R. 100(3) EPC). The appellant had not made any substantive observations on the board's communication but had filed a request for oral proceedings. The board considered the request for oral proceedings as a reply avoiding a deemed withdrawal under R. 100(3) EPC since it could not be assumed that the appellant had lost its interest in the application while requesting oral proceedings at the same time, apparently with a view to present its comments on the board's arguments orally.

## **3. Non-attendance at oral proceedings**

The absence of parties from oral proceedings is in general governed by R. 115(2) EPC and – for the boards of appeal – by Art. 15(3) RPBA (Art. 11(3) RPBA 2003). Concerning non-attendance at oral proceedings before the examining division, see also the notice from the EPO published in OJ 10/2008, p. 471.

### **3.1. Right to present comments and non-attendance of a party by choice**

According to **T 1500/10**, the notice in OJ 2008, 471 together with R. 115(2) EPC make it clear that the oral proceedings are themselves an opportunity for the applicant to present its comments, in accordance with Art. 113(1) EPC. They confirm that, if a party decides not to attend the oral proceedings without a serious reason, it chooses not to make use of the opportunity to comment at the oral proceedings on any of the objections raised during them, and it has no right to make additional written submissions. Serious reasons are the same reasons that could justify postponement of oral proceedings (see in this chapter III.C.4.1.4).

On the question of whether a decision pronounced against a party who has chosen not to attend oral proceedings may be based on new facts, evidence and/or arguments introduced during those oral proceedings, see Chapter III.B.2.7 "The right to be heard in case of the non-attendance at oral proceedings". As to the case law where the appellant (applicant) submits new claims after oral proceedings have been arranged by the board of appeal and then does not attend those proceedings, see the Chapter IV.E.4.2.3 "Filing of requests during the oral proceedings".

### **3.2. Non-attendance of party who filed new claims without amended description before oral proceedings; no reason for postponement of ruling**

In **T 917/95** the board held that a patentee who, in inter partes proceedings, filed a new claim but no amended description prior to the oral proceedings before the board of appeal and who failed to attend the oral proceedings could not rely on the board's postponing its ruling simply to permit amendment of the description, even if the new claim was grantable (see also **T 109/02**, **T 181/02**, **T 2294/08**).

### **3.3. Obligation to give notice if not attending oral proceedings**

In **T 653/91** the board held that if, having been summoned to oral proceedings, a party did 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 were inappropriate, especially in inter partes proceedings.

In **T 930/92** (OJ 1996, 191) the board also pointed out that there was an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as it knew that it would not attend as summoned. This was the case whether or not that party had itself requested oral proceedings, and whether or not a communication had accompanied the summons to oral proceedings.

In **T 692/00** the board held that for the appellant (proprietor) to announce shortly before the appointed date for oral proceedings that it might or might not attend while maintaining its request for oral proceedings could only be an abuse of procedure.

In **T 69/07** the respondent had requested oral proceedings but did not appear at the oral proceedings at the appointed time. The board noted that, in accordance with Art. 6 of the Code of Conduct of Members of the EPO, of which the representative is obligatorily a member, the members are required to act courteously in their dealings with the EPO. The representative of the respondent had had sufficient time to inform the board of its intended non-appearance at the oral proceedings. This would have avoided keeping the other party and the board first of all courteously waiting for the representative in case he had unintentionally been delayed, and then obliging the registrar of the board to carry out enquiries to establish if the representative intended to attend the oral proceedings (see also **T 1760/09**). In similar cases, the boards held that the actions of the representative were "reprehensible" (**T 954/93, T 69/07, T 1939/10**).

In all these cases, an apportionment of costs in favour of the attending party could be justified, see Chapter IV.C.6.2.2 "Acts or omissions prejudicing the timely and efficient conduct of oral proceedings".

#### **4. Preparation and conduct of oral proceedings**

##### **4.1. Fixing or changing the date for oral proceedings**

###### **4.1.1 Legal provisions and notices**

The practice for fixing the date of oral proceedings before the departments of first instance and the boards of appeal was published in a notice in OJ 2000, 456 ("the 2000 Notice"). More recently, the EPO's notice of 18 December 2008 (OJ 2009, 68) ("the 2008 Notice") adjusted the procedure for changing the date before the departments of first instance. For the current practice before the boards of appeal, the notice from the Vice-President DG 3 of 16 July 2007 (OJ SE 3/2007, 115) ("the 2007 Notice") is applicable and largely supersedes the 2000 Notice. These notices use much the same wording but are not identical.

###### **4.1.2 Request for changing the date of oral proceedings**

Parties can request a change of date of oral proceedings. For as long as a request for postponement of oral proceedings has not been granted, the requesting party cannot simply assume that it will be. The party has to consider the possibility of a refusal of the request and has to prepare the case accordingly to minimise the risk of time pressure (**T 2526/11, T 1102/03**).

According to the above-mentioned notices, a change in the date of oral proceedings can only be requested in case of "serious reasons" justifying the fixing of a new date, see point 2 of the 2007 Notice (boards of appeal) and point 2.1 of the 2008 Notice (departments of first instance), drawn from the 2000 Notice; the case law on grounds for postponement is summarised in this chapter III.C.4.1.4.

The request must be filed as soon as possible after the grounds preventing the party concerned from attending the oral proceedings have arisen, and must be accompanied



by a sufficiently substantiated written statement indicating these reasons. As far as the boards of appeal are concerned, a change of date for oral proceedings may exceptionally be allowed at the board's discretion under Art. 15(2) RPBA.

The 2000 and 2007 Notices (points 2.5 and 2.3 respectively) state that any request to set another date for oral proceedings should indicate why another representative cannot stand in for the one unable to attend (see in this chapter III.C.4.1.5).

For the question of whether a request for postponement of oral proceedings can lead to a different apportionment of costs under Art. 104 EPC, see Chapter IV.C.6.2.2 "Acts or omissions prejudicing the timely and efficient conduct of oral proceedings".

#### 4.1.3 Request or reasons for postponement filed too late

The provisions of Art. 15(2) RPBA and the 2007 Notice balance the interests of the parties and the public taking into account, among other factors, an efficient use of resources and capacities of the office. Thus, a request for postponing the date of oral proceedings may be refused if it is late filed (**T 601/06**, see also **T 1102/03**, **T 1053/06** and **T 518/10**).

In **T 1080/99** (OJ 2002, 568) the board had made it clear in a letter sent almost three months before appointed oral proceedings that a request by a party for postponement of the oral proceedings did not meet all the requirements of the 2000 Notice. The party, instead of attempting to supplement its original request as soon as possible, chose to react to the board's letter only one week before the appointed oral proceedings. The board held that the additional reasons and evidence for the request for postponement and the fixing of a new date for oral proceedings were received too late and could therefore not be accepted.

In **T 601/06** the board considered the request to postpone the oral proceedings to be late filed. The representative should have been aware when receiving the summons that he would be prevented from attending the oral proceedings and should have filed his request immediately. Filing the request more than one month later was not considered to fulfil the requirement of "as far in advance of the appointed date as possible" as required under Art. 15(2) RPBA or "as soon as possible" as required in the 2007 Notice.

In **T 485/09** the representative had requested a postponement of the oral proceedings before the board of appeal because he had already booked a vacation for the relevant date. The board rejected the request. An attorney who wished a change in the date of oral proceedings had an obligation to inform the board promptly of this desire. In the case at issue the attorney had waited five weeks before informing the board of his non-availability.

#### 4.1.4 Grounds for postponement

According to the Notices of 2007 (boards of appeal) and 2008 (departments of first instance), a change in the date of oral proceedings can only be requested in case of

"serious reasons" justifying the fixing of a new date. The notices give examples of serious reasons including "a previously notified summons [...]"; "holidays which have already been firmly booked"; and "serious illness"; however, differences in detail exist between the two Notices, compare point 2.1 of the 2007 Notice and point 2.3 of the 2008 Notice. Grounds mentioned in the two Notices as not acceptable are, for instance: excessive work pressure, or a summons to oral proceedings before the EPO or a national court notified after the summons in the relevant proceedings.

If the party is represented, the serious reasons must relate to the representative, and not the client (see **T 1916/09**, **T 2125/11**).

a) Illness and other medical issues

In **T 275/89** (OJ 1992, 126) the board considered that the illness of a duly represented party was not a sufficient reason for postponing appointed oral proceedings unless the party who was ill needed to be present. A request to change an appointment could only be allowed if unforeseen, exceptional circumstances had arisen, which either made oral proceedings impossible (such as a representative's or unrepresented party's sudden illness) or could have a decisive impact on the course of the proceedings (such as unforeseen unavailability of an important witness or expert), followed in **T 1923/06**.

In **T 1212/04** the board held that the generally accepted principle that serious illness was a sufficient reason for postponing the date for oral proceedings could not be applied to the illness of the inventor designated in the application, since the appellant had failed to give any reasons why the inventor's presence at the oral proceedings was necessary or even indispensable.

In **T 1067/03** the representative requested that the oral proceedings be postponed because of a prior appointment for a medical operation. The representative said that his client was opposed to a change of representative on the grounds that, in addition to the appeal in question, a further opposition and a patent infringement case were pending which together formed an intricate ensemble. In the board's opinion, these circumstances justified postponing the oral proceedings.

In **T 1505/06**, three days before oral proceedings before an opposition division, the appointed representative of the proprietor fell ill, and postponement of the oral proceedings was requested. At the start of the oral proceedings, the replacement attorney again requested that they be postponed due to the illness of the appointed representative. The opposition division refused the request. The board noted that the request for postponement contained all the elements necessary to allow the opposition division to decide whether or not to postpone the oral proceedings. The factors that the opposition division would have to weigh up include the proximity of the filing of the request to the oral proceedings, the complexity of the case, the availability of an alternative representative capable of preparing the case in the remaining time available and the effects of a postponement on any other party.

In **T 1916/09** the representative requested postponement of the oral proceedings on the ground that the client was seriously ill and could not attend oral proceedings. The board held that the reason of serious illness was related to impediments concerning the representative and not, as in the present case, the client.

In **T 1246/10** the board accepted a first postponement of the oral proceedings in view of the exacerbation of the appellant's serious illness and the fact that the respondent did not object to a postponement. However, the board refused the second request to postpone oral proceedings filed less than one month before the scheduled date. The respondent had already made travel arrangements for the oral proceedings and opposed any postponement thereof. Furthermore, the board had no indication that a further postponement for a few months could change the appellant's personal health situation. The appellant should have appointed a representative if he could not attend the oral proceedings himself.

b) Booked holidays

The board in **T 1102/03** applied Art. 15(2) RPBA and the provisions of the 2000 Notice (confirmed by the 2007 Notice) and stated that, while a holiday was a possible valid basis for a request, it was not necessarily a sufficient reason for postponement. The board held that the case at issue presented circumstances which entailed a special organisational burden. The effort of postponing fixed oral proceedings until a date might be found which would suit numerous parties, the members of an extended board, and the facility management of the EPO, outweighed the effort of postponing or interrupting one representative's holiday booked to a destination within Europe.

In **T 1610/08** the respondent's representative requested that the oral proceedings before the board be postponed as he had already firmly booked a holiday. The board declined the request and held that point 2.1 of the 2007 Notice, which lists pre-booked holidays as a potential reason for postponement, had to be balanced against point 2.3 of the Notice, according to which every request should explain why the representative could not be substituted. The board was of the opinion that the circumstances indicated by the respondent with respect to point 2.3 of the Notice (namely, the representative had a long-standing relationship of trust with the client, he was the only one with knowledge of the client's business or technology, and his knowledge of the earlier proceedings before the opposition division was unique and irreplaceable) were in fact common to all cases in which substitution was involved. In the board's view, only extraordinary circumstances, i.e. those which were not common to every case of substitution, should be accepted.

In **R 11/12** the request for postponement was rejected since the representative's holidays ended three days before the scheduled oral proceedings; in addition, the planned birthday party for the day after the oral proceedings could not be regarded as being a serious reason justifying the postponing of the oral proceedings to a later date.

c) Speaking at a conference

In **T 699/06** the board held that if European representatives wished to speak at conferences (even with the approval of clients whose cases are thereby delayed), the work of the boards of appeal and the interests of their clients' adversaries and the public should not be affected as a result. A representative who undertook such a commitment did so in the knowledge that this would make him unavailable to his clients, and unavailable to appear at any oral proceedings, on the date in question. See also **T 2526/11**.

d) Business engagements

In **T 1080/99** (OJ 2002, 568) the board held that a "series of business engagements" was not a reason falling within point 2.3 of the 2000 Notice, since business engagements were directly governed and planned by the office of the patent agent or the representative and were not normally affected by "external forces" within the meaning of point 2.3 of the Notice. Moreover according to point 2.4 of the 2000 Notice, "excessive work pressure" was normally not acceptable as a ground for postponement of oral proceedings.

e) National holiday

In **T 664/00** the appellant (patent proprietor) had requested an adjournment of oral proceedings in order to allow them to be attended by an expert from the United States, which would not have been possible on the date appointed by the board since this was a public holiday in the USA. The board rejected the request as national holidays in individual contracting states are not recognised by the EPO for practical reasons (see **J 5/98**). To allow for national holidays in non-contracting states throughout the world would be even less practical. See also **T 2125/11**.

f) Newly appointed representative

In **T 37/97** a new representative had been appointed after the summons to oral proceedings had been duly issued. The board rejected the request for postponement and held that the new representative, before taking on the mandate, could be expected to have made sure he was available on the appointed date or to arrange for alternative representation. Furthermore, a professional representative could be expected to be able to prepare for oral proceedings with all due care within a month unless the case was exceptionally difficult, which it was not.

g) No legal representative appointed

In **T 693/95** the board had waited for two years to give the appellants time to find a legal representative of their choice. This they had failed to do. After such a long delay there was no valid reason for postponing oral proceedings.

## h) Absence of duly represented party

In **J 4/03** the board decided that the desire of the appellant to be present himself at oral proceedings did not in itself amount to a serious ground for postponing the oral proceedings to a date on which the appellant could be present, in the absence of other special circumstances. The appeal turned essentially on how the law was to be applied to facts which were not in dispute, and so the presence or absence of a party who was duly represented in the proceedings should have no impact on the course of the proceedings or the final decision.

## i) Postponement because of late receipt of board's communication

In **T 569/11** the fact that the appellant became aware of the board's communication only shortly before the oral proceedings was not per se a reason that obliged the board to postpone the proceedings. Nevertheless, it was necessary to verify whether, in the light of the content of the communication, a postponement should be made in order to allow time for the appellant to react to the comments made by the board. This required an analysis of the points covered in the communication. In the case at issue, the board's communication did not include any new objection or any new evidence in comparison with the decision of the examining division. Accordingly, the facts of the case did not constitute an extraordinary circumstance (see **T 1610/08**) that would justify a postponement of the date of oral proceedings.

## 4.1.5 Obligation to give reasons why representative cannot be substituted

The 2000 and 2007 Notices (points 2.5 and 2.3 respectively) state that any request to set another date for oral proceedings should indicate why another representative cannot stand in for the one unable to attend. This means that if and when the board is satisfied that the representative is prevented from attending, it must therefore be considered whether another representative, who does not have to be from the same firm, can substitute for the prevented representative (**T 699/06**). If the appellant has signed a general authorisation to a law firm, the representative has to provide convincing reasons why no other representative of this firm could substitute for the representative (**T 518/10**).

In **T 1011/09** the board found that the statement prescribed in point 2.5 of the 2000 Notice had to contain more than a mere expression by the appellant of its general desire to be represented at oral proceedings by its usual representative, and that specific reasons had to be given as to why it was impossible, or at least unreasonably difficult, to arrange a replacement for the representative unable to attend (citing **T 1080/99**, OJ 2002, 568; **T 1067/03**; **T 300/04** and **T 178/03**). Moreover, point 2.5 of the 2000 Notice required that the reasons had to go beyond referring to the additional cost of replacing a representative. Such costs had to be accepted, at least up to a reasonable amount, as it could be assumed that they were generally incurred in such cases, given the new representative's need to familiarise himself with the case. See also **T 1610/08**.

#### 4.1.6 New evidence or requests

In **J 4/03** the board held that the desire of an applicant to file unspecified new evidence at an unspecified future date could not amount to a serious reason for postponing oral proceedings. Even in ex parte proceedings the appellant had to attempt to file any facts or evidence he wished to rely on before the set date of oral proceedings so that the board could exercise its discretion under Art. 114(2) EPC 1973 whether to admit the further evidence or not, on the basis of the relevant material.

In **T 881/95** the request for postponement was refused because the evidence, which could only have been provided later, was not such as to affect the decision.

In **T 427/05** the appellant filed one new main and 71 new auxiliary requests approximately two weeks before the oral proceedings. The respondent (opponent) submitted that none of these requests should be admitted into the proceedings; they were late-filed and too voluminous. Failing that, the oral proceedings should be postponed. The board decided there was no reason to postpone the oral proceedings in view of its decision to admit only those late-filed requests which related (albeit narrowed down in some cases) to the subject-matter which had been central to the discussions from the outset.

#### 4.1.7 Proceedings before a national court

In **T 392/97** the board ruled that the **subsequent** appointment of oral proceedings by a national patent court to take place on the same date as the previously appointed oral proceedings before the board was not in itself a sufficient reason for adjournment. A request to postpone an appointed and agreed date could only be allowed in the case of "unforeseen and exceptional" circumstances. "Exceptional" could be construed as meaning those circumstances which either made it impossible for the oral proceedings to take place or might have a material bearing on the course and outcome of the proceedings.

In **T 228/09** the board considered, having regard to Art. 2.2 of the 2007 Notice, that unforeseen infringement proceedings could not generally be regarded as an acceptable ground for adjournment.

#### 4.1.8 Postponement in order to avoid adverse decision of the board

In **T 1053/06** the reasons given by the appellant (applicant) for requesting postponement of the oral proceedings clearly indicated that the appellant had chosen not to pursue the case further and would prefer its patent application to be lost for non-payment of the next renewal fee at a later date rather than by an adverse decision of the board now. Those reasons had to do solely with the convenience of the appellant, which, until it received the board's negative preliminary opinion, had preferred to pursue the appeal proceedings and had indeed itself requested oral proceedings. The board refused the request for postponement.

#### 4.1.9 Continuation of oral proceedings on the next day

In **T 2534/10**, the chairman of the opposition division had proposed, late in the evening of the only scheduled hearing date, that the oral proceedings be continued the next day. Although the patent proprietor had objected to this proposal, the proceedings had been continued the next day, and both parties had attended. The board observed that the two months' notice to be given in summons to oral proceedings under R. 115 EPC met the parties' fundamental need to be able to plan for and estimate the likely course of those proceedings. They had the same need when it came to continuing proceedings on a calendar day other than that specified in the summons. Accordingly, a fresh summons had to be issued if proceedings were to be continued beyond the calendar day specified in the original summons.

In **T 1674/12** the opposition division had continued the oral proceedings on 9 September 2011, even though the summons was only for 8 September and two opponents had objected. The board held that, in the light of **T 2534/10**, the opposition division had committed a procedural error, irrespective of the opponents' objections: to continue the proceedings on 9 September, it had to have the express consent of all parties. **T 2534/10** had also ruled that remittal was necessary only if the error had affected the final decision; a case could be remitted only to recommence procedural acts performed on the second day, not covered by the summons. In the case at issue, even if the division had not continued the proceedings on 9 September 2011, it would have communicated the outcome of its deliberations in the usual way, in the minutes or the summons to the new oral proceedings. In other words, the proceedings would have taken essentially the same course, even if the division had adjourned the oral proceedings on the evening of 8 September 2011 rather than continuing them the following day.

#### 4.2. Notice of two months in the summons

Under R. 115(1), second sentence, EPC (R. 71(1), second sentence, EPC 1973) the notice given in the summons to oral proceedings must be at least two months, unless the parties agree to a shorter period.

In **J 14/91** (OJ 1993, 479) the board ruled that a dispute about a third party's right to inspect the application dossier before publication had to be decided promptly (i.e. before publication), otherwise Art. 128(2) EPC 1973 became null and void. If oral proceedings would facilitate a prompt decision, the summons under R. 71(1) EPC 1973 could give shorter notice - even without the other party's agreement - provided the parties were given enough time to prepare. The board referred to Art. 125 EPC 1973 and stated that it was a generally recognised principle of procedural law in the contracting states that notice could be curtailed in urgent cases. The degree of curtailment should be decided on a case-by-case basis.

In **T 111/95** the board stated that the examining division had no right simply to set a date for oral proceedings about two weeks after despatch of the summons. The board found that there was nothing on file to establish that the applicants' representative, at any time

and unconditionally, accepted the date set. The board thus held that the summons was null and void, as were the actions following and resulting from it.

In **T 772/03** the summons to oral proceedings did not comply with the requirement to give at least two months' notice. The board observed that the onus of proving that an agreement for a shorter notice period was reached lies with the examining division as the party making the claim (following **T 111/95**). In the case at issue the examining division had failed to prove that an agreement on a shorter notice period had been reached.

In **T 601/06** and **T 869/06** the boards offered an alternative date within a period of about two months from the date of the request in view of the balance of interests of the parties and the public. It was stated that the period of about two months arose from the fact that, except for when the parties consent, new summons had to be issued at least two months in advance of a hearing, so that dates within the two-month period from the date of the request could not be used for other cases.

According to the board in **T 2534/10**, R. 115 EPC equally applied where oral proceedings were continued on a date other than that fixed in the summons and that a fresh summons for that date therefore had to be issued.

### **4.3. Communication under Article 15(1) RPBA**

Art. 15(1) RPBA (Art. 11(1) RPBA 2003) reads as follows: "If oral proceedings are to take place, the board may send a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings." The earlier provision (Art. 11(2) RPBA 1980) required that the communication be sent together with the summons to oral proceedings. The case law on Art. 11(2) RPBA 1980 appears to remain applicable in all other respects.

#### **4.3.1 Purpose of communication under Article 15(1) RPBA**

In **T 1459/11** the board held that the purpose of the communication under Art. 15(1) RPBA was to establish the framework of the oral proceedings. The communication did not – explicitly or implicitly – represent an invitation or opportunity to file further written submissions or to shift the focus of the case to be heard at oral proceedings. The terms of the appeal were rather determined by the statement of grounds of the appeal and the reply thereto (Art. 12(2) RPBA). Consequently there was no legal basis in either the EPC or the RPBA for the filing of a "response" to a communication pursuant to Art. 15(1) RPBA. A board is under no obligation to take such a "response" into account. Any submissions – whether arguments or requests – contained in such a "response" that went beyond those contained in the statement of grounds of appeal or the reply thereto might constitute an amendment to the case presented, and it was a matter for the discretion of the board whether such submissions were to be taken into account (Art. 13(1) RPBA).



#### 4.3.2 Boards not bound by communication under Article 15(1) RPBA

In **T 614/89** the board held that a communication in accordance with Art. 11(2) RPBA 1980 was by no means binding. It 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.

#### 4.3.3 Boards' discretion to send communication under Article 15(1) RPBA

In **G 6/95** (OJ 1996, 649) the Enlarged Board held that the boards continued to have discretion as to whether or not to send a communication when issuing a summons to oral proceedings, as provided for in Art. 11(2) RPBA 1980, since the then newly introduced R. 71a(1) EPC 1973 (now R. 116(1) EPC) did not apply to the boards of appeal. The mandatory procedural requirements of R. 71a(1) EPC 1973 applied to the EPO's departments of first instance but not to the boards, because the Administrative Council could not amend the Implementing Regulations in such a way that the effect of an amended rule was in conflict with the RPBA - adopted under Art. 23(4) EPC 1973 by the Presidium of the boards of appeal and approved by the Council as reflecting the boards' independence.

#### **4.4. Late submission of new facts and evidence in the preparation for oral proceedings - Rule 116 EPC (Rule 71a EPC 1973)**

R. 116(1) EPC (R. 71a(1) EPC 1973) stipulates, inter alia, that, when the EPO issues the summons to oral proceedings, a final date for making written submissions in preparation for the oral proceedings must be fixed. New facts and evidence submitted after this date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed. The same is true for applicants or patentees invited under R. 116(2) EPC (R. 71a(2) EPC 1973) to submit documents which meet the requirements of the EPC.

As construed according to its object and purpose, R. 116 EPC (R. 71a EPC 1973) is intended to give the decision-making department and other procedural parties enough time to prepare thoroughly for the oral proceedings and so ensure that they are not faced with surprising new facts and do not take potentially inappropriate decisions in undue haste (**T 765/06**; as to the reasons for the introduction of R. 71a EPC see **T 343/08**). The purpose of R. 71a EPC 1973 is to provide the EPO with a case management framework for the preparation of oral proceedings (**T 798/05**).

In **T 452/96** the board emphasised that fixing a time limit under R. 71a EPC 1973 was not to be taken as an invitation to submit further evidence (see also **T 39/93**, OJ 1997, 134, and **T 885/93**) and therefore had no impact on the EPO's power to disregard late-filed documents (see also **T 476/96**). There is no general duty for an examining division to provide feedback on an applicant's reply to a summons to oral proceedings, in advance of such oral proceedings (**T 343/08**, see also **T 462/06**). In the ex parte proceedings **T 462/06** the board also stated that the requirement of R. 116 EPC

does not mean that already in the communication all lines of arguments or a detailed reasoning for the decision should be set out.

R. 116 EPC (R. 71a EPC 1973), and Art. 114(2) EPC on which it is based, refer to late-filed facts and evidence but not to new **arguments**, which can be made at any stage in the proceedings (T 131/01, OJ 2003,115; T 926/07, see also T 624/04). However, in the light of Art. 13 RPBA this may be different in appeal proceedings, see T 1621/09 where the board held that a new argument brought forward in appeal proceedings by a party which would have the effect of amending its case, even if the argument was based on evidence and facts already in the proceedings, can only be introduced into the proceedings at the discretion of the board by way of an amendment under Art. 13 RPBA.

For a comprehensive overview of the case law regarding late submissions in general (independent of the preparation of oral proceedings governed by R. 116 EPC), see Chapter IV.C.1, "Late submission". As to the applicability of R. 116 EPC (R. 71a EPC 1973) to the boards of appeal, see in this chapter III.C.4.4.2. For case law when the applicant files amended claims in appeal proceedings after the oral proceedings have been arranged and then does not attend them, see Chapter IV.E.4.2.6 d) "Applicant (proprietor) absent from oral proceedings".

#### 4.4.1 Examination and opposition proceedings

In T 755/96 (OJ 2000, 174) the board observed that R. 71a EPC 1973 gave the EPO a discretionary power. The EPO's power to accept or refuse late-filed new facts or evidence was in fact governed by Art. 114(2) EPC 1973, and the discretionary power to refuse new requests for amendments was governed by Art. 123 EPC 1973 and the corresponding Implementing Regulations. As to the exercise of discretion under R. 71a EPC 1973 to admit or refuse amended claims, the board held that the discretion was to be exercised by considering all relevant factors which arose in a particular case and by balancing the applicant's interest in obtaining proper patent protection for his claimed invention and the EPO's interest in bringing the examination procedure to a speedy close by the issue of a decision (following G 7/93, OJ 1994, 775).

In T 755/96 the board also held that it was important to draw a **distinction** between the **application stage** and the **opposition stage**. The reasons given for introducing R. 71a EPC 1973 made it clear that a particular concern was that in opposition proceedings other parties were not taken by surprise. Parties to opposition proceedings were often represented by professional representatives, who would need to consult their clients and technical experts for further instructions to deal with new requests or evidence. Thus there could be good reasons to refuse material filed after the final date set under R. 71a EPC 1973, or to postpone oral proceedings. However, the same considerations did not apply to an examining division which had its own technical expertise and did not have to obtain instructions from third parties. If prepared for oral proceedings, it should normally, even in relation to requests filed at the oral proceedings, be in a position to assess whether a new request was clearly not allowable and to decide on the basis of this finding not to admit such a new request into the proceedings. An

examining division which in exercising such discretion does not admit amended claims must give the reasons therefore.

In **T 712/97** the respondent (opponent) had filed a report of comparative experiments on the last day of the period set for filing comments pursuant to R. 71a(1) EPC 1973. The opposition division allowed this experimental report into the proceedings, but not the appellant's experimental report in response thereto. The board held that admitting the respondent's experimental report into the proceedings meant that the subject of the proceedings had changed within the meaning of R. 71a(1) EPC 1973 and that the appellant's experimental report should therefore also have been admitted into the proceedings. That the appellant's report would not affect the outcome of the proceedings was in these circumstances not a valid consideration. A party was entitled to know that its response was part of the documents admitted into the proceedings, even if it proved not to be decisive for the outcome before that instance.

In **T 484/99** the appellant (patentee) alleged that the refusal, under R. 71a EPC 1973, by the opposition division to consider or even look at amendments to the requests presented on the day of the oral proceedings before them amounted to a procedural violation. The board disagreed because it was clear from the wording of R. 71a(2) EPC 1973, that submissions by the proprietor presented after the final date did not need to be considered. In **T 64/02** the board referred to the case law of the boards of appeal holding that the opposition division's discretion to disregard submissions filed too late also covered amended claims presented after the final date fixed under R. 71a EPC 1973. R. 71a(2) EPC 1973 thus also applied to the belated submission of amended patent claims in an auxiliary request, even if those claims had not been requested in the summons (see also **T 1105/98** referred to further below).

In **T 951/97** (OJ 1998, 440) the board held that the subject of the proceedings was changed within the meaning of R. 71a(1) and (2) EPC 1973, *inter alia*, where the examining division itself introduced a new document, which was pertinent new material, into the proceedings for the first time during oral proceedings convened following a R. 71a EPC 1973 notification.

In **T 765/06** the examining division had pointed out in the summons that preparatory submissions and new claims should not be filed later than one month before the date of oral proceedings. Six days before the oral proceedings, the applicant filed new requests which the rapporteur, in a telephone conversation with the applicant, regarded as *prima facie* non-protectable and which were not admitted in the oral proceedings pursuant to R. 71a EPC 1973. The board found that conceding permission to file new claims did not comprise an assurance that such claims would be considered in the proceedings, with a considerable restriction of the time available for examination. To safeguard the legal form of the patent grant procedure and ensure that decisions were taken with due care, the examining division could not readily dispense, in advance and without knowledge of the matter to be considered, with the time required to prepare for oral proceedings.

In **T 798/05** the board held that R. 71a EPC 1973 did not constitute an absolute bar on late submissions in opposition proceedings, which would rule out *prima facie*

examination. R. 71a EPC 1973 did not override or restrict the principle of ex officio examination enshrined in Art. 114(1) EPC 1973, since an implementing regulation ranked lower than an EPC Article. The actual wording of R. 71a EPC 1973 using the expressions "brauchen, need not, peuvent" left room for discretion over the admission of late submissions.

In **T 937/09** the board held that, if the applicant filed amendments to the application before the final date set by the examining division under R. 116(1) EPC, the examining division could still refuse such amendments under R. 137(3), second sentence, EPC (in the version applicable until 31.03.2010; see R. 137(3) EPC for the version applicable since 1.4.2010).

#### 4.4.2 Appeal proceedings

In **G 6/95** (OJ 1996, 649) the Enlarged Board of Appeal held that the mandatory procedural requirements in R. 71a(1) EPC 1973 (R. 116(1) EPC) did **not** apply to the boards of appeal. However, in **T 97/94** (OJ 1998, 467) the board ruled that if a board decided to send the parties a communication under R. 71a(1) EPC 1973, the parties were obliged to comply with it, particularly as regards the deadline for reply. R. 71a(1) EPC 1973 was thus binding on the parties.

The board in **T 1105/98** stated that R. 71a(2) EPC 1973 was applicable to proceedings before the boards of appeal. In the case in question, the patent proprietor's auxiliary request with amended claims was presented at the start of the oral proceedings, i.e. after expiry of the time limit set in the summons. The board examined whether the auxiliary request could be refused as being out of time on the basis of R. 71a(2) EPC 1973, and decided that this provision also applied to the late submission of amended claims by way of an auxiliary request, even if the summons to oral proceedings had not contained an invitation to submit them. If the patent proprietor only submitted amended claims at the oral proceedings, the board could use its discretion to disregard them, particularly if the facts of the case had remained the same and further investigation was necessary to assess the lack of patentability alleged as grounds for opposition (see also **T 681/02**, **T 494/04**).

In **T 401/02** the board of appeal held that the admission of new requests on the basis of amended patent claims which are submitted by the patent proprietor only at the oral proceedings despite a final date having been set in the summons for the submission of such requests is distinctly limited in opposition appeal proceedings by R. 71a(2) EPC 1973. The admission of the request would normally have to be refused if the board or one of the parties to the appeal proceedings could not be expected to study the amended claims without postponement of the oral proceedings.

#### 4.5. Location of oral proceedings

In **T 1012/03** the applicant, having been summoned to oral proceedings before the examining division in The Hague, had requested that oral proceedings take place in Munich instead. The board noted that Art. 116 EPC 1973 did not expressly stipulate the

location where oral proceedings had to take place. The board examined whether the President had the power to establish examining divisions in The Hague and concluded that such a power was provided for by Art. 10(1), (2)(a) and (b) EPC 1973. The board concluded that in the case in point the justification for conducting oral proceedings in The Hague could be deduced from Art. 116 EPC 1973 in conjunction with Art. 10(1), (2) (a) and (b) EPC 1973 (see also **T 689/05**).

The examining division's rejection of the applicant's request that the oral proceedings be held in Munich instead of The Hague must be reasoned, R. 111(2) EPC, R. 68(2) EPC 1973 (see **T 689/05** and **T 933/10**).

In **T 1142/12** the board considered that the practical aspects of the organisation of oral proceedings were matters of EPO management, which came under the power of the President of the EPO as provided by Art. 10(2) EPC. The board held that the examining divisions were clearly not allowed to take a decision on this matter (**T 1012/03**). When not acceding to a request to hold oral proceedings in Munich instead of The Hague, the examining division did not take a decision but only expressed the way the EPO was managed. Consequently, that issue was not subject to appeal, nor could the board refer a question on the venue of oral proceedings to the Enlarged Board of Appeal.

In **R 13/14** the Enlarged Board clarified that the wording used in **T 1142/12** should not be understood to mean that the board had refused to decide on the issue; rather, the board had implicitly decided on the request and refused it.

#### **4.6. Oral proceedings conducted by video conference**

In **T 1266/07** (ex parte) the appellant (applicant) requested that the oral proceedings before the board be conducted by video conference. The board refused the request as being filed late but stated that in future such a request might be allowed. For this to happen, however, it would be necessary for a general framework to exist. While video conferencing before an examining division is explicitly regulated, there is no corresponding provision for the boards of appeal; in particular, it is not mentioned in the RPBA. In addition, oral proceedings held before the examining division are, in accordance with Art. 116(3) EPC, not public, whereas those before the boards of appeal are public, Art. 116(4) EPC. It would be necessary to ensure that the use of video conferencing is reconciled with the requirement that oral proceedings before the boards be public. See also **T 37/08**, **T 663/10**, **T 1427/10**, **T 2425/10**, **T 1930/12**, **T 1942/12**.

The examining division's rejection of the applicant's request to hold oral proceedings by video conference must be reasoned, R. 111(2) EPC (**T 677/08**).

In **T 2068/14** the board held that it had a discretion regarding the organisation of oral proceedings, including, in principle, holding them by video conference. This discretion was exercised according to the circumstances in any given case, including, in particular, whether the case at hand was ex parte or inter partes. A further important issue was the availability, in principle and in a specific case, of suitable rooms for oral proceedings before the board by video conference. This would typically require that provision also be

made for the public (see **T 1266/07**). While a video conference did not allow such direct communication as the face-to-face meeting involved in conventional oral proceedings, it nevertheless contained the essence of oral proceedings, namely that the board and the parties/representatives could communicate with each other simultaneously. Thus each party's case could be presented to the board in real time, and the board could put questions to the parties/representatives. The onus was on the appellant to persuade the board that conventional oral proceedings were not appropriate to properly present the appellant's case and that the board should exercise its discretion to, exceptionally, explore the possibility of holding oral proceedings by video conference. In the case at issue, the board rejected the request.

#### **4.7. Computer-generated presentations and other visual aids**

In **T 1122/01** the board explained that a PowerPoint presentation was essentially a written presentation of information, thus enabling a party to present written arguments in addition to its oral statements. It could also be a way of introducing new means of evidence, or it could lead to a completely new and unexpected presentation of the case by a party. There was therefore a risk of the other parties being caught unawares by this, of new procedural issues being raised, and of the oral proceedings becoming protracted. The board explained that the principles relating to the use of visual aids such as flip charts should also be applied to PowerPoint presentations. A party wishing to use such a presentation should announce this intention early enough before the oral proceedings and should send both the board and the other parties a copy. Any objections could then be raised and considered at the oral proceedings before the presentation was given, and a decision could be made if need be.

In **T 1110/03** (OJ 2005, 302) one of the opponents had been permitted to argue his case at oral proceedings before the opposition division by means of an hour-long computer-generated slideshow presentation containing many complex slides. The board concurred with the view expressed in decision **T 1122/01** that there was a danger of a degree of unfairness creeping in in the unrestricted use of computer-generated slideshow presentations in oral proceedings. This potential unfairness could be mitigated by providing the other parties and the division or board with copies of the material to be presented in good time before the oral proceedings.

In **T 555/06** the board held that a computer-generated slideshow presentation was, in principle, not distinguishable from other presentations using more conventional technology such as flip-charts or overhead projectors. The practice mentioned in **T 1110/03** placed certain restrictions on the timing of a party's preparation for oral proceedings but had no influence on the content. In the case at issue the opponent's representative had informed the opposition division prior to the oral proceedings that the computer-generated slideshow presentations would contain only information which was already in the file and therefore would act only as a visual aid. Nevertheless, the opponent failed to respect the opposition division's instruction to file a copy of the content in advance. In the light of the concerns raised in **T 1110/03**, the division's action in refusing the presentation was both entirely understandable and reasonable.

In **T 373/05**, a few days prior to oral proceedings before the board the appellant (proprietor) asked for a screen for showing PowerPoint slides at the hearing, without however saying what the slides were about. At the start of the oral proceedings, it distributed paper versions of the slides, setting out arguments about the admissibility of the respondent's opposition and regarding sufficiency of disclosure. The board took the view that since they contained no new facts, their late submission was no reason to disregard them under Art. 114(2) EPC 1973. On the contrary, it felt that presenting the appellant's arguments visually on paper had also helped the respondents to prepare their responses.

In the board's view in **T 1556/06**, the opposition division has discretion as to the way oral proceedings were conducted. It was not a wrongful exercise of this discretion, and thus not a procedural violation, to refuse to allow a party to use a PowerPoint presentation during oral proceedings if the party was not thereby prevented from presenting its arguments orally.

In **T 608/08** the appellant had complained that the opposition division had not allowed its request for a daylight projector to be provided. The board found that Art. 116 EPC, which enshrines in specific terms the general right to be heard laid down in Art. 113(1) EPC, confers only a right to make oral statements, but not to the use of technical aids such as a daylight projector. Since the appellant was able to make oral statements at the oral proceedings, the failure to provide a daylight projector was not in breach of its entitlement to oral proceedings or its right to be heard.

#### **4.8. Sound recording**

In **R 17/09** the Enlarged Board held that to allow or refuse a recording of the oral proceedings was a matter of discretion for the board concerned, and refusal to allow recording could not be treated as a procedural violation.

In **T 1938/09** the board did not consider the case at issue to involve such exceptional circumstances that a sound recording of the proceedings would have been justified. Even if such a sound recording were made, there would have been no legal basis for making it available to the parties.

#### **4.9. Minutes of oral proceedings (Rule 124 EPC)**

According to R. 124 EPC, minutes of oral proceedings and of the taking of evidence shall be drawn up, containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection.

##### **4.9.1 Content of minutes**

In **T 642/97** the board stated that according to R. 76 EPC 1973 (R. 124 EPC) the minutes should contain "the essentials of the oral proceedings ... and the relevant statements by the parties...". It stressed that this provision did not require that the

minutes reflect the full arguments of the parties. It was within the discretion of the minute-writer to decide what he considered "essential" or "relevant" (see **T 212/97**; see also **T 468/99**: the board was responsible for deciding upon what was necessary to be recorded in the minutes). Whereas minutes were required to contain the requests or similarly important procedural statements, most of the arguments concerning patentability were normally apparent from the previous written submissions or from the facts and submissions in the written decision and did not need to be contained in the minutes.

In **T 263/05** (OJ 2008, 329) the board held that the minutes of oral proceedings **before the boards of appeal** should record the requests of the parties on which a decision of the board is required, such as the allowability or otherwise of the appeal, the form in which the proprietor seeks maintenance of the patent, requests for remittal of the case or relating to appeal fees or costs. The minutes should also record specific statements which have an impact on the definition of the subject-matter, such as statements of surrender or abandonment of subject-matter, where these are relevant to the decision to be taken (see also **T 212/97**, **T 928/98**, **T 550/04**, **T 71/06**). The arguments of the parties concerning patentability should not be recorded. They will be apparent from the facts and submissions set out in the written decision.

In **T 240/09** the board held that, as far as the parties' requests were concerned, only the final requests to be stated by the chairman before declaring the debate closed (Art. 15(5) RPBA) were essential for the oral proceedings **on appeal**. Requests which had been withdrawn were usually irrelevant for the board's decision, and therefore not "essential".

In **T 396/89** there was disagreement between the parties as to whether the appellant had or had not made a **concession** on a particular point before the opposition division. There was no record of this in the minutes of the proceedings. The board held that if an important matter of fact was conceded, that concession ought to be carefully recorded in the minutes.

In **R 14/09** the Enlarged Board of Appeal held that an **objection under R. 106 EPC** must be recorded in the minutes since it was a relevant statement of a party (see **R 17/10**; see also **R 2/12** "at least at a party's request"). See Chapter IV.F.3.5.4 "Minutes as evidence that the objection was raised".

In **T 231/99** the board held that an essential function of the minutes was to record for the appellate body the essentials of the oral proceedings at the previous instance.

In **T 468/99** the board regarded as not essential a party's statement which concerned the **interpretation of a document**, which had not been admitted into the appeal proceedings.

In **T 957/99** the board observed that the admission of the appellant was in respect of a version of the patent in suit which **no longer corresponded to the actual request** for which it had become superfluous in view of the amendments made, and therefore could not constitute a relevant statement in the sense of Rule 76(1) EPC 1973.



In **T 397/03** the board held that the **text of requests** filed by a party at oral proceedings before the opposition division was an essential element that should be contained in the minutes.

In **T 281/03** (17 May 2006) the board held that, in order to guarantee the right to be heard, there should have been an explicit step, recorded in the minutes of the **opposition division**, giving the opponent an opportunity to **comment on inventive step** before the final deliberation, or alternatively an opportunity after the deliberation to comment on the opposition division's conclusion that such an objection was not prima facie apparent. The fact that before the final deliberation "the floor was given to the opponent again" or that the opponent made a "last submission", reported in the minutes, was not enough to meet this requirement.

In **T 1359/04** the board observed that the **examining division's introduction of new documents** only at the oral proceedings was an unusual step, and that the utmost care therefore had to be taken to safeguard the applicant's right to be heard. Thus the proceedings should normally be interrupted for as long as appropriate to give the affected party sufficient opportunity to study the new evidence and reconsider how to present his case. The very function of the minutes in such cases was to show – and hence to document – that the proper procedural steps had been duly taken.

In **T 1798/08** the board held that it was not the function of the minutes to record statements which a party considers to be possibly relevant, such as the statement made by the representative of the appellant opponent relating to the board's **alleged denial of the legal right to be heard**. This statement did not relate to the surrender or abandonment of subject-matter and did not otherwise have any impact on the definition of the subject-matter to be dealt with by board. It did not form part of the essentials of the oral proceedings and was not relevant for the present decision, either.

In **T 1735/08** (27 September 2012) the board held that those board findings whose outcome was recorded in the minutes of the oral proceedings and for which reasons were to be provided later on were to be considered relevant. By contrast, there was no need under R. 124(1) EPC, nor was it usual practice in proceedings before the EPO boards of appeal, to record in the minutes that the board had expressed a **provisional opinion on patentability** before announcing its decision. Where it was decided to set aside the contested decision and remit the case to the department of first instance for further prosecution, the set of claims on which that department was to base its fresh decision and the reasons why, in the board's opinion, that set of claims met some of the patentability requirements were not set out in the order or anywhere else in the minutes, but rather in the reasons for the decision. This was in line with the requirement that the order be concise.

According to **T 317/09** the relevance required under R. 124 EPC related to the decision to be taken by the board. The appellant's **statement describing how it understood certain features of the invention** neither affected the course of the proceedings, nor was it, as the appellant's subjective assessment, relevant for the decision to be taken by the board.

In **T 2405/10** the appellant's request to include a statement regarding the problem-solution approach was made **after the proceedings had been closed**. As this statement was not part of the oral proceedings, there was no reason to include it in the minutes, and the request was therefore refused

#### 4.9.2 No recording of statements for use in subsequent national proceedings

According to **T 928/98**, **T 263/05** (OJ 2008, 329), **T 550/04**, **T 71/06**, **T 61/07**, and **T 916/09** it is not the function of the minutes to record statements which a party considers will be of use to it in any subsequent proceedings in national courts, for example in infringement proceedings as to the extent of protection conferred by the patent in suit. This is because such statements are not "relevant" to the decision which the board has to take, within the meaning of R. 124(1) EPC. Such matters are within the exclusive jurisdiction of the national courts. On this basis the board in **T 550/04** concerning the opponent's request to record in the minutes that the expression "oxygen-free atmosphere" in claim 1 had the meaning of "completely oxygen-free atmosphere" stated that this statement would not have an impact on the definition of the subject-matter of the patent for the questions the board had to decide and was thus not proper subject-matter for the minutes. The board therefore refused the request. Concerning requests for incorporation of statements of parties in the minutes, see also **T 966/99**, **T 468/99**, **T 957/99**, **T 459/01**, **T 364/08**, **T 2009/08**, **T 1824/09**.

#### 4.9.3 Correction of minutes

If a party was of the opinion that the minutes were incomplete or wrong, since essential submissions were not reflected at all in the file, it might request the opposition division to correct the minutes to preserve its rights (**T 642/97**; **T 231/99**; **T 898/99**; **T 838/92**; **T 68/02**). The same is true in proceedings before the examining division (**T 937/07**; see also **T 2434/09**).

In **T 690/09** the appellant had not questioned the correctness of the minutes; the board held that the correctness of the minutes was therefore not formally in doubt and it had to consider the minutes as correctly reflecting the course of the oral proceedings (with reference to **R 11/08**).

In **T 1005/08** the board held that, according to the consistent jurisprudence of the boards of appeal, it was in principle the department before which oral proceedings had been held (in the case at issue the opposition division) which was competent to correct its minutes of the oral proceedings.

In **T 4/00** the board held that the decisions on the correction could not be taken by the formalities officer as that would be contrary to the requirements of R. 76(3) EPC 1973 (R. 124(3) EPC), from which it was clear that only members of the opposition division, i.e. members who have been present at the oral proceedings, bore responsibility for the minutes.

In **T 162/09** the board held that the parties and their representatives could be expected to check the minutes carefully, especially to ensure that nothing was missing, immediately on receipt and to point out any deficiency promptly, since the minutes were the only means of ascertaining what had occurred during the oral proceedings at first instance. If no request for correction had been made, the board had to assume that the minutes accurately reflected the course of the proceedings (see **R 11/08**, **R 6/14**).

In **T 231/99** it was held that the board's responsibility for the decision on the validity of the patent did not extend to deciding on the accuracy of the minutes of first instance proceedings (see also **T 1198/97**). In **T 508/08** the board stated that if the department of first instance (opposition division) saw fit to ignore its obligations (to respond to a request for correction of the minutes) there was nothing the board could do; it had no power to compel the division to fulfil them. In **T 212/97** the board explained that only decisions could be contested. Since the minutes of oral proceedings were neither a decision nor part of the decision, they could not be "annulled" by the board of appeal (as already established in **T 838/92**). A procedural violation could only be said to have occurred if the limits of the minute-writer's discretion as to what he considered "essential" or "relevant" were overstepped, e.g. if a party's unambiguous statement of surrender were omitted from the minutes.

In **T 1063/02** the board held that it could not order the amendment of the opposition division's minutes of oral proceedings unless they manifestly and definitely differed from the actual course of the proceedings.

In **T 740/00** the appellant informed the opposition division of its opinion that the minutes did not reflect the actual conduct of the proceedings. Instead of examining whether the minutes actually fulfilled the requirements of R. 76(1) EPC 1973 and then deciding whether or not to correct them, the opposition division argued in essence that the minutes were correct because the minutes said so. The board considered such a reasoning circular and thus as not fulfilling the requirements of R. 68(2) EPC 1973, which required decisions of the EPO to be reasoned. This constituted a procedural violation (see also **T 819/96**).

In **T 1721/07** the board refused the appellants' request that a summary they had drawn up of the parties' various arguments and the board's conclusions be added to the minutes of the oral proceedings. It observed that preparation of the minutes of oral proceedings was a task entrusted to the boards. This task could not be transferred or delegated, in whole or in part, to the parties, let alone just one of them (see also **T 433/11**). It also observed that no single party could be permitted to decide on or influence the content of the minutes.

#### 4.9.4 Signing of minutes

According to R. 124(3) EPC, the minutes shall be authenticated by the employee responsible for drawing them up and by the employee who conducted the oral proceedings or taking of evidence, either by signature or by any other appropriate means.

In **T 2076/11** the minutes were signed by a director rather than by the chairman who had presided over the oral proceedings. This was a procedural error.

#### 4.9.5 Refusal to record statement not an infringement of the right to be heard

According to **T 1055/05** the refusal of the division to record statements made by a party at the oral proceedings could not constitute an infringement of the right to be heard.

### 4.10. Speaking time during oral proceedings

In **T 601/05** (decision of 2 December 2009) the only substantive issue to be dealt with at the oral proceedings was Art. 83 EPC. In the evening of the second day of the oral proceedings, the board had limited the speaking time to ten minutes for each party for a "final round" of discussion with respect to a particular argument. In its decision the board held that the limitation of time was a necessary procedural measure by which the right to be heard pursuant to Art. 113(1) and 116 EPC had not been violated. On the one hand, it was the attorneys' responsibility to structure their pleadings in such a way that the time frame of the oral proceedings, which had been communicated to the parties with the summons and had not been objected by them, can be complied with. On the other hand, it was the board's responsibility to conduct oral proceedings in such a way that the time frame was kept to and to ensure that the case was ready for decision at the end of the oral proceedings. It followed from Art. 15(4) and 15(6) RPBA that the structuring of the oral proceedings was within the discretion of the board. The time to speak had been limited in the context of an issue that had already been presented in detail in the written submissions. Each party had altogether around forty minutes to plead on this issue. The board considered this amount of time sufficient for a skilled attorney to properly present her or his arguments, even if they might be complex.

### 4.11. Interpreting in oral proceedings

As to the issue of interpreting costs during oral proceedings, see in this chapter III.C.5.2; for the application of R. 4 EPC see Chapter III.F.4 "Derogations from the language of proceedings in written proceedings and in oral proceedings".

### 4.12. Oral submissions by an accompanying person

Reference is made to Chapter III.R.5, "Oral submissions by an accompanying person".

### 4.13. Excluding the public from oral proceedings

In **T 1401/05** (20 September 2006) the board excluded the public from that part of the oral proceedings which concerned the exclusion of certain documents from file inspection. Under Art. 116(4) EPC, oral proceedings shall in principle be public in so far as the board does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings. The board held that as the debate dealt with the request for exclusion of certain documents from file inspection, which had been excluded provisionally, the public could

not be admitted to the hearing on this point. Otherwise the purpose of the provisional exclusion would have been frustrated. In such a situation, the danger of serious and unjustified disadvantages had to be deemed to exist.

#### **4.14. Presence of assistants during deliberations of the board**

According to Art. 19(1), second sentence, RPBA only members of the board may participate in the deliberations; the chairman may, however, authorise other officers to attend. In **T 857/06** the board stated that in several EPC contracting states the judicial work of courts, in particular supreme courts and constitutional courts, is supported by assistants. Also the active involvement of assistants in preparing the ground for judicial decisions appeared to be widely accepted. In accordance with this practice, a limited number of assistants supports the EPO's boards of appeal. They are selected in a formal internal recruitment procedure for which only experienced examiners, i.e. permanent employees of the EPO, may apply. The board concluded that the discretion under Art. 19(1), second sentence, RPBA may be exercised to allow the board's assistant to attend and to take part in the deliberations.

#### **4.15. Handwritten amendments during oral proceedings before the board**

In **T 1635/10** the board took note of the notice from the EPO of 8 November 2013 (OJ 2013, 603) regarding the practice on handwritten amendments to patent documents. From the accompanying information on the EPO website it was clear that this applied as from 1 January 2014 to first instance proceedings. This practice is that handwritten amendments can be filed during oral proceedings, but for finalising the decision they should be filed there and then in typed printed form of the patent documents, or that a time limit should be set to file the amendments in such form. Both procedures require a check by the competent department that nothing more has been amended than what was allowed and giving the other party/parties the possibility to check and comment, before a decision can be issued. In the case at issue, the documents as proposed for the maintenance of the patent according to auxiliary request 3 contained handwritten amendments, carried out at the oral proceedings before the board. For the board to do what was required by the above notice would, in the present case, be detrimental to the principles of due process and procedural economy. The board therefore found that the documents as presented at the oral proceedings, for which the above checks could easily be performed and on which the appellant had had the opportunity to comment, were sufficient to base its (final) decision on. Since the department of first instance in any case would have to perform further formal steps before it actually maintained the patent in accordance with the board's order, it could apply its new practice to the present documents. See also **T 37/12**.

### **5. Costs**

#### **5.1. Apportionment of costs**

A different apportionment of costs may be ordered in accordance with Art. 104 EPC and Art. 16 RPBA (Art. 11a RPBA 2003), if a party, for example, withdraws a request for oral

proceedings, asks for their postponement, or fails to attend them (see Chapter IV.C.6.2.2 "Acts or omissions prejudicing the timely and efficient conduct of oral proceedings").

## **5.2. Interpreting costs during oral proceedings**

Under R. 4(1) EPC (R. 2(1) EPC 1973), "any party to oral proceedings before the EPO may use an official language of the EPO other than the language of the proceedings, if such party gives notice to the EPO at least one month before the date of such oral proceedings or provides for interpretation into the language of the proceedings" (see also Communication dated 16 July 2007, OJ SE 3/2007, 118).

In **T 473/92** the respondents asked the EPO, three days before the oral proceedings, to arrange for and bear the cost of interpreting services. According to the respondents, the period of one month stipulated in R. 2(1) EPC 1973 had not been observed because the EPO had failed to draw their attention to the period of notice mentioned in R. 2(1) EPC 1973. The board, however, decided that the respondents had to bear the costs of interpreting at the oral proceedings. If the parties were being offered a free interpreting service, the EPO should at least be enabled to minimise its costs by having sufficient time to organise the interpreting efficiently. Nor was the EPO under any obligation to draw the respondents' attention to the notice period of one month.

In **T 44/92** the board came to the conclusion that if a patent proprietor with several appointed representatives chose to use another official language for the oral proceedings in addition to the language of proceedings, the EPO would not bear the costs of interpreting (R. 2(1) and (5) EPC 1973) (see also **T 131/07**).

**D. Time limits, further processing and interruption of proceedings**

1.	Calculation, determination and extension of time limits	591
1.1.	Calculation of time limits under Rule 131 EPC	591
1.2.	Determination and extension of periods under Rule 132 EPC	592
1.2.1	Relevant criteria when time limits are extended upon request (R. 132(2), second sentence, EPC)	592
1.2.2	Applicability of Rule 132 EPC to the Rules relating to Fees	593
1.3.	Extension of time limits ipso jure on account of public holidays or dislocation in delivery of mail (Rule 134 EPC)	593
1.3.1	Public holidays (Rule 134(1) EPC)	593
1.3.2	General dislocation or interruption in delivery or transmission of mail in a Contracting State (R. 134(2) EPC)	593
1.3.3	Dislocation of a mail service outside the contracting states (Rule 134(5) EPC)	594
1.4.	Statutory periods of grace and the fiction of observance of a time limit for fee payments	595
1.4.1	Additional period for renewal fees under Rule 51(2) EPC	595
1.4.2	Period of grace for payment of fees under Rule 85a EPC 1973	595
1.4.3	Fiction of fee payment in due time pursuant to Article 7(3) and (4) RFees	595
2.	Further processing under Article 121 EPC	595
3.	Interruption of proceedings under Rule 142 EPC	596
3.1.	Application of Rule 142 EPC by the EPO of its own motion	596
3.2.	Concept of legal incapacity (Rule 142(1)(a) and (c) EPC)	596
3.3.	Determining legal incapacity of the applicant or patent proprietor for the purpose of Rule 142(1)(a) EPC	597
3.4.	Determining legal incapacity of the representative for the purpose of Rule 142(1)(c) EPC	597
3.5.	Legal incapacity of a representative from outside the contracting states	598
3.6.	Interruption of proceedings because of insolvency (Rule 142(1)(b) EPC)	599
3.7.	Consequences of interruption of proceedings (Rule 142(4) EPC)	600

**1. Calculation, determination and extension of time limits**

Time limits in the EPC have two conceptual elements: firstly, a period of time determined in years, months or days, and secondly, a relevant date, which serves as the starting date of the time limit, and from which the period of time is counted (**J 18/04**, OJ 2006, 560). The term "deadline" is broader than the terms "time limit" and "period" as it encompasses any last date for validly performing an action and says nothing about the nature of the underlying time restriction (**J 10/12**).

**1.1. Calculation of time limits under Rule 131 EPC**

In **J 14/86** (OJ 1988, 85) the Legal Board of Appeal held that the fact that R. 83(2) EPC 1973 (R. 131(2) EPC) fixed the point in time from which all the time limits

ran and defined this point as the day following that on which the event giving rise to the time limit occurred, could not be interpreted as requiring the addition of a day to time limits expressed in years, months and weeks, hence the grant of an additional day for reasons of equity. The expiry date of time limits expressed in years, months or weeks was derived from R. 83(3) to (5) EPC 1973. These paragraphs, in conjunction with paragraph 2 of the same rule, established unequivocally that the time limits were fixed in full years, months and weeks, without any possibility of their being reduced or extended (see also **J 9/82**, OJ 1983, 57).

In **J 13/88** the Legal Board of Appeal demonstrated how to calculate the 12-month priority period referred to in Art. 87 EPC. 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 expired in the relevant subsequent month on the day which had the same number as the day on which the said event occurred, which was 5.5.1987 (R. 83(2) EPC 1973 in combination with R. 83(4) EPC 1973).

**T 2056/08** concerns the calculation of the period for filing an appeal when combined with a ten-day period for postal delivery. The board noted that the two-month period stipulated in Art. 108 EPC started from the day of the presumed or actual notification. If any rule of thumb could be suggested to calculate the appeal period, it should be "ten days plus two months" rather than "two months plus ten days."

**R 18/10** concerned the calculation of the two-month time limit under Art. 112a(4) EPC. The relevant decision had been posted on 31 August 2010 and the actual notification occurred on 6 September 2010. According to R. 131(2) EPC, where a procedural step is a notification, the relevant event shall be the receipt of the document notified, unless otherwise provided. According to R. 126(2) EPC, in cases where notification is effected by registered letter such a letter is deemed to be delivered to the addressee on the tenth day following its posting. Therefore, regardless of the fact that actual notification occurred on 6 September 2010 the time limit ended pursuant to R. 126(2) EPC on 10 November 2010.

For events which trigger the start of a time limit in connection with re-establishment of rights, see below Chapter III.E.4.1.1 "Two-month time limit from the removal of the cause of non-compliance"; for "notification" as an event which triggers the start of a time limit, see Chapter III.O.; for the relevant event for calculating the time limit under Art. 78(2) EPC 1973 (R. 38 EPC), see **J 13/04**.

## **1.2. Determination and extension of periods under Rule 132 EPC**

1.2.1 Relevant criteria when time limits are extended upon request (R. 132(2), second sentence, EPC)

According to R. 132(2), second sentence, EPC (R. 84, second sentence, EPC 1973), in special cases, a certain period may be extended upon request. This provision gives discretionary power to departments of the EPO to decide on the request (**T 954/98** of



9.12.1999, **J 12/07**, **J 29/10**). The Guidelines set out examples of special cases, see Guidelines E-VII, 1.6 - November 2015 version. Only a narrow definition of acceptable grounds for further extensions of time limits beyond a total period of six months is justified (**J 12/07**, **J 29/10**, see also **T 79/99**).

In **T 79/99** the board held that when considering requests for additional time, it would take into account not only any reasons put forward but also the number of previous extensions (if any), the views of the other party or parties (if known), the effect of delays on other appeals pending before it and the general principle that all delays are to be avoided where possible.

The application of Art. 120 EPC 1973 and R. 84 EPC 1973 to cases where the time limits had expired before the entry into force of EPC 2000 is considered in **J 12/07**.

### 1.2.2 Applicability of Rule 132 EPC to the Rules relating to Fees

In case **J 7/07** the Receiving Section had given the appellant a period of one month to submit evidence and pay the surcharge under Art. 8(4) RFees (now Art. 7(4) RFees). The appellant argued that this one-month time limit was too short and amounted to a substantial procedural violation as it was not in compliance with R. 84 EPC 1973. Though R. 84 EPC 1973 referred only to the Convention and the Implementing Regulations, the board concluded that R. 84 EPC 1973 applied to the time limit in the then Art. 8(4) RFees.

## **1.3. Extension of time limits ipso jure on account of public holidays or dislocation in delivery of mail (Rule 134 EPC)**

### 1.3.1 Public holidays (Rule 134(1) EPC)

According to R. 134(1) EPC, if a period expires on a day on which one of the filing offices of the EPO is not open for receipt of documents or on which mail is not delivered there, the period shall extend to the first day thereafter on which all the filing offices are open for receipt of documents and on which mail is delivered. This also applies to periods concerning payments (**J 1/81**).

### 1.3.2 General dislocation or interruption in delivery or transmission of mail in a Contracting State (R. 134(2) EPC)

R. 134(2) EPC provides for a time limit to be extended if it expires on a day on which there is a general dislocation in the delivery or transmission of mail in a contracting state or between a contracting state and the EPO. The duration of the period of dislocation shall be as stated by the European Patent Office. The term "general interruption" was deleted in the process of revising R. 85(2) EPC 1973. However, as evidenced by the preparatory documents, the retained term "dislocation" also refers to interruptions (CA/PL 17/06, p. 356). Decisions which interpret the term "general interruption" are still cited in the following as an aid to interpreting the "general dislocation" referred to in R. 134(2) EPC.

In **J 4/87** (OJ 1988, 172) the board reaffirmed that in the event of an unforeseeable postal delay causing non-compliance with a time limit, the EPO had no discretion to extend the time limit other than in the cases referred to in R. 85(2) EPC 1973.

In **J 11/88** (OJ 1989, 433) the board held that any time limit under the EPC 1973 which expired within the period of interruption or dislocation was extended **by operation of law**. Accordingly, if the President of the EPO did not issue a statement as to the duration of that period, because he did not have the relevant information at the right time, this could not affect the rights of a person adversely affected by the interruption or dislocation. Whether or not an interruption qualified as a "general interruption" was a question of fact, which had to be decided in the light of any credible information available; in case of doubt, the EPO should make official enquiries of its own motion in application of Art. 114(1) EPC 1973.

In **J 3/90** (OJ 1991, 550) the Legal Board of Appeal interpreted the concept of a **general** interruption, explaining that R. 85(2) EPC 1973 was not restricted to nationwide interruptions. In the case at issue, the board decided that the limited geographical extent of the disruption did not disqualify the interruption from being general. Whether or not a representative had undertaken all possible measures to avoid the effects of a postal strike was not a relevant test under R. 85(2) EPC 1973.

In **J 1/93** the Legal Board of Appeal again stated that for an interruption in the delivery of mail under R. 85(2) EPC 1973 to be considered general in character **the public in general** residing in an area of some magnitude, even if of limited geographical extent, had to be affected. The loss of a single mailbag might affect a number of individual addressees but not the public in general.

In **J 14/03** the board confirmed that evidence of a disruption within the meaning of R. 85(2) EPC 1973 provided by the appellant can lead to a retrospective extension of time in a particular case, as occurred in **J 11/88**, if this evidence, had it been known at the time, would have been such as to warrant a Presidential statement under R. 85(2) EPC 1973. However, in contrast to the probative value of the evidence in **J 11/88**, in the case at issue the evidence was inconclusive.

### 1.3.3 Dislocation of a mail service outside the contracting states (Rule 134(5) EPC)

In **J 13/05** the board highlighted that R. 85(5) EPC 1973 was inserted into the EPO following the events of 11 September 2001 because the legal remedies available at that time were inadequate. It was decided not to extend R. 85(2) EPC 1973 to postal interruptions outside the contracting states, as only for those states could the EPO be sure of obtaining the information necessary to enable the President to announce a general interruption or dislocation. Therefore, unlike the preceding paragraphs, R. 85(5) EPC 1973 was drafted so as to place the **burden of proof** on the party asserting a general interruption or dislocation of the mail service. Like R. 85(2) EPC 1973, R. 85(5) EPC 1973 required that more than one person using the mail service be affected or theoretically capable of being affected by the interruption or

dislocation, even if a merely minor or geographically limited interruption might be sufficient.

#### **1.4. Statutory periods of grace and the fiction of observance of a time limit for fee payments**

##### 1.4.1 Additional period for renewal fees under Rule 51(2) EPC

The substance of Art. 86(2) EPC 1973 (late payment of renewal fee and payment of additional fee) is now contained in R. 51(2) EPC.

In decision **J 4/91** (OJ 1992, 402) the Legal Board of Appeal held that when calculating the six-month period for the payment of a renewal fee with additional fee under Art. 86(2) EPC 1973, R. 83(4) EPC 1973 should be applied *mutatis mutandis* in the light of R. 37(1), first sentence, EPC 1973. This meant that the six-month period did not end on the day of the subsequent sixth month corresponding "in number" to the due date according to R. 37(1), first sentence, EPC 1973 but on the day which was equivalent to this due date by virtue of its being the "last day of the month". For the purposes of calculating the additional period under Art. 86(2) EPC 1973, therefore, R. 83(4) EPC 1973, in the context of R. 37(1), first sentence, EPC 1973, resulted in a period running "from the last day of the month to the last day of the month".

The additional period started on the last day of the month specified in R. 37(1), first sentence, EPC 1973 even in the circumstances mentioned in R. 85(1), (2) and (4) EPC 1973. It followed that the occurrence of such circumstances at the beginning of the period did not result in the end of the period being postponed beyond the end of the sixth month and into the seventh month.

##### 1.4.2 Period of grace for payment of fees under Rule 85a EPC 1973

In the context of the EPC revision exercise (EPC 2000), R. 85a and 85b EPC 1973 were deleted to take account of the extended application of further processing under Art. 121 EPC (OJ SE 1/2003, 190). See "Case Law of the Boards of Appeal", 5th ed. 2006, VI.D.1.3.2, for a detailed, or "Case Law of the Boards of Appeal", 6th ed. 2010, VI.D.1.4.2, for a short, overview of the case law on this provision.

##### 1.4.3 Fiction of fee payment in due time pursuant to Article 7(3) and (4) RFees

Reference is made to Chapter III.Q.3.1.

## **2. Further processing under Article 121 EPC**

Under Art. 121(1) EPC, the applicant can apply for the further processing of his application if he fails to observe a time limit *vis-à-vis* the Office. However, Art. 121(4) and R. 135(2) EPC lay down exceptions to this general rule, especially with regard to the time limits for priority, remedies and the request for further processing and re-establishment of rights, and with regard to the non-observance of certain time limits for

which a special remedy provision exists in the Implementing Regulations (e.g. R. 58 and 59 EPC). Hence, in contrast to the provisions under the EPC 1973, further processing can be applied to the time limits for the payment of filing, search and designation fees, the national basic fees and the examination fees, and to the time limit for filing the request for examination (OJ SE 4/2007; MR/2/00, 157). The request is made simply by payment of the prescribed fee (OJ SE 5/2007).

In **J 37/89** (OJ 1993, 201) the Legal Board of Appeal pointed out that the applicants could overcome a loss of rights under Art. 96(3) EPC 1973 (which corresponds to Art. 94(4) EPC) resulting from the **refusal of a request for a time-limit extension** by requesting further processing in accordance with Art. 121 EPC 1973. At the same time, they could request reimbursement of the fee for further processing. This secondary request had to be decided on in connection with the final decision. Under Art. 106(3) EPC 1973 (Art. 106(2) EPC), 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 (see also **J 29/10**).

In **J 47/92** (OJ 1995, 180) the Legal Board of Appeal stated that further processing under Art. 121 EPC 1973 was available only in respect of those time limits the duration of which was to be determined or set by the EPO. This question has been overtaken by the new version of Art. 121 EPC which applies irrespective of whether the time limits are set by the EPO or are specified in the Convention or Implementing Regulations (MR/2/00, p. 157).

In **J 16/92** the Legal Board of Appeal held that where the omitted act within the meaning of Art. 121(2) EPC 1973 (R. 135(1) EPC) consisted in filing a reply in substance to a first communication. It was not completed by filing a request for an extension of time for submitting that reply, since a request for a time limit was not equivalent to the act the party in question had proposed performing within the time limit requested.

### **3. Interruption of proceedings under Rule 142 EPC**

#### **3.1. Application of Rule 142 EPC by the EPO of its own motion**

The EPO must apply the provisions of R. 142 EPC (R. 90 EPC 1973) of its own motion (**J ..87=J 902/87**, OJ 1988, 323; **J 23/88**, **T 315/87**). The consequence of an interruption in the proceedings is that the time limits in force as regards the applicant or patentee at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings were resumed (see R. 142(4) EPC). However, the time limit for making the request for examination and the time limit for paying renewal fees are only suspended (see in this chapter III.D.3.7 "Consequences of interruption of proceedings (R. 142(4) EPC)").

#### **3.2. Concept of legal incapacity (Rule 142(1)(a) and (c) EPC)**

The EPC does not define the concept of "legal incapacity", which is assessed differently according to whether the person concerned is the applicant or patentee or a professional

representative: In **J xx/xx** (=J 900/85, OJ 1985, 159) and **J ../87** (=J 903/87, OJ 1988, 177) the Legal Board held that the capacity of the **applicant or patent proprietor** to carry out legal transactions relating to his application or patent must be determined in accordance with the relevant **national law** because the interest in the patent application or the patent is an interest in property (see Art. 74 and Art. 2(2) EPC; see also **J 49/92**). On the other hand, **J xx/xx** (=J 900/85, OJ 1985, 159) states that a **uniform standard** of judging legal incapacity of **representatives** shall apply in order to avoid differences in the application of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) depending on the nationality of domicile of the representative.

### **3.3. Determining legal incapacity of the applicant or patent proprietor for the purpose of Rule 142(1)(a) EPC**

In **J ../87** (=J 903/87, OJ 1988, 177) the board ruled that a brief medical certificate attesting that the applicant had been in a state of physical and mental exhaustion and depression, was not sufficient to establish incapacity within the meaning of R. 90(1)(a) EPC 1973 since the certificate said nothing about the seriousness and duration of this condition.

In **J 49/92** the Legal Board of Appeal had no evidence - such as a medical certificate - to suggest that the applicant's condition had been such, according to German legal practice, as to exclude his exercising his will rationally, since he had still managed to transfer the fees for the application, even if they had been sent by mistake to the German Patent Office instead of the EPO.

### **3.4. Determining legal incapacity of the representative for the purpose of Rule 142(1)(c) EPC**

The basic consideration for a decision on R. 142(1)(c) EPC is whether the representative concerned was either in a fit mental state to do the work required of him at the material time or whether he lacked the capacity to make rational decisions and to take the necessary actions, see **J xx/xx** (=J 900/85, OJ 1985, 159), **J 7/99**. In **J 5/99** the board stated that that meant carefully weighing up all reliable relevant information. Also indispensable was a reliable medical opinion taking account of all material facts.

In **J xx/xx** (=J 900/85, OJ 1985, 159) the board noted that, although there were differences in the national laws of contracting states as to the concept of "legal incapacity" and as to its consequences, there seemed to be a broad agreement that a person of full age was legally incapacitated when he was suffering from such a disturbance of his mind that he was unable to form the necessary voluntary intention to carry out legal transactions which would be binding upon him, e.g. to make valid contracts. Such a disturbance of his mind could be recognised by national law even if it was temporary only (e.g. a disturbance caused by physical injury or by the influence of alcohol or other drugs) or occurred from time to time, as was the case with some mental illnesses in which the patient had lucid intervals. Disturbance of the mind causing legal incapacity was always recognised by law if it was of long duration, a fortiori if it was permanent and irreversible. Since there was a unified European profession of

representatives before the EPO, there should be a uniform standard of judging legal incapacity, in order to avoid differences in the application of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) depending on the nationality or domicile of the representative. The question of determining the legal incapacity of a representative for the purposes of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) was one for the EPO, applying its own standards, developed in the light of experience and taking into consideration principles applied in the national laws of the contracting states (see also **J 5/99**, **J 7/99**).

The legal incapacity had to be of a persistent nature (**J ../86 = J 901/86**, OJ 1987, 528). For the purposes of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC), the EPO must establish whether and if so when the representative was legally incapacitated, and in the light of its findings specify the time limits which might have been interrupted (**J ../87 = J 902/87**, OJ 1988, 323).

In **J 7/99** the board held that legal incapacity pursuant to R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) meant a mental state in which the representative was so totally or nearly totally unable to take rational decisions that all his professional duties, and not just one isolated case, were affected by his mental state. In the case at issue, legal incapacity was not established (see also **J 2/98**).

In **T 315/87** of 14.2.1989 the board accepted that the previous representative had been suffering from physical and mental disorders. Indeed, the medical documents submitted by the previous representative himself pointed to a psychosomatic condition.

### **3.5. Legal incapacity of a representative from outside the contracting states**

In **J 23/88** the Legal Board accepted the finding of the Receiving Section that an American patent attorney was not covered by R. 90(1)(a) EPC 1973 (R. 142(1)(a) EPC), being neither the applicant nor the proprietor of a European patent, nor a person authorised by national law to act on his behalf. The relevant category in that Rule (persons authorised by national law) covered legal representatives of the applicant (patent proprietor) but did not extend to a patent attorney authorised under the laws of a non-Contracting State, whose legal incapacity was, therefore, irrelevant to the operation of the above Rule.

The board however, acting on its own motion, came to the conclusion that the US patent attorney in the case at issue was, at the relevant time, a legally incapacitated representative of the applicant within the meaning of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC). This interpretation was fully consonant with the preparatory documents regarding the desirability of equal treatment of applicants from contracting and non-contracting states. The board found that the difference in the wording of R. 90(1)(c) EPC 1973 (R. 142(1)(c) EPC) from that of R. 90(1)(a) EPC 1973 (R. 142(1)(a) EPC) was deliberately chosen so as to create equal treatment between applicants in the contracting and in non-contracting states. The board observed that Art. 133(2) EPC 1973 provided a limited exception to the normal requirement for professional representation within the meaning of Art. 134 EPC 1973 in the case, and only in the case, of the filing of the European patent application. Such a filing could

validly be made by the applicant himself or by any representative duly authorised by him. Thus, in effect, once the processing of the international application had properly started in the EPO, an American patent attorney would lose his entitlement to act under Art. 49 PCT by virtue of the combined effect of Art. 27(7) PCT, Art. 133(2) EPC 1973 and Art. 134 EPC 1973. Once he lost his representative capacity, any interruption in proceedings occasioned by his death or legal incapacity would no longer be covered by R. 90(1)(c) EPC 1973.

### **3.6. Interruption of proceedings because of insolvency (Rule 142(1)(b) EPC)**

According to R. 142(1)(b) EPC (R. 90(1)(b) EPC 1973) proceedings before the EPO shall be interrupted in the event of the applicant for a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the EPO. For a case in which an **opponent** requested interruption of proceedings because of insolvency, see **T 1533/07**.

The decisive criterion for interruption under R. 142(1)(b) EPC is whether the action against the property was such as to make it legally impossible for the applicant to continue with the proceedings (**J 26/95**).

In **J 9/90** the Legal Board held that for R. 90(1)(b) EPC 1973 to be applied in the light of Art. 60(3) EPC 1973 and R. 20(3) EPC 1973, the applicant entered in the Register of European Patents and the insolvent person (here a limited company) had to be legally identical.

In the cases **J 9/94** and **J 10/94**, it was regarded as being analogous to a case of legal impossibility where the applicant, as a consequence of an action against his property, did not have at his disposal any remaining property by means of which he could have effected the required payment and he was thus, as a result of the action against his property, placed in a situation where it was factually and legally impossible for him to continue the proceedings before the EPO. In such a case it had, however, to be examined whether the actions taken effectively made it impossible for the applicant to continue the proceedings (see **J 26/95**).

In **J 18/12** the appellant company (applicant) had applied to the Legal Division for interruption of the proceedings, arguing that a court judgment had been issued - erroneously - against it, of which it had not been aware. This circumstance had only surfaced when it had applied for a bank loan, which had been refused due to its adverse credit rating, this latter being the direct consequence of the court judgment, which then directly resulted in its being left without any financial means.

The board held that the correct interpretation of R. 142(1)(b) EPC required that there be a close relationship between the action taken against the property of the applicant and the condition that this action should be the cause of the applicant being prevented by legal reasons from continuing the proceedings. This requirement of causality would normally only be fulfilled if the "action" was a legal action and was directed against the property of the applicant as a whole, i.e. against the totality of the applicant's assets. In

the case at issue, the legal action had not at all been directed against the totality of the appellant's assets, but merely ordered the payment of a specified amount. It did not have any other legal effects. The fact that the judgment had been issued against the appellant erroneously was immaterial for this finding.

In **J 26/95** (OJ 1999, 668) the board held that, in the absence of specific circumstances, proceedings against the applicant under Chapter 11 of the US Bankruptcy Code did not interrupt proceedings before the EPO within the meaning of R. 90(1)(b) EPC 1973 (R. 142(1)(b) EPC) (see also **J 11/98**). Being placed under Chapter 11 of the US Bankruptcy Code was an action taken against the property of the debtor. It did not, however, constitute a case where, as a result of such action, it was impossible for the debtor to continue the proceedings before the EPO. On the contrary, it was the very nature of proceedings under Chapter 11 that it was the debtor who continued to act for his business. Chapter 11 bankruptcy proceedings were therefore not comparable to the cases which had been recognised in the case law of the boards of appeal as leading to interruption of proceedings, i.e. where parties had been placed under receivership under French law (**J 7/83**, OJ 1984, 211) or been declared bankrupt under German law (**J 9/90**). A situation which could be compared to the exceptional case underlying decisions **J 9/94** and **J 10/94** (see above) had also not been substantiated.

### 3.7. Consequences of interruption of proceedings (Rule 142(4) EPC)

R. 142(4), first sentence, EPC (R. 90(4), first sentence, EPC 1973) states that the time limits in force as regards the applicant for or proprietor of the patent at the time of interruption of the proceedings shall begin again as from the day on which the proceedings are resumed. R. 142(4) EPC includes two exceptions in this respect, namely the time limits for making a request for examination and for paying renewal fees. R. 142(4) EPC does not, however, constitute an exception to the general principle that all time limits are interrupted. Its sole purpose is to specify how time limits are to be calculated when proceedings resume (**J 7/83**, OJ 1984, 211).

In **J 7/83** (OJ 1984, 211) the board held that in the event of proceedings for grant of a European patent being interrupted because the applicant company has gone into receivership (R. 90(1)(b) EPC 1973), the period prescribed by Art. 94(2) EPC 1973 for payment of the **examination fee** is suspended as from the date on which payments were discontinued by court order up to the date on which proceedings for grant are resumed (R. 90(2) EPC 1973). The period then resumes for the part remaining to elapse, or for at least the two months prescribed by R. 90(4), second sentence, EPC 1973. In **J ../87** (= **J 902/87**, 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 EPC 1973. R. 90(4) EPC 1973 had to be interpreted as deferring, until the date proceedings are resumed, the payment date for renewal fees which had fallen due during the period of the representative's or applicant's incapacity.



**E. Re-establishment of rights**

1.	Introduction	602
2.	Right to file request for re-establishment of rights	603
2.1.	Exception for opponent - time limit for filing statement of grounds of appeal	603
2.2.	Time limit for applicant to observe	603
3.	Non-observance of time limit directly causing a loss of right	604
3.1.	The meaning of "time limit"	604
3.1.1	Requirement of pendency when filing divisional application is not a time limit	604
3.1.2	Designation of States	604
3.1.3	"Time limitation" condition for requests for correction	604
3.2.	Time limits excluded from re-establishment under Article 122(4) EPC and Rule 136(3) EPC	605
3.3.	Time limits concerning the PCT proceedings	605
3.4.	Loss of rights as a direct consequence by virtue of the EPC	606
4.	Admissibility of requests for re-establishment of rights	606
4.1.	Time limits for filing a request for re-establishment (Rule 136(1) EPC)	606
4.1.1	Two-month time limit from the removal of the cause of non-compliance	606
	a) Removal of the cause of non-compliance	607
	b) Responsible person	608
	c) Legal fiction of deemed notification	610
4.1.2	One-year time limit following the expiry of the unobserved time limit	611
4.2.	Inability to observe a time limit	612
4.2.1	Deliberate act missing a time limit; tactical considerations	612
4.2.2	Financial difficulties	613
4.3.	Making good the omitted act	614
4.4.	Substantiation of the request for re-establishment	614
4.5.	Correction of deficiencies in the request for re-establishment	615
5.	Merit of request for re-establishment of rights	615
5.1.	Submissions to be taken into account	616
5.2.	General comments on due care	617
5.3.	Exceptional circumstances	617
5.3.1	Organisational upheaval	617
5.3.2	Sudden serious illness	618
5.4.	Isolated mistake within a satisfactory system for monitoring time limits or for processing mail	619
5.4.1	"Isolated mistake" by representative	619
5.4.2	A system operating efficiently for many years as evidence that it is normally satisfactory	619
5.4.3	Cause of mistake remains unclear	620
5.4.4	Requirement for a cross-check	620
5.4.5	Staff substitution and deputising	623
5.4.6	Second mistake by responsible person	624
5.4.7	Deficiencies in computerised systems	624
5.5.	Persons required to exercise due care; requirements regarding due care	624
5.5.1	Due care on the part of the applicant	625

a)	General principles	625
b)	Unrepresented individual applicant	625
c)	Choosing a sufficiently competent representative	626
5.5.2	Due care on the part of the professional representative	626
a)	Communication between professional representatives and their clients, the EPO or other representatives	626
b)	Payment of renewal fees	627
c)	Ignorance of or erroneous interpretation of a provision of the EPC	629
d)	Starting work on a case close to the expiry of the time limit	631
e)	Designation of receiving offices	631
f)	Abandonment of application	631
5.5.3	Due care on the part of a non-authorized representative	632
5.5.4	Due care in dealing with assistants	632
a)	Introduction	632
b)	Selection, instruction and supervision	633
c)	Technically qualified assistant	635
d)	Substitutes replacing assistants	636
e)	Ultimate responsibility of the representative	636
5.5.5	Due care in using mail delivery services	638
6.	Procedural treatment of requests for re-establishment	638
6.1.	Department competent to decide upon the request	638
6.2.	Request for re-establishment as auxiliary request	640
6.3.	Parties to re-establishment proceedings and the right to be heard	640
6.4.	Concurrent request for interruption of proceedings	641
6.5.	Re-establishment in the context of the President's extension of time limits during general disruption	641
6.6.	Redundant request for re-establishment	641
7.	Rights of use under Article 122(5) EPC	642
8.	Principle of proportionality	642
9.	Refund of the fee for re-establishment	644

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## 1. Introduction

Re-establishment of rights constitutes a legal remedy for curing a loss of rights in proceedings before the EPO. If the requirements of Art. 122 EPC and R. 136 EPC are fulfilled and the request for re-establishment is granted, the requester will be treated as if the loss of rights had not occurred (see Art. 122(3) EPC). After the revision of the EPC, further processing has become the standard legal remedy for missed time limits in the European patent grant procedure (see also Chapter III.D.2 "Further processing under Article 121 EPC") and thus in some cases has replaced re-establishment (for a synopsis of the changes see "Case Law of the Boards of Appeal", 6th edition 2010, VI.E.1, and OJ SE 4/2007).

The main requirements for a re-establishment of rights are that the requester has the right to file the request (see in this chapter III.E.2), he was unable to observe a time limit

within the meaning of Art. 122(1) EPC (which is not excluded under Art. 122(4) and R. 136(3) EPC) and this failure had the direct consequence of causing a loss of rights (chapter III.E.3), the request was filed in time and in due form and the omitted act was made good within the time limit (chapter III.E.4), and the substantive conditions were met, in particular all due care required by the circumstances had been taken (chapter III.E.5).

## 2. Right to file request for re-establishment of rights

Under Art. 122(1) EPC re-establishment of rights may be granted to both the applicant and the proprietor of a European patent. Accordingly, it is a legal remedy that is, in general, not available to opponents.

### 2.1. Exception for opponent - time limit for filing statement of grounds of appeal

Opponents are not entitled to request re-establishment of rights in respect of the two-month time limit for filing an **appeal** under Art. 108, first sentence, EPC (see **T 210/89**, OJ 1991, 433; see also **T 323/87**, OJ 1989, 343; **T 128/87**, OJ 1989, 406; **T 314/01**; **T 2454/11**); nor in respect of the nine-month time limit under Art. 99(1) EPC for filing the **notice of opposition** and paying the appropriate fee (**T 702/89**, OJ 1994, 472; **T 748/93**, **T 2254/11**).

In **G 1/86** (OJ 1987, 447) the Enlarged Board of Appeal held, however, that an **opponent as appellant** might have his rights re-established under Art. 122 EPC if he had failed to observe the time limit for filing the **statement of grounds of appeal** under Art. 108, third sentence, EPC (established case law, see **T 335/06**). The reasons justifying the exclusion of opponents from re-establishment of rights in respect of the time limit for appeal - in particular the patent proprietor's interest in no longer being left uncertain as to whether an appeal had been lodged once this time limit had expired - could not be extended to the time limit for filing the statement of grounds of appeal, because this uncertainty no longer existed. 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.

### 2.2. Time limit for applicant to observe

In **J 3/80** (OJ 1980, 92) the board made it clear that if the **national industrial property office** concerned **failed to forward** a European patent application filed with that national office **to the EPO in time**, with the result that the application was deemed to be withdrawn (Art. 77(5) EPC 1973), the applicant could not claim restitution of rights, since the EPC provided only for restitution of rights where there had been a failure to observe a time limit which it was for the applicant to observe.

### 3. Non-observance of time limit directly causing a loss of right

#### 3.1. The meaning of "time limit"

For re-establishment of rights to be possible, there must be a failure to meet a time limit vis-à-vis the EPO (Art. 122(1) EPC), i.e. a time limit given specifically to the applicant pursuant to the Convention or by an official of the EPO within which he must accomplish a certain act (consolidated cases **J 11/91** and **J 16/91**, OJ 1994, 28; **J 21/96**). Not every "time limit", "time limitation" or "time restriction" under the EPC is also a time limit pursuant to Art. 122 EPC (**J 10/01**). Time limits in the EPC have **two conceptual elements**: (1) a period of time determined in years, months or days, and (2) a relevant date, which serves as the starting date of the time limit, and from which the period of time is counted. Time restrictions imposed on applicants by the EPC, but not having these conceptual elements cannot be regarded as time limits for the purposes of Art. 122 EPC 1973 (**J 18/04**, OJ 2006, 560).

##### 3.1.1 Requirement of pendency when filing divisional application is not a time limit

The applicant may file a divisional application relating to any pending earlier European patent application (see R. 36(1) EPC; and R. 25(1) EPC 1973 in its version since 2002). This provision sets a condition and not a time limit, which involves a period of fixed length for accomplishing a procedural act. In procedural law, the fact that a conditional act can only be accomplished before a particular set of circumstances foreseen by legal provisions occurs (condition), is conceptually different from a set period of time imposed for doing an act (time limit) (**J 24/03**, OJ 2004, 544; **J 3/04**; see also **J 10/01**; **J 18/04**, OJ 2006, 560; **G 1/09**, OJ 2011, 336; **J 19/10**, **J 10/12**). R. 25(1) EPC 1973 in its version prior to 2002 did also not contain a time limit but identified a point in the grant procedure after which a divisional application could no longer be filed, namely the approval of the text according to R. 51(4) EPC 1973 (**J 21/96**, **J 4/02**).

##### 3.1.2 Designation of States

In **J 3/83** the board explained that the concept of a time limit within Art. 122 EPC 1973 involved a **period of time of a certain duration**. In the case of designation of states, there was no such period. States had to be designated at a particular time, see Art. 79(1) EPC 1973. With the EPC 2000 this is no longer an issue, as under the new Art. 79(1) EPC all contracting states party to the EPC at the time when the application is filed are deemed to be designated in the request for grant of a European patent.

##### 3.1.3 "Time limitation" condition for requests for correction

In **J 7/90** (OJ 1993, 133) the board found that the "time limitation" condition imposed under board of appeal case law, which required that, in general, a request for correction of the designation of a state or priority data had to be refused in the public interest if it was not made early enough to enable publication of a warning together with the European patent application, was not a "time limit" within the meaning of Art. 122(1) EPC 1973.

### 3.2. Time limits excluded from re-establishment under Article 122(4) EPC and Rule 136(3) EPC

Under Art. 122(4) EPC in conjunction with R. 136(3) EPC, re-establishment is ruled out in respect of time limits for which further processing is available under Art. 121 EPC, such as the time limits for paying the filing fee, search fee, designation fees and examination fee, and for the time limit for filing the request for examination, as well as any time limit set by the EPO (see also OJ SE 4/2007; for the situation under the EPC 1973, see **J 11/86**).

Re-establishment is also excluded in respect of the time limit for requesting re-establishment (R. 136(3) EPC; this was also the case under the EPC 1973, see **T 900/90**), but is possible for the time limit for requesting further processing (see Art. 121(4) EPC; this was also the case under the EPC 1973, see **J 12/92**; **J ../87**idem**J 902/87**, OJ 1988, 323; **J 29/94**, OJ 1998, 147).

In contrast to the situation under the EPC 1973, re-establishment in respect of the priority period (Art. 87(1) EPC) is possible under the EPC 2000. This change to the EPC has no implications for the interpretation of Art. 122(5) EPC 1973, which clearly rules out the time limit under Art. 87(1) EPC 1973 (see **J 9/07**).

The case law which excluded the grace periods under R. 85a and R. 85b EPC 1973 from re-establishment is now obsolete as these provisions have been deleted. Issues concerning the exclusion of PCT time limits under Art. 122(5) EPC 1973 are no longer likely to arise since the coming into force of the EPC 2000; for a detailed summary of the case law (**G 3/91**, OJ 1993, 8; **G 5/92** and **G 6/92**, OJ 1994, 22 and 25; **G 5/93**, OJ 1994, 447; **J 1/03**; **T 227/97**, OJ 1999, 495) see "Case Law of the Boards of Appeal", 5th ed. 2006, VI.E.3; for a short summary see "Case Law of the Boards of Appeal of the EPO", 6th ed. 2010, VI.E.4

### 3.3. Time limits concerning the PCT proceedings

Art. 48(2)(a) PCT states that any contracting state shall, as far as that state is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit. The application of provisions concerning *restitutio in integrum* is covered by Art. 48(2)(a) PCT, when the necessary conditions are fulfilled. Consequently, a Euro-PCT applicant who has not carried out a certain procedural act within the time limit prescribed in the PCT can take advantage of the relevant provisions of the EPC 1973 concerning re-establishment of rights in all cases where the direct European applicant too may invoke them if he fails to observe the relevant time limit (see **G 3/91**, OJ 1993, 8).

In **J 6/79** the Legal Board held that *restitutio in integrum* was not excluded, so far as the time limit for presentation of the request for examination is concerned, in the case of an international application transmitted to the EPO.

In **W 4/87** (OJ 1988, 425) the board decided that an application for restitutio in integrum could be submitted in cases where the statement of grounds supporting the protest under R. 40.2(c) PCT was submitted late, since Art. 122 EPC 1973 applied in conjunction with Art. 48(2) PCT.

The provisions of Art. 122 EPC are applicable to the time limit set by R. 13bis.4 PCT (**T 227/97**, OJ 1999, 495). For re-establishment in respect of the time limit, set under former R. 40.3 PCT, for the protest against the invitation to pay an additional search fee, see **W 3/93** (OJ 1994, 931).

### **3.4. Loss of rights as a direct consequence by virtue of the EPC**

Under Art. 122(1) EPC rights cannot be re-established unless they have previously been lost as a direct consequence of the non-observance of a time limit vis-à-vis the EPO.

In **J 1/80** (OJ 1980, 289) certified copies of priority documents had not been filed within the 16-month period provided for in R. 38(3) EPC 1973. The Legal Board of Appeal found that, according to the Convention, there was a deficiency only if the priority documents had not been filed by the end of the period. It could only be said that there was a deficiency thereafter and the applicant should have been given an opportunity to remedy that deficiency within a further period (Art. 91(2), R. 41(1), 84 EPC 1973). There could only be a loss of rights if the applicant did not then take advantage of this opportunity.

## **4. Admissibility of requests for re-establishment of rights**

### **4.1. Time limits for filing a request for re-establishment (Rule 136(1) EPC)**

The time limits for filing a request for re-establishment are set out in R. 136(1) EPC (see also Art. 122(2) EPC 1973). In principle, a request must be filed within two months of removal of the cause of non-compliance and, at the latest, within one year after expiry of the unobserved time limit; R. 136(1), second sentence, EPC provides for two exceptions: a request for re-establishment in respect of the periods specified in Art. 87(1) EPC (priority) and Art. 112a(4) EPC (petition for review through the Enlarged Board of Appeal) must be filed within two months of expiry of the unobserved time limit. Hence the case law summarised in this chapter III.E.4.1.1 is not applicable to such cases, but the principles laid down in this chapter III.E.4.1.2 are likely to be transferable to the two-month period under R. 136(1), second sentence, EPC.

If an applicant misses two time limits which expire independently of one another and each result in the application being deemed withdrawn, a request for re-establishment has to be filed in respect of each unobserved time limit (**J 26/95**, OJ 1999, 668).

#### **4.1.1 Two-month time limit from the removal of the cause of non-compliance**

The application for re-establishment of rights must be filed within two months of the date of the removal of the cause of non-compliance with the missed time limit (Art. 122(2) first

sentence EPC 1973, R. 136(1) first sentence EPC). This also applies if the time limits under Art. 102(4) and (5) EPC 1973 have been missed, even if no decision has yet been handed down concerning revocation (**G 1/90**, OJ 1991, 275). The omitted act must be completed within the same period. The fee for re-establishment of rights is also payable within the same time limit as that stipulated by Art. 122(2) EPC 1973 for the filing of an application for re-establishment (**J 18/03**).

a) Removal of the cause of non-compliance

In most cases the "cause of non-compliance with the time limit" involved some error in the carrying-out of the party's intention to comply with the time limit (**J 29/86**, OJ 1988, 84; regarding other possible causes of non-compliance, see also in this chapter III.E.4.2 "Inability to observe a time limit"). According to the case law of the boards of appeal, the removal of the cause of non-compliance occurs in such cases on the date on which the person responsible for the application (the patent applicant or his professional representative) is **made** aware of the fact that a time limit has not been observed (**T 191/82**, OJ 1985, 189; **T 287/84**, OJ 1985, 333; **J 29/86**, OJ 1988, 84; **J 27/88**, **J 27/90**, OJ 1993, 422). The decisive factor in this is the time when the person concerned **ought to have noticed the error** if he had taken all due care (established case law, see e.g. **J 27/88**, **J 5/94**, **T 315/90**, **T 840/94**, **J 24/97**, **J 27/01**, **T 170/04**, **T 1026/06**, **T 493/08**, **J 21/10**, **T 1985/11**, **J 1/13**). In **T 261/07**, relying on **T 949/94**, the patentee had argued that it had only become aware of an oversight when it could be established that the decision of the opposition division had indeed been received. The board however took the view that the cause of non-compliance was removed as soon as the patentee noticed via a file inspection "that something was amiss" (see **J 9/86**, **J 17/89**, **T 191/82**).

As stated in **J 27/90** (OJ 1993, 422), the removal of the cause of non-compliance is a matter of fact which has to be determined in the individual circumstances of each case (**J 7/82**, OJ 1982, 391; see also **J 16/93**, **T 900/90**, **T 832/99**, **J 21/10**, **T 387/11**). 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. 112(1) EPC, R. 69(1) EPC 1973 (see **T 315/90**, **J 21/10**). If, however, such a communication has duly been served, it may, in the absence of circumstances to the contrary, be assumed that the removal was effected by this communication (see also **J 7/82**, OJ 1982, 391, **J 29/86**, OJ 1988, 84; **T 900/90**; **J 27/90**; **J 16/93**; **T 428/98**, OJ 2001, 494; **T 832/99** and **J 11/03**).

In **J 29/86** (OJ 1988, 84) the board assumed a later date in view of the special circumstances of the case. In **T 900/90** the board emphasised that in all cases in which the receipt of the notification under R. 69(1) EPC 1973 could be regarded as the removal of the cause of non-compliance it had to be clearly established that neither the representative nor the applicant was aware that the application had been deemed to be withdrawn before the receipt of that notification. Other cases in which the boards agreed to a date different from that of the receipt of the communication under R. 69(1) EPC 1973 include **J 16/93**, **J 22/97**, **J 7/99**, **J 19/04**, **T 24/04** and **T 170/04**.

In **J 27/01** the board decided that persons absent from their residence for a lengthy period are obliged to ensure that legally important documents are forwarded to them so that they can note their contents within a time limit appropriate to the technology available in the particular case. The obstacle to completion of the omitted act was therefore overcome on the date on which the individual applicant could have noted the content of the EPO communication under R. 69(1) EPC 1973 if he had had it duly forwarded to him.

In **T 493/08** the Board considered that, where a time limit was not observed due to an **error of law**, the removal of the cause of non-compliance with that time limit occurs on the date on which the applicant actually became aware of the error of law. The board stated that in an apparent contrast to this view, in **T 1026/06** the date when the applicant should have made investigations was considered to be critical, even though the applicant apparently failed to undertake such investigations as a consequence of what was considered to be an error of law.

In **J 21/10**, the board held that, in cases of a request for re-establishment of rights, the existence of some factor having a causal nexus with the failure to observe the deadline in question was a procedural requirement and, as such, a prerequisite for any decision on the merits, and therefore had to be verified when examining admissibility. The same applied where such causal factor was denied, as in the case in hand, on legal grounds because the error leading to the failure to perform a procedural act subject to a deadline ought to have been discovered by a person exercising due care. Where the cause asserted in a request for re-establishment of rights consisted of an error but could be deemed to have been removed before expiry of the non-observed deadline because the error was attributable to a breach of the duty of care imputable to a responsible party, such removal resulted in the inadmissibility of the request.

In **T 1486/11** the appeal fee was not paid with the notice of appeal; the authorisation to debit the appeal fee from the representative's account was filed only with the statement of grounds of appeal. The board rejected the appellant's argument that the two-month time limit started with the reception of the communication noting the loss of rights. The start of the two-month period was the moment at which the appellant - exercising the due care stipulated by Art. 122(1) EPC - was no longer prevented from performing the payment of the appeal fee. The board held that had all due care been exercised in the case at hand, the payment of the appeal fee could not have been made without its belatedness being noticed.

#### b) Responsible person

In several decisions the boards considered the question of the responsible person who could or should have detected the omission.

In **T 191/82** (OJ 1985, 189) the board held that in a case in which non-compliance with a time limit was discovered by an employee of a representative, the cause of non-compliance, i.e. failure to appreciate that the time limit had not been complied with, could not be considered to have been removed until the **representative concerned** had



**himself** been made aware of the facts, since it had to be his responsibility to decide whether an application for re-establishment of rights should be made and, if it was to be made, to determine the grounds and supporting facts to be presented to the EPO (see also **J 7/82**, OJ 1982, 391; **J 9/86** and **T 381/93**).

In **J 1/13** the board considered that within a law or patent attorney's firm the relevant person was the representative and not his or her employee (**T 191/82**); however, it was not up to the representative to extend the time period of R. 136(1) EPC at will by keeping him- or herself intentionally uninformed (see **T 1985/11**, where the board found it irrelevant that the representative had not read the letter when acknowledging its receipt). In addition, although most cases regarding the removal of the cause of non-compliance deal with the point in time when a representative discovered (or ought to have discovered) the error, it was recognised that the person whose knowledge was relevant might also be the applicant himself (see **J 27/88**; **J 27/90**, OJ, 1993, 422; **T 840/94**, OJ 1996, 680; **T 32/04**).

In **J 27/88** the board held that the responsible person in the case at issue was neither the appellant nor the European representative but the **US patent attorney** who was the authorised agent of the appellant and was duly empowered to take all necessary measures. The date of removal of the cause of non-compliance was the date on which the US patent attorney became aware of the omission.

In **J 27/90** (OJ 1993, 422) the applicant, a US company, properly appointed a European professional representative. For the payment of renewal fees it used a computerised service firm, a so-called "**renewal fee payment agency**". The board held that in the absence of circumstances to the contrary a communication under R. 69(1) EPC 1973 to the professional representative removed the cause of non-compliance. This also applied when parties instructed the (European) professional representatives via their (national) patent attorney. The appointment of an independent service firm for the payment of renewal fees did not constitute such circumstances to the contrary.

In **J 16/93** the board held that in the event of exceptional circumstances the cause of non-compliance with a time limit may persist even though the applicant's representatives were duly informed of the loss of rights resulting therefrom. This is the case when a combination of circumstances, which cannot be blamed on either the applicant or its representatives, and which arose in particular from the fact that they had both moved to new addresses and from the illness of a director of the company applying for a European patent, made it impossible for the professional representatives to contact the applicant in due time. This combination of circumstances prevented the representatives from performing the omitted act - i.e. paying the renewal fee for the third year - since they had not received any advance. A representative whose authorisation is silent in this respect and who has not received any funds for this purpose is not expected to advance moneys on behalf of his client out of his own pocket.

In **T 840/94** (OJ 1996, 680) the board held that if a party instructed the authorised representative not to pass on any further communication from the EPO, it could not then

rely on the fact that information notified to the representative and necessary for continuing the proceedings was lacking. See also **T 1908/09**.

In **T 812/04** the board held that the person to be taken into account for the purposes of establishing the point in time when the appellant was no longer prevented from carrying out an unperformed act was the duly appointed representative.

In **T 32/04** the board considered that in the absence of a duly registered transfer of the application, the person responsible for the purpose of the EPO remained the applicant or his representative. Hence an alleged assignment of the application to a third party in the absence of such a registration was "res inter alios acta", i.e. outside the ambit of the legal relationship between the applicant and the EPO.

In **T 1908/09** the board observed that if there was more than one applicant the co-applicants had to name a common representative (Art. 133(4) and R. 151(1) EPC). If they failed to do so and one of the applicants was obliged to appoint a professional representative under Art. 133(2) EPC, this representative was deemed to be the common representative. In the case at issue, with the notification of the loss of rights (R. 126(2) EPC) to their common representative (Rule 130(3) EPC) both applicants were made aware of the fact that the time limit had expired.

c) Legal fiction of deemed notification

In **J 7/82** (OJ 1982, 391) the board held that in a case in which the receipt of a notification was relevant to the question of when the cause of non-compliance with a time limit had been removed, the significant date was the **date of actual receipt** by the applicant. In **J 22/92** the board emphasised that the removal of the cause of non-compliance was a matter of fact and therefore had to be established beyond any reasonable doubt. This was not the case where under R. 78(2) EPC 1973 (in the version in force until 31 December 1998) the notification was only deemed to have been made when despatch had taken place and when the receipt of the letter could not be proved. Thus, the board considered the date on which the responsible representative of the appellant first became aware of the missed time limit to be the date on which the removal of the cause of non-compliance with the time limit had occurred (see **T 191/82**, OJ 1985, 189).

In **T 428/98** (OJ 2001, 485) it was stated that where a communication from the EPO notified an applicant that he had missed a time limit, the cause of failure to complete the omitted act within the meaning of Art. 122(2), first sentence, EPC 1973 was as a rule removed on the date when the applicant actually received the communication, provided that failure to complete the act was purely due to previous unawareness that the act had not been completed. The legal fiction of deemed notification under R. 78(3) EPC 1973 (in the version in force until 31 December 1998, now R. 126(2) EPC) had no effect on the date of removal of the cause of non-compliance, even if this worked against the applicant because the actual date of receipt of the communication preceded the date calculated according to R. 78(3) EPC 1973 (see also **T 1063/03**).

In **J 11/03**, however, the board agreed with the appellant that the removal of the cause of non-compliance had not taken place before deemed notification in accordance with R. 78(2) EPC 1973, since there was no indication that the communication concerning loss of rights had already been received before that date (see also **J 10/99**).

#### 4.1.2 One-year time limit following the expiry of the unobserved time limit

A request for re-establishment of rights is only admissible within the year immediately following the expiry of the unobserved time limit (R. 136(1), first sentence, EPC; Art. 122(2), third sentence, EPC 1973). Under R. 136(1), third sentence, EPC, the request for re-establishment of rights is not deemed to have been filed until the prescribed fee has been paid.

In **J 16/86** the board ruled that a request for re-establishment filed over a year after expiry of the non-observed time limit was inadmissible whatever the reasons for its late submission (see also **J 2/87**, OJ 1988, 330; **J 34/92**). In **J 12/98** the board held that the words "within the year immediately following the expiry of the unobserved time limit" in Art. 122(2), third sentence, EPC 1973 could not be construed to mean "within one year of the applicant having knowledge of the unobserved time limit". This interpretation would make the starting point for calculating the two-month period referred to in Art. 122(2), first and second sentence, EPC 1973 the same as that for calculating the one-year time limit referred to in Art. 122(2), third sentence, EPC 1973, which would thus deprive Art. 122(2), third sentence, EPC 1973 of any function.

In **J 6/90** (OJ 1993, 714) the statement of grounds was not submitted until shortly after the end of the period of one year stipulated in Art. 122(2), first sentence, EPC 1973 but within the period of two months specified in Art. 122(2) EPC 1973, which in the case at issue expired later. The Legal Board of Appeal pointed out that the one-year period served to provide legal certainty. If this period had elapsed, any party could confidently assume that a patent application or patent which had been rendered invalid by the non-observance of a time limit would not be revived. However, if on inspecting the file a third party noted that an application for re-establishment had been made within the one-year time limit, he would have adequate notice. Therefore, to make a valid request for re-establishment of rights within the year immediately following the expiry of the unobserved time limit, it was sufficient if the files contained a clearly documented statement of intent from which any third party could infer that the applicant was endeavouring to maintain the patent application. (see also **T 270/91**, **T 493/95**, **J 6/98**).

In **J 6/08** the fee for re-establishment of rights was not paid until after the one-year period had expired. The board referred to the case law (**J 16/86**, **J 34/92**, **J 26/95**, OJ 1999, 668; **J 6/98**, **J 35/03**), under which the one-year period fulfils the function of a deadline whose purpose is to ensure legal certainty for the public and the completion of proceedings before the EPO within a sensible and appropriate period of time. In view of the particular circumstances of the case, however, the board considered that re-establishment was not ruled out since the fact that the conditions for re-establishment had not been met in due time - i.e. payment of the fee for re-establishment within the one-year period - was largely to be laid at the door of the Office itself. Where the Office

has failed to meet its obligation to provide clarifications or advice, a request for re-establishment filed within the period of one year can, when the principle of the protection of legitimate expectations is taken into account, be treated as valid even though the fee for re-establishment was not paid until after the period of one year had expired. In the present case, the requester's right to be treated as though the non-observance had not occurred can take precedence over third parties' interest in legal certainty, which the one-year period in Art. 122(2), third sentence, EPC 1973 is intended to ensure.

## 4.2. Inability to observe a time limit

The word "unable" in Art. 122(1) EPC implies an objective fact or obstacle preventing the required action, e.g. a wrong date inadvertently being entered into a monitoring system (T 413/91, see also T 1054/03, T 1026/06, T 493/08, T 1962/08, T 836/09, T 592/11). Unawareness of the expiry of the time limit must be distinguished from a deliberate act on the part of the applicant (representative) which is, for example, attributable to tactical considerations (see in this chapter III.E.4.2.1). Persistent financial difficulties incurred by the persons concerned through no fault of their own have also been recognised as such an obstacle (see in this chapter III.E.4.2.2).

### 4.2.1 Deliberate act missing a time limit; tactical considerations

In T 413/91 the appellant's reasons for not filing any statement of grounds were that he had expected an agreement with the proprietor, which, however, did not come about. The board stated that such a reason did not justify re-establishment of rights, pointing out that it was an extraordinary means of judicial remedy. It offered no choice to a party as a substitute for the proper action to be taken, nor did it imply any right to have the fatal effect of an **intentional step** cancelled, even if this step later on proved to have been a mistake. A party who had deliberately chosen not to file a statement of grounds for the appeal could not achieve an appellate review through the back door of a request for re-establishment.

In J 2/02 the board added that Art. 122 EPC did not imply for an applicant any right to have the final effect of an **intentional** action cancelled. Holding back the payment of the fee for a reason other than being unable to comply with the legal provisions - particularly as a matter of strategy in the circumstances and for tactical considerations - is outside the scope of Art. 122 EPC, and deprives the applicant of the possibility to invoke this article.

In T 1026/06 the board distinguished its case from the situation in T 413/91 and J 2/02, in which the boards had not recognised the act of intentionally allowing a time limit to expire as an obstacle. These two cases differed from the current case, in so far as the parties concerned had deliberately refrained, for motives extraneous to the proceedings, from performing the required actions, whereas the appellant in the current case had been unable to file an appeal because of a mistake of law.

In T 250/89 (OJ 1992, 355) the opponent had claimed that he could not have filed the statement of grounds in due time because he would have needed to refer to documents

withheld by a third party. The board confirmed the line taken in earlier decisions (see **G 1/86**, OJ 1987, 447; **T 287/84**, OJ 1985, 333). When determining whether all due care required by the circumstances had been taken, the word "all" was important and failure to observe a time limit had to be the result of an oversight, not a **culpable error**. The board rejected the application for re-establishment of rights on the ground that the opponent had had sufficient material at his disposal to be able to draw up the statement of grounds in due time in accordance with Art. 108, third sentence, EPC 1973 and R. 64 EPC 1973.

In **J 11/09** the representative omitted to make payment of the third renewal fee because he was unwilling to advance the renewal fee on account of unpaid invoices. Accordingly, the renewal fee remained unpaid not inadvertently, but **on purpose**. Given that payment had been refused on purpose, it was not possible to say that a one-off error had occurred in an otherwise well functioning system in the professional representative's office.

#### 4.2.2 Financial difficulties

In **J 22/88** (OJ 1990, 244) the Legal Board held that financial difficulties experienced through no fault of one's own and leading to failure to observe time limits for the payment of fees could constitute grounds for granting re-establishment of rights. A prerequisite for granting the request was that the applicant should have tried with all due care to obtain financial support. The board also made it clear that for "all due care" to be proven, it had, of course, to be clear that the financial difficulties were genuine and were due to circumstances beyond the reasonable control of the applicant (see also **J 31/89**, **T 822/93**). In **J 9/89** the board noted that there was no evidence before the board of any effort having been made by or on behalf of the appellant to find financial support during the critical period.

In **J 11/98** the applicant requested re-establishment in respect of the time limit for paying the renewal fee, on the grounds that at the relevant times the appellant had been seeking protection under Chapter 11 of US bankruptcy law. The board confirmed the examining division's decision refusing the request. The applicant had not shown that at the relevant time it had been so lacking in funds as to be absolutely unable to make the payment. Only the latter situation had been accepted by the board, in an exceptional case (**J 22/88**), as a ground for re-establishment. In the case at issue, the non-payment of the renewal fee was due not to an absolute inability to pay but to the applicant's business priorities at the time.

In **J 6/14** the board held that it was clear from the events described and from all the evidence adduced that the appellant, an individual applicant who had been faced with serious health problems, had been in a very difficult financial situation for several years. He had proven the genuine existence of his difficulties to justify his failure to pay the renewal fee plus additional fee. The board consequently found that he had satisfied the requirements of Art. 122 EPC.

### 4.3. Making good the omitted act

The omitted act must be performed within two months from removal of the cause of non-compliance (Art. 122(2), second sentence, EPC 1973; R. 136(2) EPC).

According to **T 167/97** (OJ 1999, 488), the requirement of Art. 122(2), second sentence, EPC 1973 implies that the completed act likewise must meet the requirements of the EPC - i.e. in the case at issue that the statement of grounds of appeal is admissible for the purpose of Art. 108, last sentence, EPC 1973. Where the statement of grounds filed with the request for re-establishment is insufficient for the appeal to be declared admissible, the request for re-establishment must itself be declared inadmissible.

### 4.4. Substantiation of the request for re-establishment

Under R. 136(2) EPC (Art. 122(3) EPC 1973) the request for re-establishment has to state the grounds on which it is based, and set out the facts on which it relies. The boards consider this requirement in relation either to the admissibility of the request or to the submissions that must be taken into account when analysing the merits of the request (see in this chapter III.E.5.1 "Submissions to be taken into account").

It is a condition for the admissibility of a request for re-establishment of rights that a duly substantiated statement of grounds be submitted within the time limit for filing the request (**J 15/10**, see also **J 19/05**). A request for re-establishment of rights complies with the requirement of R. 136(2), first sentence, EPC if a conclusive case is made, setting out and substantiating the grounds and facts on which the request relies (**J 15/10**; **T 13/82**, OJ 1983, 411). Thereby it is ascertained that the factual basis for the requested decision is not altered after the expiry of the time limit for the request (**J 15/10**, **J 19/05**, **T 585/08**, **T 479/10**). Therefore, the request for re-establishment of rights must set forth the precise cause of non-compliance with the time limit concerned (i.e. a fact or obstacle preventing the required action within the time limit), specify at what time and under which circumstances the cause occurred and was removed, and present the core facts making it possible to consider whether all the due care required by the circumstances had been taken to comply with the time limit concerned (**J 15/10**, **T 479/10**, see also **J 18/98**). A request for re-establishment of rights which relies on general statements only and contains no specific facts does not satisfy the requirement for a duly substantiated request under R. 136(2), first sentence, EPC (**J 19/05**, **T 1465/08**, **J 15/10**). The mere payment of the fee does not meet the requirements of R. 136(2) EPC (**T 1465/08**).

In **J 19/05** the board held that the request for re-establishment of rights was not sufficiently substantiated. The request was couched in purely general terms and contained no concrete facts identifying a reason for non-observance, the chronological sequence of events or the causes underlying the action or inaction of the persons involved concerning non-payment of a renewal fee.

In **T 13/82** (OJ 1983, 411) the board held that a conclusive case must be made, setting out and substantiating the facts, for the probability - at least - that a wrongful act or

omission on the part of an assistant was the cause of the failure to meet the time limit: the mere possibility was not sufficient to exculpate the applicant.

In **T 287/84** (OJ 1985, 333) the board decided that an application for re-establishment of rights could be considered as complying with the requirement that it had to set out the facts on which it relied (Art. 122(3) EPC 1973) if the initially filed application in writing, which did not contain such facts, could be read together with a further document, which contained them and was filed before the expiry of the period within which the application had to be filed.

In **T 324/90** (OJ 1993, 33) the board held that **evidence** proving the facts set out in the application could be filed after expiry of the two-month time limit laid down in Art. 122(2) EPC 1973. Only the grounds and a statement of the facts had to be filed within the two-month period. It was not necessary to indicate in an application for re-establishment the means (e.g. medical certificates, sworn statements and the like) by which the facts relied on would be proved. Such evidence could be submitted after the time limit, if so required (see also **T 667/92**, **T 261/07**, **T 1764/08**).

In **J 8/95** the appellants argued that the German-language version of Art. 122(3) EPC 1973 did not stipulate that the statement of grounds for an application for re-establishment of rights had to be filed within the time limit laid down in Art. 122(2) EPC 1973. The board decided that Art. 177(1) EPC 1973 assumed a uniform legislative intent, which could only be identified on the basis of all three texts of the EPC 1973 (see also **T 324/90**, OJ 1993, 33).

#### **4.5. Correction of deficiencies in the request for re-establishment**

If the request for re-establishment is deficient, the principle of legitimate expectation may oblige the EPO to draw attention to the deficiency if it is readily identifiable by the EPO and the party can still correct it within the time limit under R. 136(1) EPC, Art. 122(2) EPC 1973 (see Chapter III.A.3, Obligation to draw attention to easily remediable deficiencies; see e.g. **T 14/89**, OJ 1990, 432; **J 13/90**, OJ 1994, 456; **J 2/94**; **T 585/08**). If a warning can be expected but is not issued to the applicant within the relevant time limit, the EPO must set a period within which the applicant can correct the deficiency and perform the procedural act in due time (**J 13/90**, OJ 1994, 456). However, this obligation to set a new time limit does not apply to absolute time limits (such as the one year time limit under R. 136(1) EPC, Art. 122(2), third sentence, EPC 1973), which by definition are non-extendable (**J 34/92**).

#### **5. Merit of request for re-establishment of rights**

Under Art. 122(1) EPC, for re-establishment to be allowed the requester must show that he missed the time limit despite taking all the due care required by the circumstances.

## 5.1. Submissions to be taken into account

In **J 5/94** it was decided that the grounds on which a request for re-establishment of rights was based could be amplified, provided this **completed the submission** that had been filed **in due time** and thus did not alter the basis on which the original request for re-establishment had been filed (see also **J 19/05**, **T 585/08**, **J 15/10**, **T 592/11**).

In **T 324/90** (OJ 1993, 33) the board held that **evidence** proving the facts set out in the application could be filed after expiry of the two-month time limit laid down in Art. 122(2) EPC 1973. Only the grounds and a statement of the facts had to be filed within the two-month period. Likewise in **T 261/07** the board allowed the patentee, who had initially given an account of all the relevant facts to the best of its knowledge, to subsequently adduce further clarifying **evidence** supporting the case.

In **J 18/98** the examining division had refused the applicant's application for restitutio in integrum. An appeal was filed against that decision. From the established case law on Art. 122(3) EPC 1973 the board concluded that **facts submitted only with the statement of grounds of appeal** could not be taken into account, since the function of appeal proceedings was only to give a judicial decision upon the correctness of an earlier decision of the department of first instance (**T 34/90**, OJ 1992, 454).

In **T 257/07** the board stated that it had been only one year after the removal of the cause for non-compliance that the appellant qualified certain statements previously made and added new facts that previously went unmentioned, in particular regarding the system for managing files and deadlines. This omission could not be subsequently remedied by the addition of further facts, as case law would only allow the appellant to "submit further evidence which clarifies the facts which were set out in the application for re-establishment" (**J 2/86**, OJ 1987, 362; **T 261/07**; see also **T 742/11**, **T 2274/11**, **J 6/14**).

In **J 5/11** the Legal Board held that the applicant for re-establishment of rights who failed to substantiate his request adequately in the first instance proceedings, in particular after being expressly invited to do so, **could not normally** make good that failure by submitting additional evidence with the grounds of appeal. While it was true that the primary function of the boards was to give a judicial decision on the correctness of a first-instance decision of the Office (see **J 18/98**), that does not necessarily mean that new **evidence** submitted for the first time on appeal was automatically inadmissible. A rigid rule excluding all new evidence on appeal might lead to injustice and unfairness in some cases and would not be compatible with the principles of procedural law generally recognised in the Contracting States (cf. Art. 125 EPC).

In **J 16/11** the Legal Board pointed out that the boards of appeal had consistently ruled that facts pleaded for the first time during the appeal proceedings should in principle not be taken into consideration (see **J 18/98**, **T 257/07**). In the case at issue, the board had, by its communication, informed the appellant that the evidence currently on file did not seem convincing enough and, exceptionally, gave the appellant an opportunity to improve its case at this late stage of the proceedings. However, the representative,



instead of filing evidence, produced a "sworn statement" written by the appellant himself. Given that the new submission did not complement the already existing facts, but presented a new situation, these facts and evidence had to be disregarded.

## 5.2. General comments on due care

In numerous decisions the boards have ruled on the "all due care required by the circumstances" issue. In considering it, the circumstances of each case must be looked at as a whole (**T 287/84**, OJ 1985, 333). The obligation to exercise due care must be considered in the light of the situation as it stood before the time limit expired. In other words, the steps the party took to comply with the time limit are to be assessed solely on the basis of the circumstances applying at that time (see e.g. **T 667/92**, **T 381/93**, **T 743/05**, **J 1/07**, **T 1465/07**, **J 3/12**, **J 4/12**). The requirements of re-establishment, and in particular of due care, **must not be interpreted in an excessive manner** that unreasonably restricts access to the board and thus prevents the board from deciding on the merits of the case (**T 1465/07**).

In **T 30/90** the board held that the allowability of applications for re-establishment hinged on whether the conduct of the appellant and/or his representative, during the entire period after the relevant decision, was indicative of "all due care required by the circumstances". In this connection, "all due care" meant all appropriate care, i.e. as much as would be taken under the circumstances by the **average reasonably competent patentee/representative** (see also **J 11/09**). The board in **T 1289/10** held that as a general rule, a representative acting reasonably would at least take account of known problems and apply known solutions to avoid them.

For cases where the cause of non-compliance with a time limit involves some error in the carrying out of the party's intention to comply with the time limit, the case law has established the criterion that due care is considered to have been taken if non-compliance with the time limit results either from **exceptional circumstances** or from an **isolated mistake within a normally satisfactory monitoring system** (**J 2/86**, **J 3/86**, OJ 1987, 362; **T 428/98**, OJ 2001, 494 and **T 785/01**).

The party requesting re-establishment of rights bears the burden of making the case and proving that the requirements are met (**J 5/80**, OJ 1981, 343; **J 18/98**; **T 592/11**, **J 3/13**).

## 5.3. Exceptional circumstances

### 5.3.1 Organisational upheaval

In **T 14/89** (OJ 1990, 432), due to **internal reorganisation and removals**, the R. 58(5) EPC 1973 communication did not reach the responsible department of the patent proprietor. The board found that this fact, which led to non-observance of the time limit, constituted an isolated mistake such as could not be ruled out despite careful company organisation.

In **T 469/93** the board found that even if all due care required by the circumstances were to be exercised, the occasional error during **complex transfers of company ownership** could not entirely be avoided. The error in this case being an exceptional one, the causes of which had since been removed, the appellant's request for re-establishment of rights was to be allowed.

In **J 13/90** (OJ 1994, 456) the applicant, a small firm employing about 15 people, was in **takeover** negotiations with another company. In the course of the negotiations a change of attorney took place. As a result of the unforeseeable breakdown in negotiations plus the fact that action had already been taken to replace the previous attorney, payment of the fourth-year renewal fee had been overlooked. This isolated mistake in a special situation was, in the board's opinion, excusable.

In **J 21/92** and **J 24/92** the applicant and his representative (both Americans) had each changed their **fee-monitoring system**, independently of each other. The situation was further complicated by the fact that the representative was no longer responsible for paying the appellant's renewal fees.

In **T 369/91** (OJ 1993, 561) the relevant circumstances involved moving from a manual to a **computerised time-limit monitoring system**. Here "due care" meant ensuring that during the changeover period the representatives handling the various kinds of cases were told which system - manual or computerised - had generated the reminder in question. Only then could they reliably know if and when a further reminder was likely.

In **T 489/04** the board did not recognise the **installation of a new computer system** as an extraordinary circumstance. On the contrary, it considered the resulting burden on employees as foreseeable and containable, had appropriate measures been taken in good time.

In **J 11/06** the appellant submitted that, due to the removal and later change of the US representative, there was some confusion caused by this reorganisation. However, the board noted that no details at all had been given as to why this affected the payment of the renewal fee. Likewise in **J 4/07** the board did not recognise the presence of exceptional circumstances because the representative's submissions were inadequate.

### 5.3.2 Sudden serious illness

In **T 525/91** the board found it credible that the sudden and unforeseen diagnosis of illness and the announcement of the urgent need for a major operation caused the appellant's representative not only great physical weakness but also severe psychological stress. In those circumstances, and in view of the short period between diagnosis and hospital admission (two working days) and the proven absence of the secretary on one of those working days, it had to be acknowledged that even on the days between diagnosis and admission the representative had been in an exceptional situation which impeded him from devoting the necessary attention to the imminent time limit and taking the precautions needed to ensure that it was observed. In the

circumstances the board deemed the conditions for re-establishment to have been met (see also the reference in **T 1401/05** to **T 558/02**).

In **T 387/11** the representative put forward a credible case that he had failed to observe the time limit for filing the statement of grounds because of severe psychological stress caused by a sudden and unexpected bereavement (see also **T 970/12**).

However, in this context, the case law also requires an **effective system of staff substitution in case of absence** (see in this chapter III.E.5.4.5 "Staff substitution and deputising"; in particular, re the duty of care in a large firm see **T 324/90** below; re the applicant's duties see **T 1401/05** below; re the duties of a representative running a one-person office see **J 41/92** below; and re the duty of care of an individual applicant see **J 5/94**).

#### **5.4. Isolated mistake within a satisfactory system for monitoring time limits or for processing mail**

An isolated mistake by an assistant that happens in a normally satisfactory system is excusable; for cases in which such a mistake occurred and the request for re-establishment was granted see, for example, **T 612/90**, **T 281/96**, **T 1001/95**, **T 72/99**, **T 1024/02**, **T 462/02**, **T 165/04**, **T 221/04**, **T 836/09**, **T 1355/09**, **T 1171/13**, **T 1269/13**. The appellant or his representative must plausibly show that a normally effective system for monitoring time limits prescribed by the EPC was established at the relevant time in the office in question (**J 2/86**, **J 3/86**, OJ 1987, 362; **J 23/92**; **T 428/98**, OJ 2001, 494; **J 13/07**; **J 3/12**; **J 4/12**).

##### **5.4.1 "Isolated mistake" by representative**

The case law on "an isolated mistake in an otherwise satisfactory system" cannot be relied on to ignore a failure to act by the professional representative himself, unless there are special circumstances (**T 1095/06**); an isolated mistake by a professional representative in performing his check on the time limit once he has received the file to deal with is then – as a rule at least – inexcusable (**T 592/11**, see also **R 18/13** with reference to the travaux préparatoires). See in this chapter III.E.5.5.4 e) "Ultimate responsibility of the representative".

##### **5.4.2 A system operating efficiently for many years as evidence that it is normally satisfactory**

The fact that this system operated efficiently for many years was **evidence** in many decisions that it was normally satisfactory (see **J 31/90**, **J 32/90**, **T 309/88** and **T 30/90**). In **T 130/83** the board stated that if a proper reminder system had been instituted by a representative, in order to guard against the consequences of oversight in a busy office, this was itself strong prima facie evidence of the taking of care by the representative (see also **T 869/90**, **T 715/91**, **T 111/92**).

However, in **T 1465/07**, the board disagreed with the view that a monitoring system of time limits can be held to have been normally satisfactory because it worked without previous problems and consequently accept that all due care had been taken even though doubts exist. Evidence that such a monitoring system operated efficiently for many years will weigh in favour of a finding of a normally satisfactory character but will be counterbalanced by evidence that main features of such a character, such as an independent cross-check, go missing. In that case a satisfactory character will be excluded (see also **T 1962/08**).

In **T 1764/08** the board considered that the mere allegation that the case at issue was the first instance of unintended failure in filing an appeal does not show that all due care was normally observed and does not prove that a satisfactory system was in place in the representative's office.

#### 5.4.3 Cause of mistake remains unclear

In **T 529/09** the board allowed the request for re-establishment of rights. The board accepted that the representative's firm had a well-functioning and reliable system in place for processing incoming mail and monitoring time limits. The fact that in the case at issue the communication was apparently misplaced (since it did not reach the representative in charge and the time limit set in it was not entered in the computer system of the firm) had to be regarded as an isolated mistake in an otherwise satisfactory system. While **the precise circumstances of the mistake could not be elucidated any further**, this was not a sufficient reason for denying that all due care required by the circumstances had been observed in the present case.

In a similar situation the board in **T 580/06** granted the request for re-establishment even though the **cause** of the failure ultimately **remained unclear** (see also **T 1355/09**).

#### 5.4.4 Requirement for a cross-check

In **J 9/86** the board was of the opinion that in a large firm where a large number of dates had to be monitored at any given time, it was normally to be expected that at least one effective cross-check was built into the system (**T 223/88**, **J 26/92**, **T 808/03**, **T 1149/11**). The cross-check must be independent of the person responsible for monitoring time limits (**T 828/94**, **T 257/07**, **T 1962/08**). The additional burden of an independent cross-check is not disproportionate for a large firm, where the cross-check can be organised more economically than in a smaller one (**T 1465/07**). In relation to small firms and offices, the boards have at times dispensed with the requirement for a cross-check (e.g. **J 31/90**, **T 166/87**, **J 11/03**, **T 1355/09**, see below). As to the representative's own responsibility for performing an additional check when receiving the file to deal with, see **T 1561/05**, **T 592/11**, **R 18/13** as summarised in this chapter III.E.5.5.4 e) "Ultimate responsibility of the representative".

In **T 828/94** the board noted that a monitoring system should contain an **independent cross-check** to prevent the misunderstanding between a representative and a technical assistant from assuming that a notice of appeal would be prepared and filed on time by

the other person, for example, someone would be responsible for checking independently of the representative and the assistant. The board noted that where a misunderstanding was likely to arise as a result of the two being responsible for the same file, the assistant should have clear instructions on how to proceed.

Concerning the need for an independent cross-checking mechanism and the form it should take, see also **T 428/98** (OJ 2001, 494), **T 1172/00**, **T 785/01**, **T 36/97**, **T 622/01**, **J 1/07**, **J 13/07**, and **T 1726/08**. In **T 257/07** the board emphasised that an independent cross-check must necessarily include either **another person** or an automated system alerting another person.

In **T 1962/08** the representative argued before the board that an independent cross-check in the system for monitoring time limits was not obligatory. The board confirmed what had been said in **T 428/98**, namely that the requirements to be met by a system for monitoring time limits in general included making sure that monitoring duties were not left to one person alone, but that the system incorporated an overall checking mechanism which was independent of the person responsible for monitoring time limits. This checking mechanism could be provided within a single system for monitoring time limits. If the checking mechanism involved a second system for monitoring time limits, the latter had to be independent of the former ("redundant") (see also **T 1465/07**).

In **T 686/97** the board held that the provision of a "redundant" or "failsafe system" is an essential component of a normally satisfactory reminder system in corporate patent departments. The failure to provide administrative reminders to the responsible patent attorneys of the time limits applying to the filing of statements of grounds of appeal was incompatible with the operation of a normally satisfactory system.

In **T 283/01** of 3.9.2002 the board pointed out that the applicant's system was not properly designed to handle the appeal in question, involving partial responsibility of an external representative. The deviation from the normal way of filing and prosecuting an appeal had been the applicant's deliberate decision in the particular circumstances of the case. Taking all due care required by the circumstances of the case should have implied installing an **individual control mechanism**, offering a realistic possibility of detecting and correcting the failure to note and calculate the time limit for filing the statement of grounds.

**T 261/07** concerned a case in which an **intermediary delivery service** received and distributed mail within the patentee's premises. The board held that there had been no effective cross-check. Such a failsafe system would have required a regular comparison between the mail room database and the database of the Central Intellectual Property Department in order to discover discrepancies.

The case **T 836/09** concerns the re-establishment of rights after an isolated mistake by an assistant within an otherwise satisfactory system of **processing outbound mail**. In a case where the mistake happened when processing the mail, the duty of at least one effective cross-check built into that system was dispensed with, irrespective of whether or not a large firm was concerned. The reason was that, in contrast to the monitoring of

time limits, the risk of an error in the processing of outbound mail was low because such processing generally involved the execution of straightforward steps (see also **T 178/07**, **T 1171/13**).

In **T 1355/09** the board held that no control mechanism had to be in place because the firm involved was very small and it had not overlooked a time limit, but rather the mistake had been made **during payment** of the appeal fee, i.e. whilst performing the act needed to observe the time limit. In these circumstances, no control mechanism was required, the likelihood of error being comparatively low. Insisting on one would in practice reduce the time limit: to be effective, any checks would have to be made after payment, but also within the time limit.

In **T 1149/11** the board held that the duty of care concerning supervision of the assistant required that an effective cross-check was implemented, at least in a firm where a large number of time limits have to be monitored.

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, concerning a patent department of two attorneys, no such check was made.

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 **J 31/90** the board took the view that this system, while far from perfect, could be considered in the special circumstances of the case to be normally satisfactory. The board emphasised, however, that the system could only be so considered because of the particular conditions in which the representative and her secretary worked. Over a period of ten years, working together alone in a small office they had built up an excellent working relationship and mutual trust.

In **T 428/98** (OJ 2001, 494) the board stressed the exceptional nature of the ruling in **J 31/90** and **T 166/87** and said that according to the appellant's submission his representatives' office was staffed by two patent agents, two lawyers, a partly qualified patent lawyer (*Patentassessor*) and a law graduate, i.e. six people dealing in their main professional capacity with cases relating to intellectual property rights. Such cases being commonly subject to time limits, with immediate negative legal consequences for the client if they were missed, time-limit monitoring in such an office was a major undertaking in terms of both significance and scale. The board therefore deemed a cross-checking mechanism to be essential. See also **T 1962/08**, **T 1726/08** (firm with 40 attorneys at four locations is not small), **T 479/10**.

In **J 11/03** the board confirmed that the organisational requirements for a generally efficient time-limit monitoring system were subject to variation on account of the firm's

size and nature and the number of time limits that had to be monitored. A cross-checking mechanism may in certain circumstances be regarded as superfluous in a small firm employing normally reliable personnel and normally working in an efficient and personal manner, but not in a large company with its own patent department (**T 166/87**). The appellant was a very small firm with a commercial division essentially comprising only the commercial manager and the book-keeper. In the circumstances additional checking that payments had actually been made might be deemed superfluous without impairing the functioning of the system.

#### 5.4.5 Staff substitution and deputising

In **T 324/90** (OJ 1993, 33) the board held that in a large firm, where a considerable number of deadlines had to be monitored at any given time, it had normally to be expected that at least **an effective system of staff substitution** in the case of illness and for absences in general was in operation in order to ensure that official documents such as decisions by the EPO, which started periods within which procedural steps had to be carried out, were properly complied with.

In **T 1401/05** (20.9.2006) the Board followed decisions **T 324/90**, **J 41/92** and **J 5/94** and deemed it necessary that **reasonable provisions for absence** due to the illness of a person who is in charge of monitoring time limits are made, unless in the particular circumstances of a case imposing such provisions would have to be considered as an undue burden. Only where any necessary provisions have been taken will it be possible to deem the monitoring system of time limits to be "normally satisfactory" (see **T 324/90**), which is a condition for a finding of due care and, thus, for considering illness to be an excuse for not meeting a deadline. Regarding the need for a back-up in the specific case, the Board considered it of relevance that the number of time-limits to be complied with was small (the appellant filed only a few patent applications per year). Under these circumstances, the Board accepts that it was not necessary for meeting the standard of due care to make specific provisions for the unforeseeable two-day illness of the sole employee in charge of monitoring of time limits; more specifically, no substitute for him had to be appointed.

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

In **J 41/92** (OJ 1995, 93) the Legal Board of Appeal found that a careful and diligent professional representative had, in any case, to be expected to take into account that he or she might fall ill and be prevented for some time from taking care of time limits. Therefore, if a professional representative ran a one-person office, appropriate provisions needed to be made so that, in the case of an absence through illness, the observance of time limits could be ensured with the **help of other persons**. If there was no substitute or assistant at the representative's office, co-operation with colleagues or with a professional association could, for example, be sought for this purpose. See also **T 387/11**, in which the representative, who ran a one-person office, had taken precautions to ensure that another representative could cover for him if he were absent

owing to illness, so that deadlines would normally be met. In taking such organisational measures, he had met the requisite standard of "all due care".

In **T 677/02** the board decided that a large enterprise had not exercised all the due care required by the circumstances if, when the representative actually responsible was on **short time working**, no **deputy** had been designated to cross-check the input of time limits into the system for monitoring time limits.

#### 5.4.6 Second mistake by responsible person

In **T 808/03** the board held that the condition of "an isolated mistake by a usually reliable person" was not met in the present case, as the responsible person had made a **second** mistake when processing the reminder of a system for monitoring time limits.

#### 5.4.7 Deficiencies in computerised systems

In **T 473/07** the board held that the representative's practice of checking only the dates entered by his records clerks while relying on the resulting time limits calculated by the computerised system did not rule out errors. Modern real-world offices comprised computerised systems but **program deficiencies** were also a well-known part of that reality and could not be absolutely ruled out. Therefore, relying exclusively on a time limit generated by a computer program and refraining even from a plausibility check did not meet the all-due-care requirement.

In **T 902/05** the board held that whether the systems used in a particular firm to ensure that procedural acts were completed in due time fulfilled the requirement of the taking of "all due care" depended upon the individual circumstances of each case (see also **T 1663/12**). Where an applicant relied solely on electronic means to record and monitor time limits, the regular making of back-up copies, or some equivalent form of securing data, would generally be an elementary precaution. This had not been done in the case at issue.

For a case in which the computerised system was deemed satisfactory, see **T 1269/13**.

### 5.5. Persons required to exercise due care; requirements regarding due care

Primarily it is up to the applicant (patent proprietor) to show due care. The applicant has to accept the actions of his representative, including the actions of the attorney's assistants and employees, on his behalf (**J 5/13** with reference to **J 5/80**, OJ 1981, 343; **J 1/07**). The "due-care" obligation is assessed differently, depending on whether an applicant, his representative or an assistant is involved.



### 5.5.1 Due care on the part of the applicant

#### a) General principles

In **J 3/93** the board ruled that the duty to exercise all due care stipulated by Art. 122 EPC 1973 applied first and foremost to the applicant and then, by virtue of the delegation implicit in his appointment, to the professional representative authorised to represent the applicant before the EPO. The fact that the representative had acted correctly did not exempt his client from suffering the consequences of his own mistakes, or even negligence (see also **J 16/93**, **J 17/03**, **J 1/07**, **J 1/13**).

In **T 381/93** the board of appeal observed that the applicant was entitled to rely on his duly authorised professional representative to deal with the EPO. However, the board held that to the extent that he was on notice that a time limit had not been met and/or that instructions were required in order to meet it, an applicant had a duty to take all due care in the circumstances to meet the time limit.

In **J 22/92** the board held that the applicant, who had appointed US attorneys for the purpose of the PCT application, was entitled to believe that a copy of a communication had been sent to the US attorneys as well. The board referred to the principle of proportionality and stated that the loss of the patent application as a result of what may be considered at most a minor procedural irregularity would otherwise appear an extremely severe result. The board held that, in the case in point, the due care to be considered was in fact not that which was expected from a professional representative but that which was expected from an applicant unaware of the proceedings.

#### b) Unrepresented individual applicant

In **J 5/94** the board made allowance for the fact that the appellant was an individual applicant who had not appointed a representative and who was neither familiar with the requirements of the Convention nor in possession of an established office organisation attuned to ensuring that procedural deadlines were met. The board pointed out that in such a case the **same standards** of care as those required of a professional representative or the patent department of a large firm could **not** be applied.

At the same time, an individual applicant was also obliged to exercise due care in the course of the procedure. Accordingly, when not using the services of a professional representative, he must himself take all possible steps to ensure that he can do, properly and punctually, whatever is required during the grant procedure to prevent any loss of rights. He is not entitled either to invoke **general ignorance of the law** or to leave undone anything which may reasonably be expected of him with a view to observing time limits (**J 5/94**, **J 27/01**, **T 671/02**, **J 2/02**, **J 6/07**, **T 493/08**, **T 555/08**, **J 15/08**, **J 8/09**, **J 7/12**).

With regard to re-establishment in respect of disciplinary proceedings and the European Qualifying Examination, the board ruled in **D 6/82** (OJ 1983, 337) that a mistake of law, particularly one regarding the provisions on notification and calculation of time limits, did

not, as a general rule, constitute grounds for re-establishment of rights. The obligation to take "all due care required by the circumstances" meant that persons engaged in proceedings before or involving the EPO had to acquaint themselves with the relevant procedural rules.

In **J 23/87** the board ruled that exercising due care under Art. 122 EPC 1973 meant that an applicant, when deciding whether to pursue his application, could not rely entirely on **information** provided voluntarily by PCT authorities and the EPO at various stages of the procedure, and instead had to ensure that he was normally able to comply with the basic PCT and EPC 1973 time limits even if he received this information late or not at all.

In **T 601/93** the appellant was not aware of the need to file a statement of grounds within the time limit. The board held that any **legal error** which might have led the appellant to believe that the requirement was not to be observed would exclude the application of due care, considering the unequivocal provision in Art. 108 EPC 1973.

#### c) Choosing a sufficiently competent representative

In **J 23/87** the applicant failed to furnish a translation of an international application within the prescribed time limit. The appellant, a small Japanese firm with limited financial resources, submitted that a Japanese patent attorney without special knowledge of PCT matters had been consulted, and that this attorney had misinformed the appellant. The board held that for an applicant who lacked the necessary knowledge of the PCT and the Convention procedures, it was obviously necessary to consult a competent professional representative in order to cope with the procedures involved in such a patent application. Thus, the board was not satisfied that the appellant, being completely ignorant about the special procedure to be observed in this case, had chosen a sufficiently competent professional representative and let him properly advise the appellant on the matters involved having had an opportunity to study the details concerning the present application.

#### 5.5.2 Due care on the part of the professional representative

When an applicant is represented by a professional representative, a request for *restitutio in integrum* cannot be acceded to unless the representative himself can show that he has taken the due care required of an applicant or proprietor by Art. 122(1) EPC (**J 5/80**, OJ 1981, 343). In other words, what Art. 122 EPC requires from an applicant also applies to an applicant's representative (**T 1149/11**).

The extensive case law on a professional representative's duty of care in **dealing with assistants** is dealt with below in this chapter III.E.5.5.4.

#### a) Communication between professional representatives and their clients, the EPO or other representatives

In **T 112/89** the board stated that, regarding the due care required by Art. 122(1) EPC 1973, the obligations of the applicant and those of his representative

were clearly distinct and that the due care to be exercised by the representative might depend on the **relationship which existed between him and his client**. The board noted that it was clear that both the representative and the applicant had to exercise all due care in order to observe all the time limits during patent granting procedures. In the case at issue, the board was not convinced that the duty of the representative was fully discharged when he had notified his client that a time limit was to be observed and was satisfied that the client had received the notification. On the contrary, when a representative had been instructed to lodge an appeal and did not receive in due time from his client the necessary additional instructions he needed to discharge his duty, he should take all necessary measures to try to obtain from his client these instructions.

In **T 1401/05** (20 September 2006) the board stated that the communication between the representative and his client (patent applicant) had worked efficiently. The representative was therefore entitled to rely on his client's awareness of the expiry of the time limit. The representative was not required to issue a further reminder to meet his obligations of due care.

In **T 1289/10** the board held that if a European representative provided a contact **email** address for all kinds of mail, including mail that may require immediate action by the representative, it was essential to perform a mail check at least at the end of each business day. Given the known problem that legitimate mail from time to time was wrongly marked as a possible threat it was evident that this check must include the quarantine area of the email system.

In **T 1101/14** the board considered that the **signing** of documents was an act that required particular care on the representative's part, especially when the signature related to the last legal remedy against an adverse decision. A representative who had mistakenly signed a statement of grounds of appeal having most of its pages missing had, in the absence of special circumstances which could justify the representative's mistake, to be considered not to have taken all due care required by the circumstances.

In **J 15/14** the board held that in a proper workflow between two representative's offices where one had the function to give instructions to the other, a confirmation from the other representative that a particular instruction had been received and followed was required; if no confirmation was received a follow-up e-mail should be sent in order to safeguard the rights of the client.

#### b) Payment of renewal fees

In **J 11/06** the board held that according to the established jurisprudence of the Legal Board of Appeal following decision **J 27/90**, even if renewal fees were paid by someone else, the appointed professional representative remained responsible in the procedure before the EPO, and had to take the necessary steps to ensure payment if intended (likewise **J 1/07**, **J 4/07**, **J 12/10**, **J 5/13**). No reasons had been submitted as to which concrete steps had been taken. The board distinguished the case at issue from **T 14/89** and **J 13/90**. In both these cases, specific reasons were given as to why the mistakes happened, and corroborating evidence was filed.

In **J 4/07** the European representative had every reason to believe that it was the appellant's intention to continue prosecution of the application in suit. Under these circumstances the Board did not consider that it was sufficient for the European representative only to send a single reminder more than four months prior to the expiry of the critical term.

In **J 12/10** the board confirmed that it was established jurisprudence of the boards of appeal that a representative, once appointed - and even if the renewal fees were paid by someone else - remained otherwise fully responsible for the application, and that this included a continuing obligation to monitor time limits, send reminders to the applicant, etc.

In **J 5/13** the board considered that the extent of the duties of the representative depended on the agreement between the representative and his client. An appointed representative whose authorisation was silent concerning the payment of the renewal fees and who had not received any funds for this purpose was **not expected to pay the fee by advancing money** on behalf of the applicant out of his own pocket (**J 16/93, J 19/04, J 1/07**). Instead, he retained only a "**secondary responsibility**" (see **J 1/07**). Thus the representative's responsibility, above all, consists in finding out what his client really intends to do with respect to payment of the renewal fees (see **J 16/93**). The scope of duties of a representative who retains only such a "secondary responsibility" to inform and advise his client with respect to the due date for renewal fees cannot be the same as it would be if he were responsible for the payment itself. In the case in question, the representative had fulfilled his responsibility by sending repeated letters to the responsible person within the appellant's company.

In **T 942/12** the board held that if a European representative was **expressly instructed** that he was not required to monitor the payment of renewal fees, the duty of due care did not involve that he nevertheless monitored the payment. It could not be expected that the European representative monitors renewal fee payments at his own expense.

In **J 19/04** the board held that a professional representative is not obliged to pay renewal fees on his client's behalf if he has received no instructions to do so. However, the representative's conduct has to be assessed according to the extent to which he has done all that is necessary to ascertain the **client's true wishes** (see also **J 1/07**). It is not the number of (unanswered) reminders that is decisive, but when those reminders were sent in relation to the date on which the time limit expired, how the reminders were formulated and what the representative's duties were in relation to the client.

In **J 16/93** the board stated that a representative who had not received **any funds** for the **purpose of paying the renewal fee** and whose authorisation was silent in this respect was not expected to advance moneys on behalf of his client out of his own pocket. As the client was, in this situation, free to abandon its application by ceasing to pay the fees demanded by the Convention, the representative risked effecting a payment which he would not be able to recover either from the EPO (even though his client had not wished the payment to be made), or from the client, if the authorisation was silent in this respect.

In **T 338/98** the appellant was first represented by professional representative A, but later asked him to transfer all files to a new representative B. One European patent application failed to be transmitted. Although the representatives were aware that the renewal fee was due for this application, they did not reach clear agreement about paying it, with the result that the fee was not paid and the application was deemed to be withdrawn. The board held that in these circumstances it did not appear appropriate formally to delimit the individual responsibilities of each of the representatives during a transfer of cases requiring, by its very nature, close co-operation between the persons involved and naturally leading to overlapping responsibilities. The fact that in these circumstances the representatives had been unable to reach agreement about the way to proceed and that the appellant had not been informed of the outstanding renewal fee and of the disappearance of the file in question was not an indication that all due care required by the circumstances had been taken at that moment.

c) Ignorance of or erroneous interpretation of a provision of the EPC

In **J 3/88** the board noted that account should be taken of the fact that under Art. 134(1) EPC 1973 the contracting states had in principle confined representation of applicants before the EPO to "professional representatives" who, by virtue of their qualification should guarantee the best possible representation. The board stated that it followed that a representative could not relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fell upon him personally, such as, for example, the interpretation of laws and treaties. If he delegated such tasks to an employee and if the latter made an error in the course of that work which resulted in the failure to observe a time limit, the representative could not claim that he had taken all due care required by the circumstances (see also **J 33/90**).

In **J 31/89** the Legal Board of Appeal confirmed that erroneous interpretation of the EPC **owing to a mistake of law** on the part of the duly authorised representative with regard to the rules for calculating time limits (in the case in point, regarding the late payment of a renewal fee together with the additional fee) could not be excused. The appellant and the representative failed to determine correctly the last date for valid payment of the renewal fee (see **J 42/89, T 853/90, T 493/95, T 881/98**).

In **T 624/96** the board expressed doubts about the nature of the original mistake, which concerned calculation of the time limit for filing the statement of grounds of appeal. This was possibly a "mistake of law" caused by ignorance or misinterpretation of the provisions of the EPC, as in e.g. **J 31/89** or **T 853/90**. The board found that in the circumstances of the case at issue, however, the agent had not made a "mistake of law" of this kind. The agent cited an earlier appeal in which he had represented the same applicant, showing that he indeed had some familiarity with the appeals procedure. He also submitted programmes of training courses, at which he had given talks on European patents and EPO proceedings. It could be therefore be ruled out that a legal error in calculating the period for lodging the statement of grounds of appeal might have arisen from his ignorance of the EPC.

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 representative's interpretation of a legal provision of the EPC was not the result of, and did not lead to, a failure to exercise all due care required by the circumstances. In **T 493/08** the board shared the view expressed in **J 28/92** and stated that there might be exceptions to the rule that an error of law could not be excused, which, however, could be acknowledged only under rigorous criteria.

In **T 516/91** the mistake made by the representative was that he requested **an extension of two months for submitting the grounds of appeal**. The board emphasised that the time limits set by Art. 108 EPC 1973 could not be extended. In mistakenly believing that an extension of these time limits was possible, the representative failed to exercise due care (see also **T 248/91**, **T 853/90**, **T 316/13**).

In **T 460/95** the representative requested an extension of the time limit, although, in his professional capacity, he should have known that time limits under Art. 108 EPC 1973 could not be extended. The board noted that representatives were expected to be acquainted with the provisions of the EPC regarding time limits, and that the representatives in question had not been as vigilant as the situation demanded. In this specific case, however, the representative had taken the precaution of contacting the Registry of the Boards of Appeal beforehand, and had received information from that body which had led him to take action prejudicial to his interests. The board held that appellants should not suffer injury merely because they had relied on **information received from the EPO** which later proved to be mistaken or likely to have been misunderstood.

In **T 881/98**, the appellant's professional representative had written to the Registry of the boards of appeal requesting a two-month extension to a time limit, without giving reasons or indicating that the time limit in question was for submitting the statement of grounds of appeal. He added that if not notified to the contrary he would assume his request was allowed. The board refused the request for re-establishment. The Registry had not fallen short of legitimate expectations, as in this case (in contrast to **T 460/95**) the appellant had not been misled to his detriment by wrong information from the Registry but had himself made the mistake of thinking that the time limit could be extended.

In **T 733/98** the board informed the appellants that the statement setting out the grounds of appeal did not comply with Art. 108, third sentence, EPC 1973. The appellants requested re-establishment in respect of the time limit for filing the statement of grounds, arguing that they had relied on Legal Advice No. 15/84 of the EPO, which had still been in force when they had received the communication under R. 51(4) EPC 1973. The board held that the appellants had misinterpreted the Legal Advice in question, having failed to realise that the procedure for handling main and auxiliary requests which it described no longer applied once amended R. 51 EPC 1973 entered into force. The board decided that the requirement of all due care required by the circumstances was not met in this case.

In **T 744/11** the statement setting out the grounds of appeal was received in electronic form three minutes after expiry of the four-month time limit. The representative argued that his office was based in Cambridge and that, since the clocks in the United Kingdom were one hour behind Central European Time (CET), he had sent the statement of grounds within the time limit. The board could not accept this argument for the simple reason that the relevant time for the purpose of the law was the time at the EPO (i.e. the time at Munich or The Hague) and not the time in the United Kingdom. However, the board considered the appellant's request allowable, in particular because the appellant had shown that the non-observance of the time limit was not caused by lack of due care but rather by a justifiable human error on the part of the representative.

According to **T 316/13**, a European patent attorney is expected to know the EPC provisions concerning the legal remedies available in the event of failure to observe time limits, even if he has never been faced with the problem before, without waiting for the board of appeal to tell him exactly what he needs to do.

d) Starting work on a case close to the expiry of the time limit

In **J 16/92** the board made it clear that anyone getting himself into a situation where he could not be sure of being able to complete the omitted act ran the risk of his request for further processing being ruled inadmissible for failure to complete the omitted act in good time. In this case the representative had not started working on the file until four days before expiry of the time limit for further processing and hence had discovered too late that he was unable to find the first communication to which he was to respond. See also **J 7/12** (where a payment order was transmitted late in the afternoon of the last day of the grace period for paying a renewal fee plus additional fee).

e) Designation of receiving offices

In **J 1/03** the board emphasised the paramount importance of the designation of receiving Offices and the difficulty or even impossibility, in many cases, of correcting wrong or missing designations. Consequently, the benchmark for what "all due care" meant in those cases, was very high. Likewise the check of the content of the international application on the basis of the "Notification of Receipt of Record Copy" issued by the International Bureau had to be made very carefully.

f) Abandonment of application

In **T 1022/14** the board observed that abandonment of an application was a final action with serious consequences if misapplied. Thus for a decision to close a file and to abandon an application the utmost care had to be taken to establish whether the client had without any doubt issued instructions to that effect. The decision to abandon an application had to be taken by the representative himself, on the basis of his own observations and knowledge. This responsibility could not be delegated to employees, as decisions of this kind required the special knowledge of the representative for which he had to assume personal responsibility as a professional.

### 5.5.3 Due care on the part of a non-authorised representative

In determining whether all due care has been taken, the acts of all those persons the appellant has asked to act on its behalf must be considered, which also applies to non-authorised representatives instructed by the appellant (**T 2274/11** with reference to **J 4/07**).

In **J 25/96** the board held that where a US applicant availed himself of the services of a US patent attorney for matters which in relation to the EPO fell within the applicant's responsibility, the US patent attorney had to be regarded as the agent of the applicant. Thus, to meet the "all due care" requirement, the **US patent attorney** had to show he had taken the due care required of an applicant (see also **J 3/88**, **T 1401/05**).

In **J 4/07** the board pointed out that a non-European representative can be held responsible for meeting the obligations of any representative whose duty it is to care for his client's interests, irrespective of whether such representative is entitled to represent before the EPO or any other patent office (see **J 25/96**). The monitoring of specific time limits that were set expressly does not depend on knowledge of EPC law. Thus a non-European representative must also establish a **reliable monitoring system** for such time limits. Furthermore, any representative, whether European or non-European, moving from one law firm to another must take provisions upon entry in that firm that those filed that he carries over are integrated into a time limit monitoring system.

In **J 3/08** the board held that according to the established jurisprudence, if an agent was appointed, the agent had also to observe all due care and if he did not act accordingly this was imputed to the applicant. In the case at issue, it was clear that the agent, by not acting as instructed, had not properly handled the case. According to the board, if **fraud** by an agent were to be accepted as a reason for re-establishment of rights, by derogation from the general principle that an agent's behaviour was imputed to the applicant, the evidence presented must be so conclusive as to convince the board that a fraud took place as opposed to just unprofessional behaviour.

In **T 742/11** the board held that the actions of an agent, who acted as an intermediary between the appellant and the professional representative, must be imputed to the party he is acting for, and the same level of care is expected from the agent as from a professional representative, or at least as from the party itself. Indeed, requiring a certain level of care from a professional representative and a party using his services would become utterly pointless if an intermediary acting between the party and the professional representative were not required to show the same level of care.

### 5.5.4 Due care in dealing with assistants

#### a) Introduction

The case law concerning due care on the part of professional representatives' assistants was established in **J 5/80** (OJ 1981, 343). This key ruling by the Legal Board of Appeal lays down that a request for re-establishment of rights can be acceded to in the event of



a culpable error on the part of the assistant, if the professional representative is able to show that he has **chosen** for the work a suitable person **properly instructed in the tasks to be performed**, and that he has himself exercised reasonable **supervision** over the work (see also **T 191/82**, OJ 1985, 189; **T 105/85**, **T 110/85**, OJ 1987, 157; **T 11/87**, **T 176/91**, **T 949/94**, **T 221/04**, **T 1149/11**, **T 1171/13**).

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 or the applicant (**J 5/80**, **J 33/90**, **J 26/92**, **T 43/96** of 5 July 1996; **T 221/04**, **T 1465/07**, **T 1663/12**). Decision **J 5/80** also pointed out that, if other than **routine tasks** are delegated which normally would fall to the representative by virtue of his professional qualification, the representative would not be able to establish that he exercised all due care (see also **J 33/90** and **T 715/91**). More recent decisions stress that responsibility in every respect passes to the representative as soon as he is presented with the file for processing, and that to that extent he is not justified in relying on an assistant's calculation of a time limit (see in this chapter III.E.5.5.4 e) "Ultimate responsibility of the representative").

For a case where an unrepresented individual applicant has entrusted a third person with the payment of renewal fees and other administrative tasks, see **T 555/08**.

Regarding the **burden of proof** in the form of an adequately detailed statement in connection with the duty of care in the selection, instruction and supervision of assistants, see **J 18/98**.

b) Selection, instruction and supervision

It is incumbent upon the representative to choose for the work a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over the work (**J 5/80**; **J 16/82**, OJ 1983, 262). These duties are incumbent upon him also with regard to **substitutes** for holidays, special leave and other emergency situations. New assistants must be supervised on a regular basis for a period of at least some months (see **J 3/88**, **T 715/91**).

The case law cited above applies equally to a **patent attorney residing in the USA** (or his assistants) if he acts in collaboration with the duly appointed professional representative. In **J 3/88** the US patent attorney of a "non-resident" applicant acted in collaboration with the duly appointed professional representative. The "docket clerks" (assistants of the US patent attorney) were entrusted with the performance of routine tasks such as noting time limits and checking due dates. The board stated that in order to be able to carry out these admittedly rather simple tasks properly, they needed nevertheless some **basic knowledge**. The board concluded that, although no special qualifications were required, it was fairly impossible for a docket clerk to perform these routine tasks satisfactorily without having previously been given appropriate instruction and being supervised closely until he was familiar with the job. A reasonable **supervision** of the activity of a newly engaged docket clerk implied that his work be periodically checked. In order to be effective and avoid culpable errors, these periodic

checks should not be initiated mainly by the docket clerk on the occasion of his alerting the patent attorney in charge to a coming due date, but should rather be performed systematically irrespective of such alerts, at least during an initial training period of several months. These checks should be aimed at making sure that, especially in consideration of subsequently received fees reminders, the index cards were accurately updated.

In **T 191/82** (OJ 1985, 189) the non-payment in due time of an additional fee was found to be clearly attributable to an unfortunate concatenation of errors by nevertheless properly selected and experienced employees.

In **J 12/84** (OJ 1985, 108) the due care required in the circumstances was not observed when the **employees of another company** were instructed to sign for registered mail addressed to the representative, as he was not able to supervise the work of such persons not employed by his firm.

In **T 309/88** the board stated that even employees **without formal training** as patent attorney's assistants could perform the task of recording and monitoring time limits. This was routine work which did not require specialised knowledge and professional qualifications. However, the assistant had to be properly instructed in the tasks to be performed and a trained employee had to be on hand to give advice.

In **J 26/92** the board noted that according to the case law of the boards of appeal, routine tasks could be entrusted to an assistant provided that the necessary due care on the part of the representative had been exercised in dealing with the assistant. In this respect, it was incumbent upon the representative to choose for the performance of routine tasks a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over their work.

In **T 949/94** the board stated that a representative was expected to exercise a reasonable supervision over the work delegated. This did not mean that he had to supervise the posting of every letter. Once he had signed a letter and ordered his secretary to post it, he was entitled to assume that it had been posted. In the light of that, the board was satisfied that the representative had exercised due care in dealing with his secretary (**J 31/90**, **T 1171/13**).

In **T 1062/96** the board found that the **posting** of a letter prepared and signed by the representative was a **typical routine task** which the representative could entrust to an assistant (see also **T 335/06**). In the case in question the assistant was expressly instructed to send the letter by fax on the same day. In a properly organised office the representative could rely on the correct execution of such an instruction. The sending of the fax did not require any specialised knowledge or qualification. Therefore, the assistant, here a secretary, who had proven to be reliable in the daily work of the representative's office, could have been expected to do this job within her own responsibility. Since the order was to be carried out more or less immediately, a later check whether the fax had actually been despatched was not necessary.

In **T 1465/07** the board considered the obligations of the representative in dealing with assistants developed by the case law of the boards to be fully compatible with the **principle of proportionality**. In the case at issue the secretary of the representative had previously worked for another partner and after her taking up her new job the **instructions** given in relation to the backup check consisted in little more than the order to continue to perform that check in the same way as she had done in her former position. The board considered that this was insufficient and that she required **supervision** at shorter intervals during the period immediately following her taking up the new job. Requiring such supervision was not only appropriate and necessary but also not disproportionate, as supervision does not require a substantial amount of time.

In **T 1764/08** the board held that filing an admissible appeal was not a routine task, but rather a complicated task which needed clear instructions from the professional representative to his assistant. In the case at issue, however, there was no evidence on file as to whether the assistant received instructions from the appellant's representative to send the statement of grounds of appeal to the EPO, and if so, what instructions.

In **T 1149/11** the board held that if a representative of an applicant delegated tasks to an assistant, the representative carried the duty of care concerning the proper selection, instruction and supervision of the assistant. This responsibility lasted as long as delegation of tasks was given. The duty of care concerning supervision of the assistant required that an effective cross-check was implemented, at least in a firm where a large number of time limits have to be monitored. This was particularly so in the case at issue because the nature of the time limit concerned required particular care. In fact, the time limit for filing a notice of appeal and paying the appeal fee pursuant to Art. 108 EPC was absolutely critical because, if it was missed, there was no further ordinary remedy and the contested decision had legal effect (see also **T 439/06**, OJ 2007, 491).

In **T 555/08** the board found that the requisite standard of due care was not met by uncritically accepting the accuracy of an **assistant's oral statements** although they must have been open to doubt (see **T 602/94**). Failure to query or check such statements had to be viewed in the context of the obligation to supervise assistants. Especially where there were signs that mistakes might have been made, it was essential to check whether assistants were correctly performing the duties assigned to them.

In **T 2336/10** the board held that the representative did not appear to have issued proper instructions as regards the correct way to deal with the time limit for filing a **statement of grounds of appeal**. An assistant to whom that task was entrusted had to be instructed to work on the assumption that, once the notice of appeal had been filed and the appeal fee paid, a statement of grounds of appeal would in principle have to be filed within the four-month time limit laid down in Art. 108 EPC.

c) Technically qualified assistant

In **T 715/91** the board held that the consequences of an error by a technically qualified assistant (an engineer training for the European qualifying examination) imputed to the representative would also have to be borne by the appellants. The task of writing, or at

least supervising, the despatch of important submissions, such as grounds of appeal, would normally fall to the representative himself. Furthermore, given that the assistant had only recently been taken on, the representative could not be expected to have been able to ascertain in such a short time to what degree the assistant did know the rules and regulations of the EPC.

In **T 828/94** the board found *inter alia* that the technical assistant in charge was not supervised well enough and had not been properly instructed.

Referring to the required standard in exercising due care, the board decided in **T 832/99** that a technical employee working in a firm of patent attorneys was not an assistant but was carrying out *de facto* the work of a patent attorney. This meant that the **same strict requirements** for due care would have to be applied to the technical employee as were applied to the appellant and the appellant's representative.

d) Substitutes replacing assistants

In **J 16/82** (OJ 1983, 262) the board stated that the conditions relating to assistants also applied in the case of a substitute replacing an assistant who was on holiday, ill or otherwise absent. It was a commonly experienced fact of life that assistants did have to be temporarily replaced from time to time. Where a qualified assistant was absent, therefore, the applicant or representative had either to be able to call on a similarly qualified substitute or else himself to take over the work assigned to the assistant. The **same standard of care** had to be exercised as regards the choice, instruction and supervision of the substitute as of the assistant himself (**T 105/85**).

e) Ultimate responsibility of the representative

In **J 25/96** the statement of grounds for the request for re-establishment of rights explained *inter alia* that non-observance of the time limit had been caused by the assistant entrusted with monitoring time limits. The board held that the case law according to which a representative could entrust suitably qualified and supervised personnel with monitoring time limits had been developed for routine tasks and normal cases. It did not mean that a representative could also entirely leave such staff to monitor cases which (i) were **particularly urgent**, (ii) needed **particular attention** and further steps by the representative himself to ensure that the necessary acts were still performed in time, (iii) could result in an **irrevocable loss of rights** if any error or delay occurred.

In **T 719/03** the board did not accept the appellant's argument that the failure to comply with the time limit had been an isolated mistake by the qualified secretary who had noted on the cover page of the revocation decision only the time limit for appeal but not also the time limit for filing the statement of grounds of appeal. The board held that the appellant's representative had himself failed to exercise due care, since the contested decision had been shown to him twice without his noticing the incompleteness of the note concerning the mandatory time limit that had to be monitored. The board took the view that, with **careful handling** of a dossier involving statutory time limits, the

representative was so often faced with the time limits to be observed that **compliance with the time limit was ensured**.

In **T 439/06** (OJ 2007, 491), concerning the necessary "due care" required from the representative, the board emphasised that fulfilling the requirements of proper selection, instruction and supervision only meant that the assistant's error in dealing with the delegated task cannot be imputed to the representative. It does not mean that with the proper selection, instruction and supervision of the assistant the representative's responsibility ends there once and for all, and that he need not take further care with respect to the delegated task (see also **T 1149/11**). What all due care calls for depends on the specific circumstances of the case. It is not necessary to perform a triple check from the outset, once such a decision is received in the representative's office and when the time limit is noted. This still belongs to the administrative treatment of the file where the representative does not yet need to be involved if he has installed a satisfactory system. However, once the representative gets the file on his desk for his own action, in order to comply with the relevant time limit, responsibility passes over to him in all respects. All due care under these circumstances requires the representative to verify the time limit calculated by his records department when he receives the file for dealing with it. He cannot simply rely on having delegated this task once and for all to his records department (see also **J 1/07**; **T 719/03**; **T 473/07**).

Likewise in **T 1561/05** the board held that the representative was personally at fault in failing, when signing the statement of grounds for appeal, to check the calculation of the time limits by his support staff and therefore to notice that the calculation was wrong. A task forming part of the representative's **core duties**, such as performing a **final check** when signing a submission which is subject to a time limit, cannot be delegated in a way that absolves the representative of responsibility.

In **T 1095/06** the board stated that a professional representative could not be required to double-check every action by an assistant. If the professional representative failed to act because he had not received a reminder due to some error of a properly chosen, properly instructed, and reasonably supervised assistant this could be regarded as "an isolated error in an otherwise satisfactory system" which would still allow re-establishment to be granted. However, a professional representative must be presumed to be **supervising his own work continuously**. The case law on "an isolated mistake in an otherwise satisfactory system" could not be relied on to ignore a failure to act by the professional representative himself, unless there were special circumstances which made the failure to act compatible with taking all due care.

In **T 592/11** the board held that, where a double check was carried out by the representative and an assistant, the former was liable for any negligence in performing his own part of this check. This was because, where double checks were carried out by assistants only, the representative had to perform an additional, third check (see **T 439/06**, **T 1561/05**). If, however, they were carried out by an assistant and the representative himself, the latter had to be subject to the same standard of care with respect to his part of the check. An isolated mistake by a professional representative in performing his check was then - as a rule at least - inexcusable.

In **R 18/13** two "isolated" mistakes had been made, one by the professional representative, the other by his assistant. The Enlarged Board considered the travaux préparatoires and found that an "isolated mistake", such as assistants might make, was not excusable in a representative. If he was given a file to deal with, he could not simply assume that his assistants had reliably done all their work on it so far; he had to make sure, through appropriate control mechanisms before the file reached him, that time limits arising were complied with, or – at the latest when he was given the file to deal with – check for any time limits himself. The request for re-establishment was refused.

#### 5.5.5 Due care in using mail delivery services

In decision **T 667/92** the board considered whether the appellant could be said to have taken all the due care required by the circumstances when allowing only two days for delivery from the UK to Germany and whether, in these circumstances, the choice of using a special carrier for the delivery was in keeping with the due care requirement. The board pointed out that a party who missed a time limit had also to show due care in its **choice of method of delivery** and that the use of outside agents might be held against the applicant under Art. 122 EPC 1973 owing to a lack of proper safeguards. The board added that in parallel situations telefaxing should preferably be used. The board took into account the very extraordinary circumstances regarding the withholding of the item by the customs in Munich for 36 hours, an incident which could not reasonably be foreseen, and allowed the request.

In **T 381/93** the problem arose from the failure of the private courier service to deliver the package containing the corresponding documents to the EPO as instructed. In deciding on due care, the board referred to decision **T 667/92**, in which it was stated that a party who had missed a time limit had also to show due care in its choice of method of delivery. The board held that once a reliable carrier had been chosen and commissioned for the delivery, a party was entitled to rely on them, provided that the party had given all the necessary and proper instructions to the carrier.

If a party to proceedings requests re-establishment of rights on the basis that a document missed an EPO time limit because it did not arrive within the **standard delivery time**, that party will have to prove that the form of postage used would normally have ensured that the document would reach the EPO on time. The board left out of account the question of whether a party who relies on the usual delivery time has exercised all due care with regard to the time limit (**T 777/98**, OJ 2001, 509).

## 6. Procedural treatment of requests for re-establishment

### 6.1. Department competent to decide upon the request

The department competent to decide on the omitted act shall decide upon the application (R. 136(4) EPC, Art. 122(4) EPC 1973).

The boards of appeal are competent to decide on the request for re-establishment in respect of the time limit for filing a **notice of appeal** (Art. 108 EPC), since the

department competent to decide whether the appeal was inadmissible for non-compliance with Art. 108 EPC is, under R. 101(1) EPC, the board of appeal (**T 1973/09**, **T 808/03**, **T 949/94**, **T 473/91**, OJ 1993, 630). The boards of appeal are also competent to decide on the request for re-establishment in respect of the time limit for filing the written **statement setting out the grounds of appeal (T 624/96)**.

While this competence in relation to admissibility of an appeal is subject to the exception of Art. 109(1) EPC (interlocutory revision), this provision confers only the limited power to set aside the department's own decision if the appeal was considered admissible **and** well founded (**T 808/03**, **T 1973/09**). The admissibility of an appeal under Art. 109 EPC only falls under the jurisdiction of the department of first instance when this question can be decided immediately on the basis of the appeal submissions themselves (notice of appeal and statement of grounds, date of payment of the appeal fee). The boards of appeal have exclusive jurisdiction over a request for restitutio in respect of a time limit relating to the appeal itself (**T 473/91**, **T 949/94**, **T 65/11**).

In **T 555/08** loss of rights (deemed withdrawal of the application due to non-payment of a **renewal fee**) occurred **while appeal proceedings were pending**. When appeal proceedings start, responsibility for the case passes from the department of first instance to the boards of appeal (the devolutive effect, see **T 473/91**, OJ 1993, 630). Hence in the case in point jurisdiction to decide on the request for re-establishment lay with the board hearing the pending appeal (see **T 191/82**, OJ 1985, 189; **T 936/90**; **T 708/08**; **T 1935/08**).

In **T 1381/11** the board referred to **T 555/08** and held that a loss of rights due to the non-payment of renewal fees automatically terminated the appeal proceedings. The issue of whether or not an appeal was pending was therefore directly linked to a request for re-establishment of rights regarding failure to pay the renewal fee made at the appeal stage. The formalities officer should therefore have acted on behalf of the board of appeal rather than the examining division, before which the case was no longer pending. The board thus took the view that it had jurisdiction to decide over the request for re-establishment of rights according to Art. 111(1), second sentence, EPC (see also **T 649/13**).

In **W 3/93** (OJ 1994, 931) the board held that as the board had to decide on the protest, it was also competent to examine the request for re-establishment of rights (Art. 122(4) EPC 1973).

In **J 22/86** (OJ 1987, 280) the board stated in relation to the failure to pay **grant and printing fees** and to file translations that the examining division was in the first instance competent to decide upon such omitted act. However, in view of the special circumstances of this case, the board decided, pursuant to Art. 111(1) EPC 1973, to exercise the power of the examining division to decide upon the application for restitutio (see also **J 9/86**).

In **T 26/88** (OJ 1991, 30) the appellant failed to comply with the request (pursuant to R. 58(5) EPC 1973) to pay the printing fee and to file translations of the claims within

three months of notification of the request. The board found that the circumstances of decision **J 22/86** were quite different from the case at issue and justified the exceptional exercise of the power of the examining division to decide on the application for re-establishment. In the case before the board the **opposition division's formalities officer** was responsible (see also **T 522/88**).

In **J 10/93** (OJ 1997, 91) the Legal Division not only decided on the request for recording the transfer of a patent application, for which it was competent according to Art. 20(1) EPC 1973, but also dealt with the appellants' application for re-establishment of rights which it rejected as inadmissible. Since the omitted act was the applicants' failure to reply to a communication of the examining division issued pursuant to Art. 96(2) EPC 1973, the department competent to decide on the application for restitutio was the **examining division** (Art. 122(4) EPC 1973). The board set aside the decision finding that the Legal Division had exceeded its powers. It stated that this could not be justified by any need to decide on the request for restitutio as a preliminary issue to be answered before examining the request for registering the transfer.

In **J 23/96** the examining division had informed the applicant that the request for re-establishment would be decided once the decision under R. 69(2) EPC 1973 was final, or during any ensuing appeal. Before the board, the applicant suggested that the board decide on the request for re-establishment. The board refused to decide on the request for re-establishment because it was not the "competent department" within the meaning of Art. 122(4) EPC 1973. The competent department was the examining division.

## **6.2. Request for re-establishment as auxiliary request**

In **J 23/96** the applicant had applied for a decision under R. 69(2) EPC 1973 (R. 112(2) EPC) and, as an **auxiliary request**, asked for re-establishment of rights. The examining division issued a brief communication saying that the request for re-establishment would be decided once the decision under R. 69(2) EPC 1973 was final, or during any ensuing appeal. The board noted that auxiliary requests were filed in case the main request was refused; they then took its place and had to be dealt with in the **same** decision. The course taken by the examining division was at odds with procedural economy, and might also oblige the applicant to appeal twice. This amounted to a substantial procedural violation (see also **J 1/80**). The board referred the matter back, without considering the merits, for the division to decide on the two requests together.

## **6.3. Parties to re-establishment proceedings and the right to be heard**

In **T 1561/05** the board held that in the context of inter partes proceedings, the patent proprietor and the opponent were also parties to the re-establishment proceedings. The party contesting the request has an unlimited right to be heard under Art. 113 EPC 1973.

In **T 552/02** the board held that the response to be given to the application for re-establishment was of the utmost importance for the respondents, as it affected the actual admissibility of the appeal and hence the reviewability of the opposition division's decision to revoke the patent in suit. From this the board deduced that it would be a



breach of Art. 113(1) EPC 1973 to take a decision concerning the interests not only of the appellants but also of the respondents without giving the latter an opportunity to present comments.

#### **6.4. Concurrent request for interruption of proceedings**

In **J ..87** (=J 902/87, OJ 1988, 323) the board decided that, in accordance with R. 90 EPC 1973 (R. 142 EPC), which the EPO must apply of its own motion, the legal incapacity of an applicant or his representative has the effect of interrupting proceedings and, where appropriate, the one-year time limit referred to in Art. 122(2) EPC 1973 (now R. 136(1) EPC).

In **T 315/87** the board stated that, in case a request for interruption was filed together with a request for re-establishment, preference should be given to the application of Art. 122 EPC 1973, under which less severe impairment could also be grounds for re-establishment of rights. The question of any interruption of proceedings under R. 90 EPC 1973 could be left open provided that all the losses of rights which had occurred could be overcome by *restitutio in integrum*.

In **J 9/90** the Legal Board of Appeal held that for R. 90(1)(b) EPC 1973 (interruption of proceedings because of insolvency) to be applied in the light of Art. 60(3) EPC 1973 (unchanged) and R. 20(3) EPC 1973 (R. 22(3) EPC), the applicant entered in the Register of European Patents and the insolvent person (here, a limited company) had to be **legally identical**. However, the fact that the persons involved were not identical did not necessarily rule out re-establishment of rights under Art. 122 EPC 1973. Someone who was only indirectly affected by an event, such as insolvency, could be "unable" within the meaning of Art. 122(1) EPC 1973. In such a case however the persons so affected had to prove that they had exercised all the due care that could have been expected of them in the circumstances of such an insolvency.

#### **6.5. Re-establishment in the context of the President's extension of time limits during general disruption**

In **T 192/84** (OJ 1985, 39) it was held that if the President of the EPO extended time limits expiring during a period of general interruption in the delivery of mail in a contracting state (R. 85(2) EPC 1973; now R. 134 EPC, reworded), a pending application for re-establishment of rights considered to have been lost during that period, which had been filed by a representative having his place of business within that state, had to be deemed to have been made without purpose *ab initio*, even though the non-observance of the time limit was due to causes other than the interruption in the delivery of mail. Accordingly, it could be declared that no rights were lost and the fee for re-establishment of rights could be refunded.

#### **6.6. Redundant request for re-establishment**

In **T 1198/03** the respondent (opponent) sent his reply to the appellant's statement of grounds of appeal one day late and requested that, if the board did not otherwise

consider the reply, he be re-established into **the time limit for filing the reply**. The board decided to consider the respondent's reply. The request for re-establishment was therefore redundant.

In **T 2317/13** the board held that the re-establishment request was redundant since the delay in filing the statement of grounds of appeal had been only of minutes and the lateness of the filing was truly minimal (the first four pages of the statement of grounds were in fact received before the time limit expired). According to the board, the discretion given to the board by Art. 13(1) RPBA to admit and consider late-filed submissions which amended a party's previously filed written case extended to the late admission and consideration of the written case itself (see **T 1198/03**).

## 7. Rights of use under Article 122(5) EPC

In **J 5/79** (OJ 1980, 71) the board stated that according to Art. 122(6) EPC 1973 (Art. 122(5) EPC), third party rights of use arose only where the restoration related to an already **published European patent application** or a European patent; those whose commercial interests were at stake should be entitled to be sure that protection, the existence of which was public knowledge, and which had fallen into the public domain, no longer had effect. In the case at issue, the restoration related to an application that was unpublished at the material time, so on that ground alone there could be no third party rights of use. In addition, the restoration of rights had not been **made public**. Third party rights to continue use of an invention where an applicant's rights have been lost and restored cannot arise if the loss and restoration of the applicant's rights occur before publication of the European patent application.

## 8. Principle of proportionality

In **T 111/92** the statement of grounds of appeal had been filed two days late due to an error of calculation of the due date on the part of the representative. The board held that the mistake in calculating the ten-day period due to human error at a time when the person in question was under pressure was an isolated mistake in an otherwise satisfactory system. The board referred to the principle of proportionality and stated that, in accordance with general principles of law, as applied in the context of administrative law, a procedural means used to achieve a given end (e.g. a sanction following a procedural non-compliance) should be no more than that which is appropriate and necessary to achieve that end. Bearing the principle of proportionality in mind, the loss of the patent application because of the procedural irregularity which has occurred in the case at issue would be a severe result. Moreover, the interests of any third party misled within the meaning of Art. 122(6) EPC 1973 by the fact that the statement of grounds of appeal was filed two days late would be protected by Art. 122(6) EPC 1973. The board allowed thus the application for re-establishment (see also **T 869/90**, **T 635/94**, **T 804/95**, **T 27/98** and **J 22/92**).

In **J 44/92** and **J 48/92** the boards noted that the principle of proportionality **only** applied **in borderline cases, in support of other grounds** already substantiating to a certain extent the allowance of the appeal. Usually it had been applied where a time limit had

been missed by one or two days due to some miscalculation (see below). The board considered that the principle of proportionality did not assist the appellant as there had been a major system fault, which could not be excused by reliance on the principle of proportionality.

In decision **T 971/99** and **T 1070/97** the boards stated that Art. 122(1) EPC 1973 **did not leave any room for the application of the principle of proportionality**, so that the number of days by which a time limit had been missed was irrelevant for deciding whether all due care was applied or not. Only the character of the conduct before the time limit expires was decisive for the consideration of the issue of due care, not the length of the ensuing delay (see also **T 439/06**, OJ 2007, 491; **T 1561/05**; **T 1465/07**).

In **T 1465/07** the board interpreted Art. 122 EPC 1973 in the context of the right of access to a court taking into account the case law of the European Court of Human Rights and the European Court of Justice. The principle of proportionality applies to limitations of the right of access to the boards of appeal, such as rules on time limits, by legislative measures or their application. This means that those measures or their application must not exceed the limits of what is appropriate and necessary in order to attain the objectives legitimately pursued by the legislation in question; when there is a choice among several appropriate measures or ways of applying them recourse must be had to the least onerous, and the disadvantages caused must not be disproportionate to the aims pursued. As for the application of Art. 108 EPC 1973 in conjunction with Art. 122 EPC 1973, the principle of proportionality has the consequence that the interpretation of those provisions must not impose means that are inappropriate, unnecessary or disproportionate in relation to the aim to be achieved, namely legal certainty and the proper administration of justice by avoiding any discrimination or arbitrary treatment. Correspondingly, the **conditions for granting re-establishment**, in particular the requirement of due care, **must not be interpreted in an excessive manner** that unreasonably restricts access to the board and thus prevents the board from deciding on the merits of the case.

In **J 8/09** the appellant had failed to pay a renewal fee and requested re-establishment of rights. He put forward the principle of proportionality, citing the fact that a company was already producing the system to which the application related and that the consequence of a single late payment of the renewal fee would be disproportionate. The board rejected this argument. The principle of proportionality could be defined as a duty for a court or an administration to find a balance between a party's error and the legally ensuing consequences when a margin of weighing the importance of the circumstances existed (see **J 5/97**). However, when the boards of appeal referred to the principle of proportionality in the case law, it was never as a main ground but in support of other grounds already substantiating, to a certain extent, the allowability of the appeal especially when a reliable system for managing the time limits and an isolated mistake within such a system could be assessed (see **J 44/92** and **J 48/92**).

In **J 13/11** the Legal Board stated that the time limits in the EPC aim to serve legal certainty and the proper administration of justice by avoiding any discrimination or arbitrary treatment (see also **T 1465/07**, **T 592/11**). The severe consequence of a loss of

a patent application in the case at issue could not be considered in isolation but had to be assessed against the values of legal certainty and proper administration of justice that are embodied by the time limits appropriate to Art. 122 EPC. The application of the principle of proportionality would empty the time limits of Art. 122 EPC of any content and would make the provisions of this article uncertain. In addition the boards of appeal do not have the power to apply provisions of the EPC *contra legem*, that is contrary to their unambiguous meaning and purpose.

## 9. Refund of the fee for re-establishment

In **J 7/93** the EPO did not tell the appellant to ignore its previous communications issued in connection with a time limit supposed to be missed; this would have enabled the appellant to recognise that its request for re-establishment was unnecessary. Instead, the EPO continued the proceedings for re-establishment of rights and finally refused *restitutio* without taking into account the fact that these proceedings had been unnecessary from the very beginning. The board found that this amounted to a substantial procedural violation within the meaning of R. 67 EPC 1973. The board held that it was equitable to order reimbursement of the appeal fee, even though the appellant had not applied for this (**J 7/82**, OJ 1982, 391). The board held that since there was no longer any legal ground to request re-establishment of rights, the fee for re-establishment was wrongly accepted by the EPO and, therefore, had to be refunded to the appellant (confirming **J 1/80** and **T 522/88**).

In **T 1198/03** the respondent (opponent) sent his reply to the appellant's statement of grounds of appeal one day late and requested that, if the board did not otherwise consider the reply, he be re-established into **the time limit for filing the reply**. The board decided to consider the respondent's reply. The *restitutio* request was therefore **redundant**. Distinguishing the present case from other cases, where an application for re-establishment of rights was equally redundant but the boards did reimburse the corresponding fee, the board stated that, in the case before it, *restitutio* was not, as a matter of principle, applicable as a remedy, and that in such a situation a party should not be able to reap cost benefits from the redundancy of a *restitutio* request filed on an auxiliary basis. Otherwise parties might be encouraged to file such inapplicable requests.

In **T 2317/13** the board held that the re-establishment request was **redundant** since the delay in filing the statement of grounds of appeal had been only of minutes and the lateness of the filing was truly minimal. The board decided to reimburse the fee for re-establishment. It compared the case with the one in **T 152/82** (OJ 1984, 301), in which the fee had been reimbursed after it became apparent that the re-establishment request would not have become effective.

In contrast, in **T 971/06** the **Office had committed mistakes** which caused the request for re-establishment. As the appealed decision of the examining division did not comply with Art. 97(2) EPC 1973, it was considered invalid by the board. The examination should therefore have been re-opened without an appeal. Furthermore, the appellant was misled by the examining division for several months as to the procedure for remedying the mistake. When the examining division finally issued a communication

refusing its request to correct the decision, the appellant filed an appeal, a statement of grounds of appeal and requests for re-establishment. The board considered these requests unnecessary, but an understandable reaction. It found that the fees paid in respect of these requests had to be refunded.

In **T 46/07**, the board found that, if the fee for re-establishment of rights is paid after expiry of the two-month period laid down in Art. 122(2) EPC 1973, the application for re-establishment of rights does not come into existence and therefore the fee must be refunded even without a respective request.

In **T 2454/11**, the board observed that, in earlier board decisions taken in the light of **G 1/86**, requests from an **appealing opponent** for re-establishment of rights had been regarded as "devoid of purpose" or "not validly filed" and the fee refunded (see e.g. **T 520/89**, **T 266/97**). The board endorsed the view taken more recently in **T 1026/06** that the fee was not refundable. It could only be reimbursed if it had been paid for no legal reason or if a refund was required by a legislative provision. Under Art. 122(3) EPC, a request for re-establishment of rights was not deemed to be filed until the fee had been paid, so payment was required for the request to have effect. There had therefore been a legal reason for its payment and there was no provision requiring a refund.

In **T 2017/12** (OJ 2014, A76) the appellant had missed the time limits for filing the appeal and the statement of grounds of appeal. It had **paid the fee** for re-establishment of rights **twice**, once for each missed time limit. The board refused the request for refund of one of the fees. There were no explicit provisions in the EPC dealing with the case in which several time limits had been missed. This was an indication that each time limit had to be considered separately and that, in the absence of any hint to the contrary, for the number of fees to be paid the number of missed time limits was decisive. In line with decision **J 26/95**, the board considered that the corresponding time limits expired independently of one another, notwithstanding the fact that they were triggered by the same event. In addition, the failure to meet either of these time limits individually results in a loss of the right to appeal. Failure to comply with either one of the two time limits would cause the appeal to be rejected as inadmissible, provided that the appeal fee was paid. Consequently, two fees for re-establishment were indeed due and hence a refund of one of those fees was not possible.

## F. Languages

1.	Language of filing and date of filing of a European patent application	646
2.	Language of the proceedings	647
3.	Derogations from the language of the proceedings in written proceedings and in oral proceedings	647
4.	Language privilege	649
5.	Translations	649
6.	Language-related fee reductions	651
6.1.	European patent application	651
6.2.	Request for examination	651

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The central provisions of the language regime of the EPC are to be found in Art. 14 EPC and R. 3 to 7 EPC.

Attention is also drawn to the Guidelines for Examination, A-VII and E-IV – November 2015 version.

### 1. Language of filing and date of filing of a European patent application

Art. 14(2) EPC requires that a European patent application is filed in one of the official languages of the EPO - i.e. English, French or German (Art. 14(1) EPC) - or, if filed in any other language, translated into one of the official languages. It is therefore possible to file an application in any language, in compliance with Art. 5 PLT, which states that, for the purpose of obtaining a filing date, a description of the invention in a language of the applicant's choice must be accepted (see also R. 40(1)(c) EPC). If a required translation is not filed in due time (see R. 6(1), 36(2), 40(3), 57(a), 58 EPC), the application shall be deemed to be withdrawn (Art. 14(2) EPC; cf. Art. 90(3) EPC 1973 and **J 18/01**).

Under the former law, a European patent application could only be filed in an official EPO language (Art. 14(1) EPC 1973) or, by persons benefiting from the "language privilege", in an official language of a contracting state other than English, French or German ("admissible non-EPO language"), with a translation to be filed in an official EPO language (Art. 14(2) EPC 1973; see also **J 15/98**, OJ 2001, 183; **J 6/05** and **J 9/01**). To be accorded a date of filing, an application had to contain one or more claims, in addition to a description, in one of the languages referred to in Art. 14(1) and (2) EPC 1973 (Art. 80(d) EPC 1973; see also **J 18/96**, OJ 1998, 403 and **J 22/03**). For the current scope of the "language privilege" see Art. 14(4) EPC and R. 6(3) - (7) EPC and also in this chapter III.F.4-6.

In **J 7/80** (OJ 1981, 137) the Legal Board held that where documents making up an application were partly in an official language of the EPO and partly in another language which was an official language of a contracting state, then, for the purposes of deciding whether the application complied with Art. 14(1) or (2) EPC 1973, in accordance with

Art. 80(d) EPC 1973, the significant language was that used for the description and claims. Other documents making up the application should normally be corrected by translation into that language.

In **T 382/94** (OJ 1998, 24) the board held that if the drawings were filed in full on the date of filing, they formed part of the application as filed, even if they contained text matter in an official language other than the language of the proceedings. There was nothing to prevent the application being amended on the basis of a translation of this text matter into the language of the proceedings.

## **2. Language of the proceedings**

The official language in which the application is filed or into which it is translated is the language of the proceedings in all proceedings before the Office, unless the Implementing Regulations provide otherwise (Art. 14(3) EPC).

In **G 4/08** (OJ 2010, 572) the Enlarged Board of Appeal ruled that if an international application has been filed and published under the PCT in one official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into one of the other two EPO official languages.

## **3. Derogations from the language of the proceedings in written proceedings and in oral proceedings**

Under R. 3(1) EPC (R. 1(1) EPC 1973) any party may use any EPO official language in written proceedings.

In **T 706/91** the appeal had been drawn up in accordance with R. 1(1) EPC 1973 in one of the official languages, namely German. The appellant had therefore cited passages from the disputed European patent's claims and description in that language, even though they had been drawn up in French as the language of the proceedings. The board decided that these references were admissible.

In **G 4/08** (OJ 2010, 572) the Enlarged Board of Appeal clarified that EPO departments cannot use, in written proceedings on a European patent application or an international application in the regional phase, an EPO official language other than the language of the proceedings used for the application under Art. 14(3) EPC (thereby overruling **J 18/90**, OJ 1992, 511).

R. 4(1) EPC (cf. R. 2(1) EPC 1973) allows any party to oral proceedings to use an official language of the EPO other than the language of the proceedings, provided he either gives the EPO at least one month's notice or arranges for interpreting into the language of the proceedings. Under R. 4(5) EPC the EPO must, if necessary, provide at its own expense interpretation into the language of the proceedings, or, where appropriate, into its other official languages, unless such interpretation is the responsibility of one of the parties.

In **T 34/90** (OJ 1992, 454) the respondent did not give notice that he wished to use another official language in the oral proceedings and also failed to provide interpretation. 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. The board reiterated the principle that appeal proceedings are not a mere continuation of first-instance proceedings, but are, for the purpose of deciding the permissibility of using an alternative official language under R. 2(1) EPC 1973 (R. 4(1) EPC), as for other procedural purposes, wholly separate and independent from those. Accordingly, the respondent's attempt to use the other language, without fulfilling the requirements of R. 2(1) EPC 1973 as they applied to the pending appeal proceedings, was rejected.

See also the communication from the Vice-President of DG 3, OJ SE 3/2007, 118.

In **T 774/05** the board stated that R. 2(1) EPC 1973 (R. 4(1) EPC) implied that a party could choose to use one of the official languages set out in Art. 14(1) EPC 1973 and was entitled to speak and hear that language. However, a party had to be clear as to which official language it wished to use. The party then had a right to both speak and hear in that language, so long as the conditions of R. 2(1) EPC 1973 were fulfilled. The party did not, however, have a right to have a language in which it would speak and a different language in which it would listen.

In **T 418/07** the respondent announced that it would use German at the oral proceedings (language of the proceedings being English) and requested the board to provide translation from German into English for the benefit of one of its employees who would attend the oral proceedings and who did not speak German. The board acknowledged the right of any party to use any of the three official languages in oral proceedings, but stated that the right to interpreting from either of the two other languages was circumscribed by R. 4 EPC. A party which elected to use a language which was not understood by one of its own representatives or employees could not for that reason request a free translation. The board could not provide translation merely to suit the convenience of a party.

In **T 2422/10** the board rejected the respondent's argument that it had an absolute right to interpreting into English as the language of the proceedings. The general rule needed to be set against the principle of efficiency of the proceedings and the duty of all services of the EPO, including the boards of appeal, to observe the finances of the EPO. The wording of R. 4(5) EPC allowed the board to assess the necessity of such interpreting (cf. **T 131/07**). It was evident that the respondent's representative was quite capable of understanding any oral submissions of the appellant in German without interpretation.

The respondent was also accompanied by an expert, whom the board decided not to hear following the criteria of **G 4/95** (OJ 1996, 412). In these circumstances the board considered that interpretation into English for the expert at the expense of the EPO would not be justified. Accompanying persons did not have an automatic right to it.



The matter of the language arrangements in oral proceedings in relation to an accompanying person also arose in **T 131/07** and **R 3/08** (for the latter see under chapter IV.F.3.13.18).

For a case which concerns the discretion given to the EPO under R. 4(1), last sentence, EPC to derogate from the provisions of this Rule, see **T 982/08**.

On the costs of interpreting during oral proceedings see further III.C.5.2.

#### **4. Language privilege**

According to Art. 14(4) EPC, natural or legal persons having their residence or principal place of business within the territory of a contracting state having a language other than English, French or German as an official language, and nationals of that state who are resident abroad, may file documents which have to be submitted within a given time limit in an official language of that state (these languages are sometimes referred to as "admissible non-EPO languages"). A translation in an official EPO language must also be filed (see R. 6(2) EPC). The scope of the fee reductions available in respect of documents filed in accordance with Art. 14(4) EPC has been limited with effect from 1 April 2014 (see in this chapter III.F.6). For the language provisions with respect to the filing of the European patent application itself, see in this chapter III.F.1.

The board in **T 149/85** (OJ 1986, 103) decided that it is inadmissible for a German opponent to file an opposition in Dutch even if represented by a Dutch patent attorney.

In **T 1152/05** the notice of appeal was filed in Dutch by a company which had its principal place of business in the US and thus could not benefit from the provisions of Art. 14(4) EPC. A translation into French was filed on the same day. The notice of appeal was deemed not to have been filed. Following **G 6/91** (OJ 1992, 491), if the translation was filed at the same time as the original, the EPO could not take it as the "official" notice of appeal and ignore the original as superfluous. See also **T 41/09** and III.A.3.2.1.

#### **5. Translations**

Concerning the filing of a required translation of a European patent application, see in this chapter III.F.1.

Under Art. 14(4) EPC, if any required translation of a document filed in accordance with that provision is not supplied in due time (see R. 6(2) EPC), the document is deemed not to have been filed (cf. Art. 14(5) EPC 1973).

In **T 323/87** (OJ 1989, 343), the translation required under Art. 14(4) EPC 1973 was not filed in due time in accordance with R. 6(2) EPC 1973. The notice of appeal was therefore deemed not to have been received (Art. 14(5) EPC 1973), and the appeal was held not to have been filed. See also **T 193/87** (OJ 1993, 207), which concerned a notice of opposition.

However, in **T 126/04** the board did not follow **T 323/87** with respect to the legal consequence of failure to comply with the time limit. It held that the only possible interpretation of the reference in R. 65(1) EPC 1973 to R. 1(1) EPC 1973, which itself referred to Art. 14(4) EPC 1973, was that R. 65(1) EPC 1973 determined the legal consequence of failure to file a translation of the notice of appeal as required by Art. 14(4) EPC 1973. The legal consequence was therefore the **inadmissibility of the appeal**. It was not a case of conflict within the meaning of Art. 164(2) EPC 1973, since R. 65(1) EPC 1973 was a *lex specialis*. The provisions of R. 65(1) EPC 1973 are now to be found in R. 101(1) EPC, which does not refer to R. 3(1) EPC, the equivalent to R. 1(1) EPC 1973.

In **T 170/83** (OJ 1984, 605) a debit order was filed in error in Dutch. The board held that Art. 14 EPC 1973 did not apply - a debit order did not have to contain text in a language at all, whilst remaining quite clear. The question whether a debit order in a non-official language was effective therefore did not arise.

In **T 700/05**, the board found that, taking into account that Euro-PCT applications were deemed by Art. 153(2) EPC to be European applications and the principle that they thus had to be treated as favourably as applications made in a contracting state, a PCT application originally filed in Japanese had to be treated in the same way as an application filed in the language of a contracting state which was not an official language of the EPC. The provision of Art. 14(2) EPC 1973 had thus to be applied by analogy to allow also the translation into English of an original PCT application in Japanese to be brought into conformity with the original Japanese text of the application throughout the proceedings before the EPO, i.e. also including opposition and appeal proceedings. See also **T 1483/10**.

Shortly before the oral proceedings before the board in case **T 265/11**, the appellant (opponent) filed an uncertified translation of the claims of the international application underlying the patent. It argued that it was evident from this translation that certain features were different in the originally filed claims with respect to the English translation filed on entry into the European phase (Art. 158(2) EPC 1973), and requested that the newly filed translation filed be used as a basis for the analysis under Art. 123(2) EPC. The board affirmed that an international application for which the EPO is a designated or elected Office, and which has been accorded an international date of filing, is equivalent to a regular European application (Art. 150(3) EPC 1973; now Art. 153(2) EPC). For the application in question, R. 7 EPC 1973 (cf. R. 7 EPC) applied *mutatis mutandis* to the translation filed under Art. 158(2) EPC 1973. As no evidence had been provided that the translation already on file was not in conformity with the original text of the application, the board, in accordance with R. 7 EPC 1973, assumed that translation to be in conformity with the original text of the application for the aforementioned purpose.

Concerning translation points in relation to amendments see Chapter II.E.1.1.5 "Language issues".

## 6. Language-related fee reductions

Under R. 6(3) - (7) EPC (as in force from 1 April 2014 – see Decision of the Administrative Council of 13 December 2013, OJ 2014, A4) certain categories of applicants fulfilling the requirements of Art. 14(4) EPC are eligible for a fee reduction when filing a European patent application or request for examination (see also Notice of 10 January 2014, OJ 2014, A23). A corresponding language-related fee reduction is no longer available for oppositions, appeals, requests for limitation or for revocation, or petitions for review (for earlier decisions concerning the former reduction of the opposition and appeal fees, see "Case Law of the Boards of Appeal", 7<sup>th</sup> ed. 2013, III.F.5).

In **G 6/91** (OJ 1992, 491) the Enlarged Board of Appeal ruled that the persons concerned were only entitled to the fee reduction under R. 6(3) EPC 1973 if they filed the **essential item of the first act** in filing, examination, opposition or appeal proceedings (note: the last two cases are no longer relevant – see previous paragraph) 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. According to **T 905/90** (OJ 1994, 306, Corr. 556), neither a request for a fee reduction, nor a notification that only a reduced fee had been paid, was an essential part of the first act of the relevant proceedings (see also **J 4/88**, OJ 1989, 483).

### 6.1. European patent application

Under the EPC 1973, an application could be filed in an official EPO language (Art. 14(1) EPC 1973) or, by persons benefiting from the "language privilege", in an official language of a contracting state other than English, French or German (Art. 14(2) EPC 1973).

According to **J 4/88** (OJ 1989, 483, see headnote), for the purposes of Art. 14(2) EPC 1973 and R. 6(3) EPC 1973 it was sufficient if the description and claims were filed in an official language of a contracting state other than English, French or German; it was not significant for this purpose that other parts of the European patent application were filed in one of the official languages of the EPO only (further to **J 7/80**, OJ 1981, 137 – see in this chapter III.F.1). If the applicant availed himself of the option provided in Art. 14(2) EPC 1973 both the filing fee and the examination fee were reduced (R. 6(3) EPC 1973).

### 6.2. Request for examination

**J 4/88** (OJ 1989, 483) (see in this chapter III.F.6.1) deals with the reduction of both the filing fee and the examination fee.

In **J 21/98** (OJ 2000, 406) the appellant (applicant), who had filed a **request for examination** in Italian within the time limit provided for under Art. 94(2) EPC 1973 (see now R. 70(1) EPC), and simultaneously an English translation, had been refused the reduction in the examination fee pursuant to Art. 14 EPC 1973. According to the

Receiving Section, the written request for examination in Italian should have been filed together with the request for grant. However, according to the board, Art. 94(2) EPC 1973, in conjunction with Art. 75, Art. 92 and Art. 94(1) EPC 1973, was to be interpreted such that, within the grant procedure, the request for examination constituted an **autonomous step** quite separate from the (previous) step of filing the patent application, enabling the applicant to consider whether to continue the grant procedure in the light of the search report. Since the EPC 1973 gave the applicant the right to file the request for examination after the publication of the search report, it followed that the same right had to be owed to the applicant who wanted to avail himself of the option provided for in Art. 14(2) and (4) EPC 1973 (see also **J 22/98**, **J 6/99**, **J 14/99** and **J 15/99**).

In **J 36/03** the board held that the examination fee should be reduced if the request for examination was filed in an authorised non-official language, even in cases where the **application was transferred, before the examination fee was paid**, to an applicant who was not one of the persons referred to in Art. 14(2) EPC 1973.

**G. Law of evidence**

1.	Introduction	654
2.	Admissible evidence	656
2.1.	Non-exhaustive list of admissible means of evidence	656
2.2.	Witness testimonies and expert opinions	657
2.2.1	Hearing witnesses	657
2.2.2	Difference between witnesses and experts	659
2.2.3	Expert opinions (Article 117(1)(e) EPC)	659
2.3.	Statements in writing	660
2.4.	Other documents	663
3.	Taking of evidence	664
3.1.	Relevance of the evidence	664
3.2.	Time frame for submitting evidence	666
3.3.	Right to be heard	671
3.4.	Return of filed evidence	674
4.	Evaluation of evidence	674
4.1.	Principle of free evaluation of evidence	674
4.2.	Probative value of evidence on a case-by-case basis	675
4.2.1	Witness testimony and written statements	676
4.2.2	Test and experimental evidence	678
4.2.3	Archives and internet publications	680
4.2.4	Other written evidence	681
4.3.	Standard of proof	683
4.3.1	General – "Balance of probabilities"	683
4.3.2	Public prior use	684
4.3.3	Public availability of prior art documents	687
4.3.4	Claiming a valid priority	690
4.3.5	Abusive conduct	691
4.3.6	Receipt of formal documents	692
5.	Burden of proof	693
5.1.	Apportioning the burden of proof	693
5.1.1	General	693
5.1.2	Individual cases	695
a)	Novelty	695
b)	Inventive step	696
c)	Sufficiency of disclosure	696
d)	Content of the priority document	697
e)	Receipt of formal documents	697
5.2.	Shifting the burden of proof	700
5.2.1	General	700
5.2.2	Cases in which the burden of proof was reversed	701
5.2.3	Cases in which the burden of proof was not reversed	702

## 1. Introduction

Before an administrative authority or a court takes a decision, it is required to establish the existence of the material facts, i.e. the facts from which, under the relevant legal provision, the legal effect ensues. The facts are established by taking evidence. The purpose of all evidence, whatever its nature, is to confirm a party's assertions.

The main provisions governing evidence, the means and taking of evidence and the conservation of evidence are Art. 117 EPC, Art. 131(2) EPC, R. 117 to 124 EPC (the last rule as amended by decision CA/D 6/14 of the Administrative Council (OJ 2015, A17), which entered into force on 1 April 2015) and R. 150 EPC.

In the revised EPC 2000, the content of Art. 117(2) to (6) EPC 1973 was rephrased in the new Art. 117(2) EPC. The procedural aspects concerning the taking of evidence were transferred to the Implementing Regulations (see OJ SE 5/2007, Part II, pp. 176-192). Furthermore, the revised Art. 117(1) EPC no longer lists the EPO departments which may take evidence; it now includes a general reference to "proceedings before the European Patent Office".

Art. 117 EPC, entitled "Means and taking of evidence", provides for the submission of evidence before all EPO departments, including the Receiving Section, examining divisions, opposition divisions, the Legal Division and the boards of appeal.

Beyond the letter of the EPC, the boards of appeal have addressed multiple issues of admissibility and taking of evidence in their case law. In addition, they have elaborated specific principles governing the evaluation of evidence and the allocation of the burden of proof in order to ensure that EPO proceedings are conducted in a fair and consistent manner.

In accordance with the principle of free evaluation of evidence, any kind of evidence, regardless of its nature, is admissible (**T 482/89**, OJ 1992, 646).

That proceedings before the EPO are conducted in accordance with the principle of free evaluation of evidence was recently reiterated by the Enlarged Board (**G 1/12**, OJ 2014, A114).

Parties can freely choose the evidence they wish to submit - the kinds listed in Art. 117(1) EPC are merely examples (**T 543/95**, **T 142/97**, OJ 2000, 358).

Art. 117(1) EPC and Art. 113(1) EPC embody a basic procedural right generally recognised in the EPC contracting states, viz. the right to give evidence in appropriate form (specifically by producing documents under Art. 117(1)(c) EPC) and the right to have that evidence heard (**T 1110/03**, OJ 2005, 302).

Whether or not a fact can be regarded as proven has to be assessed by the department hearing the case having taken all the relevant evidence into consideration (**T 474/04**, OJ 2006, 129, citing **G 3/97**, OJ 1999, 245, point 5 of the Reasons).

All the means of giving or obtaining evidence covered by Art. 117 EPC are subject to the discretion of the EPO department concerned, which will order it to be taken only if it considers this necessary (**T 798/93**, OJ 8/1997, 363).

If the evidence offered as proof of contested facts essential to the settlement of the dispute is decisive, the department hearing the case must, as a rule, order that it be taken (see **T 474/04**, OJ 2006, 129, about witnesses). All appropriate offers of evidence made by the parties should be taken up (**T 329/02**).

As for the standard of proof, the EPO generally applies the "balance of probabilities" (see **J 20/85**, OJ 1987, 102, point 4 of the Reasons). The balance of probabilities standard is met if, after evaluating the evidence, the boards are persuaded one way or the other (**T 286/10**). However, especially in cases where only one party – the opponent – had access to information about an alleged public prior use, the case law has tended toward expecting that the public prior use be proved beyond any reasonable doubt or "up to the hilt" (see e.g. **T 55/01**, point 4.1 of the Reasons, and **T 472/92**, OJ 1998, 161, point 3.1 of the Reasons; **T 2451/13** (Catchword)). Summary of the case law concerning the standard of proof can be found e.g. in the following recent cases: **T 738/04** (point 3.4 of the Reasons); **T 286/10** (point 2.2 of the Reasons); **T 918/11** (point 3.3 of the Reasons); **T 2054/11** (points 2.2 and 2.3 of the Reasons); **T 2227/11** (point 2 of the Reasons); **T 274/12** (point 4.2.1 of the Reasons); **T 202/13** (point 15.6.1 of the Reasons); **T 2451/13** (point 3.2 of the Reasons).

**T 286/10**, a decision on **internet publications** cited as prior art, is dealt with below, in the section on the standard of proof needed to persuade the department concerned (see in this chapter III.G.4.3.1 and III.G.4.3.3 and in Chapter I.C.3.2.3).

Examining the evidence a board took into account would amount to revisiting the substance of the case and so falls outside the ambit of the review procedure (**R 21/09**, **R 6/12**). A reversal of the burden of proof is not covered by the exhaustive list of possible grounds for a petition for review (**R 21/10**).

R. 3(3) EPC provides that documentary evidence may be filed in any language. The EPO may, however, require that a translation in one of its official languages be filed within a specified period. If the required translation is not filed in due time, the EPO may disregard the document in question, as for example in **T 276/07**. The language to be used for taking evidence and writing the minutes is governed by Art. 14(3) EPC (language of the proceedings) and R. 4 EPC (derogations from the provisions on use of the language of the proceedings in oral proceedings); (Guidelines E-III, 1.3 "Taking of evidence" – November 2015 version; see also Chapter III.F.2. "Language of the proceedings").

Cross-references: evidential matters permeate all aspects of patent law; it is thus recommended to read also the following chapters, which deal specifically with these matters: I.C.3.2.3 "Internet disclosures"; I.C.3.2.2 "Lectures and oral disclosure"; I.C.3.5 "Issues of proof"; I.C.3.5.1 "Burden of proof"; I.C.3.5.2 "Standard of proof"; I.C.3.5.2c) "Internet – proof of the date of availability"; II.A.2.2.2 "Burden of proof"; II.C.5.6.7

"Experiments"; II.C.5.8 "Post-published documents"; II.C.8. "Evidence"; II.E.5 "Evidence and standard of proof for allowing amendments and corrections"; III.A.1.3 "Causal link and the requirement of proof"; III.B.2.3 "Surprising grounds or evidence"; III.B.2.4.3 "Failure to consider evidence"; III.B.2.6.4 "Hearing witnesses"; III.B.2.7.1 "Facts and evidence put forward for the first time during oral proceedings in inter partes cases"; III.C.4.4 "Late submission of new facts and evidence in the preparation for oral proceedings - Rule 116 EPC"; III.E.4.4 "Substantiation of the request for re-establishment"; III.R.6 "Distinction between presentation of facts and evidence and presentation of arguments"; IV.B.2.8.5 "Fresh argument based on grounds and evidence communicated beforehand"; IV.C.1.2 "Late-filed facts, arguments and evidence in opposition proceedings"; IV.C.1.3 "Late-filed facts, arguments and evidence in appeal proceedings"; IV.C.1.3.6c) "Evidence of common general knowledge"; IV.C.2.2.6 "Evidence for and effect of a transfer"; IV.D.2.2.8 "Indication of facts, evidence and arguments – substantiation of grounds for opposition"; IV.D.2.2.9c) "Alleged public prior use"; IV.D.3.4.5 "Examination of fresh facts and evidence"; IV.E.7.2.4 "New facts or evidence". See also Guidelines E-III "Taking and conservation of evidence" – November 2015 version.

## 2. Admissible evidence

### 2.1. Non-exhaustive list of admissible means of evidence

Art. 117(1) EPC does not contain an exhaustive list of admissible evidence, only mere examples. Parties to the proceedings are thus free in their choice of evidence. **Any kind of evidence** is admissible during proceedings before the EPO.

The EPC does not foresee that certain questions of fact may only be proved by certain forms of evidence. Questions of fact must be settled on the basis of any credible information available (see e.g. **J 11/88**, OJ 1989, 433).

For instance, request for correction may be based upon means of evidence in other than document form (**G 11/91**, OJ 1993, 125; cf. **G 3/89**, OJ 1993, 117).

Any kind of evidence, regardless of its nature, is admissible during proceedings before the EPO. Accordingly, the boards of appeal have admitted to the proceedings evidence obtained from witnesses or experts in accordance with R. 117 EPC (former R. 72 EPC 1973) as well as documents of any kind, including affidavits and statutory declarations (see **T 117/86**, OJ 1989, 401; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169; **T 314/90**).

The admissibility of evidence should be clearly **distinguished** from the weight of evidence: whereas admissibility involves the question whether a piece of evidence should be considered at all, the probative value of evidence refers to the question whether the evidence to be considered provides sufficient proof of the alleged facts (see e.g. **T 1698/08** on the distinction between admission of evidence and probative value of a document, and **T 838/92** about a witness).



In **T 1710/12**, in the board's view, Art. 117(1) EPC gives **no order of preference** regarding the means of giving or obtaining evidence in proceedings before the EPO and it remains the **free choice of a party** to rely on the hearing of a witness (Art. 117(1)(d) EPC) or on production of a sworn statement in writing (Art. 117(1)(g) EPC).

The board in **T 885/02** observed that the opinion of an expert does not necessarily reflect the view of the skilled reader for various reasons. Those **experts** who were in the case at issue **eminent scientists** had their own experience which was not necessarily common general knowledge. Those observations did not mean that those declarations were to be disregarded.

## 2.2. Witness testimonies and expert opinions

### 2.2.1 Hearing witnesses

It is the function of a witness to corroborate what has been alleged (**T 543/95**) and not to fill in the gaps in facts brought forward to support the case (**T 374/02**). It is necessary that a party who wishes to adduce evidence by means of a witness should indicate what **factual details** it wishes to prove by this means (**T 374/02**). The principle of free evaluation of evidence also applies to the hearing of witnesses under Art. 117(1)(d) EPC (**T 482/89**, OJ 1992, 646).

Compare the present section of this chapter with chapter III.G.2.3 below on statements in writing (written testimony). Compare also: chapter III.G.3.1 below on the relevance of evidence offered, particularly requests that witnesses be heard; chapter III.G.3.2 on when evidence should be submitted or taken; chapter III.G.3.3 on, among other things, observance of the right to be heard where a request that a witness be heard is refused. Chapter III.G.4.2.1 below deals with how oral testimony and written statements are assessed.

The EPC requires **clear requests** with regard to testimonies a party wishes witnesses to give, since the responsible department of the EPO must issue a decision regarding the taking of oral evidence (see Art. 117(1)(d) and R. 72(1) EPC). The board in **T 374/02** was of the opinion that the "implicit offer of witnesses" did not specify what should be able to persuade the board to evaluate the evidence already existing in the file differently. Witnesses were meant to corroborate the facts not to fill in gaps in the facts and arguments. The lack of an indication of the facts which were to be proven by testimonies of the three persons mentioned meant that the necessary conditions for the hearing of witnesses did not exist in the case before the board (other examples: **T 2054/11**; **T 703/12**). **T 1028/11**, cited below, deals with a - justified - refusal to hear a witness and an alleged infringement of the right to be heard. In **T 30/12**, the board refused a request to rehear a witness (see below on the relevance of evidence offered).

The EPC does not rule out that the parties to the proceedings offer their **employees** as witnesses (see e.g. **T 482/89**, OJ 1992, 646; **T 124/88**, **T 830/90**, OJ 1994, 713; **T 443/93**, **T 937/93**) or **clients** (**T 575/94**). See also **T 327/91**, **T 558/95**, cited in this

chapter III.G.2.3 on statements in writing, and **T 508/00** under chapter III.G.3.2 on when evidence should be submitted). The credibility of witnesses cannot be impugned merely because they had a **business relationship** with a party (**J 10/04**, referring to several other decisions). The allegation that a witness might be biased does not itself render the testimony inadmissible; suspicion of bias is rather a matter to be considered during the evaluation of evidence. The **parties must be given an opportunity to comment** on the results of the witness hearing (**T 838/92**; on this point also **T 582/90**). In the context of an alleged oral disclosure (lecture), evidence from the lecturer and a member of the audience, provided by them in the form of both affidavits and oral testimony, was not considered by the board in **T 2003/08** to prove beyond reasonable doubt that the subject-matter of the claim was disclosed during the lecture; the board also observed that relations with the appellant-opponent's company could possibly have influenced their objectivity. In contrast to the opposition division the board considered it appropriate to hear Dr W and Dr K as witnesses because their testimony **could affect the outcome of the proceedings**. The transcript of the witness hearing contained a point concerning their relationship to the appellant-opponent. In the end their oral testimony did not dispel the board's doubts as to the content of the lecture.

The opposition division apparently considered documents as being of a more conclusive evidentiary value than witnesses. Such an approach has no basis in the EPC, Art. 117 EPC containing no ranking of the means of evidence listed in it. The board was also of the opinion that the application of the standard of proof "beyond reasonable doubt" did not justify disregarding the testimonies (**T 918/11**, prior use - long-ago events).

In **T 582/90** the witness was heard by the competent court in Nantes, France (in **T 827/99**, hearing of a witness by national tribunal not necessary).

One object of producing written statements – which are an admissible form of evidence – is to avoid having to call those who made them as witnesses (**T 674/91**; see, however, **T 474/04**, in which it was held that the department of first instance ought to have heard the person who had made the written declaration in question, *infra* in this chapter III.G.2.3).

See also in this chapter: **T 703/12** (timing of a request that a witness be heard – generic reference to submissions in opposition); **T 480/11** (late witness); **T 838/92** (impartiality of a witness); **T 267/06** (need to order the hearing of a witness); **T 716/06** (whether the evidence offered was useful); **T 1096/08** and **T 225/03** (first-instance department wrongly decided not to hear the witnesses); **T 1100/07** (department of first instance's decision not to order hearing of witnesses justified in one case but not in the other); **T 190/05** (citing **T 474/04** extensively and specifying how the department of first instance should have proceeded); **T 361/00** (unnecessary to hear author of unsworn written statements as a witness because statements irrelevant to outcome of the decision); **T 1210/05** (conclusions based exclusively on the testimony of a witness); **R 6/12** (hearing witnesses/experts not ordered by the board). See also in this chapter III.G.4.2.1, III.G.3.1 below on relevance, and Chapter III.B.2.6.4 "Hearing witnesses".

### 2.2.2 Difference between witnesses and experts

The boards of appeal have drawn a distinction between the hearing of witnesses and the hearing of **opinions by experts**: a witness is put forward to substantiate facts of which he/she has personal knowledge. In **T 311/01** the appellant (opponent) offered witness testimony on the skilled person's knowledge and understanding of the cited prior art. However, the testimony was offered as evidence not of specific facts but of the knowledge and ideas of skilled persons in the technical field concerned, so that the appellant was in fact offering experts, not witnesses. Regarding itself expert enough with regard to the features and advantages described in the prior art, the board refused to hear the proposed "witnesses" (see also **T 1511/06** and **T 32/10**).

In **T 480/11** the appellant had referred to Mr J. as a technical expert in its letter of four weeks before the oral proceedings and had requested that he be allowed to comment on any technical issue relating to the claimed invention that might come up. However, the subject on which he intended to speak according to the appellant's request as specified during the oral proceedings was not simply a technical issue but an event in the past, namely the performance of experiments and the results obtained thereby, which had taken place at the appellant's laboratory. So the appellant's request was actually directed to hearing Mr J. as a witness rather than as a technical expert. If the witness had been allowed to speak, the respondent would have had to be given sufficient opportunity to challenge the witness statement and it would have been necessary to adjourn the oral proceedings. The board decided not to allow the appellant's request to hear Mr J., pursuant to Art. 13(3) RPBA.

In a case where the board including three technically qualified members assesses technical facts in the light of patent law and considers itself expert enough to decide upon a matter without technical assistance from an expert within the meaning of Art. 117(1)(e) EPC, such assessment, as stated by the board in **T 1676/08** (case with five members), is a matter for the board and not for a technical expert within the meaning of Art. 117(1)(e) EPC. Such assessment does not mean that any member of the board becomes a witness within the meaning of Art. 117(1)(d) EPC or an expert within the meaning of Art. 117(1)(e) EPC.

### 2.2.3 Expert opinions (Article 117(1)(e) EPC)

The decisions reported below concern requests that the board take evidence from an independent expert under Art. 117(1)(e) EPC and R. 121 EPC (the case law shows that the boards refused those requests). Such cases are to be distinguished from those where opinions of a party's expert are submitted as evidence (which are more common) and in which the department in question will evaluate the opinion's probative value; see in this chapter e.g. **T 753/09** (expert opinion produced too late); **T 1676/08**; **T 658/04**; **T 885/02**; **T 276/07** (language); **T 74/00** (legal expert opinion, Japanese law); **T 517/14** (right of priority, legal expert opinion, Israeli law); **R 18/09** (late-filed external legal opinion on the admissibility of the petition). An opinion of a party's expert is a means of evidence under Art. 117(1) EPC (**T 517/14**, point 2.8.4 of the Reasons). See also the section of this chapter on evidence based on tests and experiments.

In **T 375/00**, the board, ruling on the opponent's request that it order an expert opinion under Art. 117(1)(e) EPC, held that actively seeking experts to help the case of one of the parties could leave it open to an accusation of partiality and that it was for the parties to find the evidence they needed. **Only if** the board did not consider itself in a position to decide upon a matter without technical assistance would expert evidence within the meaning of Art. 117(1)(e) EPC become appropriate (**T 1676/08**, citing also **T 395/91**, point 5.3 of the Reasons, **T 230/92**, point 5.3 of the Reasons, **T 375/00**, point 1.2.2 of the Reasons, and **T 311/01**, point 5 of the Reasons). Other cases rejecting a request for an expert opinion: **T 1548/08**, **T 1763/06**.

In **T 443/93** too, the board refused a request for such an expert opinion made at the oral proceedings after a witness had been heard, noting that the appellant had neither filed the request on time, nor supplied specific grounds justifying such a request at that stage in the proceedings.

In **T 392/06**, during oral proceedings the respondent (opponent) requested the appointment of an independent technical expert in view of the contradictory experimental results of the appellant (proprietor) and the respondents (opponents). The board said that the onus to provide evidence rested on the opponents. The board had not settled a contradiction between experiments from the appellant and the respondents, but had decided on the evidence submitted by the respondents, which turned out to be incomplete. The board had no reason to substitute for the respondents **to compensate for their deficiency** in the provision of the evidence which supported their objection of lack of novelty in allowing an independent expert. Furthermore, commissioning of an independent expert would have made postponement of the oral proceedings necessary, which was contrary to Art. 13(3) RPBA (see also the obiter dictum in **T 998/04**, reported in this chapter III.G.5.1.1, on the burden of proof).

**T 8/13** addressed several procedural aspects. On the request formulated by the appellant (opponent) to hear an independent expert of a university, the board considered that the questions on which it had to decide did not require any further technical expertise to be gathered from outside the Office. The appellant did not provide any further argument as to why hearing an independent technical expert would have been required in order to decide on this case. There were thus no good reasons why the board should have exercised its discretionary power under R. 117 EPC as requested by the appellant.

### 2.3. Statements in writing

Art. 117(1)(g) EPC provides for sworn statements in writing as a means of evidence (rare in practice). However, since any kind of evidence is admissible in proceedings before the EPO, other, less solemn types of written statement (common in practice), e.g. statutory declarations, are also accepted. It is for the boards then to assess their probative value on a case-by-case basis. Such declarations consist of a witness's written statement, the main purpose of which is to avoid the need to hear that witness. The board may, however, decide to order such a hearing, for example if a party so requests. The terminology used in the case law includes "affidavits", "statutory declarations" and

"unsworn statements" (French: "déclarations écrites", "déclarations sur l'honneur" and "attestations"; German: "eidesstattliche Versicherungen" and "eidesstattliche Erklärungen").

According to the practice of the boards of appeal, affidavits or statutory declarations, whether in original or copy form, are considered as possible means of providing evidence. One purpose of written declarations is to avoid the need to hear the undersigning person as a witness. Where such declarations consist of answers to questions put forward by legal experts several declarations may have certain stereotyped formulations in common. The board is not obliged to check the signatures as long as no counter-opinion has been presented concerning those signatures (**T 674/91**; see also **T 558/95**). In **T 474/04** (OJ 2006, 129), where one party invoked **T 674/91** to justify not having to hear the author of an unsworn witness declaration ("eidesstattliche Versicherung") as a witness, the board pointed out that the case before it was different in that the fundamental assertions made in the declaration were **contested**, the author had been offered as a witness, and the appellant had consistently demanded that he be heard. The opposition division's decision not to summon him as a witness although he was available had handicapped the appellant in its defence against what turned out to be the **decisive piece of evidence**. It was observed that this piece of evidence largely lay "within the power and knowledge of the opponent".

Written statements by potential witnesses or parties typically have a lower probative value than oral evidence taken by the department deciding on the case. If a disputed point is **highly relevant to the validity of the contested patent**, it is, as a rule, not in keeping with good procedural practice for an opposition division not to take up an opportunity to hear a witness or party in evidence and instead to require written statements and make do with their typically lower probative value. The board in **T 329/02** could not identify any extraordinary circumstances that might have justified an exception to this rule in the case in point.

In **T 918/11**, the board found that it went against the general rules concerning the consideration of evidence to distinguish dogmatically between the evidentiary value of a witness testimony on the one hand and a document on the other hand. The opposition division had apparently considered documents to be of a more conclusive evidentiary value than witnesses. Such an approach had no basis in the EPC, Art. 117 EPC containing no ranking of the therein listed means of evidence.

Sworn statements in writing, one of the means of giving evidence listed in Art. 117(1) EPC, are **not automatically ordered simply at the request of one party**. All the means of giving or obtaining evidence covered by Art. 117 EPC are subject to the discretion of the department concerned, which will order their use only if it considers this necessary (**T 798/93**, OJ 8/1997, 363).

The board may consider an affidavit to be admissible evidence even if it is signed by the general manager of the appellant (see **T 327/91**). In **T 2003/08** (reported in this chapter) the board observed that relations with the appellant's (opponent's) company could possibly have influenced Dr W's and Dr K's objectivity concerning their declarations

("Eidesstattliche Versicherung"). The board considered that its reservations concerning declarations E1 (declaration of Dr W, lecturer) and E2 (declaration of Dr K, member of the audience) could possibly be dispelled by hearing the authors of declarations E1 and E2 themselves.

Sworn statement (Art. 117(1)(g) EPC) are to be distinguished from "**statutory declarations**", which are not given on oath. Albeit not explicitly covered by Art. 117(1)(g) EPC, statutory declarations are regarded as admissible means of evidence and are taken into account in accordance with the principle of the unfettered consideration of evidence (see e.g. **T 770/91**, **J 10/04** and **T 535/08**).

A statutory declaration ("eidesstattliche Erklärung" or "déclaration tenant lieu de serment") is a means of giving evidence within the meaning of Art. 117(1) EPC and as such is subject to the principle of free evaluation of evidence (**T 558/95**, cf. **T 482/89**, OJ 1992, 646, point 2.1 of the Reasons; **T 575/94**, point 3.7 of the Reasons). The board in **T 443/93**, which had French as the language of the proceedings, referred to a document entitled "eidesstattliche Erklärung" alternately as a "déclaration sous serment" (affidavit) and a "déclaration écrite" (written statement); **T 563/02** referred to a document entitled "affidavit" as "déclaration sur l'honneur". The board in **T 474/04** (OJ 2006, 129), which had English as the language of the proceedings, referred to a document entitled "eidesstattliche Versicherung" as a "declaration in lieu of an oath" and an "unsworn witness declaration". In **T 703/12**, the board called a document of this kind entitled "eidesstattliche Versicherung" a "statutory declaration" and in **T 1231/11** an "affidavit". In proceedings before the EPO even a simple declaration can be an admissible means of evidence within the meaning of Art. 117(1) EPC (**T 474/04**, OJ 2006, 129 – a decision establishing a number of points relating to the law of evidence). The EPO accepts unsworn solemn declarations the same way it accepts other unsworn statements (**T 970/93**, **T 313/04**).

In **T 558/95**, the board held that the fact that the statutory declarations produced by the opponent partly used the same wording and had been drawn up by employees of the opponent did not necessarily mean they should be excluded as inadmissible. The opposition division had discretion to decide whether to examine them, and to **determine whether or not** the evidence in them was **sufficient**.

In **T 190/05**, which contains extensive reasoning on the issue of evidence, the board ruled that, under R. 68(2) EPC 1973 (R. 111(2) EPC), the opposition division ought to have explained more clearly in the reasons for its decision why it had regarded the alleged prior use as substantiated and the statutory declaration as sufficient evidence. Neither the summons nor the brief communication, nor the minutes of oral proceedings, could substitute adequate reasoning in the decision.

In **R 3/10** the Enlarged Board took signed declarations of persons who had attended the oral proceedings into account.

On the probative value of witness testimony and written statements, see also in this chapter III.G.4.2.1.

## 2.4. Other documents

In any proceedings before, inter alia, an opposition division or a board of appeal, evidence may be given by producing documents, either in response to an order by the department hearing the case (Art. 117(1)(c) EPC) or – more commonly – on a party's own initiative in support of its claims. As the EPC neither defines the term "documents" nor gives any indication of the probative value of such documents, the principle of free evaluation of evidence applies. **Any kind of document**, regardless of its nature, is **admissible** during proceedings before the EPO, including appeal proceedings (**T 482/89**, OJ 1992, 646).

The term "documents" in Art. 117(1)(c) EPC was considered in **T 314/90** as meaning essentially all written documents in which thoughts are expressed by means of characters or drawings, including published documents.

In **T 795/93** the board was of the opinion that a document as a means of disclosing the state of the art was a means of proof with a variety of functions. It was intended first to prove what had been made available to the public in the written description it contained, i.e. what contribution in the form of information, knowledge, teaching, etc. it made to the state of the art, and also served to prove when such information had been made available.

**T 760/89** (OJ 1994, 797) dealt with a deposition stemming from infringement proceedings before a United States District Court filed in the opposition proceedings as evidence. The board held that it is in principle admissible under the EPC to consider evidence obtained by a foreign court because the list of means of evidence enumerated in Art. 117(1) EPC is non-exhaustive and because the principle of free evaluation of evidence applies. On national decisions and the production in proceedings before the EPO boards of appeal of documents produced in national court proceedings, see **R 21/09** (chapter III.G.3.3 "Right to be heard" and for more examples of cases concerning **national proceedings** in connection with issues of evidence: **T 582/90**, **T 665/95**, **T 1904/12** (boards not always obliged to justify in detail why a given piece of evidence is disregarded or not convincing), **T 407/08** (experts' opinion ordered by German Court filed by party), **T 276/07** (expert appointed by Court of Bologna), **T 885/02** (several kind of documents/arguments submitted)).

In **T 71/99** the minutes of the proceedings as taken by the opposition division did not provide a full account of the conduct of the oral proceedings. To show the board what had actually happened, the respondent submitted part of a copy of **a report of the opposition proceedings** which had been dictated by his representative in the course of those proceedings. The appellant argued that this document should not be admitted, albeit without disputing the facts set out in it. Since the submitted part of the report was significantly more precise and not difficult to understand, the board saw no reason to disregard the evidence. In **R 3/08** the Enlarged Board, having taken private minutes into account, considered that there was no indication that the petitioner had raised any objection. On minutes of oral proceedings as evidence of the course of the proceedings, see chapters III.C.4.9, IV.F.3.5.4 and **R 7/11**.

In **T 1698/08** the respondent (patentee) objected to the admission of an (**internet**) extract from the Zürich Commercial Register as it stated at the end that the information was provided without warranty and had no legal effect whatsoever, which in its opinion had the consequence that the extract could not be considered as a means of evidence within the meaning of Art. 117(1) EPC. The board stated that Art. 117(1)(c) EPC lists "production of documents" as a valid means of giving evidence, noting that the list in Art. 117(1) EPC is not exhaustive. A refusal to admit such a piece of evidence (an uncertified extract from a commercial register) could therefore not be based on Art. 117(1) EPC. The board decided that there was no reason to exercise its discretion to refuse to admit the evidence, as it could neither be said that it was irrelevant nor that it was unnecessary. A **refusal** to admit it could in any case **not be based** on statements in the document with respect to the **accuracy of the facts** it contained. Such statements relate to the probative value of a document.

See also in this chapter III.G.4.2.3 "Archives and internet publications" and III.G.4.2.4 "Other written evidence". **T 286/10**, a decision on internet publications cited as prior art, is dealt with there and in the section on the standard of proof required to persuade the department concerned (chapter III.G.4.3.1 and III.G.4.3.3).

### 3. Taking of evidence

#### 3.1. Relevance of the evidence

Art. 117 EPC entitled "Means and taking of evidence" is applicable before all EPO departments, including the Receiving Section, examining divisions, opposition divisions, the Legal Division and the boards of appeal. The decision whether to order any of the means of taking evidence listed there depends on whether or not the evidence in question can be considered relevant (i.e. necessary or useful for settlement of the dispute). The decisions reported here deal, essentially, with requests that a witness be heard and it may also be useful to refer to the section in this chapter III.G.2.2, which concerns (refused) requests that an expert's opinion be obtained (Art. 117(1)(c) EPC). Reference is also made to chapter III.G.3.2, which deals with situations when the giving or taking of evidence can be requested or should be ordered. See also in this chapter III.G.3.3, which deals with whether a failure to order that evidence be taken results in an infringement of the right to be heard.

The EPO departments must ascertain the **relevance of evidence submitted to them** before deciding whether to admit or reject it. EPO departments do indeed have some discretion in admitting evidence offered, for example where it is no longer needed because the fact at issue is not contested by the other party, where the decision will in any case go in favour of the party offering it, where it is submitted very late in the proceedings and is considered immaterial, or where for some other reason it cannot affect the outcome (e.g. evidence offered in an inadmissibly late-filed opposition) (**T 142/97**, OJ 2000, 358).

In **T 798/93** (OJ 1997, 363), the board observed that all the **means of giving or taking evidence** covered by Art. 117 EPC are subject to the **discretion** of the department



concerned, which will order their use only if it considers this necessary. It then refused the appellant's request for the taking of evidence as to the opponent's identity because it was couched in general terms and did not refer to any specific means. The only specific means requested was a sworn statement in writing but, in the absence of any legitimate doubt as to the opponent's identity, the board considered that this was neither useful nor necessary.

All appropriate offers of evidence made by the parties should be taken up. As a rule, it cannot be considered to be in keeping with good procedural practice for an opposition division not to take up an opportunity to hear a witness or party in evidence (**T 329/02**).

According to **T 716/06**, it is true that where **oral evidence of a witness** is requested by a party the competent EPO department should grant this request only if it considers this oral evidence necessary, i.e. when it is required to clarify matters that are decisive for the decision to be taken. If a request is made by an opponent to hear a witness on an alleged public prior use and on the disclosure of a certain feature by this prior use, the competent department of the EPO must as a rule grant this request before deciding that the alleged public prior use is neither established nor a novelty-destroying part of the state of the art because the feature in question is not found to be disclosed therein. In **T 2003/08** (reported supra) the board – in contrast to the opposition division – considered it appropriate to hear the witnesses because their testimony **could affect the outcome** of the proceedings.

In **T 1100/07** (alleged prior use, sale of a vehicle with a given feature), the department of first instance had refused to hear two witnesses. The board held that it had been right to refuse to hear one of them, as he would merely have confirmed what he had said in his written statement about documents that anyway spoke for themselves and hearing him would have had no impact on the final decision. It should, however, have heard the other witness. It was true that the request that he be heard had been filed late and that granting it would have meant adjourning the oral proceedings, but the opposition division had based its final decision on a failure to establish the prior existence of a single given feature and the witness would allegedly have been able to give evidence on that very point. Thus, the refusal to hear him was wrong and might have affected the outcome of the decision. The case was remitted to the opposition division.

In **T 361/00** the board explained in detail why, given the circumstances of the case before it, hearing the witness would be unnecessary because it would in no way affect the outcome of its decision.

In **T 1231/11** the board refused the request to hear a witness in support of an allegation of prior use. The witness had been offered to confirm the contents of his statutory declaration, but the board concluded that since he had not made any written statement regarding the decisive issue, any information provided on this matter would amount to introducing new facts into the proceedings. As to the opponent's assertion that the witness had been unable to produce such a written statement due to confidentiality obligations, it was questionable for the board how he would have complied with such obligations during oral proceedings, since those were, like the minutes of the taking of

evidence and the decision, public. In addition the board concluded that there had been no substantial procedural violation by the department of first instance since hearing the witness had not been considered relevant for the outcome of the case. The board found the circumstances to be different from those ruled on in three other cases, where the request to hear witnesses related to facts already on file: **T 267/06** (essential details referred to in the affidavit); **T 25/08** (hearing necessary in order to confirm what had been brought forward in writing); **T 448/07** (need to clarify inconsistencies in a written statement).

In **T 1410/14** (prior use – train – test drive) the board remarked in particular that, since the witness whose hearing the opponent had requested would not have been able to testify as to the decisive material facts, such a hearing would serve no purpose.

In case **T 30/12**, as evidence adduced for proving the invoked public prior use in opposition proceedings, the appellant (opponent) relied upon the drawing A9 and the testimony of Mr H, made before the opposition division. As regards the request for a renewed hearing of the witness Mr H before the board, the board noted that the appellant did not request that the witness be heard again to supplement his testimony by corroborating facts but only to clarify the statements made before the opposition division. However, the statements made by the witness as to whether document A9 was handed over to a member of the public were clear and unambiguous. The request to **rehear** Mr H was eventually rejected by the board.

### **3.2. Time frame for submitting evidence**

This section concerns when the parties should submit evidence and when the taking of evidence should be requested or ordered. It should be read together with chapter III.G.3.3 below, which deals with the issue of respect of the right to be heard where the department decides not to consider the evidence offered. The circumstances in **T 1028/11**, for example, illustrate the impact of the timing of an offer of evidence.

While it has been accepted in the jurisprudence of the boards of appeal that EPO departments have some discretion in admitting evidence, e.g. where the evidence is unnecessary or of no relevance (cf. **T 142/97**, OJ 2000, 358, point 2.2 of the Reasons), the **main legal basis for refusing the admission of evidence** is, as stated by the board in **T 1698/08**, the provisions dealing with the late filing of evidence (Art. 114(2) EPC, Art. 12(4) and 13 RPBA). See for consideration of late-filed evidence: Chapter IV.C.1 "Late submission".

R. 116 EPC (former R. 71a EPC 1973) should not be construed as an invitation to file new evidence or other material departing from the legal and factual framework of issues and grounds pleaded and evidenced throughout the proceedings prior to the hearing of the appeal (**T 39/93**, OJ 1997, 134, cited more recently in this connection in e.g. **T 1932/12**).

In **T 100/97**, the board discussed in detail the criteria to be applied to late-filed evidence. Since a UK infringement action had been stayed pending the outcome of the EPO

appeal, a swift settlement of the case was especially desirable, and admitting facts and evidence submitted at a late stage might have resulted in a remittal protracting the already lengthy proceedings and thus further delaying the UK proceedings. Moreover, for the contents of the statements to be considered sufficiently credible, they had to be **corroborated by documents of a definite date**. Taking into account the very late stage in the proceedings and in the absence of any such documents, it could not be established with a sufficient degree of certainty what had been made available to the public before the priority date of the opposed patent; the board therefore decided to disregard the late-filed evidence (Art. 114(2) EPC). Compare with **T 1057/09** (point 5.9 of the Reasons) concerning remaining doubts as to the authenticity of a late evidence.

In **T 1830/11**, the board observed that there are **no provisions** in the EPC **obliging** opponents to provide evidence against every possible fallback position defined in the dependent claims. Thus, if amendments were made to the claims during oral proceedings before the opposition division (as in the case at issue, where claim 1 had been amended to include the features of a dependent claim in the patent as granted), the obligation to submit evidence "in due time" under Art. 114(2) EPC might, depending on the circumstances, arise first at the stage of filing the statement of grounds of appeal. The board added that, contrary to what the patent proprietor (respondent) had claimed, **T 66/11** did not specify that late-filed documents cited in response to amendments resulting from a combination of granted claims were inevitably inadmissible. That the newly cited document did not disclose all features of claim 1 did make it any less relevant to its purpose, which was to show that the opposition division had erred in the contested decision on a specific point.

The board in **T 574/02** found that documents could not be considered late-filed simply because they had only been submitted on appeal, and any board faced with a request that it refuse to admit a document or evidence as late-filed first of all had to verify whether it really was late or whether, in the particular circumstances of the case, it had been submitted in due time (for a detailed account of the relevant criteria, points 2.2.2 to 2.3 of the Reasons). Finding that the filing party had at all times acted and reacted promptly and with good judgment, the board held that the documents had been submitted **in due time** within the meaning of Art. 114 EPC. Concerning the moment in time fixed by the rules when a party's case is deemed to be completed, refer for example to **T 1949/09** (late-filed tests).

In **T 1096/08**, the board could not share the view of the opposition division. Exercising its discretion under Art. 12(4) and 13(1) RPBA, the board considered it appropriate to take evidence from the two witnesses offered by the respondent (opponent) during the first oral proceedings. By contrast, the board did not admit to the first oral proceedings a further witness who had been offered **at a late stage**. In the board's view, the piecemeal approach of the respondent to asserting yet another alleged prior use shortly before the second oral proceedings clearly could not have been dealt with by the appellant or the board without further adjournment of the oral proceedings (for the consequences of such a piecemeal strategy, see **T 245/10** below).

The board in **T 1100/07** held that, although the opponent's request that a witness be heard had been filed late and unsatisfactorily presented, the opposition division ought to have heard the witness, particularly since he could have provided testimony on a crucial point it had ultimately relied on in its decision. The case was remitted to the opposition division for a hearing of the witness. The board's decision includes extensive reasoning on its findings on witness testimony.

In case **T 703/12**, the board stated that, in accordance with Art. 12(2) RPBA, the appellant's statement of grounds of appeal **should contain its complete case**, inter alia it should specify expressly all the evidence relied on. The appellant (opponent) was aware from the impugned decision that it was questionable whether the alleged prior use had been proven beyond any reasonable doubt. Therefore the board considered that there was no justification, such as a new development in the appeal proceedings, for the appellant to wait until the oral proceedings to request that Mr B (author of the statutory declaration D2) be heard as a witness in order to prove the alleged prior uses detailed in D2. Furthermore, consistent with established jurisprudence, the generic reference to the appellant's submissions in opposition in the notice of appeal could not be interpreted as expressly specifying the offer of Mr B as a witness. Accordingly, the witness offer made for the first time during the oral proceedings constituted an **amendment to the appellant's case** in accordance with Art. 13(1) RPBA and could only have been dealt with by an adjournment of the oral proceedings. In accordance with Art. 13(3) RPBA, the board exercised its discretion not to hear Mr. B. On the issue of a party's complete case, refer to **T 30/15**.

In **T 1760/10**, a replacement witness, Mr S, was offered due to the death of the first witness proposed. During oral proceedings the board decided to hear Mr S as a witness. The respondent (patentee) objected to the hearing of the witness: the nomination of Mr S as a witness was **late** (March 2013 / notice of appeal 2010 / oral proceedings October 2013) and the appellant (opponent) had not indicated the matters on which he should testify. In the board's view, nothing should have surprised the respondent in this regard. In the communication issued with the summons to oral proceedings, the board had indeed indicated that the chain of alleged public prior use contained certain irregularities and did not seem to be sufficiently proven and that the appellant was at liberty to request Mr S to attend oral proceedings, at which he might be heard, albeit that it remained unclear at that time as to how Mr S had relevant knowledge of the events.

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 EPC 1973 (**T 953/90**).

In **T 753/09** an expert declaration had been filed by the appellant (opponent) as a response to the summons to oral proceedings issued by the board, ostensibly to demonstrate how the skilled person would interpret documents E1 and E2. The expert declaration had been submitted **less than two months before the oral proceedings** and was therefore regarded as a late submission. Having said that it would allow such belated evidence only if it were sufficiently relevant and if the other party could

reasonably react to the late filing, the board ultimately refused to admit it into the proceedings. Firstly, the declaration did not provide more technical information than the documents E1 and E2 themselves, thus from a technical point of view it was not more relevant than the documents on file. Given that the technical teaching of both documents was relatively simple, and given that patent attorneys normally had a technical background themselves, the expert's explanations might as well be put forward in an equally convincing fashion by the authorised representatives of the appellants, with no less evidential weight before the board. Secondly, an expert declaration had to be considered not just as an argument, but as evidence pursuant to Art. 117(1)(e) EPC. The other party should be given the possibility to have such an expert declaration verified or possibly refuted by another expert with the same qualifications (as requested by the respondent as an auxiliary measure). Indeed, in the particular case, such a defence against the expert declaration required quite some time.

It is clear from the provisions of Art. 13 RPBA that, in spite of the principle of the right to be heard under Art. 113(1) EPC, a party does not have the right to have evidence which he filed or offered during appeal proceedings, in particular during *inter partes* proceedings, admitted into these proceedings (**T 1676/08**). In this case the board addressed several procedural aspects, in particular the fact that – allegedly in response to expert opinions submitted by the opponent – the patent proprietor had submitted as evidence a large volume of documents comprising more than a thousand pages and containing expert opinions only one month ahead of the oral proceedings, which the board had already postponed once at the proprietor's request. Stating detailed reasons for its decision, the board applied Art. 13(3) RPBA and refused to admit one of those expert opinions in particular (D100), finding that D100 was not identifiable as of particular relevance among submissions of over a thousand pages. It also refused to order at such a late stage an opinion by an expert pursuant Art. 117(1)(e) EPC or, since the relevant conditions set out in **G 4/95** were not met, to hear the party's expert at the oral proceedings in the capacity of an accompanying person.

In **T 245/10** the board held that the respondent (opponent) had had sufficient time to consider the results of comparative tests filed with the statement of the grounds of appeal, and admitted them into the appeal proceedings. The respondent had announced in 2010 that it would comment on those tests and/or present counter-tests on condition the board first issued an opinion on the admissibility of the appellant's tests. The board found that, in filing its own comparative tests only a month before the oral proceedings in 2012, the respondent had taken the risk of compromising the admissibility of its own tests, observing that a **piecemeal strategy** resulting in multiple rounds of oral proceedings devoted solely to the admissibility of late-filed evidence ran counter to **procedural economy** (Art. 15(6) RPBA). Before setting out its conclusion as to whether the late-filed experimental data was admissible, the board (citing **T 270/90**, OJ 1993, 725, point 2.2 of the Reasons) had first of all reiterated that, in accordance with the criteria established by the boards for the exercise of discretion to admit or disregard such evidence, it had to ensure that the late submission was not a **tactical abuse of procedure** prejudicial to procedural fairness and that admitting the evidence would not infringe the other party's right to be heard.

In case **T 712/97**, the opposition division did not allow the appellant's experimental report in response to the respondent-patentee's experimental report into the proceedings. To admit the experimental report of one party, but not the response of the other party gave the appearance of **discriminatory treatment**. The opposition division had committed a procedural violation.

In **T 973/10**, the board, in exercising its discretion to decide whether to admit late-filed evidence of prior use, considered whether there were any circumstances justifying its late submission and whether it was prima facie relevant. It found that there was no justification, rejecting the appellant's (opponent's) argument that finding the evidence had been costly. The financial consequences of the workload involved could not justify submitting new evidence at the appeal stage. Nor was the late submission justified by the appellant's decision to appoint a new representative for the appeal. The board then held that the evidence was anyway not prima facie relevant. The **photographs** produced were not sufficiently compelling evidence because they did not enable it to reach any objective conclusion as to the nature and structural details of the device allegedly disclosed at a meeting. It thus refused to admit the late-filed evidence into the appeal proceedings (Art. 114(2) EPC in conjunction with Art. 12(4) RPBA).

The board in **T 508/00** ruled that poor communication within a company or group of subsidiary companies was not an adequate and acceptable reason to admit late-filed documents the opponent had submitted during the appeal proceedings in support of an alleged prior use. Moreover, the documents in question, which included technical drawings with no explanations, were so large in number that it would have been difficult for the board or the other party to deal with them properly. The board therefore refused to admit them. By contrast, it admitted written statements produced by the opponent because they related to the alleged prior use, had been submitted relatively early in the appeal proceedings, giving the patent proprietor time to respond to them, and constituted a response to the opposition division's decision and to employee statements produced by the proprietor a month prior to the oral proceedings before the opposition division.

In **J 20/85** (OJ 1987, 102), the Legal Board held that evidence should be taken as soon as an issue arises. In a dispute between the appellant and the Receiving Section as to whether a particular document had been filed on a particular day, the post room staff could not have been expected to have a clear recollection of what had happened more than a year after the events in question. See also in this chapter: **T 1028/11** (late-filed request for a witness hearing); **T 2003/08** (hearing of a duly summoned witness who had failed to confirm attendance but was present on the appointed day).

In **T 190/05**, the board found that the opposition division had been wrong to base its finding that an alleged prior use had destroyed a patent's novelty solely on a statutory declaration, because the patent proprietor had expressly disputed both the allegations made by the opponent and those in the declaration, which represented, besides, a piece of evidence and not in itself prior art. That it would have been impossible to give the witness named by the opponent the minimum two months' advance notice (R. 72(2), first sentence, EPC 1973, R. 118 EPC) of the already scheduled oral proceedings was not, in the board's view, an exceptional circumstance justifying the failure to invite him. The

case was remitted to the opposition division for a hearing of the witness and also to avoid the loss of two instances for determination of the case.

A party may be heard in the absence of his patent attorney if the latter has been duly informed (cf. **T 451/89** and **T 883/90**, ex parte cases concerning apparatus that seemed to operate in a manner clearly contrary to well-established physical laws – taking of evidence ordered at oral proceedings).

### 3.3. Right to be heard

An opposition division's refusal to consider evidence filed **in due time** infringes a party's fundamental right to free choice of evidence and the right to be heard (**T 142/97**, OJ 2000, 358). Pursuant to Art. 113(1) EPC each party must be allowed to comment on any evidence legitimately submitted in the proceedings. Allowing one party, even the party that originally submitted the evidence, to require unilaterally and arbitrarily that the evidence be withdrawn or excluded from consideration would infringe this right (**T 95/07**; cf. the case in **T 760/89**, OJ 1994, 797, concerning a return of documents filed as evidence).

As a rule, if assertions made in an unsworn witness declaration ("eidesstattliche Versicherung") remain **contested**, a request from a party to hear the witness must be **granted** before these assertions are made the basis of a decision against the contesting party. In **T 474/04** (OJ 2006, 129), the opposition division had revoked the patent in suit because the invention did not involve an inventive step over the prior use evidenced in the declaration in lieu of an oath. Since fundamental assertions made in the declaration had been contested, the author was offered as a witness. Although the appellant (patentee) had consistently demanded that the author be heard, the opposition division decided not to summon him as a witness, even though he was available. In the board's view, the appellant had effectively been prevented from making use of a decisive piece of evidence. Thus, the opposition division had infringed the appellant's right to be heard, which constituted a substantial procedural violation justifying the remittal of the case to the department of first instance (this decision was extensively cited in **T 190/05**).

Failure to consider evidence will normally constitute a substantial procedural violation in that it deprives a party of basic rights enshrined in Art. 117(1) and Art. 113(1) EPC (**T 1098/07**). In **T 135/96** (point 3 of the Reasons), ignoring documents (and arguments) relevant to inventive step was found to violate the party's right to be heard. The board in **T 1110/03** (OJ 2005, 302) made a similar finding where indirect evidence substantiating an allegation of fact relevant to novelty was disregarded. In **T 1110/03**, the board observed that Art. 117(1) EPC and Art. 113(1) EPC embody a basic procedural right generally recognised in the EPC contracting states, viz. the right to give evidence in appropriate form (specifically by producing documents under Art. 117(1)(c) EPC) and the right to **have that evidence heard** (**T 1110/03**); except to the extent that they were expressly excluded from the debate (**T 2294/12**). In **T 1536/08** the opposition division had infringed the opponent's right to be heard by completely ignoring the unambiguous offer in its notice of opposition to provide the original printed versions of crucial prior-art documents (see also Chapter III.B.2.4.3 "Failure to consider evidence").

In **T 838/92** the board observed that in applying the principle of free evaluation of evidence, the opposition division or the board of appeal must exercise caution when evaluating the testimony of a witness whose impartiality is in doubt, with the parties of course being given an opportunity to comment on that testimony (Art. 113(1) EPC 1973). The board was not minded to sustain the appellant's objection to consideration of court bailiffs' reports on the basis that they had been established unilaterally. Such documents recording findings of fact were merely pieces of information which could be added to the file as evidence once they had been **submitted to the parties for comment**. In **T 909/03**, where one of the appellants had objected to the manner in which a witness had been heard, the board held that it was not necessary for a party to be given a copy of the minuted testimony before questioning a witness. During the oral proceedings the party had been given sufficient opportunity to comment on the testimony of the witness.

In **R 6/12** (case **T 928/10**), the Enlarged Board considered unfounded the assertion made by the petitioner (opponent) in its first ground for review that it had been surprised by the board's failure to order that expert witnesses be heard. The petitioner could and should have taken an **active part in the proceedings** and, in particular, it was up to it to inform the board during the debate of any need to hear witness to support its line of argument. In its second ground for review, the petitioner contended that the board's decision did not take account of its arguments in general or, more specifically, the submissions of an assistant expert on the technical effect alleged by the patent proprietor. The Enlarged Board, without assessing the evidence the board had taken into account, which would have amounted to revisiting the substance of the case and so fell outside the ambit of the review procedure, dismissed the petitioner's claim to have been denied its right to be heard as unfounded. The board was **not obliged to address in detail each and every argument** presented by the party. The Enlarged Board had already found in **R 21/09** that, on the pretext of an alleged infringement of the right to be heard, it was actually being asked to review the substance of the decision by examining whether the evidence the board had relied on had been appropriate and sufficient. This clearly fell outside the ambit of review proceedings, it being solely a matter for the board to decide whether to take a piece of evidence into account and, if so, to determine its probative value.

While it is well-established by case law that **third-party observations** can be considered, both at first instance and on appeal, there is no obligation on the board beyond such consideration and no right of a third party to be heard on the admissibility of its observations and of any evidence in support of observations. The admissibility of third-party observations (and accompanying evidence) is entirely a matter for the board (**T 390/07**). As a rule, third parties have none of the procedural rights associated with status as a party to the proceedings, in particular the right to be heard (**T 1756/11**). Conversely, parties to the proceedings can comment at any stage on new facts and evidence emerging from third-party observations filed after expiry of the opposition period, if they think that these could influence the decision (**T 1756/11**; see also Chapter III.N. "Third-party observations").

In **T 267/06** an **affidavit** with an attached, **undated drawing** (item D12) and a witness hearing had been offered as evidence of the public prior use claimed in the notice of



opposition. The opposition division had rejected the opposition to the European patent. The only reference it had made in its decision to the offer of a witness hearing as evidence was in the "Summary of facts and submissions", while the reasons dealt exclusively with the item D12 affidavit and drawing. In the board's view, essential details referred to in the affidavit and deemed to be illustrated in the drawing seemed not to have been taken sufficiently into account by the opposition division. In those circumstances, the witness hearing offered as further evidence should not have been disregarded for the purposes of assessing the claimed public prior use as per D12. This amounted to a fundamental procedural violation as it deprived the opponent of the opportunity to exercise the right to be heard under Art. 113(1) EPC.

The appellant in **T 1028/11** alleged that the opposition division had infringed its right to be heard, and so committed a procedural violation, by refusing to hear the witness it had offered. The board disagreed: a witness's function was, in essence, simply to corroborate the alleged facts on which they were heard and not to fill in gaps in those facts. Parties therefore had to specify what legally relevant facts the witness's testimony was intended to prove. Based on the evidence available, the opposition division had taken the view that the public prior use was not prejudicial to patentability. The board found that there would have been little point in hearing the witness at that stage. During the oral proceedings, the opponent had again requested that the witness be heard. Given the witness's absence, however, the opposition division could not have granted the request without adjourning the proceedings. Thus, at that late stage of the proceedings, the opposition division had been entitled to dismiss the request and had not thereby committed any procedural violation. This case was cited in **T 444/09**.

In **T 2003/08**, witnesses were summoned in accordance with R. 118 EPC and they were invited to confirm their attendance. Neither witness replied at all. But both witnesses were present on the day for which they were summoned. The appellant (patentee) requested the board to refrain from hearing them. The failure to react to the invitation in the summonses did not have any influence on the board's view that the witness evidence of Dr W and Dr K was necessary. Furthermore the board stressed that if a witness does not himself comply with a request directed to him, it does not mean that the party or representative is indulging in "**procedural games**".

In **T 361/00** the board ruled that there was no point hearing the author of statutory declarations as a witness at oral proceedings because, in view of the other aspects on file that had been discussed, it would not change its decision. Nor did the board agree that the opposition division had committed a substantial procedural violation by ignoring an offer to present the witness: the minutes of the oral proceedings – which the party concerned had not contested – did not record that it had made such an offer.

In **T 1872/08**, the board decided that in not admitting the comparative tests offered by the patentee, the opposition division had not taken into account that it deemed further comparative data to be absolutely necessary in order to overcome its objections as to inventive step. The opposition division had thus **deprived** the patentee **of the possibility to defend its case effectively**. For these reasons, the opposition division

had not used its discretion in a reasonable way by not admitting the additional comparative tests.

In **G 4/92**, concerning the exceptional case of a decision taken against a party who has been duly summoned but fails to appear at oral proceedings, the Enlarged Board established that **new evidence** may not be considered unless it has been previously notified and 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 (**G 4/92**, OJ 1994, 149, headnote 2). For more on non-attendance at oral proceedings, see Chapter III.C.3.

In **R 21/09**, the party alleged an **infringement of the right to defence** on the basis that the board had refused to allow further discussion of **all the documents submitted to the English courts**.

See also Chapter III.B.1 "Right to be heard".

### 3.4. Return of filed evidence

As a rule, documents filed as evidence during opposition proceedings and submissions referring to them remain in the file until the end of the proceedings and for at least five more years (see R. 147 EPC (amended since then: OJ 2015, A83); former R. 95a EPC 1973). 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 might be the case if the documents have been filed in **breach of a confidentiality agreement** and if they do not belong to the state of the art but are third party statements filed as part of the response to the opposition, and if the other parties involved agree with the request. The same applies to submissions referring to such documents (**T 760/89**, OJ 1994, 797).

## 4. Evaluation of evidence

### 4.1. Principle of free evaluation of evidence

Neither in the EPC nor in the case law of the board of appeal are formal rules laid down for the evaluation of evidence. The Enlarged Board of Appeal has recalled that proceedings before the EPO are conducted in accordance with the principle of the free evaluation of evidence (**G 1/12**, OJ 2014, A114, citing **G 3/97**, OJ 1999, 245, point 5 of the Reasons, and **G 4/97**, OJ 1999, 270, point 5 of the Reasons).

Thus the EPO departments have the power to assess whether the alleged facts are sufficiently established on a case-by-case basis. Under the principle of free evaluation of evidence, the respective body takes its decision on the basis of all of the evidence available in the proceedings, and in the light of its conviction arrived at freely on the evaluation whether an alleged fact has occurred or not (see e.g. **T 482/89**, OJ 1992, 646; **T 592/98**, **T 972/02**; see also e.g. **T 838/92**, in which the board found there was a

detailed and consistent body of evidence establishing that a device had been on sale before the patent application was filed). However, the principle of free evaluation of evidence in EPO proceedings cannot go so far as to justify the refusal of a **relevant and appropriate** offer of evidence. Free evaluation of evidence means that there are no firm rules according to which certain types of evidence are, or are not, convincing. The deciding body must take all the relevant evidence before deciding whether or not a fact can be regarded as proven (**T 474/04**, OJ 2006, 129, citing **G 3/97**, OJ 1999, 245, point 5 of the Reasons). On the other hand, failure to submit evidence despite a board's request to do so may be viewed as a sign that the evidence would perhaps not confirm what has been claimed (see **T 428/98**).

When evaluating evidence, it is necessary to distinguish between a document which is alleged to be part of the state of the art within the meaning of Art. 54(2) EPC, in the sense that the document itself is alleged to represent an instance of what has been made available to the public before the priority date of the opposed patent, and a document which is not itself part of the state of the art, but which is submitted as evidence of the state of the art or in substantiation of any other allegation of fact relevant to issues of novelty and inventive step (**T 1110/03**, OJ 2005, 302). In the first situation, a document is **direct evidence** of the state of the art; its status as state of the art cannot normally be challenged except on authenticity. In the second situation, a document is also **evidence** albeit **indirect**; it provides a basis for an inference about, e.g. the state of the art, common general knowledge in the art, issues of interpretation or technical prejudice etc. – an inference which is subject to challenge as to its plausibility. Only a document of the first kind can be disregarded on the sole ground that it is published after the priority date. Documents of the second kind do not stand or fall by their publication date even on issues of novelty and inventive step. Disregarding indirect evidence would deprive the party of a basic legal procedural right generally recognised in the contracting states and enshrined in Art. 117(1) and Art. 113(1) EPC.

Following the above distinction, the board in **T 1797/09** held the comparative examples in document D1 that had not been made available to the public at the priority date, i.e. a document that qualified as indirect evidence, to be equivalent to the comparative examples put forward by a party as proof of its allegations. Such examples were allowable at any reasonable point of the proceedings, provided they were not in abuse of the proceedings. In the case at issue, the comparative examples in document D1 cast doubt on the allegation that the claimed features would solve the technical problem in a non-obvious manner. The patent was thus revoked for lack of inventive step.

The board in **T 419/12** likewise applied the distinction clarified in **T 1110/03** and ruled that the fact two of the documents cited had been published after the priority date did not preclude their admission for the purpose of clarifying facts or common general knowledge.

#### 4.2. Probative value of evidence on a case-by-case basis

According to the principle of free evaluation of evidence, each piece of evidence is given an appropriate weighting according to its probative value. As the Enlarged Board of

Appeal pointed out in **G 3/97** (OJ 1999, 245, point 5 of the Reasons) and **G 4/97** (OJ 1999, 270, point 5 of the Reasons), "(t)he principle of free evaluation would be contradicted by laying down firm rules of evidence defining the extent to which certain types of evidence were, or were not, convincing" (cited in **G 1/12**, OJ 2014, A114).

The following cases illustrate how the boards have evaluated various pieces of evidence in the light of the specific circumstances.

#### 4.2.1 Witness testimony and written statements

See also in this chapter III.G.2.2 and III.G.2.3.

The probative value of the declarations of a witness depends on the circumstances of the particular case (**T 937/93**, cited in **T 190/05**). 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**). An allegation based solely on suspicion cannot reasonably be expected to form a valid ground for casting doubt on the credibility of the evidence (see **T 970/93** involving allegations of falsified evidence). The statements of employees of one of the parties were regarded as sufficient evidence in a series of appeal cases, e.g. **T 162/87** and **T 627/88**, **T 124/88**, **T 482/89** (OJ 1992, 646), **T 363/90**, **T 830/90** (OJ 1994, 713), **T 838/92** and **T 327/91**, **T 190/05**, **J 10/04** (employee of representative's law firm).

In **J 10/04**, the Receiving Section had doubted the credibility of sworn statements given by a legal assistant on the basis that they were not persuasive because she was not impartial and her statements were based on personal impressions. It had not invited her to be heard in person as a witness because it had considered that this would not lead to a different its evaluation of the evidence. The Legal Board held, first of all, that a sworn statement was a form of evidence with a high probative value, especially if it was given, as in the case in point, in the knowledge that wilfully false statements were punishable under the applicable law. Strong reasons were therefore needed to disregard this kind of evidence, for example a set of circumstances making the statement very unlikely. If the Receiving Section had considered the circumstances described in the statement very unlikely, it ought to have heard the witness personally in order to evaluate her credibility (the ruling in **J 10/04** has been applied in e.g. **T 1100/07**, in which the board reiterated some of the rules on hearing witnesses).

With regard to the credibility of witnesses, the board observed in **T 1210/05** that even a person who was not being dishonest might make untruthful statements. A person can be honestly mistaken in his recollection of an event, particularly if the event took place some time ago.

In **T 100/97**, without casting doubt on the good faith of the submitted declaration, the board stated that for the content of such statements to be considered sufficiently credible, it had to be **corroborated by documents of a definite date**. In the absence of any such documents, the board decided that it could not be established with a sufficient

degree of certainty what had been made available to the public before the priority date of the opposed patent.

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 1191/97** the appellant's criticism of the evaluation of evidence by the department of first instance did not pose a serious threat to the witness's credibility. The fact that the events at issue had taken place a long time ago could readily explain certain imprecisions in the witness's testimony. The board saw no indication that the witness had been in breach of his obligation to testify to the best of his recollection.

In **T 61/07** the board made clear that the doubts cast by the respondent on the witness's memory about events which had happened 23 years ago concerned not the witness's credibility but the **credibility of the testimony**. However, it saw no reason to doubt that his testimony was credible. Just because the witnesses had each independently met a third witness before being heard did not automatically mean that their recollections had been influenced. Shortly before a party alleges prior use, witnesses are normally sounded out about what they actually remember. Such a discussion with a potential witness did not automatically imply that during it the party or one of its staff had influenced what the party remembered.

In **T 905/94**, the board held that the fact that one witness had made his declaration three years earlier than other witnesses was not sufficient reason to make his testimony more credible.

In **T 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 361/00**, the appellant (opponent), seeking to establish novelty-destroying public prior use during the opposition proceedings, had submitted a technical report and a statutory declaration ("eidesstattliche Erklärung") relating to visits to a cement works and proposed that the declaration's author additionally be heard as a witness. On appeal, it submitted two new documents, one being a second statutory declaration by the same author. The board went into the circumstances of the visits and the particular features of cement works in some detail and, observing that it was common ground between the parties that the technical report had not been made available to visitors, held that the fact that they could have found out what was in it **on request** did not mean its content had been made publicly available. Visiting a cement works was not the same as visiting a library. As to the two **statutory declarations**, the board had no doubt that they had been made in good faith but found them to be **contradictory**. Having found that the appellant's submissions at the oral proceedings had not clarified the contradictions, it

concluded that the appellant had failed to furnish conclusive proof of the alleged prior use. Lastly, it held that there was no need to hear the witness, giving reasons for this finding (on contradictory statements, see also **T 833/99**).

In **national proceedings** before the Dutch District Court and Court of Appeal, several witnesses had been heard, and written statements had been introduced by both parties. The Dutch Court of Appeal could not establish an uninterrupted chain of proof that the alleged public prior uses had indeed taken place before the priority date of the contested patent. After evaluating the Dutch Appeal Court's findings, the board's judgment in **T 665/95** was that no further investigations were necessary and that the conclusion of the Dutch Appeal Court could be followed, with the consequence that the subject-matter of the granted claim 1, contrary to the impugned decision of the opposition division, was considered to be novel. (Other examples of cases in which findings made in national proceedings served as evidence include **T 760/89**, OJ 1994, 797 (USA); **T 582/90** (FR), **T 1043/93** (IT), **T 885/02** (NL); **T 276/07** (IT); **T 407/08** (DE); **R 21/09** (UK); **T 1904/12** (DE) and **T 202/13** (NO)).

An **unsigned statement** by an unknown and unnamed person should in principle be given minimal weight (**T 750/94**, OJ 1998, 32). In **T 212/97**, the board could not regard the citation of facts based on **hearsay** and not accompanied by a witness testimony as adequate evidence for the alleged prior uses.

#### 4.2.2 Test and experimental evidence

In **T 702/99** the board made extensive remarks with regard to the probative value of test evidence. It noted that it was essential that **comparative tests** conducted by a number of persons as evidence for or against qualities such as an improved "feel" of a product (e.g. cosmetics) be made under conditions of maximum objectivity on the part of those conducting the tests. Parties to proceedings should adopt the same standards in the preparation of such test evidence as they should in the preparation of experimental evidence. While the use of independent persons would naturally tend to carry more weight, the use of employees might not be objectionable per se as long as the test conditions were designed to ensure that the employees were not biased by prior knowledge of either the tested products or of their employer's expectation of the test result. The presentation of test evidence also had to be accurate, but the format of the presentation was of secondary importance; a carefully prepared report and/or table might convey as much information as a large number of statements from the testers.

In **T 275/11**, the invention concerned a bleaching/highlighting composition for hair. In order to demonstrate that the problem was successfully solved, the appellant (patentee) referred to two comparative examples. The board cited **T 702/99** and recalled that the comparison had to be made under conditions that ensured maximum objectivity on the part of those conducting the tests. It was desirable to show that the tests had been **carried out under "blind" conditions** to avoid any suspicion of bias. The board found that there was no indication of the conditions under which these tests had been conducted. Therefore, any effects referred to by the appellant had to be disregarded.

In **T 453/04** the board found the **experimental evidence** advanced by the appellant (opponent) to be defective for two reasons. Firstly, the teachings of the patent in suit were not accurately replicated. Secondly, the product presented as representative of the prior art had not been shown to belong to the prior art. Thus the experimental evidence of the appellant did not demonstrate that the process steps set out in claim 1 of the main request resulted in products indistinguishable from those of the prior art.

In **T 1872/08** which concerned inventive step and the non-obvious solution of a problem based on an advantageous effect demonstrated by means of comparative tests, the Opposition Division had not deemed the tests provided by the applicant (appellant) to be relevant because the tests had been made with one specific printer on one specific paper, both different from the paper and the printer used in example 18 of document (D9). The board stated that, according to the established jurisprudence of the boards of appeal, "in the case where comparative tests are chosen to demonstrate an inventive step with an improved effect over a claimed area, the nature of the comparison with the closest state of the art must be such that **the effect** is convincingly shown to have its **origin in the distinguishing feature of the invention**. For this purpose it may be necessary to modify the elements of comparison so that they differ only by such a distinguishing feature ..." (**T 197/86**, OJ 1989, 371, point 6.1.3 of the Reasons). The board concluded in **T 1872/08** that the comparative tests provided sufficient evidence that the problem was solved.

In **T 71/09**, the tests cited by the appellant (proprietor) had compared a composition according to the invention with a different composition found in the prior art. The board observed that, where comparative tests were chosen to establish inventive step on the basis of an effect produced over the claimed area, the comparison with the closest prior art had to show convincingly that the effect was **attributable to** the distinguishing of feature the invention. In the circumstances of the case, however, a mere comparison of the two compositions was insufficient to demonstrate that the alleged effect had been caused by the claimed solution or that this effect had been produced across the entire claimed area. Indeed, the improved resistance of hair dye to shampoos might **be caused by other factors**. Improved durability of hair dye had not been established for all the claimed compositions.

In **T 479/06**, the board found that tests results cited by the proprietor to show that the problem was solved by the claimed solution and so establish inventive step were **not conclusive**. It could not conclude on that basis that the technical problem had actually been solved, so the technical problem had to be redefined.

In **T 1127/10** (hair treatment), the problem to be solved had been defined in the light of the closest prior art. The next step was to examine whether the claimed subject-matter actually solved that problem and, if not, to redefine the problem. Since there was no experimental data in any of the examples in the patent, the appellant had submitted a document reporting on two series of comparative tests. The board, however, after reiterating the criteria to be met by comparative tests produced to establish a technical improvement over the closest prior art, found that the document's description of the test procedure and analysis of the results were deficient and insufficiently informative to

demonstrate plausibly that such an improvement had been achieved (see also **T 1962/12**: comparative examples deficient – improvement not plausibly demonstrated).

The board in **T 578/06**, noting that the EPC does not require experimental proof for patentability, considered that the disclosure of experimental data or results in the application as filed and/or post-published evidence was not always required to establish that the claimed subject-matter solved the objective technical problem. This was particularly true where no substantiated doubt had been raised.

The Enlarged Board stated in **R 9/14** that the petitioner was mistaken in believing that the deciding board had committed a serious procedural violation by not informing it of the correct sequence to be followed in the problem-solution approach and in the way it had applied the substantive law. The submission of comparative-test results to prove an effect or improvement was part of the problem-solution approach when establishing the problem over the closest prior art that is effectively solved by the claimed subject-matter. The petitioner's specialist knowledge of patent law should have told it that. There could thus be no question of a "surprise" or infringement of the right to be heard.

In **T 1248/08**, in the application as filed, a number pertaining to a value used in example 1 was illegible and indecipherable. It was not clear whether it should read "0.08" or "0.09", or even "0.05". The board held that the arguments of the appellant adopting proof "on the balance of probability", in particular **a survey** in favour of the value of "0.09", had to fail. According to the survey conducted amongst partners and staff at the firm of the appellant's representative these results demonstrated that the value in question could not be considered to be "0.09" with a certainty "beyond reasonable doubt", as required by the established jurisprudence. In any event, a question of accuracy and disclosure could not be decided by a **poll** (see also Chapter II.E.5 "Evidence and standard of proof for allowing amendments and corrections").

#### 4.2.3 Archives and internet publications

In **T 314/99** concerning the availability to the public of a diploma degree paper ("Diplomarbeit"), the board took the view that the paper had not become publicly available by its mere arrival in the archive of the Chemistry Department Library of the University. The **logbook** produced in evidence was a handwritten note book in which the diploma degree papers received in the archive were entered by the librarians. The logbook itself was not an official publication of the library but essentially an internal document of the library staff. After closer examination of the annotations in the logbook, the board said that it could not be concluded with certainty that the relevant entries had actually been made before the relevant priority date and it could not be ruled out that they had been added at a later time, when for one reason or another the time frame had become relevant. (See also, with respect to a diploma thesis allegedly disclosed during an oral presentation, **T 1057/09**).

In **T 91/98** the respondent (opponent) had challenged inventive step on the basis of document (8) which was an **entry from the Lexis-Nexis database**. The document did not, however, provide any evidence as to when this information had been entered into



the database, i.e. as to when it had been made available to the public. Nor could the date of availability be taken as the date mentioned in the heading of the entry (September 3, 1985) as this latter date could not be equated to the distribution date of the information and was not even necessarily correct. After detailed evaluation of the declarations and affidavits filed by the respondent the board arrived at the conclusion that the date on which the information contained in document (8) had been made available to the public could not be unambiguously defined.

In **T 286/10**, the board held that a merely general allegation that **digital libraries** were unreliable was not enough to cast doubt on the date on which a document stored with Internet Archive ([www.archive.org](http://www.archive.org)) had become publicly available. It applied the usual standard of proof on the balance of probabilities (more recently, **T 2227/11**).

In **T 1698/08**, there was no reason for the board to exercise its discretion to refuse to admit the evidence, as it could neither be said that it was irrelevant nor that it was unnecessary. A refusal to admit could in any case not be based on statements in the document with respect to the **accuracy of the facts** it contained. Such statements related to the probative value of a document. Based on the principle of the free evaluation of evidence (**G 3/97**, OJ 1999, 245, point 5 of the Reasons), the board is free in assessing to what extent the information in a document is credible, whereby such a statement may play a role. Case **T 1698/08**, in respect of the disputed validity of an authorisation related to an (internet) **uncertified extract** from a commercial register.

For decisions on internet disclosures, see aforementioned **T 286/10**, in which the board rejected the conclusion reached in **T 1134/06** that digital libraries on the internet are inherently unreliable (see chapters III.G.4.3.1 and III.G.4.3.3 below, dealing with standards of proof), but also **T 1469/10** and Chapter I.C.3.2.3 "Internet disclosures" and I.C.3.5.2c) "Internet – proof of the date of availability". Lastly, see **T 1553/06** (point 5 of the Reasons, pages 41 to 43) and **T 2/09** (point 3.2 of the Reasons, pages 53 to 56), both exceptional in that they were test cases (N.B. both these decisions preceded **T 286/10**).

#### 4.2.4 Other written evidence

In **T 332/87** a dated **internal paper**, marked as being confidential and not signed, was - together with an undated leaflet - not considered sufficient evidence. In **T 595/89** the board decided that the opponent's in-house documents relating to the installation of a device in an aeroplane and to the sale thereof were not sufficient to prove public prior use.

In **T 204/88** a **letter of tender** was not sufficient to prove public prior use because it was not discernible when and to whom the device was to be delivered and because the device was described in terms too general for anyone to identify whether it corresponded to the invention. In **T 725/89** too, a dated tender was not regarded as sufficient evidence, as it was not proven when the tender had actually been presented, and the date of the tender was only one week prior to the priority date. By contrast, the board took the view

in **T 482/89** (OJ 1992, 646) that an **unsigned delivery note**, together with other documents, could constitute sufficient evidence of delivery.

In **T 48/96** the board decided not to accept copies of pages from a **catalogue** bearing a date as sufficient proof of availability to the public. In order to prove the allegation that a particular apparatus described in a catalogue had been available to the public before the priority date, it was not sufficient to show that the catalogue had been published on time, because a mere indication in a catalogue did not constitute absolute proof that the described product had in fact been available to anybody; for example, there could have been a delay (see in this chapter III.G.4.3.3 for examples of cases concerning catalogues and commercial brochures, including **T 1710/12**, in which the board addressed the implications for the standard of proof where such a catalogue has not been produced in support of alleged prior use).

In **T 905/94** the patent proprietor had exhibited a blind at an exhibition. After having considered the evidence regarding the exhibition the board looked at the question of whether use of the same **trade name** for different models could constitute evidence of the fact that the patent proprietor had marketed or described the blinds according to the patent at issue before the date of priority. In the board's opinion, such use could not constitute sufficient evidence since it was common practice in industry for the same name to be used and retained for a product, the technical characteristics of which changed over time as improvements were made.

In **T 2357/12** concerning the transfer of opponent status and the concept of "universal succession", the board commented on the evaluation of evidence. The proprietor questioned the probative force of **private documents**, as submitted in this case, rather than public registration documents, as evidence of the transfer of opponent status in inter partes proceedings. The board stated that whereas **public registers** often enjoyed public trust regarding the facts registered and other public documents might be more conclusive on formal questions, the identity of the issuer and the date and place of creation of a private document could be more easily contested. However, neither kind of document provided irrefutable evidence of the correctness of a document's content. Citing examples of the different types of documents accepted in individual cases, the board pointed out that the boards had always accepted public and/or private documents as evidence of the transfer of rights, whether by way of universal succession or a single transfer of assets. The level of proof required was credibility of the facts for which evidence was given, in the light of all circumstances.

The opponent having died, the board had to decide in **T 74/00** whether the evidence had shown that an heir or heirs had succeeded to the right of the opponent to appeal or to the appeal itself. In the board's view, the best evidence which could be provided was evidence of the relevant law of succession (here, Japanese law) by way of **legal opinion** from a Japanese attorney-at-law; the mere filing of copies of a party's correspondence with his instructing Japanese attorneys could not serve as substitute. In **T 205/14** (and **T 517/14**) Israeli law (applicable) was proved to the satisfaction of the board by an expert opinion provided by the party (right of priority – assignment).

### 4.3. Standard of proof

#### 4.3.1 General – "Balance of probabilities"

The EPO departments decide on the issues that arise before them on the basis of the evidence adduced by the parties. Their decisions need not, and in most cases cannot, be based on absolute conviction, but instead are to be arrived at on the basis of the overall balance of probabilities, in other words on the footing that one set of facts is more likely to be true than the other. If the result of the boards' evaluation of the evidence is such as to persuade them one way or another, then the **balance of probabilities** standard is met. This standard applies particularly in opposition appeal proceedings where the boards of appeal are called upon to reach a conclusion on the basis of the overall balance of probabilities, as distinct from "beyond all reasonable doubt" or "absolute conviction" (on the latter concept, refer to the more recent case **T 2451/13**). Each of the parties must therefore seek to prove facts alleged by it to that degree of proof (see e.g. **T 182/89**, OJ 1991, 391; **T 270/90**, OJ 1993, 725; **T 859/90**, **T 109/91**, **T 409/91**, OJ 1994, 653; **T 1054/92**, **T 296/93**, OJ 1995, 627; **T 326/93**, **T 343/95**, **T 363/96**). The standard of balance of probabilities applies also in decisions issued in ex parte proceedings (**T 381/87**, OJ 1990, 213; **T 69/86**, **T 128/87**, OJ 1989, 406; **T 939/92**, OJ 1996, 309).

When an issue of fact is being examined and decided by the EPO on the balance of probabilities, **the more serious the issue** the more convincing must the evidence be to support it. If a decision on such an issue may result in refusal or revocation of a European patent, for example, in a case concerning alleged prior publication or prior use, the available evidence in relation to that issue must be very critically and strictly examined. A European patent should not be refused or revoked unless the grounds for refusal or revocation (that is, the legal and factual reasons) are fully and properly proved (**T 750/94**, OJ 1998, 32; **T 329/02**). See also Guidelines G-IV, 1 "State of the art – General remarks and definition" – November 2015 version): "If the applicant shows sound reasons for doubting whether the document forms part of the 'state of the art' in relation to his application and any further investigation does not produce evidence sufficient to remove that doubt, the examiner should not pursue the matter further."

The board in **T 286/10**, citing **T 472/92**, observed that it is settled case law that evidence is generally assessed in terms of what seems most probable; it made an **exception** only for public prior use objections where practically all the supporting evidence lay within the power and knowledge of the opponent (see in this chapter III.G.4.3.2 "Public prior use").

The strict standard was required for **internet disclosures** in **T 1134/06** (point 4.1 of the Reasons; affirmed in **T 1875/06**, points 7 to 9 of the Reasons), the board taking the view that internet archives were generally unreliable, and that the prior publication of an internet disclosure therefore had to be proven beyond all reasonable doubt. The board in more recent **T 286/10** disagreed. Instead, it followed **T 2339/09** (point 2 of the Reasons) and **T 990/09** (point 10 of the Reasons) and held that there was no legal basis for applying different evidential requirements to internet disclosures than to the prior art generally: in other words, the normal requirements – balance of probability or sufficient

presumption – applied, once any uncertainties had been clarified. There was no reason to apply the yardstick of "beyond any reasonable doubt". Nor could **T 472/92** be used, in the case in point, to justify a different standard of proof for internet disclosures. (More recently, see **T 2227/11**, with reference to the Guidelines and the Notice from the EPO concerning internet citations, OJ 2009, 456).

In the board's judgment in **T 658/04**, an expert's declaration which is not supported by verifiable facts but which merely constructs some hypotheses, cannot reflect the **common general knowledge** to be considered for assessing the sufficiency of disclosure within the meaning of Art. 83 EPC. For this reason, document (12) – declaration of U.K Pandit submitted by the appellant (patent proprietor) as an expert opinion – did not form part of the common general knowledge. **T 658/04** also summarised what is part of the common general knowledge according to the case law of the boards of appeal.

In cases concerning an application for re-establishment of rights in respect of the time limit for filing the statement of grounds according to R. 136 EPC (former Art. 122(2) and (3) EPC 1973), the application is regarded as duly supported only if it is clear from the facts set out and credibly substantiated ("glaubhaft gemacht") that the applicant took all due care required by the circumstances to observe the time limit (see **T 13/82**, OJ 1983, 411; cf. also **T 243/86**). It is not further specified whether this standard involves a lower degree of probability, as the term "Glaubhaftmachung" for the purposes of German, Austrian and Swiss law (see Chapter III.E.4.4).

#### 4.3.2 Public prior use

Although the standard of proof is the same for all objections covered by Art. 100 EPC (cf. **T 270/90**, OJ 1993, 725), the case law identifies two levels or standards of proof to be applied with regard to disputes around public prior use - either the "balance of probabilities" or "up to the hilt". The standard of **balance of probabilities** is applicable when both the patent proprietor and the opponent had access to the material of which public prior use is alleged (see e.g. **T 363/96**, **T 12/00**, **T 1105/00**, **T 2043/07**, **T 1464/05**, point 4.3 of the Reasons; **T 202/13**, point 15.6.2 of the Reasons; **T 1170/13**, point 2.3 of the Reasons). By contrast, in cases **where all evidence** in support of an alleged public prior use lies within the **power and knowledge of the opponent**, while the patentee has barely any or no access to it at all, it is incumbent upon the opponent to prove the alleged prior use **up to the hilt** (**T 472/92**, OJ 1998, 161; cf. **T 782/92** referring to proof "beyond any reasonable doubt"). Subsequent case law also confirmed that, where public prior use is cited, the assessment of probability which normally underlies the boards' opinion must yield to a stricter criterion close to **absolute conviction** (**T 97/94**, OJ 1998, 467; see also **T 848/94** and **T 12/00**; recent case **T 2451/13** discussed this concept). Decision **T 918/11** (point 3.3 of the Reasons) summarised the case law on standards of proof and the conclusion drawn in **T 750/94** (OJ 1998, 32), with the board also emphasising the need to take into consideration that the application of the strict standard of proof referred to in the impugned decision was not justified in view of the fact that the actual production and the selling of the containers was clearly outside the sphere of the opponent. The board was also of the opinion that the application of the standard of proof

"beyond reasonable doubt" did not justify disregarding the witness testimony (regarding facts which had occurred a long time ago). The more recent decision **T 2451/13** summarised the principles governing the standard of proof in case of public prior use and specified the meaning of the standard of "up to the hilt" (see Catchword) used in **T 472/92**, which is to prove beyond reasonable doubt. All the evidence about the publication date of a brochure was essentially in the hands of the opponent (brochure originated from a subsidiary of the opponent, on this latter point see also **T 738/04**).

If any reasonable doubt exists as to what might or might not be the result of carrying out the literal disclosure and instructions of a prior art document, in other words if there remains a "grey area", then the case of anticipation based on such a document has to fail (**T 793/93**; see also **T 464/94** and **T 95/07**).

In **T 2010/08**, the board pointed out that the requirement to prove prior use beyond reasonable doubt could not be circumvented by overstressing the principle of *ex officio* investigation and so shifting the burden of proof from the opponent to the opposition division or the board of appeal.

The board in **T 703/12** stated that all the evidence in support of the alleged public prior use (of a water filter jug, presented at the Ambiente trade fair in Frankfurt) lay within the power and knowledge of the appellant (opponent). The respondent (patent proprietor) disputed that the "what" was disclosed and that the "circumstances" of the prior use were proven beyond any reasonable doubt. The board was not convinced that either what was disclosed or the circumstances of the alleged disclosure had been proven to the required degree of certainty, namely beyond any reasonable doubt.

**T 274/12** dealt with an alleged prior use (talks between firms), all the evidence being in the hands of the opponent. In this case the board had to also decide whether there was an implicit obligation to maintain secrecy.

In **T 1469/08**, the appellant (opponent) alleged a public prior use in the form of the sale of composite "PARP PU" prostheses before the patent's priority date. Although the public prior use stemmed from the opponent itself, it had provided only **sales records** to substantiate the prostheses' availability. In such circumstances, there were **serious doubts** that documents actually existed establishing the prostheses' availability to the public before the priority date. See also **T 71/09**, setting out the case law and citing **T 750/94** and **T 97/94**. The respondent (opponent) alleged public prior use prejudicial to the novelty and inventive step of the subject-matter claimed. Here too, the prior use was its own: the evidence presented involved its company's sale of a certain product. The board held that the evidence submitted failed to establish the product's composition beyond any reasonable doubt.

In **T 674/91**, the board stated that all the assertions (affidavits or declarations) made by different witnesses of the alleged prior use and which were in agreement with one another already provided **sufficient evidence** of the commercial nature of the tests mentioned. An obligation of confidentiality could not have existed, since the access to

the new tool was not restricted to a particular group of persons. The board concluded that the prior use was prior art within the meaning of Art. 54(2) EPC 1973.

In **T 1210/05**, the board concluded that the contested prior disclosure via the **public display of a poster** identical to document (1) at an Edinburgh congress had not been sufficiently established, i.e. beyond all reasonable doubt, based on the following considerations: the fact that the various means of evidence, namely the submitted documents, the affidavits of the witnesses as well as their oral testimony, did not contradict each other was not sufficient to meet the required standard of proof. Furthermore, the finding of the opposition division rested **exclusively on the testimony of one of the witnesses**. No independent evidence (in writing or by other persons) was available to support it. This did not mean that the written and oral testimony of the witness was per se insufficient. However, the board stated that there had to be good reasons for treating this evidence alone as having established the facts beyond any reasonable doubt.

**T 1057/09** concerned a "diploma thesis" whose content was allegedly disclosed inter alia during an oral presentation before the priority date of the patent in suit (ephemeral - beyond any reasonable doubt).

In **T 225/03** the opposition division had not taken evidence by hearing the witness before revoking the patent because it had considered the allegation of public prior use to be adequately proven by the documentary evidence. The board found that level of proof to be insufficient, and held that the respondent's request – that the **documentary evidence be complemented by hearing the witness** – had to be granted, as only the witness could confirm the links between the individual pieces of evidence and the circumstances of use as explained in his statutory declaration. It therefore sent the case back to the department of first instance for further prosecution.

In **T 441/04** the board agreed with the respondent (patent proprietor) that evidence in document form was normally preferable to witness testimony about long-ago events. But that did not mean that in the case in point such testimony was necessarily excluded per se or less convincing than documentary evidence. Applying the (high) standard of proof beyond doubt, the board considered that it had taken due account of the fact that the alleged public prior use – proven by witness testimony – was attributable to the appellant. The evidence submitted (mainly witness testimony) had measured up to that standard, and therefore no new or additional proof (such as drawings) was needed.

In **T 1914/08**, the board – like the opposition division at first instance – regarded two witnesses' testimonies as the decisive evidence proving without any gaps the alleged prior public use. Each testimony, considered in isolation, gave a consistent and full picture of the process in question. Accordingly, it endorsed the opposition division's evaluation of the evidence, the standard of proof applied by it ("beyond all reasonable doubt") and the result of its analysis. It held, moreover, that the patent proprietor's (appellant's) request for additional evidence had to be refused. Since the opposition division had, in the course of its unfettered consideration of the evidence, concluded that the alleged prior public use had, essentially, been established by the two witnesses'

testimonies and since the appellant had been unable to cast doubt on the probative value of those testimonies, there was no need for the opponent (respondent) to adduce further evidence in either the opposition or the appeal proceedings.

In **T 833/99**, the opponent (appellant) had raised a novelty objection, claiming that prior use had occurred following public disclosure of an identical process: grooved-rail frogs for tramlines had been sold and installed in various German towns over a specified period. The opposition division had found this disclosure to be insufficiently proven, and had duly dismissed the objection. In support of its contention that the manufacturing process lacked novelty, the opponent relied on two photos (showing the grooved-rail frogs) measuring 6 cm by 6 cm and appearing inside a **prospectus**. The **photos** were **not clear enough** to say that the edges could not have been the result of flame-cutting. Lastly, during **invitations to tender**, the municipal employees had been required to observe confidentiality. The appellant said they might have breached that confidentiality, e.g. by informing repair workers of certain steps in the process, but **did not back this up with firm facts** such as dates, circumstances, etc., or with other evidence. Mere suppositions could not be entertained; they were not proof, and the onus was on the appellant to show that its **allegations were well founded** (**T 782/92**; **T 472/92**, OJ 1998, 161). Lastly, the board observed that there was no law to the effect that the confidentiality governing **tender procedures** ends when they do.

Features of subject-matter that was visible only briefly can be considered to have been made publicly available only if it can be shown beyond doubt that they were clearly and directly apparent to the skilled person for that short time (**T 1410/14**: train – test drive).

#### 4.3.3 Public availability of prior art documents

With regard to the public availability of **commercial brochures**, some boards adopt the less strict standard of the "balance of probabilities" (see e.g. **T 743/89** (brochure produced by the patentee) and **T 804/05** (prospectus issued by a third party)). Concerning a commercial brochure (prospectus) of a product produced by the opponent, in one decision, **T 1748/10**, the board considered it more appropriate to assess public availability on "the balance of probabilities" citing **T 743/89** and **T 1140/09** and not the standard "up to the hilt" as alleged by the patentee, in view of the fact that the brochure originated from the opponent. In the board's view, although D1 originated from the opponent, it was distributed to the public. Therefore both parties were able to access and adduce evidence relating to the availability of document D1. The board in **T 1140/09** considered the "balance of probabilities" to be the proper standard of proof to be applied for the question of the public availability of document E3, a brochure that had been distributed by the appellant (opponent) to visitors at CeBIT and had therefore been made available to the public before the priority date. In the particular case, **however**, the evidence presented by the appellant was such that it also met the stricter standard of proof as proposed by the respondent. Given the importance of large industrial fairs such as CeBIT for doing business and the strong interest of the appellant in making its brochure as widely available as possible, the board found that the public availability of document E3 was proven beyond reasonable doubt.

In **T 184/11** the board first had to decide whether the document was an advertising brochure or a product data sheet. It contained no detailed technical data, merely general technical information. After a detailed review of the case law on standards of proof and the public availability of advertising brochures, the board decided that nothing in the reasons given for the contested decision indicated that the opposition division, in assessing probability, had not critically and precisely evaluated the evidence before it.

In **T 146/13**, the proprietor maintained that it had not been proven beyond any doubt that an advertising brochure had been distributed before the patent's priority date. The board, citing settled case law on commercial brochures as prior art and in particular **T 743/89** and **T 804/05**, held that enough time (two years) had elapsed between printing and the priority date to conclude that the brochure really had been made available to the public. Adding that in practice the whole point of printing advertising brochures was to attract the attention of potential clients, it therefore decided that the brochure was prior art within the meaning of Art. 54(2) EPC. (Compare with **T 738/04**, point 4.1.1 of the Reasons).

In **T 743/89** it had been proved that a **leaflet** disclosing the invention had been printed seven months before the priority date, but it was uncertain when the leaflet had been distributed. Based on the balance of probabilities, the board concluded that the leaflet was available to the public before the priority date of the patent in suit and was, consequently, comprised in the state of the art. Although the date of distribution could no longer, i.e. 10 years on, be ascertained, it could reasonably be assumed that it had taken place within less than 7 months and had thus been completed well before the priority date of the patent in suit. The opposite assumption that the brochure had been kept confidential was not very plausible since it was in the patentee's own interest to ensure wide-spread distribution of the brochure in order to inform as many potential customers as possible of this latest development in a highly competitive field. Hence, the onus of proof was incumbent on the patentee who incidentally, being the originator of the pamphlet, should be in the possession of the necessary information.

In **T 2451/13** the board applied the standard "up to the hilt" as meaning beyond reasonable doubt concerning the publication date of a brochure (brochure originated from a subsidiary of the opponent - all evidence essentially in the hands of the opponent).

The board in **T 1710/12** agreed that the rigorous standard of "up to the hilt" is typically applied in cases where a prior use is involved. However, in the case before it, catalogue E1 had not been provided **in support of** an alleged prior use, but as written evidence on its own. The board thus deemed it appropriate to judge the public availability of E1 using the "balance of probabilities" approach. Document E1 (catalogue published by a company not being a party) was considered prior art under Art. 54(2) EPC.

In **T 2003/08** the board observed that, in contrast to a written document the contents of which are fixed and can be read again and again, an **oral presentation** is ephemeral. Therefore, the standard of proof for ascertaining the contents of an oral disclosure is high. **T 1212/97** could not be interpreted as setting an absolute standard for the amount of evidence necessary to prove the contents of an oral disclosure. In the present case



evidence from the lecturer and a member of the audience, provided by them in the form of both affidavits and oral testimony, was not considered by the board to prove beyond reasonable doubt that the subject-matter of the claim was disclosed during the lecture (see also **T 667/01** and **T 12/01** about oral presentations, and **T 1057/09** about the alleged availability of a "diploma thesis" whose content was allegedly disclosed *inter alia* during an oral presentation before the priority date of the patent in suit).

In **T 151/99** the board regarded it as **highly plausible** in the light of the available evidence that a **master's thesis** had become available to at least one member of the public. If the reference was in a document published before the priority date of the patent in suit then it could be assumed that the thesis had also been made available to the public before the said date (decision analysed more recently in **T 538/09**, which concerns a master's thesis of the first examiner as prior art; also citing **T 1134/06** and **T 750/94** in that an important criterion in evaluating evidence is the reliability of the source: fullfiled for University of Utah).

In **T 1134/06** the board pointed out that, as a first step in evaluating evidence, the **reliability of the source** had to be ascertained. Where, for the purposes of assessing novelty and inventive step, the state of the art under Art. 54(2) EPC is established on the basis of traditional publications such as published patent applications or specifications, the majority of these publications emanate from sources which are considered as reliable. The evidentiary weight of such sources normally resides in the large number of physical, existing copies of the publication, or because the source itself has the character of public authority, such as a patent office. Therefore, publication date and content are assumed to be truthful with a high level of confidence. In the case at issue, however, the disclosure had been made available to the public on the **Internet**. In order to establish that an internet disclosure formed part of the state of the art, the board held that the same strict standard of proof as for prior use or prior oral disclosure had to be applied – the same questions "when", "what" and "under which circumstances" had to be answered (endorsed by **T 1875/06**. In a more recent decision, **T 19/05**, concerning a printout of web pages the board stated that if an internet disclosure is to be used as prior art, a strict standard of proof should be adopted (availability to the public before the effective filing date was not proven in this case; not even used as common general knowledge as alleged by the opponent). Furthermore, the board took the view that the circumstances which allowed the determination of whether a disclosure on the Internet had been made available to the public might, where appropriate, also include factors that had a bearing on the reliability of the information, for example, the manner in which information had been procured and date stamped, how it had been preserved by the source, and whether it had remained unaltered since deposit. However comparison should be made with **T 286/10** regarding Internet Archive ([www.archive.org](http://www.archive.org)) that applies the usual standard of proof on the balance of probabilities (see also **T 2227/11**); chapter III.G.4.2.3. Concerning information from the internet see also Chapters I.C.3.2.3 "Internet disclosures"; I.C.3.5 "Issues of proof"; I.C.3.5.2c) "Internet – proof of the date of availability".

In **T 1469/10** the board held that the publication dates indicated on the documents published by the ETSI 3GPP organisation, which was regarded as a reputable

standardisation body having clear and reliable rules for their publications, were of a high probative value and thus might serve as prima facie evidence that a document was published on the date indicated, and regarded the documents at issue thus as representing the state of the art under Art. 54(2) EPC.

As a matter of principle, if an **adverse decision** of an organ of the EPO is to rely on a certain fact that fact should be proven beyond any reasonable doubt. In **T 826/03**, the board applied this principle when attempting to establish the publication date of a Canadian patent application, and whether it was prior art. It found that in view of the contradictory evidence on file and in the absence of any further clarifying information from the Canadian Intellectual Property Office, it was virtually impossible for the board to establish with certainty that the public had access to the application according to document D3 before the priority date claimed by the application in suit. It therefore considered document D3 as not belonging to the prior art within the meaning of Art. 54(2) EPC.

#### 4.3.4 Claiming a valid priority

In **T 1056/01** the board pointed out that because of the crucial effect a valid priority date had on patentability, the date of filing of the application whose priority was claimed had to be proven in a formal way, namely by a certificate issued by the authority which had received that application (see R. 53(1) EPC and Art. 4D(3) Paris Convention). Even if no such **formal proof** was prescribed for the timely withdrawal of a previous application pursuant to Art. 87(4) EPC (see Art. 4C(4) Paris Convention), it appeared appropriate to require an equally high standard of proof, for once there existed a previous application concerning the same invention both dates were equally relevant for establishing the validity of the claimed priority. However, in the case at issue, the timely withdrawal of the UK application for the purposes of Art. 87(4) EPC could not be established. Unlike facts barring patentability (see for example **T 219/83** cited by the appellant), the timely withdrawal of a previous application was a positive precondition for claiming a valid priority from a subsequent application for the same invention. Hence, the date of the effect of the withdrawal was a fact which could act in the applicant's favour, and she had relied on it just as she had relied on the filing date (and the content) of the subsequent UK application (this decision was cited and applied in **T 62/05**)

Case **T 493/06** involved the issue of the valid transfer of a priority application. According to the board, the submitted statutory declarations and notarial certifications provided sufficient evidence that the copy of the transfer agreement was the same as the original.

In **T 205/14** the board disagreed with the reasoning of **T 62/05** that the transfer had to be proven in a formal way, applying an equally high standard of proof as that required by Art. 72 EPC 1973. Art. 72 EPC 1973 set out formal requirements for a valid assignment of a European patent application and thereby limited the means of giving or obtaining evidence for determining such a transfer. Having regard to Art. 117 EPC and the principle of free evaluation of evidence, the rule should not be extended beyond its scope of application. Since the provisions of the EPC did not lend themselves to an autonomous determination of the requirements for transfer of the right of priority, the

validity of such transfer was a matter of **national law** (cf. **T 1008/96** (two pieces of evidence mutually exclusive: declaration before a notary public and decision of Italian Court); cf. also approach in **T 160/13** (transfer of priority right within a corporate group – emails), **J 19/87**, **T 493/06**). **T 205/14** and **T 517/14** deal with numerous issues of proof, standard of proof and burden of proof.

See also Chapter II.D.2.2 "Priority right of the applicant or his successor in title".

#### 4.3.5 Abusive conduct

In **G 3/97** and **G 4/97** (OJ 1999, 245 and 270) the Enlarged Board of Appeal held that if the person named as opponent according to R. 76(2)(a) EPC (former R. 55(a) EPC 1973) was acting on behalf of a third party, such an opposition was inadmissible only if the involvement of the opponent was to be regarded as circumventing the law by abuse of process. The deciding body had to be satisfied on the basis of clear and convincing evidence that the law had been circumvented by abuse of process.

In **T 291/97** the appellant had contended in the statement of grounds of appeal that the publication of document (1) had occurred in consequence of an evident abuse within the meaning of Art. 55(1)(a) EPC, and thus did not constitute prior art citable against the claims at issue. The board decided that the above publication was to be taken into consideration for the application of Art. 54 EPC. It observed in its decision that the finding of an **evident abuse** under Art. 55(1)(a) EPC was a serious matter. An abuse was not lightly to be presumed. The standard of proof was identified by the words "evident abuse" (German: "offensichtlicher Missbrauch"; French: "un abus évident") as being high: the case had to be clear-cut, and a doubtful case would not be resolved in favour of the applicant. The evidence filed in the case at issue did not meet the standard that the board would consider appropriate, in particular in that virtually every declaration filed contained serious mis-statements that had subsequently been corrected, or the indicated mis-statements had not been relied on. That the errors had been corrected or not relied on was commendable, but left unresolved the problem of whether any part of such a statement could be relied on at all. The board also pointed out that in proceedings before the EPO it had to be possible to rely on the written evidence as having been checked with the facts; should that not be the case, the party in question would run the risk of having its evidence being disregarded as unreliable as a whole (see also **T 41/02**).

In **D 5/86** (OJ 1989, 210), the board held that an infringement of the rules of professional conduct had to be established to the satisfaction of the disciplinary body before it could impose a disciplinary measure. Absolute certainty was not required, but a **higher degree of probability** which in human experience verged on certainty. A disciplinary measure could not be imposed if there was reasonable doubt as to whether the infringement had occurred.

#### 4.3.6 Receipt of formal documents

See Chapter III.O.4 "Spheres of risk and apportioning the burden of proof" and Administrative Council decision CA/D 6/14 dated 15 October 2014 (entry into force: 1 April 2015) amending R. 2, 124, 125, 126, 127, 129, 133 and 134 EPC (OJ 2015, A17; explanatory notice: OJ 2015, A36), discussed in the chapter on notification. With respect to the burden of proving receipt, see also chapter III.G.5.1.2(e) below.

The issue under appeal in **T 1200/01** was whether an opposition of the appellant against the patent could be deemed to have been filed. According to Art. 99(1), last sentence, EPC, this was only the case if the opposition fee had been paid within the opposition period. However, in the case at issue no trace of a notice of opposition nor of a voucher for payment of the opposition fee allegedly filed by the appellant had been found within the EPO. The board noted that, concerning the standard of proof to be applied for establishing the receipt of documents not found within the EPO, it was the established case law of the boards of appeal that, even if proof to this effect could seldom lead to absolute certainty, it at least had to show to a **high degree of probability** that the alleged filing had taken place (see also **T 128/87**, OJ 1989, 406, cited by the board). It also noted that in some previous cases (see **T 243/86** and **T 69/86**, cited by the board) it had been accepted that this standard was met if there were concrete traces of the item sought which, even if they did not show it for certain, indicated a high probability of the lost document having once been in the EPO. Nevertheless, any other means of giving evidence, such as witness testimony, could equally be considered in this context.

The communication noting the loss of rights under R. 112(1) EPC (former R. 69(1) EPC 1973) is deemed to have been delivered to the addressee on the tenth day following its posting, unless the letter failed to reach the addressee or reached him at a later date. In the event of any dispute, it is incumbent on the EPO to establish that the letter reached its destination (R. 126(2) EPC; CA/D 6/14 for the revised wording; former R. 78(2) EPC 1973). In **J 9/05** and **J 18/05**, the only evidence provided by the examining division was a letter from the Deutsche Post referring to the information received from the foreign postal service, according to which the letter had been delivered to an authorised recipient, who, however, was not specified. The board stated that the probative value of the submissions and evidence of the appellant had to be balanced against the probative value of evidence established by the EPO. Balancing the evidence of the examining division, which consisted of the rather vague letter from the Deutsche Post, against the evidence submitted by the appellant, and taking into account the serious consequences for the appellant, the board came to the conclusion that it had not been sufficiently proven that the applicant had received the R. 69(1) EPC communication. In such a situation, where the EPO bore the burden of proof, the applicant had to be given the benefit of the doubt.

In **T 529/09** a communication pursuant to R. 82(3) EPC (invitation to parties to file observations with regard to the maintenance of patent in amended form) had been sent out on 8 September 2008 by registered letter addressed to the proprietor's representative. According to R. 126(2) EPC (see CA/D 6/14 for the revised wording) a registered letter was deemed to have been delivered to the addressee on the tenth day

following its posting, unless it had failed to reach the addressee or reached him at a later date. In the board's view, "delivered to the addressee" did not mean that the notification in question had to be brought to the attention of the professional representative in person. It sufficed that the registered letter had been received by a person authorised to take delivery, e.g. an employee of the representative's office (see **T 743/05**). In the present case, the board regarded the evidence on file as sufficiently reliable and complete to prove the proper delivery of the letter. In this respect, the board highlighted a significant difference between this case and **J 9/05** and **J 18/05**, in which the appellant had filed a considerable amount of counter-evidence pointing out specific reasons why the letter might not have been received by the representative's office.

See also **J 10/04**, reported above, which differed from the "ordinary" cases concerning lost mail in that the application had reached the USPTO and only some of the papers were missing, and **T 1535/10**, in which the board found that responsibility for obstacles and delays in receiving decisions having to be notified under R. 126(1) EPC had to be assigned according to spheres of risk (III.O.4 "Spheres of risk and apportioning the burden of proof").

## 5. Burden of proof

### 5.1. Apportioning the burden of proof

#### 5.1.1 General

In the absence of relevant EPC provisions, the principles concerning the allocation of the burden of proof have been developed through the case law of the boards of appeal. **Each party bears the burden of proof for the facts it alleges.** At all events, a party cannot deny facts which related to its own actions or were the subject of its own perceptions on the ground of "ignorance", if the presentation of the facts in question is essentially the party's responsibility (**T 247/98**).

With regard to principles of procedural law generally recognised in the contracting states, a party relying on Art. 125 EPC and asserting that German law allows for the revision of a decision of a court of final jurisdiction in the case of a fundamental procedural violation, will also have to produce evidence that such a procedural principle exists in most EPC contracting states and is therefore "generally recognised" for the purpose of Art. 125 EPC (**T 843/91**, OJ 1994, 832). Following on from that, another board stated in **T 833/94** that, when the evidence offered did not directly indicate the truth or falsity of the fact in issue, but required knowledge of the **national law** and patent practice, such **law and practice had to be proved, as did any other fact** on which a party based its arguments (proof of a national right by means of a written statement from a Japanese lawyer (**T 74/00**), and proof of Israeli law applicable by submitting a legal expert opinion, (**T 517/14**)).

In **ex parte proceedings** the applicant bears the burden of proof for the facts in his favour, e.g. the fact that a document cited by the examining division does not form part of the state of the art (**T 160/92**, OJ 1995, 35), the fact that the conditions laid down in

Art. 123 EPC have been met (**T 383/88**) or the fact that a limitation of the claims is admissible (**T 2/81**, OJ 1982, 394). Sufficient disclosure also obliges the applicant to provide evidence of the skilled person's relevant knowledge if there is reason to believe it may not cover all the subject-matter claimed. If reasonable doubts exist about the scope or public nature of the specialist knowledge required for adequate disclosure of the invention, the applicant discharges his duty to disclose by submitting suitable evidence in support of the facts in his favour, in order to fulfil his duty to disclose the invention (**T 82/07**). In **T 32/95**, the board referred to a passage from the Guidelines (now G-IV, 1 "State of the art" – November 2015 version, which is cited in full in connection with **T 750/94**, see point 4.3.1 above).

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

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

In **T 998/04** the board emphasised as an *obiter dictum* that the burden of proof for alleged lack of patentability lay with the opponent and could not be dispensed with by requesting the board to carry out its own investigations, in particular, by summoning four named witnesses, by commissioning an independent expert to carry out experimental tests and by allowing individuals from the appellant company to attend any tests and to question witnesses or experts. Moreover, granting these requests would not be consistent with the character of the post-grant opposition proceedings under the EPC which were in principle to be considered as contentious proceedings between parties

normally representing opposite interests, who should be given equally fair treatment (see **G 9/91**, OJ 1993, 408, point 2 of the Reasons). If the opponent disputes the existence of novelty, an inventive step or the reproducibility of the invention, it bears the burden of proof in this respect at first and second instance (e.g. **T 762/04**, **T 382/93**, **T 16/87**, OJ 1992,212; **T 182/89**, OJ 1991, 391). In case of uncertainty about a prior-art disclosure, the patentee should be given the benefit of the doubt (**T 1003/96**; see also **T 230/92**, **T 345/86**, **T 601/91** and **T 968/91**).

A technical problem set out in a patent is considered to be credibly solved by a claimed invention if there are no reasons to assume the contrary. Under such circumstances, the burden is normally on the opponent to prove the opposite or at least provide evidence casting doubt on the alleged solution of the problem. If the opponent succeeds, the burden of proof shifts to the patent proprietor who must then prove its assertions (see e.g. **T 1797/09**). Where, however, the opponent succeeds in casting serious doubt on the persuasiveness of the patentee's evidence merely by arguing that this evidence was subject to **erroneous evaluation** by the examining division, this allegation may render the patentee's evidence inappropriate but cannot justify the conclusion that the invention **fails** to solve the existing technical problem. Such allegation does not discharge the opponent from the burden of submitting convincing counter-evidence that the claimed subject-matter cannot solve the technical problem (**T 596/99**).

The appellant relied upon experimental reports. However, these tests did not prove its allegations beyond all reasonable doubt. The proprietor (appellant) submitted that the burden of proof lay with the respondents (Opponents) to show that the amendments did in fact extend the protection conferred (Art. 123(3) EPC). However, it was the proprietor (appellant), who had amended the patent as granted and who was responsible for demonstrating, beyond all reasonable doubt, that said amendment did not extend the protection conferred (**T 2285/09**).

Reversely, the patentee cannot relieve itself of the burden of providing **counter-evidence** for facts it alleges by simply stating that all the evidence was within the power of its opponent (with reference to **T 472/92**, OJ 1998, 161;), without providing proof for the contention that it is not within its power to obtain counter-evidence (**T 254/98**). As far as apportioning the burden of proof is concerned, it is irrelevant whether or not the patentee can access the requisite evidence more easily than the opponent (**T 1162/07**; see also **T 1710/12**).

### 5.1.2 Individual cases

#### a) Novelty

For the purpose of assessing novelty, the party alleging that the inevitable outcome of a prior art disclosure is in contradiction with the explicit disclosure of the cited prior art has not only the burden of reproducing the earlier disclosure in such a way as to demonstrate that the alleged inevitable outcome has occurred, but also the burden of proving convincingly that if any significant deviation from the conditions specified in the earlier disclosure are not material to the outcome (**T 204/00**; see also **T 396/89**).

In **T 713/01** the appellant denied the existence of an "enabling" disclosure in D2 with regard to the preparation of polymers in the presence of a solubilised lithium pyrrolidide initiator by reference to **T 124/87** (OJ 1989, 491) and **T 206/83** (OJ 1987, 5). According to this case law, the criterion for a prior art disclosure to be novelty-destroying is that the claimed subject-matter should be directly and unequivocally inferred from an enabling disclosure in it. In the case at issue, the board held that the only difference between D2 and the claim wording, i.e. the presence or not of a solubilising agent as part of the lithium pyrrolidide initiator, did not qualify as a distinguishing feature of the claimed product because that "**product-by-process**" feature was not detectable on the product by a reliably distinguishing property. In this context, the board added that in proceedings before the examining division the burden of proof for an allegedly distinguishing "product-by-process" feature lay with the applicant (see further **T 205/83**, OJ 1985, 363 and **T 279/84**).

See Chapter I.C. "Novelty".

b) Inventive step

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 had in fact conducted its 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.

The burden of proving that the claimed method leads to the **advantageous effects** mentioned in the patent in suit rests with the patentee. In the absence of any corroborating evidence that these advantageous effects were obtained, the alleged effects are not to be taken into account when assessing inventive step (cf. **T 97/00**; see also **T 1409/04**).

In **T 862/11**, the appellant (opponent) failed to submit comparative tests in support of its own assertion that an improvement was implausible owing to the lack of any evidence. In the absence of such tests, however, it failed to convince the board, which therefore regarded the problem as solved, and saw no need to reformulate it.

See Chapter I.D. "Inventive step".

c) Sufficiency of disclosure

The burden of proof is determined by the legal cases which the respective parties are trying to make. Whether it is discharged or not is assessed by the board based on all the relevant evidence put before it. The burden of proof of insufficiency is as a general rule on the **opponents**, who should prove that despite making all reasonable efforts they



were unable to put the invention into practice. If the patentee is claiming a result, which the prevailing technical opinion suggests is not achievable, and if the opponents are not able to repeat the method in the patent, they cannot be expected to do more than the patentee. Then, the burden of proof is on the patentee to show that the extraction method in the patent works as stated so that at least one way of putting the invention into practice has been given to the skilled person (approach set out e.g. in **T 518/10**, which in turn cited **T 792/00** and **T 1842/06**).

**T 30/15** (inter partes) contains extensive reasoning on the issue of burden of proof and on the submission of evidence in respect of Art. 83 EPC in conjunction with procedural aspects (RPBA) especially at the appeal stage after a first instance decision revoking the patent for insufficiency of disclosure. (Compare with **T 1329/11**, point 3.9 of the Reasons).

In **T 1886/12**, which also contains reasoning on the issue of burden of proof concerning alleged insufficiency of disclosure, the appellant (opponent) raised several objections but did not discharge the burden of proof.

d) Content of the priority document

In **T 1147/02** the board dealt with the issue of which party to the appeal proceedings bore the burden of proving the exact content of a priority document in order to establish the relevant priority date. Since the appellant was the one to challenge the priority date necessary for establishing prior art, the principles elaborated in the case law of the boards of appeal dictated that the appellant also bore the burden of convincingly proving that the relevant date was not the filing date of the priority document.

e) Receipt of formal documents

See also Chapter III.O.4 "Spheres of risk and apportioning the burden of proof". R. 126 EPC (notification by post) and R. 127 EPC (electronic notification) lay down rules on the burden of proof in case of dispute (for the amended versions of these provisions, see CA/D 6/14 in OJ 2015, A17, and the explanatory notice in OJ 2015, A36, points 3.1 ff). On the requisite standard of proof, see also in this chapter III.G.5.1.2(d) and III.G.4.3.6.

In **T 632/95** the board pointed out that the burden of proving that a document had been received lay with the party submitting the document just as, vice versa, the EPO bore the burden of proving receipt of the documents it issued.

It has to be observed that a party submitting that something has not happened is faced with the difficulty of proving this allegation. The party can essentially presume what could have happened or what normally would have been done if a letter had been received, in order to cast doubt upon the EPO's evidence, but it is hardly ever possible to file compelling evidence that the letter was not received. The EPO is also in a difficult situation if an applicant submits that it has not received a communication. The EPO then has to start enquiries with the postal services and rely on the information obtained. Since

details are not given, this information is usually unsatisfactory. After a certain period the relevant information may not even be obtainable at all. However, this ought not to be to the detriment of the applicant, specifically not where communication noting a loss of rights is concerned. These problems could be avoided if such communications were delivered by registered letter with advice of delivery (**J 9/05** and **J 18/05**).

According to the German version of R. 126 (2) EPC (former R. 78(2) EPC 1973), the EPO must in a case of doubt ("im Zweifel") establish the date on which the letter was delivered to the addressee. In **T 247/98** the board decided that, when establishing the meaning of the term "im Zweifel" in the German version, account should be taken of the French and English versions, which assumed that there was a dispute ("en cas de contestation", "in the event of any dispute"). From the general principles concerning the burden of presentation which fell on the parties, it followed that a party seeking the application of a legal provision favourable to its interests had to set out the facts justifying such application, even if it did not ultimately bear the burden of proof for those facts. Although, in the event of a dispute within the meaning of said rule, the burden of proof for the date of delivery fell on the EPO, this could not be taken to mean that a party wishing to rely on the late delivery of a letter from the EPO had no obligation to contribute to the clarification of circumstances within its own sphere of activity but could sit back, as it were, and wait to see whether the EPO succeeded in ascertaining when the letter had been delivered to the party. A dispute ("Zweifel" in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting.

In **J 3/14** the board stated that, in a situation where the representative submitted that he had not received a communication, the EPO bore the burden of proof. In the board's opinion, it had at least been **made plausible** that the postal authorities erroneously delivered the letter to an unauthorised person in view of an authorisation which seemed to allow the collection of "all registered mail". The appellant also brought evidence as to the absence of its representative from her place of business. The board concluded that, in cases where the EPO bore the burden of proof, the applicant had to be given the **benefit of the doubt**. If doubts remained about what had really happened, this could not be to the detriment of the applicant. This applied all the more in a situation like the one at issue where the refusal of the application was the immediate consequence for the applicant.

In **T 50/12** the board held that, by producing the advice of delivery, the EPO had fulfilled its duty under R. 126(2) EPC to assess the actual date of delivery to the addressee. Hence, the burden of proof lay with the appellant. To prove the later delivery, the appellant submitted two documents, neither of which convinced the board of appeal.

Under the EPC, the date of receipt of an item at the EPO is critical when assessing compliance with a time limit. The burden of proof that a filing has been effected falls on the filing party. The impossibility of furnishing proof of a higher probability that an item was filed than that it was not filed, must therefore count against the filing party – as found by the board in **T 1200/01**. In this particular case, the available evidence did not convince the board that there was a higher degree of probability that the alleged filing had taken

place than that it had not. Contrary to the decision in **T 1200/01**, the board in **T 2454/11** found that the strict allocation of the burden of proof to the sender of correspondence addressed to the EPO could not be mitigated by weighing up the probability of receipt. Such an approach to examining the issue would seriously jeopardise legal certainty and water down the standard of legal clarity required in formal procedures such as those before the EPO. The need in disputed cases to interpret the vague legal notion of probability and the judicial exercise of ascertaining whether a greater or lesser likelihood was to be presumed would result in a wide variety of possibly contradictory approaches to the issue. Such inconsistencies would run counter to the need for a transparent and straightforward procedure and therefore had to be avoided in the interests of the public and third parties involved in the proceedings. Consequently, a high probability of delivery could not be a factor in deciding whether correspondence had actually been received. Rather, it was for the sender to prove such receipt to the board's satisfaction.

In **J 10/91** the board held that if a letter and attached cheque in payment of a fee, had been lost without further evidence or any high probability that it had been lost in the EPO, the risk was then borne by the sender. Even conclusive evidence that something had been posted could not be treated as sufficient to prove that a document had been received by the EPO. In this respect, the board in **J 8/93** stated that if the post failed to deliver a document, the applicant would suffer the consequences for failing to file that document.

Under R. 125(4) EPC (former R. 82 EPC 1973; paragraph 4 not amended by CA/D 6/14) the burden of proof that documents have been duly notified to the parties lies with the EPO. In **T 580/06** the question was raised whether the "OK" reference on the transmission sheet of a faxed document was sufficient proof of receipt. In the absence of relevant EPO case law, the board drew on procedural principles developed for notification by fax in German law, the fax transmission in question having arisen in the territory of the Federal Republic of Germany. In line with the German case law on that issue, the board recognised that an up-to-date objective assessment of the question of **receipt of a fax** by the addressee needed to take into account the technology underlying faxes. The high reliability of this technology nowadays was based amongst other things on established technical protocols, according to which modern fax machines operated. On the basis of various considerations the board reached the conclusion that the "OK" reference on the transmission sheet of a fax was to be regarded as proof of an error-free and complete transmission, through which the fax had entered into the area of responsibility of the representative. Once the fax had entered the area of responsibility of the addressee indicated by the reference "OK", then a transfer of risk took place so that the recipient bore the risks in his own sphere.

Under R. 125(4) and 126(2) EPC the EPO has to bear not only the risks arising within its own sphere but also the "transport" risks, e.g. of post going astray on its way to the addressee. But here a distinction must be drawn between risks borne by the EPO and those for which the addressee has organisational responsibility and power (T 1535/10, see headnote). See Chapter III.O.4, "Spheres of risk and apportioning the burden of proof". This same division of risk applies also to newer, electronic means of notification

under R. 127 EPC (see also the EPO's explanatory notice in OJ 2015, A36, especially as regards amendment of R. 124 to 127 and 129 EPC).

## 5.2. Shifting the burden of proof

### 5.2.1 General

Once a party has submitted conclusive proof of its allegations, it has complied with the requirement of the burden of proof. The evidence need not prove the facts with absolute certainty in order to be deemed conclusive; it suffices that it proves that they are highly probable. If a party has discharged its burden of proof, the counterparty seeking to refute the conclusively established facts by way of counter-arguments bears the burden of proving the alleged facts (**T 1162/07**; see also **T 270/90**, OJ 1993, 725). In **T 109/91** the board held that the burden of proof might shift constantly as a function of the weight of the evidence, i.e. if a party provided enough evidence to demonstrate a fact to the conviction of the board, the mere allegation of the contrary by the other party is not convincing (confirmed e.g. in **T 525/90**, **T 239/92** and **T 838/92**).

In **ex parte proceedings**, when the applicant challenges prima facie evidence concerning a fact, i.e. the nominal publication date of a document, and submits evidence to displace such prima facie evidence, the burden of proof shifts to the examining division to establish that the document was "made available to the public" within the meaning of Art. 54(2) EPC on that date (see **T 929/94** with reference to **T 750/94**, OJ 1998, 32). According to **T 128/87** (OJ 1989, 406), a party presenting a cheque to the EPO bore the burden of proof for its receipt by the EPO. However, if the party furnished sufficient proof that a certain document had been filed, such evidence shifted to the EPO the burden of providing a greater weight of evidence to the contrary (**T 770/91** and **J 20/85**, OJ 1987, 102). The more recent case **T 538/09** addressed this issue of burden of proof and standard of proof in its analysis of **T 750/94** and **T 151/99**.

In **opposition proceedings** the burden of proving that the objections raised under Art. 100 EPC have been substantiated lies with the opponent. Where the opposition division has decided to maintain the patent and the opponent has filed an appeal against this decision, the burden of demonstrating **on appeal** that the reasons for maintaining the patent were justified is not automatically shifted to the patent proprietor (**T 667/94**). In other words, appeal proceedings do not result in a shift in the burden of proof to the detriment of the patentee; before the opposition division it is the opponent who bears the burden of proof of demonstrating that the patent does not fulfil the requirements of the EPC (**T 1210/05**). However, once the opposition division has decided to revoke the patent, the burden shifts to the proprietor of the patent, who then has to demonstrate on appeal that the reasons for revoking the patent were not sound, i.e. that the opposition division's decision was wrong as to the merits (**T 585/92**, OJ 1996, 129; point 3.2 of the Reasons).

### 5.2.2 Cases in which the burden of proof was reversed

In **T 570/08** the opponents had filed evidence in the form of comparative tests with the aim to support their argument that the claimed additive composition in the patent-in-suit did not solve the problem of improving lubricity and solubility of a diesel fuel oil. These results were in contrast to the tests which the patent proprietor had provided, so that the board was confronted with a series of tests leading to contradictory results. Therefore the board could not share the patent proprietor's argument that the burden of proof rested with the opponents, since the opponents' test results cast doubts on the effect allegedly achieved by the present invention. The patent proprietor could not convincingly eliminate those doubts and the patent was revoked.

In **T 131/03** the board pointed out that, once the opponent had established a strong presumption that **unusual parameters** as those used to define the claimed subject-matter were inherently disclosed in the prior art, the patent proprietor could not merely claim the benefit of the doubt. It was incumbent upon the patentee to establish the extent to which the parameters used in the definition of its invention actually distinguished the claimed subject-matter from the prior art.

The burden of establishing insufficiency of disclosure generally lies with the opponent. When the patent does not give any information on how a feature of the invention can be put into practice, only a weak presumption exists that the invention is sufficiently disclosed. In such case, the opponent can discharge the burden of proof by plausibly arguing that common general knowledge would not enable the skilled person to put this feature into practice. The patent proprietor then bears the burden of establishing the contrary assertion that common general knowledge would indeed enable the skilled person to carry out the invention (**T 63/06**). In **T 338/10**, citing this approach, the board held that the reasoned arguments submitted by the respondent (opponent) reversed the burden of proof, placing the onus on the appellant to show that the skilled person would have considered it likely that the claimed therapeutic effect was obtainable in the case in point, despite a lack of data and thus only a weak presumption. But since the appellant had not responded by submitting any arguments or evidence, the board held that the patent as granted did not comply with Art. 83 EPC (the principles applicable in the context of that article are set out in **T 518/10**, see Chapter II.C.8).

In **T 1846/10** the board observed that example 5 of the patent provided verifiable facts which raised **serious doubts** that the invention could in fact be carried out by the average person skilled in the art without undue experimentation or inventive skills by following the guidance provided in the patent. Under these circumstances, no additional experimental evidence from the appellant (opponent) was required as it could rely on the evidence provided by the patent itself. The board concluded that the appellant had discharged its burden of proof.

In **T 792/00** the board found that if the patent contained only an example with a hypothetical experimental protocol, and if this example was to be relied on for showing sufficiency, then the burden of proving that this protocol worked in practice as stated lay with the patentee. Evidence that a variation of the protocol worked was unlikely to be

enough. However, if the example contained a complete experimental protocol and the patentee affirmed that the results reported had been obtained, a board was likely to accept that the patentee had done enough to shift the burden of proof to the opponent who would then have to provide a repeat of the experiment in order to convincingly demonstrate that the protocol did not, in fact, work as stated.

In **T 967/09** the board observed that a successful objection of lack of sufficiency of disclosure presupposes that there are **serious doubts**, substantiated by verifiable facts (see e.g. **T 19/90**, OJ 1990, 476 and **T 890/02**, OJ 2005, 497). In order to establish insufficiency of disclosure in inter partes proceedings, the burden of proof is upon an opponent to establish, on the balance of probabilities, that a skilled person reading the patent, using his common general knowledge, would be unable to carry out the invention (see **T 182/89**, OJ 1991, 391). In **T 967/09**, the board was satisfied that opponent III had substantiated, by means of verifiable facts, serious doubts that the patent did not disclose the invention as defined in claim 1 in a manner sufficiently clear and complete for it to be carried out by the skilled person. These doubts were considered not to be convincingly rebutted by the appellant (patent proprietor). Accordingly, the board considered that respondent (opponent III) had discharged its burden of proof in this respect. Therefore the patent, in respect of the subject-matter of claim 1, was insufficiently disclosed. **T 1842/06** sets out various evidential requirements under Art. 83 EPC, especially those applicable in ex parte proceedings. It states that if an examining division or board objects that the description's disclosure is insufficient, it bears the burden of proving that. If an invention is "revolutionary" (e.g. linked to the "memory of water"), reversing this burden of proof may be justified if the claimed invention's feasibility and reproducibility does not appear sufficiently plausible on the basis of the application. Doubts might arise for example merely because a technical effect that is **a priori contrary to the laws of physics** is not adequately substantiated by experimental results (see also **T 518/10**, point 7.10.1 of the Reasons, on the burden of proving insufficiency in inter partes cases).

In **R 21/10**, the Enlarged Board ruled that a board's alleged reversal of the burden of proof is not a ground for review, these being exhaustively listed in Art. 112a(2)(a) to (e) and R. 104 and 105 EPC. It found that, in any event, the technical board concerned – far from reversing the burden of proof – had merely applied the rule that each party bears the burden of proving the facts it asserts.

### 5.2.3 Cases in which the burden of proof was not reversed

In **T 954/93** the appellant (opponent) had put forward objections to the patent on the basis of lack of novelty, which would have had to be demonstrated by means of experiments. It had not, however, carried out any tests on the ground that they would have been very expensive. The board considered the allegation unproven and refused to reverse the burden of proof. The fact that experiments would have been very expensive did not shift the burden of proof onto the patent proprietor.

In **T 453/04** the opposition had been rejected, i.e. the grounds alleged pursuant to Art. 100 EPC had been found not to be substantiated. The board referred to the previous

case law in **T 667/94** according to which, in such cases, the burden of showing that the decision of the opposition division was incorrect remained with the appellant (opponent). The burden is not automatically shifted to the proprietor to show on appeal that the reasons for maintaining the patent were justified was not automatically shifted to the proprietor.

According to **T 499/00**, the burden of proof could not be reversed to rest with the patentee in cases where – as opposed to the situation in **T 585/92** – the patent had been revoked by the opposition division not on the strength of a real failure to disclose the information needed to reproduce the claimed subject-matter, but for reasons that the board elsewhere deemed erroneous.

## H. Interpretation of the EPC

1.	The Vienna Convention on the Law of Treaties	705
1.1.	Principles of interpretation of the Vienna Convention	706
1.1.1	The interpretation of good faith in accordance with the ordinary meaning	706
1.1.2	Supplementary means of interpretation	707
1.1.3	Interpretation of exclusions from patentability under the Vienna Convention	707
1.2.	Application of the rules of interpretation	708
1.2.1	Grammatical interpretation	709
1.2.2	Systematic interpretation	709
1.2.3	Teleological interpretation	709
1.2.4	Subsequent agreement or practice	709
1.2.5	Secondary considerations	710
2.	Interpretation of the EPC affected by TRIPS Agreement	710
2.1.	General	710
2.2.	Elements to be taken into consideration by the boards of appeal	710
3.	The European Convention on Human Rights	711
4.	Impact of national decisions on the case law of the boards of appeal	711
4.1.	The duty of the boards of appeal to interpret and apply the EPC	711
4.2.	Effects on the case law due to the differences between national legislation and the EPC	712
4.3.	National decisions: no binding effect on the boards of appeal	712
5.	Decisions of the Administrative Council: boards of appeal not formally bound	713
6.	Implementing Regulations	713
7.	Changes in relation to an established practice and interpretation	714
8.	Interpretation of the various language texts of the EPC (Article 177 EPC)	715

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On the interpretation of provisions of the EPC, the EPC itself provides relatively little guidance. There is the Protocol on the Interpretation of Art. 69 EPC of 5 October 1973 as revised by the Act revising the EPC of 29 November 2000. This deals with the extent of protection under Art. 69 EPC. Otherwise, the EPC contains only regulations like the hierarchy of legal provisions (Art. 150(2) and 164(2) EPC) and the equal authenticity of the EPC in its three official language versions (Art. 177 EPC). Art. 125 EPC is not concerned with the interpretation of the EPC but serves merely as a "fill-in" in case of missing procedural provisions. The EPC itself thus contains no general rules for its interpretation, and one must look outside the terms of the Convention itself for such rules (**G 2/12**, **G 2/13**, OJ 2016, A27 and A28).

As an international treaty, the EPC has to be interpreted in accordance with the rules of interpretation developed in the so-called "law of nations" or public international law. To the traditional kind of international treaty which regulates legal relations between States had to be added the treaty which directly creates and defines rights and duties for individuals and corporate bodies (**G 5/83**, OJ 1985, 64; **G 2/12**, **G 2/13**).



In the interpretation of international treaties which provide the legal basis for the rights and duties of individuals and corporate bodies it is necessary to pay attention to questions of harmonisation of national and international rules of law. The boards of appeal may take into consideration decisions and opinions given by national courts in interpreting the law (see **G 5/83**, OJ 1985, 64; see also **G 2/12**, **G 2/13**). Nevertheless, in the proceedings before the European Patent Office, such considerations do not exonerate a board of appeal from its duty as an independent judicial body to interpret and apply the EPC and to decide in last instance in patent granting matters. TRIPS provisions, like decisions of the European and International Courts of Justice and national decisions, are elements to be taken into consideration by the boards of appeal but are not binding on them (**T 154/04**, OJ 2008, 46).

Although the European Patent Organisation is not a party to the Vienna Convention on the Law of Treaties concluded on 23 May 1969 (hereinafter Vienna Convention), the principles of interpretation of Arts. 31 and 32 of the Vienna Convention are to be applied to the interpretation of the EPC even though its provisions do not apply to the EPC *ex lege* (**G 5/83**, **G 2/08**, OJ 2010, 456). The boards of appeal refer to legal sources outside the EPC, including, for example, Vienna Convention and the TRIPS Agreement. Thus the boards of appeal may be guided in their decisions by the provisions of other international instruments. However, they have no obligation to apply them directly (**G 2/02** and **G 3/02**, OJ 2004, 483).

### 1. The Vienna Convention on the Law of Treaties

In **G 5/83** (OJ 1985, 64) the Enlarged Board stated that the provisions of the Vienna Convention do not apply to the EPC *ex lege*, since the former Convention applies only to treaties which are concluded by States after the entry into force of the Vienna Convention with regard to such States (Art. 4, Vienna Convention). At the time of conclusion of the EPC, the Vienna Convention was not in force. Nevertheless, there were convincing precedents for applying the rules for interpretation of treaties incorporated in the Vienna Convention to a treaty to which in terms they do not apply (see also **G 2/12**, **G 2/13**). The International Court of Justice did already apply principles expressed in the Vienna Convention to situations to which the Convention strictly did not apply, whilst the European Court of Human Rights, the Federal German Constitutional Court and the House of Lords (England) have also applied the principles of interpretation in Art. 31 and 32 of the Convention to treaties to which strictly they do not apply. After a careful study of the whole subject, the Enlarged Board of Appeal concluded that the European Patent Office had to do the same.

In **J 10/98** (OJ 2003, 184) the Legal Board of Appeal stated that, although the Vienna Convention did not expressly apply to the interpretation of EPC, PCT or the Paris Convention, since it came into force at a later date than all of those treaties, in accordance with what had been recognised by the Enlarged Board of Appeal in decision **G 5/83**, its principles of interpretation were a valuable guide to the interpretation of all treaties executed both before and after it. In **T 1173/97** (OJ 1999, 609) the board stated that although the Vienna Convention is not applicable to the EPC, it has considerable

authority and has frequently been cited by the boards of appeal when applying principles laid down in it.

### 1.1. Principles of interpretation of the Vienna Convention

It is established in the jurisprudence that the principles of interpretation provided for in Art. 31 and 32 Vienna Convention are to be applied when interpreting the EPC. Decisions and opinions given by national courts in interpreting the law may also be taken into consideration (**G 2/12**, **G 2/13**). These principles have been acknowledged and applied by the Enlarged Board and the boards of appeal alike (**G 1/83**; **G 5/83**; **G 2/02** and **G 3/02**, OJ 2004, 483; **G 2/08**, OJ 2010, 456; **J 10/98**, OJ 2003, 184; **T 128/82**, OJ 1984, 164; **T 1173/97**, OJ 1999, 609).

#### 1.1.1 The interpretation of good faith in accordance with the ordinary meaning

In **G 2/08** (OJ 2010, 456) the Enlarged Board stated that from the reading of Art. 31 and 32 of the Vienna Convention taken together it follows that the provisions of a treaty (here the EPC) must first be construed according to the ordinary meaning of the terms in their context and in the light of its **object and purpose**, which means that the judge is not entitled to depart from clear provisions of law, this principle pertaining to the requirement of good faith. From the wording of Art. 32 Vienna Convention it can also be derived that **preparatory documents** are primarily to be drawn into consideration in order to confirm a meaning or to determine a meaning if the first and ordinary means of construction would lead to ambiguity or to an absurd result (see also decision **G 1/07** of 15 February 2010, point 3.1 of the Reasons).

In **G 2/12** and **G 2/13** (OJ 2016, A27 and A28) the Enlarged Board stated that this objective method of interpretation is directed to establishing the "authentic" meaning of the relevant provision and its legal terms. The starting point of interpretation is thus the wording, i.e. the "objective" meaning, regardless of the original "subjective" intention of the contracting parties. To this end, the provisions are to be read in their context so that they comply with the object and purpose of the EPC.

In **T 1173/97** the board analysed some aspects of the meaning of the expression "computer programs as such", with the emphasis on the "as such", and arrived at the conclusion that a computer program product is not excluded from patentability if it possesses the potential to bring about a "further" technical effect. The board was of the opinion that that interpretation to the exclusion of computer programs as such under Art. 52(2)(c) and (3) EPC 1973 was in full agreement with the provisions of the Vienna Convention. In its interpretation the board did not go beyond the ordinary meaning given to the terms of the EPC. The meaning it attributed to the expression "as such" in Art. 52(3) EPC 1973 was, in its opinion, not a special meaning within the meaning of Art. 31(4) Vienna Convention, which would have required the consent of the parties to the EPC.

### 1.1.2 Supplementary means of interpretation

It is a generally recognised rule of international law that when interpreting international treaties ancillary use may be made of material relating to their genesis. Under Art. 32 of the Vienna Convention, recourse may be had to supplementary means of interpretation, particularly the preparatory work for a treaty and the circumstances in which it was concluded, in order to confirm the meaning arrived at by application of Art. 31 or to determine the meaning when application of Art. 31(a) leaves the meaning ambiguous or obscure, or (b) produces a meaning which is obviously nonsensical or unreasonable (**T 128/82**, OJ 1984,164; see also **G 2/07**, OJ 2012, 130; **G 1/08**, OJ 2012, 206, point 4.3 of the Reasons; **G 2/12** and **G 2/13**).

In **G 2/12** and **G 2/13** the Enlarged Board stated that the preparatory work ("travaux préparatoires") and the circumstances of the conclusion of the EPC serve only as supplementary sources of evidence to confirm the result of the interpretation or if no reasonable meaning can be determined by applying the general rule of interpretation (Art. 32 Vienna Convention).

In **J 8/82** (OJ 1984, 155) the board noted however that it was well recognised that Art. 31 and Art. 32 of the Vienna Convention on the interpretation of treaties merely codified existing public international law. In **J 4/91** (OJ 1992, 402), for example, the Legal Board of Appeal drew on historical material relating to the EPC 1973 to support its view, arrived at from a teleological and systematic interpretation of the relevant provisions, regarding the additional period for paying renewal fees. **G 1/98** (OJ 2000, 111) discussed the purpose of Art. 53(b) EPC 1973, its relationship to other international treaties and legal texts, and its legislative history. In **G 3/98** and **G 2/99** (OJ 2001, 62 and 83), the Enlarged Board reached its conclusions on Art. 55(1) EPC 1973 after interpreting the wording and considering also the legislator's intention and the aspects of systematic, historical and dynamic interpretation.

### 1.1.3 Interpretation of exclusions from patentability under the Vienna Convention

In **G 1/07** (OJ 2011, 134) the appellant had submitted that exclusions to patentability had to be construed narrowly according to Art. 31 and 32 of the Vienna Convention.

The Enlarged Board held that no general principle of narrow interpretation of exclusions from patentability which would be applicable **a priori** to the interpretation of any such exclusions can be derived from the Vienna Convention. Rather, the general rule in Art. 31, point 1, of the Vienna Convention that a treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose must apply to the exclusion clauses contained in the EPC in the same manner as to any other provision. If the interpretation of the provision concerned according to these principles of interpretation leads to the result that a narrow interpretation is the right approach then and only then is such restrictive meaning to be given to it.

In **G 2/12** and **G 2/13** the Enlarged Board came to the conclusion that whilst there is no general notion of an obligatorily restrictive construction of exceptions to patentability, for example, such as that adopted by the Court of Justice of the European Union (CJEU) when insisting on a narrow interpretation of exceptions to or derogations from fundamental EC Treaty principles embodied in the four freedoms (Judgment of 21 June 1974, C 2-74, *Jean Reyners v. Belgian State*, ECJ 1974, 631), such a narrow interpretation might well result from applying the general principles of interpretation to a specific provision with regard to specific legal and factual circumstances.

**G 1/07** made reference to Opinion **G 1/04**, OJ 2006, 334 (point 6 of the Reasons). In that Opinion, the Enlarged Board stated - with reference to decisions of the boards of appeal having acknowledged the existence of such an a priori principle - that the "frequently cited principle", according to which exclusion clauses from patentability laid down in the EPC are to be construed in a restrictive manner, does not apply without exception. In that Opinion concerning the definition of the term diagnostic methods practised on the human or animal body, the Enlarged Board came to its conclusion that the said exclusion was indeed to be interpreted narrowly only after a thorough examination of the wording and the purpose of the exclusion clause concerned. The same approach was also taken in the Enlarged Board's decision **G 2/06** (OJ 2009, 306). There, the Enlarged Board was concerned with the interpretation of the exclusion from patentability of biotechnological inventions relating to uses of human embryos for industrial or commercial purposes under R. 28(c) EPC (and the corresponding Art. 6(2) of the EC Directive on the legal protection of biotechnological inventions). The Enlarged Board made no reference to the existence of a principle of narrow construction of exceptions from patentability. Instead, as a method for interpreting the extent of the prohibition the Enlarged Board went directly to the rules of interpretation laid down in the Vienna Convention, i.e. it looked at the terms of the provision and its object and purpose (point 16 of the Reasons). No mention was made in that decision of any narrow or restrictive view which would have to be taken because the said prohibition was an exception to patentability. The Enlarged Board decided to proceed in the same way in **G 1/07**.

## 1.2. Application of the rules of interpretation

In consolidated cases **G 2/12** and **G 2/13** (OJ 2016, A27 and A28) the term "essentially biological processes for the production of plants" in Art. 53(b) EPC needed to be construed pursuant to the general rules of interpretation. The Enlarged Board noted that it was established in the jurisprudence that the principles of interpretation provided for in Arts. 31 and 32 of the Vienna Convention were to be applied when interpreting the EPC. This question was to be analysed by means of a **methodical interpretation** of Art. 53(b) EPC in respect of, primarily, its wording and, secondarily, considering also the legislator's intention and the aspects of systematic and historical interpretation. In particular, it applied various methodical lines of interpretation which included grammatical, systematic and teleological interpretations as well as supplementary means of interpretation, principally, the preparatory work. None of these lines of interpretation led the Enlarged Board to conclude that the term "essentially biological processes for the production of plants" extended beyond the processes to products defined or obtained by

such processes. This result was confirmed when the preparatory work of the EPC was taken into account as a supplementary means of interpretation.

The supplementary means of interpretation have already been commented on above (see in this chapter III.H.1.1.2). Further arguments and the case law referred to by the Enlarged Board in **G 2/12** and **G 2/13** in applying the various **lines of interpretation** are reproduced below.

#### 1.2.1 Grammatical interpretation

The Enlarged Board stated that when interpreting provisions of the EPC, it usually starts from the wording of the relevant provision and even if the wording of a provision reveals its meaning clearly, it is then to be examined whether the result of the literal interpretation is confirmed by the meaning of the words in their context. It could well be that the wording only superficially has a clear meaning. At any rate, a literal interpretation must not contradict the purpose of the provision (see **G 1/90**, OJ 1991, 275, 278, point 4 of the Reasons); **G 6/91** (OJ 1992, 491, 499, point 15 of the Reasons); **G 3/98** (OJ 2001, 62, 71, point 2.2 of the Reasons). However, in the case in point, more than one meaning could in principle be attributed to the wording (cf. **G 1/88**, OJ 1989, 189, 193, point 2.2 of the Reasons). Therefore, the true and intended meaning of the term "essentially biological processes for the production of plants" needed to be analysed further.

#### 1.2.2 Systematic interpretation

The systematic interpretation formed a second pillar when construing a legal provision and its terms (see **G 1/88**, point 3 of the Reasons; **G 9/92**, point 1 of the Reasons; **G 4/95**, OJ 1996, 412, 421 et seq., points 4 and 5 of the Reasons; **G 3/98**, OJ 2001, 62, 71, point 2.2 of the Reasons; **G 4/98**, OJ 2001, 131, 143, point 4 of the Reasons). In applying this second method of interpretation the meaning of the wording in question was to be established in the context of the relevant provision itself. In addition, the provision as such had to be interpreted taking into account its position and function within a coherent group of related legal norms.

#### 1.2.3 Teleological interpretation

Like national and international courts, the Enlarged Board applies the method of teleological interpretation in the construction of legislative provisions in the light of their purpose, values, and the legal, social and economic goals they aim to achieve. In this, the Enlarged Board examined their objective sense and purpose (e.g. **G 1/88**, point 5 of the Reasons; **G 1/03**, point 2.1.1 of the Reasons). The starting point was marked by determining the general object of the relevant provision (*ratio legis*) because the interpretation could not contradict the provision's spirit (**G 6/91**, point 8 of the Reasons).

#### 1.2.4 Subsequent agreement or practice

The object and purpose of the exclusion under Art. 53(b) EPC was not, however, sufficiently obvious to answer the question whether or not the clause was to be

construed in a narrow or broad way. The Enlarged Board noted that under Art. 31(3) of the Vienna Convention any subsequent agreement between the parties regarding the interpretation of the treaty or its application, and any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation is to be taken into account. It pointed out that R. 26(5) EPC (formerly R. 23b(5) EPC 1973) could be regarded as such subsequent agreement and practice. R. 26(1) EPC explicitly calls for due consideration of the Biotech Directive (see **G 2/06**, point 16 of the Reasons).

### 1.2.5 Secondary considerations

The Enlarged Board stated that a "dynamic interpretation" might come into play where considerations have arisen since the Convention was signed which might give reason to believe that a literal interpretation of the wording of the relevant provision would conflict with the legislator's aims. Secondary considerations serve the purpose of testing the legal soundness of the conclusions reached in interpreting the scope of application of the process exclusion under Art. 53(b) EPC. The Enlarged Board concluded that the concept of a dynamic interpretation did not require revising the result of the interpretation established by applying traditional rules of construction.

## 2. Interpretation of the EPC affected by TRIPS Agreement

### 2.1. General

The European Patent Organisation, established by the EPC, which constitutes a special agreement under Art. 19 of the Paris Convention, is not a party to the WTO/TRIPS Agreement. The Enlarged Board of Appeal observed in **G 2/02** and **G 3/02** (OJ 2004, 483) that although the EPO is not a party to TRIPS and not bound by it, the national legal systems of the EPC Contracting States might be affected by TRIPS and they may be under an obligation to see to it that the EPC is in conformity with TRIPS. The European Patent Organisation as an international organisation has an internal legal system of its own, the EPC. The boards of appeal of the EPO have the task of ensuring compliance with the autonomous legal system established by the EPC and are bound by the provisions of the EPC alone (Art. 23(3) EPC).

### 2.2. Elements to be taken into consideration by the boards of appeal

The issue of the application of TRIPS in the context of the EPC has been considered on a number of occasions by the boards of appeal of the EPO (see for instance **G 1/97**, OJ 2000, 322, **T 1173/97**, OJ 1999, 609, **J 10/98**).

In **T 1173/97** the board stated that although TRIPS may not be applied directly to the EPC, the board found it appropriate to take it into consideration, since it is aimed at setting common standards and principles concerning the availability, scope and use of trade-related intellectual property rights, and therefore of patent rights. Thus TRIPS gives a clear indication of current trends.

In **G 2/02** and **G 3/02** the Enlarged Board of Appeal noted that TRIPS provisions, like decisions of the European and International Courts of Justice and national decisions, are elements to be taken into consideration by the boards of appeal but are not binding on them. Whereas it is legitimate for the boards of appeal to use the TRIPS Agreement as a means to interpret provisions of the EPC 1973 which allow different interpretations, specific provisions of TRIPS cannot justify ignoring express and unambiguous provisions of the EPC 1973. To do so would usurp the role of the legislator. This was confirmed by the fact that the legislator of EPC 2000 found it necessary to revise Art. 87 EPC 1973 in order to implement the TRIPS Agreement. The law to be applied by the boards of appeal was governed by the provisions of the EPC only.

In **T 1173/97** (OJ 1999, 609) the board decided that, although TRIPS could not be applied directly to the EPC 1973, it was appropriate to take it into consideration in connection with the patentability of computer program products, for TRIPS was aimed at setting common standards and principles concerning the availability, scope and use of trade-related intellectual property rights. It thus gave a clear indication of current trends. The appellant's reference to current practice at the US and Japanese patent offices caused the board to emphasise that the situation under these two legal systems (US, JP) differed greatly from that under the EPC 1973; only the EPC 1973 contained an exclusion such as that in Art. 52(2) and (3) EPC 1973. These developments nevertheless represented a useful indication of modern trends and, in the board's view, could contribute to the highly desirable further (worldwide) harmonisation of patent law.

### **3. The European Convention on Human Rights**

In its decision of 25 April 2014 in **R 19/12**, the Enlarged Board of Appeal observed that Article 6 ECHR had been recognised in **G 1/05** (OJ 2007, 362) and **G 2/08** of 15 June 2009 as a binding standard for proceedings before the boards of appeal because it relied on principles of law common to all member states of the European Patent Organisation and applying to all its departments (see also **D 11/91** and Chapter III.J.1.3. "The Convention for the Protection of Human Rights and Fundamental Freedoms"). That justified applying both national case law and that of the European Court of Human Rights as a supplementary means of interpreting the EPC.

### **4. Impact of national decisions on the case law of the boards of appeal**

#### **4.1. The duty of the boards of appeal to interpret and apply the EPC**

In **G 2/02** and **G 3/02** (OJ 2004, 483) the Enlarged Board of Appeal recognised that, in accordance with the aim of the EPC, as expressed in its preamble, to strengthen cooperation between the States of Europe in respect of the protection of inventions, there has always been the intention to harmonise the substantive patent law to be applied in the Contracting States and in the EPO.

In **G 5/83** the Enlarged Board of Appeal stated that in the interpretation of international treaties which provide the legal basis for the rights and duties of individuals and corporate bodies it is, of course, necessary to pay attention to questions of

harmonisation of national and international rules of law. This aspect of interpretation, not dealt with by the provisions of the Vienna Convention, is particularly important where, as is the case with European patent law, provisions of an international treaty have been taken over into national legislation. The establishment of harmonised patent legislation in the Contracting States must necessarily be accompanied by harmonised interpretation. For this reason, it is incumbent upon the European Patent Office, and particularly its boards of appeal, to take into consideration the decisions and expressions of opinion of courts and industrial property offices in the Contracting States. In **T 154/04** (OJ 2008, 46) the board stated that in the proceedings before the European Patent Office, such considerations do not exonerate a board of appeal from its duty as an independent judicial body to interpret and apply the EPC and to decide in the last instance in patent granting matters. In addition, despite harmonised legal regulations it is not self-evident that their interpretation is also harmonised among different national courts, let alone courts of different contracting states, so that the boards of appeal would be at a loss as to which interpretation to follow if they did not exercise their own independent judgment.

#### **4.2. Effects on the case law due to the differences between national legislation and the EPC**

In **J 9/07** the board stated that according to Art. 1 EPC 1973 the EPC established a system of law common to the contracting states for the grant of patents for inventions. This common system of law is applicable to all European patent applications irrespective of which contracting states have been designated in the European patent application. Although in general a high degree of harmonization between the EPC and national laws is desirable and has indeed been achieved, differences between national legislation and the EPC are not ruled out by Art. 2(2) EPC 1973 or Art. 66 EPC 1973 in this regard. The board stated that, save to the extent that the Convention expressly provides otherwise, the EPO is not allowed to take into consideration with respect to the designated state concerned a specific national legal provision which would be more favourable for the applicant than the provisions of the EPC. This is because this would have the consequence of giving European applications unequal treatment as regards the requirements for grant depending on which state or states have been designated, contrary to Art. 1 EPC 1973. It would also go against the principle of the unity of the application enshrined in Art. 118 EPC 1973 since, if a more favourable national provision were to be applied in relation to the designated state concerned, distinguishing between a case in which the designated state concerned is the only one designated and a case in which further states have been designated as well would appear arbitrary and unjustifiable.

#### **4.3. National decisions: no binding effect on the boards of appeal**

In decision **T 452/91** it was held that in proceedings before the instances of the EPO, questions of patentability were to be decided solely in accordance with the EPC. No national decision should be cited as if it were binding on the EPO, and claims should not be refused by the EPO on the ground that their "patentability cannot be upheld under the jurisdiction of one member state". It could be that the law in most or all other contracting states was different. The reasoning that led the national instance to its conclusion might



well lead an EPO instance to a similar conclusion under the EPC, but this would first need a careful assessment of the EPC, and of relevant EPO board of appeal case law, a comparison with the legislation and jurisprudence on which the national instance reached its conclusion, and a study of the position in other contracting states (**R 21/09, T 1753/06**).

### **5. Decisions of the Administrative Council: boards of appeal not formally bound**

In **J 16/96** (OJ 1998, 347) the issue was whether an association of representatives within the meaning of R. 101(9) EPC 1973 could also be formed by professional representatives who did not work in private practice. The Administrative Council of the European Patent Organisation had decided at its 4th meeting in 1978 that an association within the meaning of this rule could only be an association consisting of professional representatives in private practice. The Legal Board of Appeal pointed out that in their decisions the boards of appeal were not bound by any instructions and complied only with the provisions of the EPC 1973 (Art. 23(3) EPC 1973). The boards of appeal could not be formally bound by a decision of the Administrative Council concerning a question of interpretation, nor could such a decision be deemed to be an instruction for their decisions. However, such a decision was a relevant element in interpretation.

The board stated that according to consistent board of appeal case law, for the purpose of the interpretation of the EPC the rules of interpretation laid down in the Vienna Convention are to be applied (see **G 5/83**). Interpreting the case in accordance with Art. 31(1) of the Vienna Convention, the board concluded that an association within the meaning of R. 101(9) EPC 1973 could also be an association of representatives not engaged in private practice. The intended aim of the Council's decision, which was to eliminate ambiguities in the application of R. 101(9) EPC 1973, had, in the light of recent developments in the profession, not been achieved, and as such the decision was less important in relation to the other factors involved in interpretation.

### **6. Implementing Regulations**

In **T 39/93** (OJ 1997, 134) the board held that, in view of Art. 164(2) EPC 1973, the meaning of an Article of the EPC on its true interpretation as established by a ruling of the Enlarged Board of Appeal could not, in the board's view, be overturned by a newly drafted Rule of the Implementing Regulations, the effect of which would be to conflict with this interpretation. This is because, according to Art. 164(2) EPC 1973, in the case of conflict between the provisions of this Convention (the EPC Article) and those of the Implementing Regulations, the provisions of this Convention shall prevail (see also **T 885/93, T 83/05, G 2/07**, OJ 2012, 130).

In **T 991/04** of 22 November 2005 the board stated that the Munich Diplomatic Conference (1973) as the legislator of the European patent system drafted the first versions of the EPC 1973 and the Implementing Rules as a legal unity which should be read in a consistent way. In this regard the Implementing Regulations had the function of an **authentic interpretation** of the EPC 1973.

In **G 2/07** (OJ 2012, 130) the Enlarged Board of Appeal noted that the provisions of the Biotech Directive 98/44/EC, which were not yet contained in the Convention and related to substantive patentability requirements, were incorporated in the interest of uniformity in harmonised European patent law into the Implementing Regulations as they stood (see the Notice dated 1 July 1999 concerning the amendment of the Implementing Regulations to the EPC (OJ 1999, 573, point 19 of the Reasons, explanatory notes to R. 23b(5) EPC 1973)). The referring board (cf. **T 83/05**, OJ 2007, 644) had argued that the competence of the Administrative Council to amend the Implementing Regulations according to Art. 33(1)(b) EPC did not extend to core issues of substantive patent law, so that the introduction of provisions determining the boundaries of patentable subject-matter was *ultra vires*. Decisions **J 11/91** and **J 16/91** (OJ 1994, 28, point 2.3.4 of the Reasons) of the Legal Board of Appeal, cited in the referring decision, contained a sentence stating that the Regulations may deal only with procedural questions and not with matters of substantive law. No reason was given in these decisions as to why this should be so.

The Enlarged Board of Appeal stated that it is the function of the Implementing Regulations to determine in more detail how the Articles should be applied and there is nothing in the Convention allowing the conclusion that this would not also apply in the case of Articles governing issues of substantive patent law. The limits to the Administrative Council's law-making powers by means of the Implementing Regulations could be inferred from Art. 164(2) EPC. According to that Article, in case of conflict between the provisions of the Convention and those of the Implementing Regulations, the provisions of the Convention shall prevail. In decision **G 2/93** (OJ 1995, 275), the Enlarged Board of Appeal accepted that R. 28 EPC 1973 implemented Art. 83 EPC 1973 and was, at least in part, substantive in nature. Furthermore, in its more recent decision **G 2/06** (OJ 2009, 306, points 12 and 13 of the Reasons), too, the Enlarged Board did not doubt the Administrative Council's power to lay down provisions concerning substantive law in the Implementing Regulations.

Thus the Enlarged Board of Appeal held that the legislator is entitled to provide for issues of substantive law in the Rules of the Implementing Regulations. However, a Rule, not having a legal history of its own, must be clear enough to indicate to those applying it in what way the legislator intended the Article to be interpreted by means of that Rule. This, however, was not the case for R. 26(5) EPC. R. 26(5) EPC did not give any useful guidance on how to interpret the term "essentially biological process for the production of plants" in Art. 53(b) EPC and therefore that term had to be interpreted on its own authority. This was for the Enlarged Board to do (for further details on decision **G 2/07** (OJ 2012, 130)).

## **7. Changes in relation to an established practice and interpretation**

In **G 2/07** (OJ 2012, 130) the Enlarged Board of Appeal stated that there can be no "legitimate expectation" that an interpretation of a substantive provision governing patentability given in a decision of the boards of appeal will not be overruled in the future by the Enlarged Board, since recognising such an expectation as legitimate would undermine the function of the Enlarged Board of Appeal. This holds particularly true for

issues on which there is no solid body of decisions all to the same effect but where instead the relevant jurisprudence consists only of a very limited number of individual decisions, as is presently the case. In the past, the Enlarged Board has granted a transitional period in cases in which the Enlarged Board's decision has brought about a change in relation to an established procedural practice which the parties could not be expected to foresee. By contrast, for the reasons given above, the existence of "legitimate expectations" has never been acknowledged for issues before the Enlarged Board concerning the correct application, i.e. interpretation, of substantive patent law.

#### **8. Interpretation of the various language texts of the EPC (Article 177 EPC)**

In **J 8/95** it was held that even if one language version of a provision of the EPC were found to differ from the other two versions, no legal consequences could be derived from that version other than those which could be derived from the other two versions - regardless of the language of the proceedings. A difference in the wording in one language would have to be considered only in so far as it could form one element of the interpretation. In the case at issue, however, the provision under consideration, even in the allegedly different version, could readily be understood in context in the same way as the other two official languages, with the result that all three versions of the provision corresponded as far as content was concerned (see also **T 2321/08**).

**I. Main and auxiliary requests**

1.	Possibility of filing auxiliary requests	716
2.	Order of requests	716
3.	Admissibility of requests	717
3.1.	Party's responsibility to define subject-matter by filing appropriate requests	717
3.2.	Requests of equal ranking	718
3.3.	Requesting further opportunity to formulate new requests	718
3.4.	Admissibility of late-filed requests	718
4.	Obligation to give reasons for refusal of each request	718
5.	Examination procedure	719
5.1.	Direct rejection of auxiliary request by examining division	719
5.2.	Rejection in advance of further request by examining division	719
5.3.	Practice of proposing one main and one or more auxiliary requests	719
6.	Interlocutory decision on allowable auxiliary request – distinction between examination proceedings and opposition proceedings	719
7.	Opposition procedure	720
8.	Appeal procedure	721

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**1. Possibility of filing auxiliary requests**

In the proceedings before the EPO main and auxiliary requests are allowed (for grant proceedings see e.g. **T 79/89**, OJ 1992, 283; for opposition proceedings see e.g. **T 234/86**, OJ 1989, 79). An auxiliary request is a request for amendment which is contingent upon the main request (or preceding auxiliary requests) being held to be unallowable **T 153/85** (OJ 1988, 1). It is also a request for amendment covered by R. 86(3) EPC 1973 (now R. 137(3) EPC); Art. 96(2) EPC 1973 and R. 51(2) EPC 1973 (see now Art. 94(3) EPC and R. 71(2) EPC); and, during appeal proceedings, Art. 110(2) EPC 1973 and R. 66(1) EPC 1973 (see R. 100(1) EPC) (**T 79/89**, OJ 1992, 283).

**2. Order of requests**

The established system of main and auxiliary requests in the proceedings before the EPO provides that parties, when filing alternative sets of claims, must indicate the order of preference for each set of claims (**R 14/10**, **T 1125/13**).

Before a decision can be taken on the basis of an auxiliary request, the main request has to be examined and decided upon (**T 484/88**). The board in **T 169/96** pointed out that, under Art. 113(2) EPC 1973, the EPO was bound by the requests of the applicant or proprietor, and, in the case of main and auxiliary requests, this meant that the EPO was also bound to the order of the requests. However, in **T 911/06** the board held that this principle did not necessarily apply to the proceedings before the boards, see in this chapter III.I.8, below.

In **T 1439/05** the board held that to avoid misunderstanding, the examining division should clarify the status of the requests before pronouncing its decision at the conclusion of oral proceedings. In **T 883/07** the board held that in accordance with generally recognised procedural requirements, albeit not codified specifically in the EPC, once a higher order request was refused that request was off the table and the next request in the order chosen by the requester had to be considered as if it were the sole request.

### **3. Admissibility of requests**

#### **3.1. Party's responsibility to define subject-matter by filing appropriate requests**

In **T 506/91** the board held that filing requests and deciding if several alternative requests were appropriate or not was a matter that in the end could only be decided by the party concerned and it should be routine for representatives to decide independently how to pursue their cases, including what requests to submit.

In **T 382/96** the board stressed that one of the fundamental principles of European patent law was that responsibility for defining the subject-matter of a patent rested with the applicant (in opposition proceedings the patent proprietor). The applicant (patent proprietor) could not offload this responsibility de facto on to the EPO or any other parties to the proceedings by filing a multitude of requests, let alone incompletely formulated request variants. Doing so constituted an abuse of procedure, as it overburdened the EPO and any other parties to the proceedings with work not originally theirs to perform and thereby hampered the orderly conduct of proceedings. Auxiliary requests which had not been verbally specified in more detail were inadmissible for the purposes of R. 64(b) EPC 1973 because they did not identify the extent to which amendment or cancellation of the contested decision was requested; the same went for auxiliary requests for which no grounds had been set out (i.e. not substantiated) within the meaning of the third sentence of Art. 108 EPC 1973.

**T 446/00** concerned a case in which a large number of requests was filed with an offer to amend the claims further if the board so wished; the board held that a party could not in that manner abdicate its responsibility to present its case to the board and that such requests were both inadmissible and an abuse of procedure.

In **T 745/03** the board also pointed out that it was up to a party to decide on the presentation of its case. When filing several sets of claims, a party usually listed them in order of preference, the least limited claims being a main request, the more limited versions auxiliary requests, so that if a higher order request should fail, then a lower, more limited request would still have a chance of success. In the case before the board this had changed to an approach which could more aptly be designated as "pick and mix", as independent claims present in higher order requests were also to be found in lower order requests in differing permutations of independent claims. The "pick and mix" approach can both give an impression of fishing around for something patentable and mean that some independent claims are not even the subject of a decision. See also **T 221/06**.

In **R 11/08** the Enlarged Board confirmed that adopting a "pick and mix" approach could run the risk of requests being found inadmissible, abuse of procedure, and disadvantages for the party in question.

### **3.2. Requests of equal ranking**

In **T 148/06** the board held several requests inadmissible which were submitted not as principle and auxiliary requests, but as requests of equal ranking. It was not the board's duty to give a legal opinion on the admissibility of several requests as guidance for appellants in defining the order in which they would like their requests to be examined.

### **3.3. Requesting further opportunity to formulate new requests**

In **T 792/92** the board considered as inadmissible the appellant's request at the end of the oral proceedings that, should the outcome of the discussions be negative for him, he be given the opportunity to formulate new requests.

### **3.4. Admissibility of late-filed requests**

On the late-filing of requests for amendment in appeal proceedings, see Chapter IV.E.4. "Filing of amended claims in appeal proceedings"; in opposition proceedings, see Chapter IV.D.4.3. "Time frame for filing amendments"; and in examination proceedings, see Chapter IV.B.3.3.3 "Criteria for admitting amendments filed in reply to the Rule 71(3) EPC communication".

## **4. Obligation to give reasons for refusal of each request**

If a decision relates to several requests, it must give reasons for the rejection of each one. It must be clear from the decision which considerations led the division to its conclusions (**T 234/86** (inter partes), **T 169/96** (ex parte)).

According to **T 961/00**, it is a party's procedural right to file and maintain such requests as are regarded by the competent organ as unallowable or even inadmissible. If a party does so, then the competent organ has to give a decision on it, i.e. to refuse it if it is unallowable or inadmissible (see **T 1105/96**, OJ 1998, 249), but it cannot simply disregard it and deal with the case as if the request did not exist. On the contrary, this would constitute a substantial procedural violation.

In **T 1157/01** the applicant had maintained all its requests (main and three auxiliary requests). When it declared its non-approval of the text proposed for grant based on the third auxiliary request, however, the appellant did not explicitly repeat that it maintained all its previous and higher ranking requests. However, according to the general principle "A jure nemo recedere praesumitur" mentioned in **G 1/88** (OJ 1989, 189), in the absence of an explicit withdrawal, surrender of a right could not be simply presumed and silence could not be deemed to be equivalent to surrender in the logic of how the Convention operated. The decision under appeal had omitted to give reasons for the refusal of the

higher ranking requests still pending before the examining division, which amounted to a substantial procedural violation.

## **5. Examination procedure**

### **5.1. Direct rejection of auxiliary request by examining division**

In **T 488/94**, the board stated that before refusing an application in the case of main and auxiliary requests, the Examining Division in accordance with Art. 113(1) EPC 1973 would not only have to communicate its arguments regarding non-allowability of the main request to the applicant, but also regarding non-allowability of the auxiliary request, if the result of the subsequent examination of the auxiliary request was also negative. A "direct" rejection of an auxiliary request without preceding communication of the grounds on which the rejection was based would only comply with the requirements of Art. 113(1) EPC 1973 under rather exceptional circumstances.

### **5.2. Rejection in advance of further request by examining division**

According to **T 1105/96** (OJ 1998, 249), an applicant had a right both to file one or more auxiliary requests in addition to a main request, and to maintain all such requests even if the examining division communicated its view that all except the last auxiliary request were inadmissible or unallowable, and he was then entitled to a reasoned appealable decision in respect of rejection of each such request. Where an examining division had communicated its view that a further request in the form of an amended text of a claim would be allowable, the rejection in advance of such a further request unless all preceding requests were abandoned was an unlawful exercise of discretion under R. 86(3) EPC 1973 (R. 137(3) EPC) and a substantial procedural violation under R. 67 EPC 1973 (R. 103 EPC).

### **5.3. Practice of proposing one main and one or more auxiliary requests**

The board in **T 1351/06** referred to the decisions **T 79/89** (OJ 1992, 283), **T 169/96**, **T 1105/96**, (OJ 1998, 249) and to Legal Advice No. 15/05 (rev. 2, OJ 2005, 357; now incorporated into the Guidelines, see Guidelines H-III, 3. – November 2015 version), where it was held that it was standard practice at the EPO that the applicant was able to propose one main and one or more auxiliary requests at the examination stage, to amend the text of the application. The board saw no reason why the applicant should not also be able to do so in response to a communication under R. 51(4) EPC 1973, especially in cases where that communication had not been preceded by a communication under Art. 96(2) EPC 1973 and thus constituted a "first communication" within the meaning of R. 86(3) EPC 1973.

## **6. Interlocutory decision on allowable auxiliary request – distinction between examination proceedings and opposition proceedings**

In **T 549/96** it was noted that Art. 113(2) EPC 1973 required the examining division to decide upon an application only in the text agreed by the applicant. Thus an applicant

had to indicate clearly at the end of the proceedings which text he wished to be used. If an applicant failed to indicate his approval of the text of an allowable subsidiary request, e.g. by express disapproval or by maintaining one or more unallowable higher-preference requests over one considered allowable by the examining division, the examining division could refuse the application under Art. 97(1) EPC 1973. The board **contrasted opposition and grant proceedings**. In the case of an allowable auxiliary request in opposition proceedings an interlocutory decision was taken under Art. 106(3) EPC 1973 (Art. 106(2) EPC) to the effect that the European patent met the requirements of the EPC 1973, account being taken of the amendments made by the patent proprietor. This interlocutory decision then also had to include the reasons why the preceding requests did not meet the requirements of the EPC 1973. This saved the proprietor the further costs of fulfilling the formal requirements under R. 58(5) EPC 1973 (R. 82(2) EPC) before there was a final decision on the version in which the patent could be maintained. No comparable situation existed in grant proceedings. On the contrary, in ex parte appeal proceedings the principle of examination ex officio applied. Up to the grant stage it had to be ensured that the conditions for patentability were met. An interlocutory decision, stating that the application in a certain version met the requirements of the EPC 1973, would be in conflict with this purpose. The board drew attention to Legal Advice No. 15/98 (OJ 1998, 113; replaced by Legal Advice No. 15/05 (rev. 2), OJ 2005, 357; various aspects and procedural consequences of filing auxiliary requests have been incorporated into the Guidelines, see Guidelines H-III, 3 – November 2015 version).

In **T 482/06**, the board found that decision **T 549/96** was compatible with the updated Legal Advice, as it stated that "an applicant must unambiguously indicate at the end of the proceedings, which text he proposes". Legal Advice No. 15/05 set out the mechanism to provide this indication. See also **T 976/97**, also before the entry into force of Legal Advice 15/05, where the situation was similar to that in **T 549/96**. In **T 1220/05** the board (referring to **T 839/95** and **T 549/96**) held that interlocutory decisions finding an auxiliary request allowable were not in keeping with standard first-instance practice in examination proceedings, as opposed to opposition proceedings (see Legal Advice No. 15/05 (rev. 2), point 1.1), and in appeal jurisprudence were deemed undesirable owing to possible repercussions (binding effect, no reformatio in peius).

## 7. Opposition procedure

According to **T 234/86** (OJ 1989, 79), the opposition division can – and in certain circumstances must – maintain the patent as per the patentee's subordinate auxiliary request if he pursues main and auxiliary requests which are not allowable although taking precedence over the allowable one. Rejection of the requests which take precedence must be substantiated.

In **T 5/89** (OJ 1992, 348) the board confirmed that a decision may confine itself to rejecting the main request only if all subordinate requests have been withdrawn. This principle was also confirmed in **T 785/91** and **T 81/93**. Following **T 5/89**, the board in **T 861/97** stated that deciding to revoke a patent solely on the basis of the main request



when there was an expressly maintained auxiliary request constituted an infringement of Art. 113(2) EPC 1973.

In **T 155/88** the board made it clear that the patentee could not be required to withdraw any request. If he filed one or more auxiliary requests in addition to a main request and did not withdraw any of them, an opposition division was obliged in its decision to give reasons why each successive request was either not admissible (in the exercise of its discretion under R. 57(1) EPC 1973 and R. 58(2) EPC 1973, see **T 406/86**, OJ 1989, 302), or not allowable on substantive grounds (see **T 234/86**, OJ 1989, 79). If an opposition division allowed an auxiliary request without giving reasons in its decision as to why the main request or preceding auxiliary requests were not allowable, such decision would be set aside as void and of no legal effect, and the appeal fee refunded on the basis of a substantial procedural violation, as was the case in **T 234/86** and **T 484/88**.

The board in **T 848/00** agreed with the reasoning of decision **T 155/88** that if a patentee proposed amendments to its claims which arose out of the opposition and which were intended to meet the grounds of objection raised in the opposition by limiting the scope of protection sought, this should not normally be interpreted as an abandonment of the subject-matter protected by the claims of the patent as granted. But this statement did not influence how the amended set of claims was to be read because a restriction of claims was possible without abandoning the subject-matter of the patent specification as originally filed.

## 8. Appeal procedure

In **T 911/06** the board stated that applying the general principles of court procedure to the order of the requests of the appellant proprietor might be inconsistent with the purpose of the appeal procedure inter partes as expressed in the decision **G 9/91** (OJ 1993, 408). In the board's opinion, examining new requests in the appeal, when the appellant proprietor had also requested examination of the correctness of the first instance decision as a lower ranking request, would effectively reduce the appeal procedure to a simple continuation of the first instance proceedings, although it was apparent from the general logic of the EPC, that the appeal proceedings were wholly separate and independent from the proceedings at first instance. The board noted that it had been established in Legal Advice from the EPO No. 15/05 (rev. 2), OJ 2005, 357 as well as in several decisions of the boards that in the case of main and auxiliary requests from the applicant or proprietor in first instance examination and opposition proceedings, the EPO was bound to the order of these requests. However, this principle did not necessarily apply to second instance proceedings before the boards of appeal. In view of the foregoing, the board considered that it was in line with the purpose of the appeal to examine first whether the department of first instance had correctly assessed the substance of the requests presented to it. Thus, in the case at issue, the correctness of the decision refusing the maintenance of the patent as granted had to be examined first, before examining the new amended claims.

**J. Suspected partiality**

1.	General principles	723
1.1.	Exclusion and objection	723
1.2.	Rationale and importance	724
1.3.	The European Convention on Human Rights	724
1.4.	"Subjective" and "objective" test, presumption of impartiality	724
1.5.	Parties' right to have their case decided by the judge designated by law	726
1.6.	Applicability of Article 24 EPC to first-instance proceedings	726
1.7.	Applicability of Article 24 EPC to disciplinary proceedings	727
2.	Initiation of partiality proceedings and other procedural issues	727
2.1.	Notices of self-recusation	727
2.2.	Objection by other board members of the same board of appeal	728
2.3.	Objection by a party	728
2.4.	Objection by a third party	729
2.5.	Statement of grounds of objection defines the factual scope of the objection	729
2.6.	Comments of the board member concerned	729
3.	Admissibility	730
3.1.	Competence of the board in its original composition	730
3.2.	Obligation to raise the objection immediately	730
3.3.	Objection must be reasoned and substantiated	731
3.4.	Objection based on an obviously wrong understanding of the board's procedural obligations, the right to be heard and the principle of a fair trial	731
3.5.	Repetition of a previous objection	732
3.6.	Dual function as members of the Enlarged Board and another board of appeal	732
4.	Suspected partiality of members of the departments of first instance	732
4.1.	Competence to decide	732
4.2.	Rehearing of a case after remittal	733
4.3.	Personal interest	733
4.4.	Disqualifying partiality	734
5.	Suspected partiality of members of the boards of appeal	734
5.1.	Grounds for exclusion under Article 24(1) EPC	735
5.1.1	Previous involvement of a board member as a party's representative	735
5.1.2	Participation in the decision under appeal	735
5.2.	Grounds for objection under Article 24(3) EPC	736
5.2.1	Expressions of opinions on legal issues	736
5.2.2	Disqualifying partiality	736
5.2.3	Discretionary procedural decisions negatively affecting a party	736
6.	Suspected partiality of members of the Enlarged Board of Appeal	737
6.1.	Referral proceedings under Article 112 EPC	737
6.1.1	Previous participation in cases as members of the boards of appeal	737
6.1.2	Expressions of opinion on legal issues	737
6.2.	Petition for review proceedings under Article 112a EPC	737
6.2.1	Previous participation in cases as members of the boards of appeal	738
6.2.2	Expressions of opinion on legal issues	738
6.2.3	Suspected partiality of the Chairman of the Enlarged Board of Appeal	738

## 7. Legal restrictions for former board members

740

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**1. General principles****1.1. Exclusion and objection**

Pursuant to Art. 24(1) EPC, members of the boards of appeal or of the Enlarged Board of Appeal may not take part in a case in which they have any personal interest, or if they have previously been involved as representatives of one of the parties, or if they participated in the decision under appeal. Art. 24(3) EPC additionally provides that members of a board of appeal may be objected to by any party for one of the reasons mentioned in Art. 24(1) EPC, or if suspected of partiality. According to Art. 3(3) RPBA and Art. 4(3) RPEBA there are no further proceedings in the case before a decision on the exclusion of the member is taken. For the purposes of taking this decision, the member objected to is replaced (Art. 24(4) EPC).

According to the Enlarged Board in **G 2/08** of 15 June 2009, Art. 24 EPC envisages two different situations: exclusion and objection. The first, under paragraph 1, is exclusion *ex officio* of a member of the boards of appeal for specific reasons, primarily for having a personal interest or having been involved in the decision under appeal. The second, under paragraph 3, is objection by a party if it suspects a member of a board of partiality. In other words, under "Exclusion and objection" (Ausschließung und Ablehnung; Abstention et récusation) the legislator distinguishes between, on the one hand, an irrefutable presumption of law consisting in those compelling **grounds of exclusion** that must apply *ex officio*, and may therefore be raised by anyone, i.e. the parties, the board or a third person, without their having to justify any personal interest as of right, and, on the other hand, the **ground of objection** that may be raised by any party to the proceedings if it suspects partiality in a member of a board of appeal or of the Enlarged Board of Appeal, since said party enjoys a personal and legitimate interest to act in the proceedings and is entitled to due process of law in respect of said interest. In such a case the burden of proof lies with the party who raises the objection, since board members, including those on the Enlarged Board of Appeal, are *a priori* **presumed** to be unbiased (see in this chapter III.J.1.4). This distinction is also reflected in Art. 112a(2)(a) EPC (petition for review), which provides that a possible ground of review consists in a member of a board of appeal having participated in a case in breach of Art. 24(1) EPC or despite having been excluded pursuant to a decision under Art. 24(4) EPC. In other words, whereas the grounds under Art. 24(1) EPC are considered to be peremptory due to the violation of the legal principle that nobody should be a judge in his own cause, the ground which could have justified an objection for suspicion of partiality is not directly envisaged as constituting *a priori* (i.e. unless proven and decided by the board; see also **R 20/09**) a cause of review.

## 1.2. Rationale and importance

According to the Enlarged Board in **G 1/05** of 7 December 2006 (OJ 2007, 362), the right to object to a judge for reasons of suspicion of partiality is meant to prevent judges from being influenced in their decision-making - be it deliberately or inadvertently - by extraneous considerations, prejudices and predilections, i.e. by considerations other than the arguments they consider factually and legally relevant for the case under consideration. A suspicion of partiality might arise where there are circumstances possibly justifying a suspicion of a tendency to favour one or more of the parties or to discriminate against one of them.

In **G 5/91** (OJ 1992, 617) and **G 1/05** of 7 December 2006 the Enlarged Board underlined the importance of a very strict observance of the requirement of impartiality in proceedings before it and the other boards of appeal in view of their judicial functions at final instance within the European patent granting system.

## 1.3. The European Convention on Human Rights

In **G 1/05** of 7 December 2006 (OJ 2007, 362) the Enlarged Board stated that the principle of equal treatment and the right of parties to a fair trial enshrined in Art. 6(1) of the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) oblige the boards of appeal to decide the individual cases pending before them according to uniformly applied criteria and not in an arbitrary manner. In interlocutory decision **G 2/08** of 15 June 2009 the Enlarged Board also stressed that it and the other boards of appeal act as judicial bodies and apply general principles of procedural law.

In its decision **R 19/12** of 25 April 2014, the Enlarged Board observed that Art. 6 ECHR had been recognised in **G 1/05** and **G 2/08** as the binding standard for proceedings before the boards of appeal because it relies on principles of law common to all the European Patent Organisation's member states and applying to all its departments (see also **D 11/91**). This justified applying both national case law and that of the European Court of Human Rights as a supplementary means of interpretation for the EPC.

## 1.4. "Subjective" and "objective" test, presumption of impartiality

In **T 190/03** (OJ 2006, 502; see also **R 8/13** of 20 March 2015, **R 19/12** of 25 April 2014, **T 283/03**, **T 572/03**, **T 1193/02**, **T 1021/01** of 18 March 2005, **T 281/03** of 18 March 2005 and **T 281/03** of 30 March 2006) the board observed that there were two distinct aspects of partiality involved in the situations envisaged by Art. 24 EPC 1973: firstly, partiality for subjective reasons, i.e. actual partiality on the part of the member, for example due to a personal interest or a dislike of a party; and secondly, a suspicion or appearance of partiality, which would be derived by an "objective observer" from a particular action of a member, or an assumed response to a proprietor's action. Accordingly, partiality had to be determined on the basis of the following **two tests**: firstly, a "subjective" test requiring proof of actual partiality of the member concerned; and secondly, an "objective" test

according to which the deciding board judged whether the circumstances of the case gave rise to an objectively justified fear of partiality.

Actual partiality was an internal characteristic of the member himself and its presence went against the principle of a fair trial. However, suspicion and appearances were not enough to show actual partiality. It was a fundamental duty of a board member acting in a judicial capacity to take decisions objectively and not be swayed by personal interest or other peoples' comments or actions. Indeed, this principle was explicitly contained in the solemn declaration taken by board members at the time of their inauguration. Thus, a board member's personal impartiality was to be **presumed** until there was proof to the contrary (see also **G 2/08** of 15 June 2009 and **R 19/12** of 25 April 2014).

On the other hand, the appearance of partiality involved external aspects and reflected, regardless of whether the member was actually biased or not, the confidence that the board inspired in the public; as the old adage went: "Justice must not only be done; it must be seen to be done" (see also **T 900/02**, **T 2291/08** and **R 8/13** of 20 March 2015). Since this aspect of partiality related to appearances, it did not need to be proved in the same way as actual partiality, but rather it had to be established whether the circumstances gave rise to an objectively justified fear of partiality (objective element). This essentially corresponded to the "objective" and "reasonable" grounds identified in the case law of the EPO. The board stated that the above was in line with generally acknowledged procedural principles in the contracting states, e.g. the jurisprudence of the European Court of Human Rights (ECtHR).

In **G 1/05** of 7 December 2006 (OJ 2007, 362) the Enlarged Board of Appeal stated that, for an objection under Art. 24(3), first sentence, EPC to be justified, it was not necessary that the board member concerned actually be partial. It sufficed that there was a **suspicion**, i.e. an appearance, of partiality (called the "objective test" in the ECtHR jurisprudence since *Piersack v. Belgium* (1982) of 1 October 1982, No 8692/79, paragraph 30). There should be no risk that the courts would not ensure that justice was both done and perceived by the public to have been done. What was at stake was the confidence that the boards of appeal inspired in the public (see also **R 19/12** of 25 April 2014, **T 190/03** of 18 March 2005, OJ 2006, 502, ECtHR: *Puolitaival and Pirttiäho v. Finland* of 23 November 2004, No. 54857/00, paragraph 42). The Enlarged Board noted that it was, however, also commonly recognised in the jurisprudence of the boards of appeal and elsewhere that the party's "suspicion" had to be justified on an objective basis. Purely subjective impressions or vague suspicions were not enough (see also **G 3/08** of 16 October 2009, **R 2/12**, **T 1674/12**, **T 1020/06** of 28 November 2008, **T 985/01** of 18 March 2005 and **T 190/03** of 18 March 2005, OJ 2006, 502, point 7 of the Reasons and the other decisions cited there). The standpoint of the person concerned was important but not decisive (ECtHR: *Puolitaival*, paragraph 42; see also **T 241/98** of 22 March 1999 and **R 8/13** of 20 March 2015). The question was whether a reasonable, objective and informed person would on the correct facts reasonably apprehend that the judge had not or would not bring an impartial mind to bear on the adjudication of the case. It was thus necessary that a reasonable onlooker considering the circumstances of the case would conclude that the party might have good reasons to doubt the impartiality of the member objected to (see also **T 954/98** of 9 December 1999).

### 1.5. Parties' right to have their case decided by the judge designated by law

In **G 1/05** of 7 December 2006 (OJ 2007, 362) the Enlarged Board of Appeal stated that it is very important that board members discharge their duty to sit in the cases allocated to them. The right of the parties to a hearing before a judge or court in the particular composition as determined by the provisions applicable thereto ranks at constitutional level in some of the contracting states and is also recognised in the jurisprudence of the boards of appeal (see **T 954/98** of 9 December 1999, **J 15/04**, **R 15/11**). Therefore, board members cannot withdraw from the proceedings at will, i.e. for reasons which have nothing to do with the purpose of the provisions on exclusion and objection (see in this chapter III.J.2.1).

In **G 2/08** of 15 June 2009 the Enlarged Board also pointed out that its members have a duty to sit on the cases allocated to them (see also **G 3/08** of 16 October 2009) according to their jurisdiction both "*ratione legis*" and "*ratione materiae*". That is to say, parties to judicial proceedings have a right to have their case considered and decided by the judge designated or appointed by law (*droit d'être jugé par son juge naturel*; *Recht auf den gesetzlichen Richter*). This essential principle is even enshrined at constitutional level in some EPC contracting states, e.g. Germany, Austria and Switzerland. On the other hand, Art. 6(1) of the European Convention of Human Rights (ECHR) requires *inter alia* that "in the determination of his civil rights and obligations ... everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law". These principles are not incompatible and have to be construed in such a way that they are not mutually exclusive.

In **R 19/12** of 25 April 2014 the Enlarged Board likewise stressed that interpretation of the rules on objections of suspected partiality had to find a balance between two principles: no one may escape the jurisdiction of the judge appointed by law, but on the other hand everyone has a fundamental right to a fair trial before an independent and impartial tribunal (Art. 6(1) ECHR, Art. 47(2) of the Charter of Fundamental Rights of the European Union).

### 1.6. Applicability of Article 24 EPC to first-instance proceedings

In **G 5/91** (OJ 1992, 617) the Enlarged Board stated that Art. 24 EPC applies only to members of the boards of appeal and of the Enlarged Board of Appeal. Nevertheless, according to the Enlarged Board 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 applies also to the members of the EPO's departments of first instance who take part in decision-making activities affecting the rights of any party (see also **T 433/93**, **T 95/04**, **T 283/03**, **T 1193/02**). However, Art. 24(1) EPC 1973 contained some provisions specifically aimed at safeguarding the impartiality of members of the boards of appeal and of the Enlarged Board of Appeal. For example, while no member of a board of appeal could take part in an appeal if he had participated in the decision under appeal (see in this chapter III.J.5.1.2), it was clearly permissible under Art. 19(2) EPC 1973 for one member of an opposition division to have taken part in the proceedings for grant of the patent to which

the opposition related. In **T 1674/12** the board observed that, whilst the rules applicable to board members were different, a member of an examining division which had granted a patent could take part in opposition proceedings concerning the same patent, provided he did not act as chairman (see Art. 19(2) EPC).

**T 990/06** concerned enlargement of the opposition division by the addition of a legally qualified examiner. The board stressed that the division's composition had to be clear at all times so that its compliance with Art. 19(2) EPC and its members' impartiality pursuant to **G 5/91** could be verified.

See also Chapter III.K.2 "Composition of the competent departments of first instance".

### **1.7. Applicability of Article 24 EPC to disciplinary proceedings**

Art. 3 of the Additional Rules of Procedure of the Disciplinary Board of Appeal of the EPO (Supplementary publication 1, OJ 2016) contains rules on exclusion and objection in proceedings before the Disciplinary Board of Appeal. In **D 7/82** (OJ 1983, 185) the Disciplinary Board applied Art. 24(3) EPC by analogy.

## **2. Initiation of partiality proceedings and other procedural issues**

Art. 24 EPC provides for two procedural alternatives. First, under paragraph 2, the member concerned may inform the board of a reason for exclusion. Second, under paragraph 3, a party may raise an objection if it has reason to do so. Art. 3(1) RPBA and Art. 4(1) RPEBA additionally provide that the procedure under Art. 24(4) is to be applied if a board has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings.

### **2.1. Notices of self-recusation**

In **G 1/05** of 7 December 2006 (OJ 2007, 362) a member of the Enlarged Board of Appeal informed it that she ought not to be taking part in the referral, since one of the opponents in the underlying case was represented by the law firm in which her husband and her son were partners. The Enlarged Board noted that Art. 24(2) EPC 1973 served to safeguard the general principle of law that nobody should decide a case in respect of which a party might have good reasons to assume partiality, by obliging a board member to inform the board accordingly if he or she considered that he or she should not take part in a case for any such reason. This would prevent the circumstances underlying a notice of withdrawal from arising later in the proceedings and casting a shadow on the decision-making process or even the decision taken. If a member of a board of appeal in a notice of withdrawal under Art. 24(2) EPC 1973 gave a ground which could by its nature constitute a possible ground for an objection of partiality, that ground should normally be respected by the decision on replacement of the board member concerned because it could be expected that the member submitting the notice knew best whether or not a possible suspicion of partiality might arise.

In **J 15/04**, the board noted that board members' notices of self-recusation did not automatically effect their final exclusion from the proceedings (see also **R 2/15** of 21 October 2015). A notice of self-recusation only initiated the procedure under Art. 24(4) EPC 1973 but did not pre-empt the outcome of the decision to be taken. If one accepted that a notice of self-recusation would immediately and automatically exclude the member concerned, then the party's formal right to a hearing before a duly appointed member of the board as established by the EPC would be violated. The board stated that the grounds of possible partiality given by a board member in a notice of self-recusation should normally be respected by the decision. It could be expected that the member submitting a notice of self-recusation based on specific facts knew best whether or not a possible suspicion of partiality might arise. The public or a party should not suspect bias after a decision of a board of appeal finding no grounds of suspicion of partiality (see also **T 584/09** of 1 March 2013).

In **R 2/15** of 21 October 2015 the Enlarged Board held that in the case of a party's objection under Art. 24(3), first sentence, EPC (see in this chapter III.J.2.3) it had to be established that there was subjective partiality or at least an appearance of partiality (objective partiality). In the case of self-recusation, however, it was sufficient that an appearance of partiality was at least arguable in the circumstances of the case.

## **2.2. Objection by other board members of the same board of appeal**

In **J 15/04** the notices of self-recusation of the two legal members contained information concerning a possible reason for exclusion of the chairman (which did not originate from the chairman himself). The board stated that for one of the originally appointed members of the board to be replaced by his alternate, the individual member had to have informed the board that he should not take part in the appeal or have been objected to by one of the parties. However, according to Art. 3(1) RPBA, the application of Art. 24(4) EPC 1973 extended to cases in which the board had knowledge of a possible reason for exclusion or objection which did not originate from a member himself or from any party to the proceedings. Thus, Art. 3 RPBA established the possibility of an objection by other members of the same board. In the case at hand, the replacement of the originally appointed chairman by an alternate chairman for the purposes of taking a decision under Art. 24(4) EPC 1973 was justified under Art. 3(1) RPBA.

## **2.3. Objection by a party**

Most partiality proceedings are initiated by a party objecting to a board member under Art. 24(3) EPC. According to the established jurisprudence of the boards of appeal, if a party is to receive a fair hearing before a tribunal, such a party should have no reasonable ground (on an objective basis) to suspect that any member of the tribunal is partial or prejudiced in relation to deciding the case (cf. **G 5/91**, OJ 1992, 617; **G 1/05** of 7 December 2006, OJ 2007, 362; **T 433/93**, OJ 1997, 509; **T 95/04**, **T 283/03**, **T 1193/02**).



## **2.4. Objection by a third party**

In **G 2/08** of 15 June 2009, the Enlarged Board of Appeal noted that objections of suspicion of partiality were the monopoly of parties to the proceedings. However, under Art. 4(1) RPEBA, if the Enlarged Board of Appeal had knowledge of a possible reason for exclusion or objection which did not originate from a member himself or from any party to the proceedings, then the procedure of Art. 24(4) EPC was to be applied (see also Art. 3(1) RPBA). When construing the meaning of the wording "possible reason for exclusion or objection", one had to bear in mind the following distinction: (a) grounds that may be raised ex officio according to Art. 24(1) EPC and (b) an objection of partiality, reserved to the parties.

A third person could worsen the procedural status of a party to the proceedings by attempting to deprive the latter of its judge established by law. Thus, systematically allowing such complaints to proceed could well result in undue delay of the proceedings. It might therefore appear appropriate not to proceed any further with a complaint if an alleged reason for exclusion or objection not originating from a party to the proceedings or the Enlarged Board of Appeal itself would amount to an abuse of procedure. That would be the case where a complaint was not substantiated at all, ignored established case law, or had been filed maliciously in order to damage a member's reputation or with the purpose of delaying the proceedings, this list not being exhaustive.

## **2.5. Statement of grounds of objection defines the factual scope of the objection**

In **R 2/14** the Enlarged Board of Appeal held that the factual scope of an objection pursuant to Art. 24(3) EPC is defined in the statement of grounds of objection initiating the interlocutory proceedings under Art. 24(4) EPC. Apart from a subsequent elaboration of said objection by supporting facts, evidence and arguments, the subject-matter of the proceedings, as a rule, cannot be extended or changed, whether by new facts or by a new objection. Accordingly, the Enlarged Board of Appeal did not admit a submission in which the petitioner referred to a new category of objections (personal or "subjective partiality" as opposed to structural or "objective partiality"). Moreover, the circumstances on which the petitioner relied had only arisen after the closure of the oral proceedings.

## **2.6. Comments of the board member concerned**

Under Art. 3(2) RPBA and Art. 4(2) RPEBA the member concerned is to be invited to present his comments as to whether there is a reason for exclusion (as to the scope of this provision, see **T 985/01** of 18 March 2005).

In **T 1938/09** the appellant referred to **R 19/12** of 25 April 2014 and objected to the chairman of the board, arguing he was a potential deputy for VP3 (see in this chapter III.J.6.2.3). The chairman had not provided details, as requested by the appellant, on whether he had deputised for VP3. The board acknowledged that there might be cases where a board would not be in a position to decide on the objection without having received the necessary information from the member objected to. However, in the case

at hand the board deemed it irrelevant for the question of impartiality whether the chairman had deputised for VP3 and refused the partiality objection.

### **3. Admissibility**

According to Art. 24(3) EPC an objection on the ground of suspected partiality is not admissible if, while being aware of a reason for objection, the party has taken a procedural step. Nor may it be based on the nationality of members. Additionally, the boards have rejected objections as inadmissible because they were not reasoned or were a mere repetition of a previously rejected objection.

#### **3.1. Competence of the board in its original composition**

In **T 1028/96** (OJ 2000, 475) the board stated that, if an objection under Art. 24(1) or (3) EPC 1973 was made by a party, Art. 24(3), second sentence, EPC 1973 clearly required a preliminary examination of admissibility (see also **R 12/09** of 3 December 2009 and **T 355/13**). The board stated that the purpose of the preliminary examination for admissibility was to determine whether the objection could go forward for substantive examination and decision. If, from the point of view of the board in its original composition, the objection was admissible, then the procedure under Art. 24(4) EPC 1973 applied. Thus, the issue of admissibility was only relevant to the opening of the procedure under Art. 24(4) EPC 1973 and had no bearing on the future decision of the new board nominated in accordance with Art. 24(4) EPC 1973.

#### **3.2. Obligation to raise the objection immediately**

In **G 5/91** (OJ 1992, 617), the Enlarged Board of Appeal stated that, although Art. 24(3) EPC 1973 was only applicable to appeal proceedings, an objection on the ground of suspected partiality could also be disregarded at first instance if it had not been raised immediately after the party had become aware of the reason for the objection (or if it was based on nationality). The system might otherwise be open to abuse.

In **T 49/11** the admissibility of the partiality objection was disputed because the respondent, after having received the summons which had made the parties aware of the composition of the board, had filed two letters with the board before raising the partiality objection. In the first letter, the respondent had expressed its intention to speak German at the oral proceedings. The board held that such a statement constituted a procedural step within the meaning of Art. 24(3), second sentence, EPC, because it was a formal notification under R. 4(1) EPC. The partiality objection was therefore rejected as inadmissible. After analysing the text of Art. 24(3), second sentence, EPC in the three official languages (Art. 177(1) EPC), the difference between Art. 24 EPC 2000 and Art. 24 EPC 1973, and the transitional provisions of the EPC 2000, the board stated that it would have come to the same result under the old and the new text of Art. 24(3) EPC.

In **T 1677/11** it was alleged that, since the substantively identical parallel appeal case **T 1760/11** had been decided by a board in identical composition one week previously,

the board would not bring an open mind to the appeal now before it. The board first had to decide whether the said objections were admissible. It noted that the principle underlying Art. 24(3), second sentence, EPC was that an objection should be "raised immediately after the party concerned has become aware of the reason for the objection" (see below **G 5/91**, OJ 1992, 617). The board further noted that the respondents had been aware of the closely related parallel appeal **T 1760/11** right from the beginning of the current appeal proceedings. Nevertheless, it was only after an adverse decision in that case had been announced that the respondents raised their objections of suspected partiality in the case at issue. The board stated that regardless of whether the respondents had taken a specific procedural step in the current appeal proceedings, they had not submitted their objection immediately after having become aware of the reasons. It held that, in view of the fact that the objections raised were linked to both appeals, attendance at oral proceedings in **T 1760/11** had to be regarded, in the factual context of the case now at issue, as a procedural step within the meaning of Art. 24(3) EPC. Thus, the objections under Art. 24(3) EPC were rejected as inadmissible.

In **T 1020/06** of 15 May 2009 the board held that filing new requests after proceedings under Art. 24(4) EPC 1973 had been started did not render the partiality objection inadmissible.

### **3.3. Objection must be reasoned and substantiated**

In **T 1028/96** of 15 September 1999 (OJ 2000, 475) the board stated that, in addition to the two admissibility conditions prescribed in Art. 24(3) EPC, the EPC required, as a general rule, that objections be reasoned, i.e. indicated facts and arguments which were alleged to support such an objection. From this requirement it followed, firstly, that an objection based on purely subjective unreasonable doubts should be rejected as inadmissible. It also followed that if facts and arguments filed could not support the objection of suspected partiality raised, the objection was likewise inadmissible (see also **T 355/13**).

In **R 12/09** of 3 December 2009 the Enlarged Board of Appeal referred to **T 1028/96** and also held that, when determining admissibility, it had to be established whether the objection had been duly substantiated. However, according to the Enlarged Board, this merely meant ascertaining whether it met the minimum standard for objective reasoning, and not whether that reasoning was also persuasive.

### **3.4. Objection based on an obviously wrong understanding of the board's procedural obligations, the right to be heard and the principle of a fair trial**

In **T 355/13** the appellant suspected the board of partiality, inter alia because it had not provided a provisional opinion on decisive aspects of the case and because it had issued a summons to oral proceedings instead of remitting the case to the department of first instance. Referring to **G 6/95**, the board stressed that there was no procedural obligation for the board to issue any provisional opinion, and that in inter partes proceedings it was not possible to automatically follow a party's request without giving the other parties the possibility to be heard on that request (in oral proceedings, if requested). The board

considered the partiality objection inadmissible, as it was based on an obviously wrong interpretation of the board's procedural obligations, the right to be heard and the principle of a fair trial.

### **3.5. Repetition of a previous objection**

In **T 281/03** of 17 May 2006 the board found that the reason for the third partiality objection was essentially the same as that already decided by the replacement board in connection with the second partiality objection. Since the new objection had been made directly upon resumption of the oral proceedings after the respondent's previous objection to partiality had been refused, no new reason for objection could exist, so that the objection was simply a repetition of the previous objection and amounted to an abuse of the proceedings. Hence, the board decided that the request was inadmissible.

### **3.6. Dual function as members of the Enlarged Board and another board of appeal**

In **R 12/09** of 3 December 2009 the petitioner objected to the members of the Enlarged Board in petition for review proceedings, alleging that they inevitably had a personal interest owing to their capacity as members of a technical board or the Legal Board of Appeal. The Enlarged Board rejected this objection as inadmissible (see in this chapter III.J.6.2.1).

## **4. Suspected partiality of members of the departments of first instance**

### **4.1. Competence to decide**

According to the Enlarged Board of Appeal in **G 5/91** (OJ 1992, 617) the practice that a partiality objection made at first instance is decided by the director of the department concerned cannot be considered illegal in view of the administrative character of the first-instance departments, which are subject to internal instructions by the President under Art. 10(2)(a) EPC (see also **T 2509/11** and **T 71/99**). Under the EPC there is no legal basis for any separate appeal against an order of a director rejecting a partiality objection to a member of a department of first instance such as an opposition division. However, the composition of the opposition division can be challenged on appeal against the final or interlocutory decision of the division. If not all the members of an opposition division fulfil the requirement of impartiality, there is a procedural violation which would normally render the decision void. The Enlarged Board of Appeal made it clear that it lay within the competence of the boards of appeal to decide whether this requirement had been fulfilled. This was also done in practice (cf. e.g. **T 251/88**, **T 939/91**, **T 382/92**, **T 476/95**, **T 838/02**, **T 1349/10**). Such consideration might take place of the boards' own motion or at the request of a party to the appeal proceedings.

In **T 479/04** the board found that **G 5/91** did not prohibit an opposition division from deciding itself on an allegation of partiality made against it. Moreover, although the Enlarged Board had considered it advantageous for the procedural matter to be settled before a decision on the substance was taken, it could not be inferred from **G 5/91** that it was forbidden to decide on that matter together with the decision on the substance. The

board concluded that the opposition division had not committed any procedural error by deciding itself, as part of the contested decision.

#### **4.2. Rehearing of a case after remittal**

In **T 433/93** (OJ 1997, 509), following a substantial procedural violation, the decision was set aside, and the case remitted to the department of first instance for re-hearing. The board found that the remitted case had to be examined and decided by a different composition of opposition division (that is, by a composition of three new members). The board considered that if the case were re-heard and re-decided by the same composition of opposition division, the members would first have to attempt to put out of their minds the result of their previous decision on the case. The board noted that the important point was not whether the file record showed any previous evidence of actual partiality by the members of the opposition division during the previous conduct of the case (see **T 261/88** of 16 February 1993), or whether the present members of the opposition division would in fact be unprejudiced or impartial if they re-heard the case, but whether a party would have reasonable ground to suspect that they would not receive a fair hearing if the case was re-heard before the same composition of opposition division. In **T 2362/08** the board also ordered a new composition of the opposition division after remittal, stating that after procedural irregularities in the first proceedings it was fundamental that the parties have no ground to suspect that they had not received a fair hearing in the further proceedings, as they might well do if the same opposition division were again to revoke the patent even after conducting the proceedings in an impeccable way.

In **T 611/01** the board found a substantial procedural violation had occurred, remitted the case to the department of first instance and considered that the new examination proceedings should be conducted by a differently composed examining division (three new members). This was typically done when there was a question of possible bias against a party. Although that was not the case here, a differently composed division could also be appropriate when a party had reasonable grounds for feeling it might not otherwise have a fair re-hearing (see **T 433/93**, OJ 1997, 509; see also **T 628/95** of 13.5.1996). Even if the appellant had not requested a different composition it would have been important to avoid, after grave procedural irregularities, any ground for dissatisfaction with the conduct of the further proceedings. This could be the case if the same examining division, even after impeccably conducted proceedings, refused the application again.

#### **4.3. Personal interest**

In **T 143/91** the board held that a member of an opposition division was biased if he had a personal interest within the meaning of Art. 24(1) EPC 1973. The mere fact that the member had previously been employed by a company dependent on a party to the opposition proceedings was, however, not sufficient proof of such an interest.

Under Art. 17(1) of the Service Regulations for permanent employees of the EPO any permanent employee who, in the performance of his duties, is called upon to decide on a

matter in the handling or outcome of which he has a personal interest such as to impair his independence must inform the President of the Office. According to paragraph 2, this provision does not apply to members of the boards of appeal.

#### **4.4. Disqualifying partiality**

In **T 261/88** of 16 February 1993 the board stated that disqualifying partiality presumes that there is a preconceived attitude on the part of a deciding person towards a party to the case. When considering an allegation of partiality (in this case mainly based on the fact that the examiner was a former employee of the opponent), regard must be had to the particular facts of the case (cf. **G 5/91**). The board noted that the fact that the examiner's views differed from those held by the party was not disqualifying in itself. Disqualifying partiality was limited to situations where the opinion of a person responsible for taking decisions affecting the right of parties was swayed by his attitude towards a party. The content of the file had to be examined to find out whether there were major deficiencies in the reasoning underlying the decision to such an extent that there was reason to believe that they were the result of a preconceived attitude. In the case in hand, the board could not find anything basically or conspicuously wrong with the analysis of the technical questions.

In **T 900/02** the board stated that a suspicion of partiality inevitably arose if a member of an opposition division, or any other first-instance body, first solicited and then accepted employment with a firm in which a partner or other employee was conducting a case pending before that member. It stressed that, to be above all suspicion of partiality, every member had to avoid any such situation at any time during the proceedings. No-one could be seen as independent of both parties while in the employ of one of them. The board held that the second examiner's employment by the respondent's representative's firm was both a fundamental deficiency in the first instance proceedings under Art. 10 RPBA and a substantial procedural violation under R. 67 EPC 1973.

In **T 951/91** (OJ 1995, 202) objections under Art. 24 and Art. 19(2) EPC 1973 were raised suggesting that the opposition division had been biased in its attitude to the parties. 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 could be suspected of bias. The reasons in the appealed decision did not reveal any bias either.

In **T 1055/05** the board decided that the examining division's refusal to minute the submissions of a party's representative during oral proceedings did not infringe the right to be heard or constitute grounds for suspecting partiality.

#### **5. Suspected partiality of members of the boards of appeal**

Art. 24(1) EPC states that members of the boards of appeal or of the Enlarged Board of Appeal may not take part in a case in which they have any personal interest, or if they have previously been involved as representatives of one of the parties, or if they participated in the decision under appeal. Art. 24(3) EPC prescribes that members of a

board of appeal or of the Enlarged Board of Appeal may be objected to by any party for one of the reasons mentioned in Art. 24(1) EPC, or if suspected of partiality.

### **5.1. Grounds for exclusion under Article 24(1) EPC**

#### **5.1.1 Previous involvement of a board member as a party's representative**

In **R 16/10** the Enlarged Board rejected the petitioner's argument that Art. 24(1) EPC included not only the specific situation where one of the members had represented a party in the case in question but also the general situation where a member had previously acted as representative of that party in any matter. Art. 24(1) EPC related to involvement in the particular case in question and not to any past representation (see also Chapter IV.F.3.11 "Article 112a(2)(a) EPC - alleged breach of Article 24 EPC").

#### **5.1.2 Participation in the decision under appeal**

In **T 1028/96** of 15 September 1999 (OJ 2000, 475) the board stated that a member of a board in opposition appeal proceedings who had participated in the decision to grant the patent had not "participated in the decision under appeal" within the meaning of Art. 24(1) EPC 1973. However, in certain special circumstances members of a board in opposition appeal proceedings may be "suspected of partiality" within the meaning of Art. 24(3) EPC if they participated in the decision to grant the patent in suit.

In **J 15/04** the board considered whether it would be appropriate to exclude a member of the board from proceedings whenever he had played any role in a previous case which had any functional coherence with the one under consideration. Such functional coherency could be seen in the relationship of a divisional application to its parent application, as in the procedural situation at issue. The board noted that if members of a board were to be excluded because that board decided the same legal question in every case in an identical way, any established jurisprudence of a board would lead to exclusion of its members whenever the same legal question was at stake. The principle of judicial efficiency also constituted an essential element of the right to a fair trial and outweighed any allegation concerning a generally "possible" suspicion of partiality which was not based on the specific facts of the case. By the same token, the principle of a fair trial did not generally exclude a member of the boards of appeal from dealing with a party's case repeatedly, as might happen when a board referred a case back to the first instance and the appeal from the following decision established the competence of the same board. The essence of Art. 24(1) EPC 1973 was not to establish an assumption that any former involvement of a member of the board in a case dealing with the interests of a specific party established a suspicion of partiality of that member in all subsequent cases, but to exclude the participation of this member in reviewing a decision which had been dealt with by himself as part of the deciding body. In the case at issue, the board refused the partiality objection.

In **T 1020/06** of 28 November 2008 the board found that there was no provision in the RPBA or the Business Distribution Scheme (BDS) for a member to be excluded from participation in an appeal case pending before a technical board if that member had

already dealt with a similar legal or factual question in another case pending before the same or another technical board. On the contrary, Art. 7 BDS stipulated that, where appeals pending before the board were closely linked the chairman could order that the board decide in the same composition. The board rejected the objections of partiality under Art. 24(3) EPC 1973 against the original board members.

## 5.2. Grounds for objection under Article 24(3) EPC

### 5.2.1 Expressions of opinions on legal issues

In **T 241/98** of 22 March 1999 the board of appeal observed that forming an opinion is one of the most important tasks of a board. Issuing a preliminary opinion is to be seen within this context and therefore cannot be regarded as partial (see also in this chapter III.J.6.2.2).

### 5.2.2 Disqualifying partiality

In **T 843/91** of 17 March 1993 the board noted that disqualifying partiality presumed a preconceived attitude on the part of a deciding person towards a party (see also **T 1028/96** of 15 September 1999). More precisely, in the board's view, partiality would be willingly to favour one party by granting it rights to which it was not entitled, or by intentionally disregarding the rights of the other party (cf. **T 261/88** of 16 February 1993). The question whether an objection to board members on the ground of suspected partiality was justified could only be decided in the light of the particular circumstances of each individual case (cf. **G 5/91**). The board found that, whatever their gravity, deficiencies, erroneous practices or procedural violations could not be regarded as a basis for an objection on the ground of partiality if they did not result from such a preconceived attitude or deliberate intention.

In the appeal proceedings underlying **R 17/09** members of the board used the term "man in the street". The Enlarged Board found that in English this term had no pejorative associations but was commonly used to describe an average citizen. It could see no support for the allegation that members of the board were influenced in their decision by any bias against the petitioner.

### 5.2.3 Discretionary procedural decisions negatively affecting a party

According to **T 954/98** of 9 December 1999 the mere fact of taking discretionary procedural steps which might disadvantage a particular party is not enough to justify exclusion, not even if the party interpreted those steps as expressing bias against it.

In **T 190/03** of 18 March 2005 (OJ 2006, 502; see also **T 283/03**, **T 572/03** and **T 985/01** of 18 March 2005) the board held that not admitting amended claims, regardless of whether the board had correctly used its power or discretion to do so, would not give rise to an objectively justified fear of partiality.



## **6. Suspected partiality of members of the Enlarged Board of Appeal**

As is clear from its wording, Art. 24 EPC applies to both members of the boards of appeal and members of the Enlarged Board of Appeal.

### **6.1. Referral proceedings under Article 112 EPC**

#### 6.1.1 Previous participation in cases as members of the boards of appeal

In **G 1/05** of 7 December 2006 (OJ 2007, 362) a member of the Enlarged Board of Appeal was objected to because he had been the chairman of a technical board which had given a prior decision related to the question of law referred to the Enlarged Board. The Enlarged Board held that to the extent that the participation in a referral of a board member having already dealt with the matter as a member of a board of appeal was not excluded by the relevant provisions (Art. 1(2) RPEBA and Art. 2(3) BDS of the Enlarged Board of Appeal), an objection of partiality could not be based on that very fact alone (see also **G 2/08** of 15 June 2009 and **R 12/09** of 3 December 2009). On the contrary, unless there were specific circumstances casting doubt on the member's ability to approach the parties' submissions with an open mind on a later occasion, there could not be any objectively justified, i.e. reasonable, suspicion of partiality against a member of the Enlarged Board of Appeal. Moreover, if all members of the Enlarged Board of Appeal having once taken part in a decision expressing a view on a point of law which was then referred to the Enlarged Board were to be excluded from taking part in that referral, the Enlarged Board's functioning would be severely affected. It could become impossible to allocate the number of Enlarged Board members needed to conduct the case. The Enlarged Board of Appeal noted that the situation could be viewed differently if there were deficiencies in the view expressed to such an extent that there was reason to believe that they were the result of a preconceived attitude. It would also have been different if a board member had pronounced on a matter to be decided with his or her participation in such outspoken, extreme or unbalanced terms, be it in the course of or outside the proceedings, that his or her ability to consider the arguments put forward by the parties with an open mind and without a preconceived attitude and to bring an objective judgment to bear on the issues before him or her, could be doubted.

#### 6.1.2 Expressions of opinion on legal issues

In **G 3/08** of 16 October 2009 the Enlarged Board noted that, according to established case law of the boards of appeal, of the Enlarged Board of Appeal and also of national courts of member states, the mere fact that a board member had expressed a view on the legal issue to be decided on a previous occasion, be it in a prior decision or in literature, be it in a prior position in the EPO or as an expert for external political institutions, could not lead to doubts as to impartiality.

### **6.2. Petition for review proceedings under Article 112a EPC**

The present chapter concerns partiality objections raised in petition for review proceedings against members of the Enlarged Board themselves. For decisions of the

Enlarged Board on the alleged breach of Art. 24 EPC in appeal proceedings, see Chapter IV.F.3.11 "Article 112a(2)(a) EPC - alleged breach of Article 24 EPC". As to the replacement of board members after a petition for review has been held allowable, see Chapter IV.F.3.16 "Rule 108(3) EPC - effects of a successful petition for review".

#### 6.2.1 Previous participation in cases as members of the boards of appeal

In **R 12/09** of 3 December 2009 (see also **R 2/14** of 17 February 2015) the petitioner had objected to the Enlarged Board members, alleging that they inevitably had a personal interest owing to their capacity as members of a technical board or the Legal Board of Appeal. The board observed that the legislator had consciously decided to allocate the task of hearing petitions for review to the Enlarged Board as a pre-existing body with appointed members and, when doing so, had been fully aware that those members were for the most part also experienced members of technical boards or the Legal Board of Appeal. The legislator could thus only have intended that those members also be deployed in procedures under Art. 112a EPC. The legislator had demonstrated its intention that these members' dual function should not, by itself, constitute a reason for objecting to or excluding them when it came to performing this task. The objection was thus dismissed as inadmissible.

#### 6.2.2 Expressions of opinion on legal issues

In **R 2/12** of 26 September 2012 the objection of suspected partiality was derived exclusively from the communication by which the petitioner was informed of the Enlarged Board's provisional opinion on the petition. The Enlarged Board found it would be incompatible with an objective assessment of a case and with the principle of a fair trial in inter partes proceedings, if a board member could be 'deposed' on the ground that they did not opine in favour of a particular party right from the beginning of the proceedings. See also in this chapter III.J.5.2.1.

#### 6.2.3 Suspected partiality of the Chairman of the Enlarged Board of Appeal

In **R 19/12** of 25 April 2014 the petitioner objected to the chairman of the Enlarged Board of Appeal on account of his involvement, past and present, in the administration of the EPO. The Enlarged Board stressed that the rules on exclusion and objection were designed to maintain the necessary distance for the judge from the issues at stake and the parties thereto and also from the body whose decision was being reviewed. Such distance was especially important where it concerned the distance of the court and its judges from the administrative authority whose decisions were reviewed. The fact that a judge had previously held high office in an administrative hierarchy was not a sufficient ground that on its own justified a suspicion of partiality. However, the judge concerned had been appointed simultaneously as Vice-President DG 3 (VP3) and chairman of the Enlarged Board and remained, as VP3, part of the Office's administrative hierarchy. Under Art. 10(2)(f) EPC he remained subject to the supervisory authority of the President as his immediate superior. Under Art. 10(3) EPC the President was assisted by the vice-presidents, this being institutionalised in the form of the Management Committee (MAC) and the General Advisory Committee (GAC). VP3 might therefore be faced with

conflicting demands. On the one hand, as a vice-president subordinate to the President he had to implement the latter's management and performance objectives, even in relation to the boards of appeal; on the other, as part of his managerial responsibility for the boards he had to ensure that their judicial independence was not prejudiced by measures taken by the President and his administrative hierarchy. If the Enlarged Board approved a review of first-instance decisions which was restrictive in terms of the right to be heard, the examining and opposition divisions would have more latitude to shape proceedings in accordance with prescribed efficiency objectives. There was good reason for a reasonable, objective and informed person to fear that the chairman might not be capable of exercising his judicial function uninfluenced by instructions given to him in his capacity as VP3. The Enlarged Board thus considered the partiality objection to its chairman to be well-founded.

In **R 2/14** of 17 February 2015 the petitioner also requested that the chairman of the Enlarged Board be replaced due to partiality. The chairman stated that, following interlocutory decision **R 19/12** of 25 April 2014, his managerial activities in the senior management committees of the Office, i.e. the MAC and the GAC, had been discontinued. The Enlarged Board thus considered that the factual circumstances clearly differed from those on which interlocutory decision **R 19/12** had been based. What remained was that the chairman, in his function as VP3, continued to be subject to the provisions of Art. 10(2)(f) and (3) EPC, according to which the vice-presidents assist the President and are subject to his supervisory authority. These provisions could come into conflict with Art. 23(3) EPC, according to which the chairman, in his judicial function, is not bound by any instructions. Applying the concept of "normative concordance", the Enlarged Board of Appeal stated that the President's power to give instructions to the chairman in his function as VP3 pursuant to Art. 10(2)(f) and (3) EPC was limited by virtue of Art. 23(3) EPC. The chairman was accordingly relieved of any obligation (i) to obey any presidential instructions, (ii) to observe other administrative/executive directions or (iii) to assist the President pursuant to Art. 10(3) EPC, if and to the extent that any such instruction, direction or assistance might affect him and/or any other member of the boards of appeal in performing their judicial duties. When confronted with an unresolvable conflict between a managerial and a judicial obligation, his judicial duties under Art. 23(3) and 24 EPC and under Art. 6(1) ECHR prevailed. The Enlarged Board of Appeal concluded that a reasonable, objective and informed person would, after the implementation of the institutional measures adopted following interlocutory decision **R 19/12**, no longer have good reason to suspect the chairman of partiality.

In **R 8/13** of 20 March 2015 the Enlarged Board did not accept the petitioners' view that **R 19/12** was generally binding for all petition proceedings that included VP3 as chairman of the Enlarged Board. In **R 19/12** the decisive objective circumstances which created an impression of a lack of independence and impartiality for an objective observer were that the chairman of the Enlarged Board had been involved, in his function as VP3, in two administrative bodies (MAC and GAC). However, the involvement of VP3 in EPO management bodies had been limited. Moreover, the EPC's legislative history showed that the potential conflicts intrinsic to the dual function of VP3 and chairman of the Enlarged Board were perceived even prior to **R 19/12**, and were circumvented merely by means of specific organisational measures. Art. 23 EPC limited the President's power to

give instructions under Art. 10(2)(f) EPC to the Enlarged Board's chairman in his capacity as VP3. The Enlarged Board concluded that, in the circumstances of the present case and in view of VP3's restricted duties, there were no ascertainable facts giving objective cause to believe that Art. 23 EPC could no longer fulfil its safeguard role vis-à-vis Art. 10(2)(f) and (3) EPC. Whether the current organisational structure was the most appropriate one would be for the legislator to decide.

## **7. Legal restrictions for former board members**

In **G 2/94** (OJ 1996, 401) the Enlarged Board of Appeal noted that there was a potential conflict between what might be seen as a right of former board of appeal members to seek subsequent employment on the basis of their special knowledge by making oral submissions during proceedings before the EPO, and the need for proceedings before the EPO to be conducted free from any suspicion of partiality. The existence of such a potential conflict was well recognised in national judicial systems, as was the approach to resolving it through a number of legal restrictions. The existence of such restrictions reflected the generally recognised principle of law that parties to legal proceedings were entitled to a fair hearing before judges who could not reasonably be suspected of partiality. The Enlarged Board of Appeal noted that the public interest in the proper conduct of proceedings before the EPO had to prevail over the personal interest of former board of appeal members wishing to make oral submissions on behalf of parties to such proceedings. In the interest of the proper administration of proceedings before the EPO it was necessary to place some restrictions upon the admissibility of oral submissions by former members of the boards of appeal during such proceedings. See also Chapter III.R.5.2 "Oral submissions by former members of the boards of appeal".

In **T 585/06** the board noted that the former member of the boards of appeal had no longer been an EPO employee when he had attended the oral proceedings. By virtue of the fundamental principle of freedom to exercise a profession, he was in principle not prevented from working as a consultant in the field of patent law. He had not acted as an authorised representative, and had not addressed the opposition division. This amounted to an important difference from the facts of case **G 2/94**, where a former member of the boards of appeal had presented his case before his former colleagues. In the case at issue, the former member had given only hints by whispering to the authorised representative, who had been absolutely free to accept them or not, but had not made any intervention of his own motion. The appellant's representative had agreed at the beginning of the oral proceedings to his sitting beside and assisting the respondent's representative. The request for reimbursement of the appeal fee was thus refused.

**K. Formal aspects of decisions of EPO departments**

1.	Right to a decision after notification of loss of rights (Rule 112 EPC)	742
1.1.	Notification of loss of rights under Rule 112(1) EPC	742
1.2.	Form of notification of loss of rights under Rule 112(1) EPC	742
1.3.	Duties not entrusted to formalities officers	742
1.4.	Right to a decision under Rule 112(2) EPC	743
1.5.	Purpose of notification of loss of rights under Rule 112 EPC	743
1.6.	Circumstances under which decision can be applied for under Rule 112(2) EPC	743
2.	Composition of the competent departments of first instance	744
2.1.	Examining division	744
2.2.	Opposition division	744
2.2.1	Composition of opposition division includes those who have taken part in proceedings for grant contrary to Art. 19(2) EPC	745
2.2.2	Change in composition of opposition division during opposition proceedings	745
2.2.3	Enlargement and reduction of opposition division	746
2.2.4	Remittal after breach of Article 19(2) EPC	746
3.	Date of decision	747
3.1.	Entry into force of decisions	747
3.2.	Completion of the internal decision-making process	747
3.3.	Date European patent takes effect and jurisdiction after pendency	748
4.	Form of decisions	748
4.1.	General issues	748
4.1.1	Notification of decision under Rule 111 EPC.	748
4.1.2	Substance of decisions	749
4.1.3	Communication under Rule 111(2) EPC	750
4.1.4	Department of first instance issues more than one decision	750
4.1.5	Inconsistency between oral and written decisions	751
4.2.	Reasons for the decision	751
4.2.1	Legal requirement for reasoned decisions under Rule 111(2) EPC	751
4.2.2	Examples of compliance with the requirements of Rule 111(2) EPC (former Rule 68(2) EPC 1973)	752
a)	Incomplete and deficient reasoning	752
b)	Reasons not well-founded	753
c)	Findings to obviate remittal	753
4.2.3	Examples of non-compliance with the requirements of Rule 111(2) EPC (former Rule 68(2) EPC 1973)	753
a)	Incomplete and deficient reasoning	753
b)	No explanation given for decision reached	754
c)	References to communications	755
d)	Reference to decision of board of appeal	756
e)	References to unrelated issues	756
f)	Assessment of inventive step without assessing the prior art	756
g)	Identical decision after remittal for further prosecution	756
4.3.	Decisions according to the state of the file	757

4.3.1	Request for decision 'on the file as it stands'	757
4.3.2	Decisions 'on the file as it stands' to be reasoned	757
4.3.3	No waiver of right to a reasoned decision	758
4.3.4	Documents comprising 'state of the file'	758
4.4.	Right to have comments considered	758
4.5.	Signatures on a decision	759
4.5.1	Decisions to be signed	759
4.5.2	Examples of invalid signatures	759
	a) When decision is announced in oral proceedings	759
	b) Director's signature in place of examiner's signature	759
4.5.3	Examples of valid signatures	759
	a) Computer-generated communications	759
	b) Death of examiner between oral proceedings and written decision	760
	c) Decision in written proceedings	760
	d) Illegible signature	760
	e) Draft decisions	760
5.	Principles for the exercise of discretion	761

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## 1. Right to a decision after notification of loss of rights (Rule 112 EPC)

### 1.1. Notification of loss of rights under Rule 112(1) EPC

Pursuant to R. 112(1) EPC (former R. 69(1) EPC 1973) if the EPO notes that the loss of any rights results from the EPC, it must communicate this to the party concerned. If the party disagrees with the finding of the EPO it may apply for a decision on the matter by the EPO (R. 112(2) EPC, former R. 69(2) EPC 1973) or it may request further processing or reestablishment of rights, as the case may be (**J 14/94**, OJ 1995, 824).

### 1.2. Form of notification of loss of rights under Rule 112(1) EPC

The board in **J 43/92** noted that R. 69(1) EPC 1973 did not prescribe any particular form for the communications provided therein, distinguishing them from other communications or notifications under the EPC. A reference to a time limit to apply for a decision was not necessarily decisive as to the true nature of the communication. Whether a document constituted a communication pursuant to R. 69(1) EPC 1973 should be derived from its substantive content and its context.

### 1.3. Duties not entrusted to formalities officers

The **act of informing** an opponent under R. 112(2) EPC does not belong to the duties entrusted to formalities officers of the opposition divisions by virtue of the powers transferred to the Vice-President of Directorate-General 2 of the EPO by order of the President of the EPO under R. 11(2) EPC (see **T 161/96**; OJ 1999, 331). An appellant is not therefore entitled to rely on the formalities officer's communication that no loss of rights has occurred.

In **T 808/03** the board found that a formalities officer was not empowered to grant *restitutio in integrum* in relation to the filing of a notice of appeal (apart from the exception of the granting of interlocutory revision pursuant to Art. 109(1) EPC 1973) and that the purported decision was accordingly null and void. The department competent to decide whether an appeal was admissible and thus *inter alia* whether a notice of appeal met the requirements of the EPC 1973 was, subject to the exception mentioned, the board of appeal of the EPO (R. 65(1) EPC 1973; see **T 949/94** of 24.3.1995 and **T 473/91**, OJ 1993, 630).

#### **1.4. Right to a decision under Rule 112(2) EPC**

The right to a decision after notification of loss of rights is a substantial procedural right which cannot be ignored by the EPO. A party who applies for a decision under R. 112(2) EPC is entitled to receive one. If the correctness of a notification of loss of rights under R. 112(1) EPC is challenged, the EPO has a duty to reply within a **reasonable period of time** having regard to the subject-matter of the communication (see **J 29/86**, OJ 1988, 84; and **J 34/92**).

#### **1.5. Purpose of notification of loss of rights under Rule 112 EPC**

In **J 7/92** the board stated that the purpose of a notification under R. 69(1) EPC 1973 is not to give an applicant a chance to take at least remedial action by way of a request for re-establishment of rights. As stated by the Enlarged Board in its opinion **G 1/90** (OJ 1991, 275), when, according to the EPC the European patent application shall be deemed to be withdrawn, the applicant must be "informed" of the loss of rights (R. 69(1) EPC 1973). According to R. 69(2) EPC 1973 he may then, within two months of notification of the communication, apply for a decision "if he considers that the finding of the EPO is inaccurate". Although it is the customary practice of the EPO to send renewal fee reminders, it is in no way compelled to issue such communications. By communicating such information, the EPO provides only a voluntary service from which no rights can be derived (following **J 12/84** (OJ 1985, 108)). The EPC 1973 did not provide that the EPO should note the loss of rights mentioned in R. 69(1) EPC 1973 within a certain period. Nor did it provide any period of time for the ensuing communication. However, when incoming requests or documents contained clear deficiencies which were obviously easy to correct and could be expected to be remedied within the time limit to avoid a loss of rights, then the principles of good faith might require the EPO to draw attention to such deficiencies (on the principle of the protection of legitimate expectations see Chapter III.A).

#### **1.6. Circumstances under which decision can be applied for under Rule 112(2) EPC**

In **J 43/92** the board noted that a decision pursuant to R. 69(2) EPC 1973 (now R. 112(2) EPC) could only validly be applied for in the circumstances defined in R. 69(1) EPC 1973 (now R. 112(1) EPC). Thus, it was a necessary condition for such an application that the EPO had previously noted the loss of a right resulting from the EPC 1973 without any decision and communicated this to the party concerned.

Otherwise, there was no basis for the EPO to give a decision pursuant to R. 69(2) EPC 1973.

## **2. Composition of the competent departments of first instance**

### **2.1. Examining division**

Art. 18(2) EPC stipulates that an examining division must consist of three technical qualified examiners. If the examining division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner.

In **T 714/92** the board held that the taking of 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.

In **T 160/09** the board found it permissible for the second examiner at oral proceedings to be different from the one who signed the summons. This was not at all comparable to the situation in **T 390/86** (see point 2.2 below), where the written decision had not been signed by those members of the opposition division who had delivered the decision during oral proceedings. There is no prohibition on changing the composition of a division, nor is the EPO required to follow a particular procedure to do this.

In **T 1207/09** the examining division's second member at oral proceedings was not the one who had signed the summons. In view of **T 390/86** (OJ 1989, 30) it was argued that this was a substantial procedural violation. The board took a different view, following **T 160/09**. In **T 390/86**, the written decision had not been signed by the examining division members who had taken the decision at the oral proceedings. Under those circumstances it was not certain that the written decision reflected their views. But **T 390/86** did not mean that the examining division's composition could not be changed prior to oral proceedings. In the case at issue, the decision had been signed by the examiners who had taken part in the oral proceedings, so **T 390/86** did not apply. Furthermore, Art. 18(2) EPC set out only that an examining division had to consist of three technically qualified examiners; it did not require that the initial composition be maintained throughout the proceedings.

### **2.2. Opposition division**

Art. 19(2) EPC stipulates that an opposition division must consist of three technical examiners, at least two of whom must not have taken part in the proceedings for grant of the patent to which the opposition relates. An examiner who has taken part in the proceedings for grant of the patent may not be chairman of the opposition division.



### 2.2.1 Composition of opposition division includes those who have taken part in proceedings for grant contrary to Art. 19(2) EPC

Where the composition of an opposition division is held to be contrary to the requirements of Art. 19(2) EPC, in that two or more took part in the prior proceedings for grant, this is generally held to be a substantial procedural violation, the decision is set aside, the appeal fee reimbursed and the case remitted for fresh examination by an opposition division with a different composition (see e.g. **T 251/88**, **T 382/92**, **T 476/95**, **T 135/12**, **T 285/11**). If only one examiner took part in the prior proceedings, that examiner may not be chairman in the subsequent opposition proceedings under Art. 19(2) EPC (**T 939/91**).

Art. 19(2), first and second sentence, EPC refers to the participation of members of the opposition division at **every stage** of the grant proceedings, not only to their involvement in the final decision (**T 476/95**).

In cases of a breach of Art. 19(2) EPC it follows from the lack of jurisdiction of the department of first instance that the impugned decision is void ab initio. The faulty constitution of the opposition division gives rise to a substantial procedural violation and the appeal fee must be reimbursed (see e.g. **T 382/92**).

### 2.2.2 Change in composition of opposition division during opposition proceedings

In **T 390/86** (OJ 1989, 30) all three members of the opposition division were changed between the oral and written decision. The board held that a decision must at least be written on behalf of and represent the views of the members appointed to decide the proceedings, and must bear signatures which indicate this. The written reasons for a decision delivered during oral proceedings can only be signed by members of the deciding body who took part in the oral proceedings. The same principle applies if between the orally delivered decision and the written decision proceedings in accordance with R. 58(4) EPC 1973 have taken place. Where a final substantive decision has been given orally by an opposition division during oral proceedings, if the subsequent written decision giving the reasons for such oral substantive decision is signed by persons who did not constitute the opposition division during the oral proceedings, the decision is invalid.

**T 390/86** has been followed in numerous decisions, see for example, **T 243/87**, **T 960/94** and **T 2076/11**.

In **T 243/87** the board of appeal developed the principles established in **T 390/86**, further holding 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. The situation in which one of the appointed members was incapacitated (e.g. through illness) was quite different; in such cases one of them could sign on behalf of the member unable to do so after checking that the reasoned written decision represented the point of view of all the members who had taken part in

the oral proceedings. This was followed in other cases where only one member of the opposition division had changed between the oral and written decision; see e.g. **T 960/94** and **T 862/98**. However, where the change in the composition of the opposition division occurs **prior** to the oral proceedings, this is not by itself a breach of the right to a fair hearing (**T 1652/08**). In the case at issue the opposition division had at all times been properly composed and, accordingly, there had been no infringement of Art. 19(2) EPC 1973.

In **T 900/02** a number of procedural irregularities had occurred after the oral proceedings before the opposition division, including a delay of over three years before despatch of the written decision (in fact, two decisions were issued, in different compositions). The board followed **T 390/86** and **T 862/98**; a signed written decision issued after oral proceedings should be the decision of those members of the first instance who conducted the oral proceedings and none others. If for any reason, (even quite acceptable and understandable reasons such as illness or retirement), the same three members were not available, then the parties were to be offered new oral proceedings.

### 2.2.3 Enlargement and reduction of opposition division

In **T 990/06** the board took the view that Art. 19(2) EPC 1973 gave clear instructions as to how an opposition division was normally to be composed. This ensured that the parties knew what panel would be hearing and deciding on their case at oral proceedings and could thus verify compliance with Art. 19(2) EPC 1973 and check that the panel members were impartial in keeping with **G 5/91** (OJ 1992, 617). It was therefore essential that the opposition division's composition be clear and verifiable at all crucial stages of the proceedings. For this reason any procedure to enlarge it by adding a legally qualified member under Art. 19(2) EPC 1973 likewise had to be open to scrutiny. Such transparency was, of course, also required where the legally qualified member ceased to be on the division because there was no longer any reason for him to participate.

In **T 1254/11** the board held that an opposition division enlarged to four members pursuant to Art. 19(2) EPC 1973 could in principle be reduced again to three members. It was for the four-person panel to decide on the reduction. In this respect the board concurred with **T 990/06**. In deciding on the reduction, the opposition division consisting of four members must properly exercise its discretion. The board assumed *arguendo* that the fact that neither a decision to enlarge nor a decision to reduce the opposition division had been added to the publicly available file and the fact that the appointment of the new chairman could only be traced from the internal register of the EPO both constituted fundamental deficiencies of the proceedings before the opposition division. However, unlike in **T 990/06**, it was possible to determine from the file that the division had been lawfully enlarged and, at a later stage, lawfully reduced again.

### 2.2.4 Remittal after breach of Article 19(2) EPC

It is established case law (see **T 251/88**, **T 939/91**, **T 382/92**, **T 476/95**, **T 838/02**, **T 825/08**, **T 1349/10**, **T 1700/10**) that an improper composition of the opposition division

is a substantial procedural violation requiring remittal to the opposition division under Art. 111 EPC and reimbursement of the appeal fee (see also Chapter IV.E.7 "Remittal to the department of first instance").

In **T 838/02**, the chairman of the opposition division was excluded as he had participated in the grant proceedings. The board held that if the composition of the opposition division was contrary to Art. 19(2) EPC 1973, the parties should be given the opportunity to comment, before the board decided on the remittal of the case. In **T 1349/10**, with similar facts, the board distinguished the situation from that in **T 838/02**, where the patent had been revoked by the opposition division and held that violations of Art. 19(2) EPC 1973 should lead to a remittal regardless of the parties' position at least in situations where third parties were affected by the outcome of the defective first instance proceedings, as in the case before it, where the patent was maintained in the opposition proceedings.

In **T 234/11** the dossier showed that two members of the opposition division had taken part in the grant proceedings, in contravention of Art. 19(2) EPC. The board ruled that the wording of Art. 19(2) EPC left no room for discretion. Nor did **T 838/02** apply, because here the parties to the proceedings had differing interests: one sought remittal to the opposition division, the other did not want that. In contrast to **T 838/02**, where the patent had been revoked by the department of first instance, here the issue was the patent's maintenance in amended form. As a result, the public too was affected by the procedurally flawed decision (see **T 1349/10**), so the case was remitted.

### **3. Date of decision**

#### **3.1. Entry into force of decisions**

The Enlarged Board of Appeal in **G 12/91** (OJ 1994, 285) distinguished between decisions taken after the closure of the debate in oral proceedings and decisions taken following written proceedings. Where oral proceedings are held, the decision may be given orally. The decision becomes effective by virtue of its being pronounced. The equivalent of that point in time in written proceedings is the moment the decision is notified. Once it has been pronounced and, in the case of written proceedings, notified, the decision enters into force and cannot be amended, even by the department that issued it. A decision may only be revoked by the department that issued it by way of an interlocutory revision under Art. 109 EPC 1973 if one of the parties has filed an admissible and well-founded appeal.

#### **3.2. Completion of the internal decision-making process**

According to **G 12/91** (OJ 1994, 285) the point in time at which a decision enters into force, i.e. the moment it is pronounced or notified, is not the last moment at which parties could still submit observations. This had to be done **at an earlier point** in the proceedings to allow the decision-making department time to deliberate and then issue its decision based on the parties' submissions. Where oral proceedings are held, this moment is the closing of the debate, this point being fixed by the decision-making

department - having first heard the parties' submissions - to allow itself time to consider its decision (see **J 42/89**; **T 762/90** and **T 595/90**, OJ 1994, 695).

In the case of decisions taken following **written** proceedings, the point in time at which the internal decision-making process was completed was the date on which the formalities section handed over the date-stamped, post-dated decision to the EPO postal service.

This marks the completion of proceedings before the decision-making department, which can no longer amend its decision. This point in time should be clearly indicated in the decision (see also **T 631/94**, OJ 1996, 67, which held that intervention was not possible thereafter if no appeal was filed).

In **T 2573/11** the board decided that if it was clearly indicated in the decision on which date the formalities section handed the decision over to the EPO postal service, this date was thus the date on which written proceedings before the decision-making department were completed.

In **T 798/95** the board held that a request for amendment filed after the completion of the proceedings up to grant before an examining division was to be disregarded even if the filing of the request and the completion of the proceedings occurred on the same date.

### **3.3. Date European patent takes effect and jurisdiction after pendency**

A request under R. 139 EPC for amendments to the description or claims can only be filed during the pendency of application or opposition proceedings. Under Art. 97(3) EPC, the decision to grant a European patent takes effect on the date on which the mention of the grant is published in the European Patent Bulletin. After that date, R. 139 EPC can only be applied while opposition proceedings were pending. See, for example, **J 42/92**, where the board also pointed out that there was no reason why, once no application or opposition proceedings were pending before the EPO, decisions on the question of corrections should not fall within the sole jurisdiction of the national courts or other authorities responsible for proceedings in which this question might arise (see also **T 777/97**).

## **4. Form of decisions**

### **4.1. General issues**

#### **4.1.1 Notification of decision under Rule 111 EPC.**

When a substantive decision is given orally during oral proceedings it must be formally notified to the parties in writing (R. 111(1) EPC) and formally completed by giving reasons for the decision in writing (R. 111(2) EPC) (see **T 390/86** (OJ 1989, 30). According to this decision, it was clear from R. 68 EPC 1973 (now R. 111 EPC) and Art. 108 EPC 1973 that until a substantive oral decision was formally completed in

writing and notified to the parties, the two-month period within which a notice of appeal had to be filed did not begin.

#### 4.1.2 Substance of decisions

For more detail see also Chapter IV.E.2.2.2 "Decisions".

A decision of the EPO may be, but ought not to be, given in a document which in form appears to be merely a communication (**J 8/81**, OJ 1982, 10). Whether a document issued by the EPO constitutes a decision or a communication depends on the substance of its **contents**, not on its **form** (see e.g. **J 8/81**, OJ 1982, 10; **J 26/87**, OJ 1989, 329; **J 43/92**, **T 222/85**, OJ 1988, 128, **T 713/02**, **J 14/07** and **T 165/07**). The criterion of substance has to be assessed in its procedural context (see **T 713/02**, OJ 2006, 267). The decisive question was whether the document at issue, when objectively interpreted in its context, could have been understood by its addressees as a final, i.e. not merely preliminary, and binding determination of substantive or procedural issues by the competent organ of the EPO.

In **T 222/85** (OJ 1988, 128) the board noted that the contents of a "communication" never constituted a "decision". This distinction was important, because only a "decision" could be the subject of an appeal - see Art. 106(1) EPC 1973. In the case at issue the communication only represented a preliminary view, on an ex parte basis, and was not binding upon the department of the EPO which sent it. In contrast, the contents of a "decision" were always final and binding in relation to the department of the EPO which issued it, and could only be challenged by way of appeal.

In **T 999/93** a notification of the decision of the Examining Division in writing was never prepared; the annex to the minutes of the oral proceedings - although containing reasons - could not validly fulfil the function of a decision in writing since it did not bear any name or signature. It was not possible to see from it that it was made by the examiners who were appointed to the particular examining division responsible for the oral proceedings. If a decision of a particular division is to be legally valid, it must have been written on behalf of and represent the views of the members who were appointed to that division to decide the issues forming the subject of the decision, and it must bear signatures which indicate this (see **T 390/86**, OJ 1989, 30).

In **J 14/07** the board held that the communication refusing the request for reimbursement of 50% of the examination fee constituted a decision within the meaning of Art. 106(1) EPC 1973, even though it was not signed since the formalities officer was competent to decide on the request for reimbursement of the fee (R. 9(2) EPC 1973 in conjunction with the Notice from the Vice-President of Directorate-General 2 of the European Patent Office dated 28 April 1999 concerning the entrustment to non examining staff of certain duties normally the responsibility of the examining or opposition divisions, OJ 1999, 504). See now Decision of the President of the European Patent Office date 12 December 2013 (OJ 2014, A6). See also in this chapter III.K.4.5.3 a).

#### 4.1.3 Communication under Rule 111(2) EPC

Under R. 111 EPC (formerly R. 68 EPC 1973), decisions of the EPO which are open to appeal shall be accompanied by a written communication of the possibility of appeal. The Rule explicitly states that the parties may not invoke the omission of the communication. According to **T 42/84** (OJ 1988, 251), this applies equally to the omission of the text of the articles alone. The failure of the Office to enclose the text of Arts. 106 to 108 EPC with the decision thus neither invalidated the decision nor did it constitute a substantial procedural violation. See also **T 231/99** and **T 493/08**.

#### 4.1.4 Department of first instance issues more than one decision

In **T 830/03** the opposition division had issued a second written decision intended to supersede a first written decision already sent. The board noted that the need for legal certainty required a presumption of validity in favour of a written decision which was notified to the parties by an opposition division in accordance with the formal requirements of the EPC 1973, in particular R. 68 to R. 70 EPC 1973 (now R. 111 to 113 EPC). Once the decision was pronounced and the (first) written decision, in the case at issue, notified to the parties, the opposition division was bound by it even if it considered its decision not to "have any legal effect" (see **T 371/92**, OJ 1995, 324). The decision could be set aside only by the second instance on the condition that an allowable appeal was filed under Art. 106 EPC 1973. With the filing of the first notice of appeal, the power to deal with the issues involved in this case passed from the department of first instance to the appeal instance (devolutive effect of the appeal). All actions carried out by the opposition division after the notification of the (first) decision, and a fortiori after the filing of the first appeal, were ultra vires and thus had no legal effect.

In **T 1257/08** the board, referring to **T 830/03** stated that under the presumption of legal validity, the first written decision notified constitute the opposition division's only legally valid written decision. The opposition division was bound by it and could not itself set it aside. Furthermore, only the first written decision as legally valid decision was appealable.

It is disproportionate to impose on the appellant the filing of two statements of grounds of appeal as a precaution (**T 993/06** following **T 116/90**).

The board in **T 1093/05** (OJ 2008, 430) pointed out that it is established board of appeal and Enlarged Board of Appeal case law that an examining division is bound by its final decision on an application, which can be set aside only following an admissible, allowable appeal (see **G 12/91**, OJ 1994, 285; **G 4/91**, OJ 1993, 707; **T 371/92**, OJ 1995, 324; **T 1081/02**; **T 830/03**). In view of this established case law, the board could not subscribe to the view expressed in **T 971/06** that an erroneous decision is a nullity and therefore no appeal needs to be filed against it. (NB Only one decision was issued in **T 971/06**).

#### 4.1.5 Inconsistency between oral and written decisions

An inconsistency between the oral decision announced at the oral proceedings and the written decision is in breach of R. 111 EPC (formerly R. 68(1) EPC 1973) and is hence a substantial procedural violation (see e.g. **T 666/90**). In this decision the opposition division had indicated in oral proceedings that it would maintain the patent as amended on submission of new claims (which were submitted by the deadline set) but in its written decision revoked the patent. Similarly, in **T 425/97** the sole ground of appeal was the inconsistency existing between the written decision and the form of the patent held to be patentable by the opposition division at the oral proceedings. The substantive deviation amounted to a procedural violation. See also **T 318/01**, **T 1590/06** and **T 1698/06**.

In examination proceedings, where the decision to grant the patent referred to the documents approved by the applicant under R. 51(4) EPC 1973 (now R. 71(3) EPC) these documents became an integral part of that decision (see **T 850/95**, OJ 1997, 152). In **T 740/00** the board found by analogy, that in opposition proceedings the documents referred to in the decision to maintain the patent in amended form also formed an integral part of that decision. Differences between the decision pronounced at the oral proceedings and the written decision were not mistakes which could be corrected under R. 89 EPC 1973, but amounted to a substantial procedural violation requiring immediate remittal of the case to the department of first instance.

### 4.2. Reasons for the decision

#### 4.2.1 Legal requirement for reasoned decisions under Rule 111(2) EPC

R. 111(2) EPC (formerly R. 68(2) EPC 1973) embodies the general principle of law that appealable decisions must be reasoned and states: "Decisions of the European Patent Office which are open to appeal shall be reasoned".

The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a department of first instance (see inter alia **T 34/90**, OJ 1992, 454 and **G 9/91**, OJ 1993, 408). A reasoned decision issued by the first instance department meeting the requirements of R. 111 EPC is accordingly also a prerequisite for the examination of the appeal (**T 1182/05**).

The reasoning given in a decision open to appeal has to enable the appellants and the board of appeal to examine whether the decision was justified or not. A decision therefore should discuss the facts, evidence and arguments which are essential to the decision in detail. It has to contain the logical chain of reasoning which led to the relevant conclusion (**T 292/90** on inventive step; confirmed in many decisions, e.g. **T 951/92**, **T 740/93**, **T 698/94**, **T 278/00** (OJ 2003, 546); **T 70/02**, **T 963/02**, **T 897/03**, **T 763/04**, **T 316/05**, **T 1366/05**, **T 1612/07**, **T 1870/07**, **T 1997/08** and **T 2366/11**).

The decision has expressly to set out the logical chain of argument upon which the conclusion and therefore the final verdict were based, in respect of each and every ground that was pleaded and substantiated (**T 698/94**). It is the consistent case law of

the boards of appeal (see e.g. **T 740/93**) that a "reasoned" decision should deal with all important issues of dispute. See also **T 1709/06**. The grounds upon which the decision was based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision (see e.g. **T 278/00** (OJ 2003, 546) and **T 1182/05**).

Under Art. 113(1) EPC, EPO decisions had to show that the parties' fundamental arguments had been addressed (**T 2352/13**). According to **T 246/08**: "In brief, a decision must show that all potentially refutative arguments adduced by a party are actually refutable." Merely repeating the parties' submissions was not enough; rather, it had to be clear from the reasons that their core arguments had been addressed in substance in arriving at the decision. In particular, final decisions had to take account of comments received in response to EPO communications (see **T 1997/08**). The board held that the right to be heard had been infringed.

The principle enshrined in R. 68(2) EPC 1973 (now R. 111(2) EPC) ensured a fair procedure between the EPO and parties to proceedings, and the EPO could only properly issue a decision against a party if the grounds on which it was based had been adequately reasoned (**T 652/97**). In **T 1123/04** the board noted that the criteria for the "reasoned decision" under R. 68(2) EPC 1973 are elaborated in the Guidelines (currently Guidelines E-IX, 5 – November 2014 version): the requirement in R. 68(2) EPC 1973 for a "reasoned decision" was not only motivated by the basic legal principle that a party should be informed of the detailed grounds of a negative decision, but that such reasoning and grounds should be comprehensible to those conducting a later judicial review (R. 68(2) EPC 1973: "Decisions ...which are open to appeal"). It should not be necessary for a board of appeal to have to reconstruct or even speculate as to the possible reasons for a negative decision in the first instance proceedings. In principle, a decision referred to in R. 68(2) EPC 1973 should be complete and self-contained.

In **J 20/99** the board noted that all EPO departments should, if quoting a decision of the boards of appeal or any other legal authority, identify that authority and place the cited passage(s) in quotation marks, not merely cite verbatim without attribution.

#### 4.2.2 Examples of compliance with the requirements of Rule 111(2) EPC (former Rule 68(2) EPC 1973)

##### a) Incomplete and deficient reasoning

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. This did not contravene R. 68(2) EPC 1973; it was sufficient for a decision to be reasoned in some way, even if the reasoning was incomplete and deficient. Following **T 856/91**, the board in **T 1231/03** found that the material defects in the opposition division's decision which the appellant had cited (incoherent line of argument, inaccurate formulation of the technical problem and allegedly erroneous assessments) could not constitute a breach



of R. 68(2) EPC 1973. In **T 1747/06** the board distinguished the case before it from that in **T 856/91** (see in this chapter III.K.4.2.3 b)).

See in this chapter III.K.4.2.3 a) for examples of cases where incomplete reasoning was nonetheless found sufficient within the meaning of R. 111(2) EPC.

b) Reasons not well-founded

In **T 647/93** (OJ 1995, 132) the board observed that the reasons for the refusal of the application in the examining division's decision were somewhat enigmatic and there was no basis for them in the EPC 1973. However, even if the reasons for the decision were not well founded, this did not mean that the decision was not reasoned at all within the meaning of R. 68(2) EPC 1973.

c) Findings to obviate remittal

In **T 473/98** (OJ 2001, 231) the board held that it is entirely appropriate and desirable in the interests of overall procedural efficiency and effectiveness that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC 1973 employing the standard decision formula, by way of obiter dicta, findings which could obviate remittal in the event of the revocation being reversed on appeal.

#### 4.2.3 Examples of non-compliance with the requirements of Rule 111(2) EPC (former Rule 68(2) EPC 1973)

a) Incomplete and deficient reasoning

A decision is not reasoned within the meaning of R. 111(2), first sentence, EPC if it is not unambiguously clear from it (possibly after consulting other parts of the file) which request(s) – including any items such as claims, description pages and drawings – it is based on (**T 405/12**).

In **T 278/00** (OJ 2003, 546) the board held that the reasoning of a decision under appeal must be taken as it stands. The requirements of R. 68(2) EPC 1973 could not be construed in such a way that, in spite of the presence of unintelligible and therefore deficient reasoning, it was up to the board or the appellant to speculate as to what might be the intended meaning of it. The board had to be in a position to assess on the basis of the reasoning given in the decision under appeal whether the conclusion drawn by the first instance was justified or not. That requirement was not satisfied when the board was unable to decide which of the various inconsistent findings indicated in and justifying the decision under appeal were correct and which were false (see also **T 316/05**).

In **T 70/02** the board found that simply stating "no convincing arguments have been found in your letter" in response to letters in which the objections put forward were exhaustively discussed by the applicant, did not comply with R. 68(2) EPC 1973. Whilst reasoning did not mean that all the arguments submitted should be dealt with in detail, it was a general principle of good faith and fair proceedings that reasoned decisions

should contain at least some reasoning on crucial points of dispute, in order to give the party concerned a fair idea of why its submissions were not considered convincing and to enable it to base its grounds of appeal on relevant issues.

The mere summary of a party's submissions does not constitute sufficient reasoning (**T 1366/05** and **T 534/08**). In the latter case it was not clear from the wording of the contested written decision why the opposition division had come to its conclusion, whether or not the opposition division had adopted the respondent's arguments entirely, or whether or not it had had its own objections.

In **T 1929/12** the board ruled that remittal was not appropriate, despite deficiencies in the reasons for the decision. See Chapter IV.E.7 "Remittal to the department of first instance".

b) No explanation given for decision reached

In **T 493/88** (OJ 1991, 380) the board held that a decision of an opposition division rejecting an opposition had not been correctly reasoned within the meaning of R. 68(2), first sentence, EPC 1973 if, after giving the reasons why the opposition division, unlike the opponent, considered the subject-matter of the patent to be new, it failed to state the reasons why it considered that the subject-matter also involved an inventive step.

Where there was no explanation of how the examining division had arrived at its conclusion that the claimed process was an obvious juxtaposition of certain documents, this was held insufficient **T 292/90**).

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 698/94** neither the minutes of the oral proceedings before the opposition division nor the appealed decision itself contained the slightest hint at the arguments brought forward by the parties. It was impossible for the parties to the proceedings to see how the opposition division had arrived at its conclusion of lack of novelty. The losing party was deprived of its legitimate right to challenge the reasoning on which the decision was based, which was the very purpose of proceedings before the boards of appeal (see **G 9/91**, OJ 1993, 408).

See also **T 135/96**, **T 652/97**.

In **T 1747/06** the board distinguished the situation before it from that in **T 856/91**, where the board had held that an incomplete decision did not constitute a breach of R. 68(2) EPC 1973 since it was sufficient for a decision to be reasoned in some way, even if the reasoning was incomplete and deficient. According to the board in **T 1747/06**, **T 856/91** dealt with the specific question of whether or not references in the reasoning of

the decision to the knowledge of recognised experts and to a statement of a recognised expert in the context of what a person skilled in the art could derive from a specifically cited prior art document, without it being clear who these experts were or what exactly the statement was, resulted in the decision being not reasoned. The board concluded that the decision was reasoned even if the reasoning was incomplete and deficient. In the case at issue in **T 1747/06**, however, no reasoning was given at all (see also in this chapter III.K.4.2.2 a) above).

In **T 1724/10** the board held that the juxtaposition of seemingly contradictory conclusions (e.g. acknowledgement of technical differences but no possibility to define a technical problem), presented in the contested decision as apodictically evident and without any factual support, does not constitute a "reasoned decision" within the meaning of R. 111(2) EPC.

c) References to communications

See also below Chapter III.K.4.3 "Decisions according to the state of the file".

In **T 897/03** the board held that a decision that leaves it to the appeal board and the appellant to speculate as to which of the reasons given by the examining division in different communications might have been decisive for the refusal of the application, could not be considered to meet the requirements of R. 68(2) EPC 1973 (see also **T 652/97** and **T 278/00**, OJ 2003, 546).

In **T 963/02** the board stated that if a decision was merely reasoned by a reference to a preceding communication, the requirement of R. 68(2), first sentence, EPC 1973 was only met if the communication referred to itself fulfilled the conditions defined in **T 897/03** and **T 278/00** above.

In **T 177/15** the decision under appeal solely referred to reasons given in two communications issued in the course of the examination of the application, each dealing with a different set of claims. Hence the board had to examine both communications for facts, evidence and arguments that may have justified the refusal of the application. This was deemed to be at odds with the principle that, for a decision to be reasoned (R. 111(2) EPC), it must be self-contained, i.e. it must include all and each of the facts, evidence and arguments that are essential to the decision and the chain of reasoning in the decision must be complete.

In **T 353/11** the decision under appeal referred solely to a communication annexed to a summons to attend oral proceedings. The communication did no more than to identify the closest prior art and the distinguishing feature of the invention, indicate that it was "not clear" whether the examples of the application illustrated the distinguishing feature of the invention, state it would be examined whether or not the process was inventive, and invite the appellant to file a comparative example. It neither gave an explicit conclusion with respect to inventive step, nor any reasons as to why the claimed process was not inventive. Thus, the examining division did not issue a reasoned decision within the meaning of R. 111(2) EPC.

d) Reference to decision of board of appeal

In **T 227/95** the contested decision contained no reasons on the merits of the case but merely stated: "for the reasons it is referred to the decision of the board of appeal dated 24.01.94" (meaning **T 527/92**). However, **T 527/92** contained no such reasons, since the case was remitted to the opposition division for further prosecution. The requirements of R. 68(2) EPC 1973 were not met.

In **T 1205/12** and **T 1206/12**, which are worded identically, the board held that a mere reference to jurisprudence of the boards of appeal did not, by itself, constitute or replace an argument in a first instance decision. If a deciding body, in a decision, wanted to rely on an argument put forward in a decision of the boards, be it part of its ratio decidendi or an obiter dictum, it was insufficient merely to refer to it or to cite it. The deciding body also had to make clear that it adopted the argument and explain why, in what respect and to what extent this argument applied to the case at hand.

e) References to unrelated issues

In **T 615/95** the board held that an examining division's decision should not be supplemented normally by annexes dealing with issues having no relation to the issues dealt with in the reasons for this decision.

f) Assessment of inventive step without assessing the prior art

In **T 87/08** the board pointed out that Art. 56 EPC required that the assessment of inventive step be made "having regard to the state of the art". Accordingly, a decision was not sufficiently reasoned in the sense of R. 68(2) EPC 1973 (R. 111(2) EPC) if the chain of reasoning to justify the finding of lack of inventive step merely stated that a purported effect had not been achieved, i.e. this technical problem had not been solved, without reformulating the problem in a less ambitious way and without assessing the obviousness of the claimed solution to that reformulated problem in the light of the cited prior art.

In **T 2375/10** the board found that since the requirement of inventive step under Art. 56 EPC had to be assessed in the light of the prior art, the decision of the examining division to conclude that there was a lack of inventive step without referring to the prior art was insufficiently reasoned within the meaning of R. 111(2) EPC. See also **T 306/09**.

g) Identical decision after remittal for further prosecution

In **T 740/93** the case had been sent back to the department of first instance because of a procedural violation (incorrect composition of the opposition division). Because of the remittal with the order for further prosecution of the opposition, the first decision became nothing more than a communication and the first statement of grounds of appeal therefore had to be considered as a response to this communication. The new opposition division rendered a decision which was nearly identical to the first one. Although the decision under appeal contained a reasoning as to why the subject-matter of the patent

in suit was considered to lack an inventive step and referred to points of dispute raised in the proceedings up to the first decision, it did not contain any direct reference to the important issues of dispute raised in the first statement of grounds of appeal and failed to comment upon the other issues of dispute. It thus did not meet the requirements of R. 68(2) EPC 1973.

### 4.3. Decisions according to the state of the file

#### 4.3.1 Request for decision 'on the file as it stands'

Applicants may request a decision "on the file as it stands" or "according to the state of the file", e.g. when all arguments have been sufficiently put forward in the proceedings and the applicant is interested in a speedy appealable decision. In such a case, the decision will be of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such a decision (see Guidelines E-IX, 4.4 – November 2015 version). See also in this chapter III.K.4.2.3 c).

#### 4.3.2 Decisions 'on the file as it stands' to be reasoned

No provision of the Guidelines can override an article or rule of the EPC 1973, such as R. 68(2) EPC 1973, now R. 111(2) EPC (**T 861/02**). It is therefore well-established that, notwithstanding the provisions of the Guidelines, decisions open to appeal must still be reasoned. The standard form provided for by the Guidelines is entirely appropriate in the special case where the examining division fully expressed and reasoned its objections to the application text in preceding communications (**T 1182/05**). It may be used to issue a decision only if all the arguments put forward have already been sufficiently addressed in one or more preceding communications and no new objections have been raised since those communications were transmitted (**T 1093/13**, **T 2364/09**). However, a standard decision form for issuing a decision "on the state of the file" which refers to several communications, leaving it up to the board of appeal to construct the applicable reasons by "mosaicing" various arguments from the file, or, which leaves it in doubt which arguments apply to which claim version, does not meet the "reasoned" requirement of R. 68(2) EPC 1973 (now R. 111(2) EPC). See, for example, **T 278/00** (OJ 2003, 546), **T 861/02**, **T 897/03**, **T 276/04**, **T 1182/05**, **T 1309/05**, **T 1356/05**, **T 1360/05**, **T 1709/06**, **T 952/07**, **T 1612/07**, **T 1442/09**, **T 177/15** and **T 180/10**. These requirements obviously aim at allowing the losing party to understand the reasons for the negative decision taken against it so that it can envisage the filing of an appeal. The same is true for the board of appeal, which has to understand why the department of first instance took the impugned decision (**T 952/07**).

In **T 180/10**, contrary to what was stated in the second communication ("the applicant's explanations ... have been carefully considered"), it was apparent that the examining division had ignored all the appellant's arguments since this communication and, therefore, the decision were silent on them. The requirements of R. 68(2) EPC 1973 were not fulfilled.

The Guidelines (C-V, 15.2 - November 2015 version) explain that, in order to comply with the requirement that a decision on the state of the file be reasoned (R. 111(2) EPC), use of a standard form referring to the previous communication is only possible where the previous communication properly identifies the application documents on file and is well-reasoned and complete with respect to the grounds and the reasons for the refusal of the current request.

#### 4.3.3 No waiver of right to a reasoned decision

A request for a decision on the state of the file thus cannot be construed as a waiver of the right to a fully reasoned first instance decision, even in the light of the suggested procedure in the Guidelines (**T 265/03**, **T 583/04**, **T 1182/05**, **T 1356/05**, **T 1360/05**, **T 1309/05** and **T 750/06**). The duty to provide reasons in administrative decisions is a fundamental principle in all contracting States, R. 68(2) EPC 1973 being simply an expression of this principle. Further, from the point of view of the practical functioning of the system envisaged in the EPC, absent a reasoned decision within the meaning of this rule the board could not examine the appeal (Art. 110 EPC) (**T 265/03**, **T 1356/05** and **T 1360/05**, following **T 278/00**).

#### 4.3.4 Documents comprising 'state of the file'

The "state of the file" is not restricted to those documents on file which were issued by the EPO, but also includes all those documents and arguments which were filed by the applicant prior to (or even simultaneously with) his request for a decision "on the status of the file" (**T 265/03**). It does not include the note of a telephone conversation (**T 583/04**). This was the summary record of a conversation not a communication pursuant to Art. 96(2) EPC 1973. Whereas the phone call note is a record of a dialogue, a communication constitutes a unilateral legal notice to a party. The two documents serve quite different purposes. This does not exclude the possibility of the statements made orally by phone being confirmed and adopted in a formal communication from the examining division inviting observations with a term set for reply. See also **T 750/06**.

### 4.4. Right to have comments considered

The right to be heard under Art. 113(1) EPC is not just a right to present comments but also to have those comments **duly considered** (see, e.g. **J 7/82**, OJ 1982, 391; **T 508/01**, **T 763/04**, **T 1123/04** and **T 246/08**).

The comments presented must be considered in the ensuing decision (**J 7/82**, OJ 1982, 391 and **T 246/08**). A decision must show that all potentially refutative arguments adduced by a party are actually refutable. Failure to take into due account a potentially refutative argument of the applicant when deciding the case deprived the applicant of its right to be heard in contravention of Art. 113(1) EPC and amounted to a substantial procedural violation (**T 246/08**).

On inadequate reasons given in the decision at first instance, and the circumstances in which reimbursement of the appeal fee is justified, see Chapter IV.E.8.4.4.

## 4.5. Signatures on a decision

### 4.5.1 Decisions to be signed

In **T 390/86** (OJ 1989, 30) the board noted that although R. 70 EPC 1973 (now R. 113 EPC) states that "any communication from the EPO is to be signed by and to state the name of the employee responsible", there was nothing in R. 68 EPC 1973 (now R. 111 EPC) or elsewhere in the EPC which specifically required the decision of a first-instance department of the EPO (i.e. one open to appeal) to be signed by the employee(s) responsible. The board held that if the decision of a particular division was to be legally valid it had to bear the signatures of the members who had been appointed to that division to decide the issue. (See also e.g. **T 999/93**).

### 4.5.2 Examples of invalid signatures

#### a) When decision is announced in oral proceedings

The written reasons for a decision delivered during oral proceedings can only be signed by members of the deciding body who took part in the oral proceedings. The same principle applies if between the orally delivered decision and the written decision proceedings in accordance with R. 58(4) EPC (R. 82(1) EPC) have taken place (**T 390/86**, OJ 1989, 30). The board went on to say that in a case where a final substantive decision has been given orally by an opposition division during oral proceedings, if the subsequent written decision giving the reasons for such oral substantive decision is signed by persons who did not constitute the opposition division during the oral proceedings, the decision is invalid.

A decision signed by two members who had taken part in the oral proceedings and by one who had not was held null and void in **T 243/87**. The board ordered remittal to the department of first instance, and a refund of the appeal fee because a substantial procedural violation had occurred.

#### b) Director's signature in place of examiner's signature

A director's signature purporting to be on behalf of the second examiner was invalid because nothing in the EPC 1973 authorised a director to sign on behalf of a member of an examining division to which he did not himself belong (**T 211/05**).

### 4.5.3 Examples of valid signatures

#### a) Computer-generated communications

In **T 225/96**, the board noted that the forms accompanying the decisions are never signed, because they are computer-generated and therefore, under R. 70(2) EPC 1973 (now R. 113(2) EPC), a seal may replace the signature.

In **J 14/07** the communication refusing the request for reimbursement of 50% of the examination fee constituted a decision within the meaning of Art. 106(1) EPC 1973, even though it was not signed (see in this chapter III.K.4.1.2). The mere indication of the name of the formalities officer without any signature, but which had been replaced by a seal, complied with the requirements of the then current R. 70(2) EPC 1973 because the communication was produced using a computer.

b) Death of examiner between oral proceedings and written decision

In **T 1170/05** one of the examiners had died and so the decision of the first instance bore the signatures of only two of the three members of the division, the chairman signing on behalf of the deceased examiner. The chairman explicitly declared in a note that the written grounds reflected those which had been discussed during the deliberation of the examining division, and which had led to the decision announced at the end of the oral proceedings. This was held to comply with the case law of the boards of appeal, in particular, **T 243/87** (see in this chapter III.K.4.5.2); the decision was valid.

c) Decision in written proceedings

In the contested first-instance decision in **T 777/97**, only two of the members of the division had signed the decision, one purporting to sign on behalf of the absent chairman. According to the board, decisions **T 390/86** and **T 243/87** (see in this chapter III.K.4.5.2(a)) were not directly applicable, because those two cases had been concerned with the decision making departments' composition during the oral proceedings at which they had announced their respective decisions, since the subsequent written decisions giving the reasons for those oral decisions had to be signed by the same department members. The case now in hand, by contrast, concerned a decision taken in a written procedure on the basis of the evidence on file. It went without saying that only those members who had taken the decision could decide on a request for its correction. The decision had to be considered open to appeal.

d) Illegible signature

In **D 8/82** (OJ 1983, 378) the surname of the signature appeared only as a mark in which one could still discern the first letter and which was recognisably intended as a signature. The board held that it was valid since in several contracting states of the EPO there is no requirement that a signature be legible or recognisably composed of letters. It is enough that it serves to identify the signatory.

e) Draft decisions

In **T 225/96**, the contested decision had been signed by only the first examiner on the opposition division. The board sent the case back for regularisation, but the division replied that the three non-signing members were not prepared to put their names to a text issued without their knowledge or approval. The board concluded that the document sent to the parties was merely a draft. This amounted to a substantial procedural violation. Had the signatures merely been missing, this could have been corrected under



R. 89 EPC 1973 (now R. 140 EPC) which allows correction of linguistic errors, errors of transcription and obvious mistakes in EPO decisions. In general, the decision as notified to the parties is presumed to be authentic. See also **T 837/01**.

## 5. Principles for the exercise of discretion

The EPO can only exercise discretion if the power to do so can be derived from the EPC (**J 4/87** and **J 20/87**, OJ 1989, 67). Discretion-related issues are discussed in numerous other chapters under the relevant provisions: see e.g. Chapter IV.B.2.6.1 for the examining division's discretion under R. 137(3) EPC, Chapter IV.C.1.3.3 for the opposition division's discretion over late-filed submissions, Chapter IV.E.3.6 for review of first-instance discretionary decisions, Chapter IV.E.7.6 for discretion over remittal, Chapter IV.C.1.3.3 for the boards' discretion over late-filed submissions, and Chapter IV.E.4.4.5 for discretion over claim amendments in appeal proceedings.

Thus, in the event of an unforeseeable postal delay causing non-compliance with a time limit, where R. 85(2) EPC 1973 (relating to general interruption or subsequent dislocation in the delivery of mail in a Contracting State) was not applicable so as to extend the time limit, the EPO had no discretion to extend it (**J 4/87**). Similarly, there was no support anywhere for the idea that the EPO was entitled to exercise any general discretion based on equity in respect of refunding the fee for the European search report (**J 20/87**, OJ 1989, 67).

When a decision hinges upon the exercise of discretion the reasons should be given. Such reasons should take into account those factors which are legally relevant to the issue in question, and should not simply consider whether the facts of the case are exactly the same as in a previously decided case. Such factors are determined by considering the purpose of the exercise of the discretion in its context, and in the context of the EPC as a whole, e.g. the balancing of the EPO's interest in a speedy completion of the proceedings against the applicant's interest in obtaining a patent which is legally valid in all the Contracting States (**T 182/88**, OJ 1990, 287; citing **T 183/89**). This has been followed in many decisions, see e.g. **T 951/97**, **T 749/02**, **T 497/03**, and **T 1837/07**.

In **G 7/93** (OJ 1994, 775) the Enlarged Board stated that if an examining division had exercised its discretion under R. 86(3) EPC 1973 (now R. 137 EPC) against an applicant in a particular case and the applicant filed an appeal against the way in which discretion had been exercised, it was not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, in order to decide whether or not it would have exercised its discretion in the same way as the department of first instance. If a department of first instance was required under the 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 department of first instance had exercised its discretion if it came to the conclusion either that the department had not exercised its discretion in accordance with the proper principles, or that it had done so in

an unreasonable way, and had thus exceeded the proper limits of its discretion (see also **T 640/91**, OJ 1994, 918).

In **T 109/08** the board held that a board of appeal, when reviewing the opposition division's exercise of discretion under Art. 114(2) EPC, has the power to overrule a decision if the board concludes that the opposition division based its decision on manifestly incorrect technical assumptions or on an erroneous approach to applying said ground of opposition since this amounts to a misuse of the discretionary power under Art. 114(2) EPC.

## L. Correction of errors in decisions

1.	General issues	763
1.1.	Retrospective effect of corrections	764
1.2.	Correction requests as opposed to appeals	764
2.	Errors in the printed version of the European patent specification	765
3.	Competence to correct a decision under Rule 140 EPC (former Rule 89 EPC 1973)	766
4.	Procedural status of third parties	767

### 1. General issues

R. 140 EPC (formerly R. 89 EPC 1973) states that, in EPO decisions, only linguistic errors, errors of transcription and obvious mistakes may be corrected. It cannot be used to correct errors of substance, content or procedure. It does however cover both decisions of the boards and those of first-instance departments. The boards' previous case law, that it could be within the scope of R. 140 EPC (R. 89 EPC 1973) to correct the text of a patent if it was not, and obviously could not be, in the form intended by the decision-making department (classic examples of such rulings being **T 850/95**, OJ 1997, 152; **T 425/97**, **T 965/98**), was radically changed by **G 1/10**. The boards in **T 367/96** and **G 1/97** (OJ 2000, 322) had already held previously that R. 89 EPC 1973 had to be interpreted narrowly and, accordingly, only allowed for the correction of formal errors in the written text of the decision notified to the parties in accordance with R. 111 EPC (R. 68 EPC 1973). It did not, however, pave the way for re-examination of the factual or legal issues on which a decision was based, nor for reversal of any conclusion derived by the decision-making department from a consideration of these issues.

In **G 1/10** (OJ 2013, 194), however, the Enlarged Board went further, holding that, since R. 140 EPC is not available to correct the text of a patent, a patent proprietor's request for such a correction is inadmissible whenever made, including during opposition or limitation proceedings. The Enlarged Board's decision was limited to corrections of grant decisions, more precisely to corrections within grant decisions of the description, claims and drawings (patent documents), and not concerned with corrections of bibliographic data.

The Enlarged Board of Appeal pointed out that legal certainty and the prevention of adverse effects on third parties were the reasons for the narrow ambit of allowable corrections under R. 140 EPC (see **G 1/97**, travaux préparatoires). It agreed with the statement in **T 850/95** that patent documents referred to in a grant decision become an integral part of the decision, but did not agree with the subsequent conclusion that errors in those documents may subsequently be corrected under R. 140 EPC.

The Enlarged Board stated that the absence of a possibility to request patent corrections under R. 140 EPC should not prejudice patent proprietors. If a correction is obvious (as it should be to satisfy R. 140 EPC) then there will be no surprise or adverse effect on

opponents or others, because all concerned should read the patent as if corrected and an actual correction is unnecessary. If, however a correction is less than immediately obvious, it should not be allowed under R. 140 EPC anyway, which is confined to correction of "obvious mistakes". If, given the opportunity to check the patent text before approving it, an applicant does not draw any errors to the attention of the examining division and thus ensures that his approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be his alone, whether the error was made (or introduced) by him or by the examining division.

If however the examining division proceeds to make a decision to grant which contains an error subsequently made by it, so that the granted text is not that approved by the proprietor, then the proprietor is adversely affected by that decision and is entitled to appeal. A patent proprietor may seek to amend his patent during opposition or limitation proceedings and such an amendment could remove a perceived error, however, it would have to satisfy all the legal requirements for amendments including Art. 123 EPC.

In **T 212/88** (OJ 1992, 28) the board held that the absence of a chairman's or minute-writer's signature at the end of an opposition division's decision was a rectifiable, obvious error within the meaning of R. 89 EPC 1973 (now R. 140 EPC). In the case in question a second examiner had been referred to in the minutes as a member of the opposition division, although in fact he was not a member and did not take part in the oral proceedings (see also **T 212/97**).

### **1.1. Retrospective effect of corrections**

In **T 212/88** the board held that correction of errors had to be by means of a decision under R. 89 EPC 1973 (now R. 140 EPC) with retrospective effect from the date of the original decision. The same board emphasised the retrospective effect of corrections under R. 89 EPC 1973 in **T 116/90** but stated that it was unnecessary to re-date the decision as from the date of correction.

### **1.2. Correction requests as opposed to appeals**

In **T 425/97** the board referred to **G 8/95** (OJ 1996, 481), which dealt with the scope of R. 89 EPC 1973 (now R. 140 EPC), stating that the difference between an appeal against a decision and a request for correction of a decision might be seen in the fact that in the first case the remedy was directed against the substance of the decision and in the latter case against the form in which the decision was expressed. In another decision issued prior to **G 1/10**, the board in **T 1093/05** (OJ 2008, 430) similarly held that, if a grant decision was defective, the patent proprietor had to consider carefully the nature of the defect and how it could best be rectified. If it involved a substantial procedural violation, rectification was possible only on appeal. A request for correction under R. 89 EPC could succeed only if it was clear that the examining division had not intended to grant the patent in that form – and also in what form it had intended to grant it.

In **T 1869/12** the board stated that in case of procedural violations in the granting procedure, rectification is only possible via appeal against the decision to grant. A correction of the published European patent specification or of the decision to grant cannot be allowed when this specification corresponds to the true intention of the Examining Division when granting the patent

## **2. Errors in the printed version of the European patent specification**

In **T 150/89** some printing errors in the published patent specification were found which were not present in the version accepted by the EPO. The board found that such omissions should normally be corrected as a matter of routine. The decision to grant was legally binding as regards existence and scope of the patent (Art. 97 EPC 1973). The specification reproduced that decision (Art. 98 EPC 1973). It was an official document published by a public authority for general information, and as such had legal force before the courts. It was therefore subject to the same correction criteria as the grant decision itself under R. 89 EPC 1973 (now R. 140 EPC). Thus the specification was to be brought into line with the decision to grant, and whether this took the form of a reprint or a corrigendum (which was a matter for the department of first instance, or possibly its formalities officer, to decide) should clearly indicate the correction made.

In **T 55/00** the examining division had sent a "Communication under R. 51(4) EPC 1973" to the representative of the appellant. The enclosed documents contained only pages 1 to 40 of the description. The appeal was against the decision of the examining division to refuse the appellant's request for correction of errors under R. 89 EPC 1973 (now R. 140 EPC). He had requested the issue of a corrected patent specification. The board held that a correction under R. 89 EPC 1973 was not possible, because the non-inclusion of pages 41 to 44 of the description was due to the discretion of the examining division and not to any error. The board held that because the EPC 1973 did not provide for any possibility of amending or revoking a patent once granted - except as a result of an opposition procedure - and because patent proprietors were not allowed to file a notice of opposition against their own patent, it was very important also to check the content of the decision and documents.

In **T 1869/12** the appellant (applicant) lodged an appeal against the decision of the examining division refusing to correct the published European patent specification. It tried to achieve, via correction of the decision to grant, the patent to be comprising the set of claims proposed by the examining division with a communication under R. 71(3) EPC, however, with substantive amendments as subsequently proposed by the appellant. The board based its decision on **G 1/10** and also stated that the appellant's request could not be granted, since it was clear that the examining division intended - and maintained that intention - to grant the patent with its own proposed claims. While the procedure to grant was defective the board stated that the appellant should have filed an appeal against the decision to grant the patent.

### **3. Competence to correct a decision under Rule 140 EPC (former Rule 89 EPC 1973)**

The EPO makes corrections on request or of its own motion (**T 150/89**). In **G 8/95** (OJ 1996, 481) the Enlarged Board of Appeal decided that the competence to correct errors in a decision under R. 89 EPC 1973 (now R. 140 EPC) lay with the body which had given the decision. So in the examination procedure the examining division had to decide on a request to correct errors in the decision to grant. If the request for correction of the decision to grant concerned the grant of the patent, then the decision on the correction had also to concern the grant of the patent, since it was the request of the party which defined the subject of the dispute. The Enlarged Board also agreed with the statement made in **J 30/94** (OJ 1992, 516) that it was the decision to refuse the request for correction which was under appeal. According to the Enlarged Board, this did not alter the subject of the dispute before the second instance. The decisive criterion in Art. 21(3)(a) EPC 1973 was not that the decision under appeal was itself the decision to grant. It was sufficient for the decision to "concern" the grant, and this was necessarily the case if the subject of the decision was the text in which the patent was to be or had been granted, since this was the result of the substantive examination and defined the rights conferred by the patent. The Enlarged Board came to the conclusion that the decision refusing a request for correction of the decision to grant concerned the grant of the patent. It was, therefore, the technical boards – not the Legal Board of Appeal – which had to decide on appeals from a decision of an examining division refusing a request under R. 89 EPC 1973 for correction of the decision to grant.

In **T 867/96** the patentee had requested the correction under R. 89 EPC 1973 (now R. 140 EPC) of a sentence, in the reasons for a board of appeal decision, stating that all the parties had agreed that a certain document represented the closest prior art. The board pointed out that the case was closed, as *res judicata*, and therefore no longer before it. Citing in particular **G 8/95** (OJ 1996, 481) and **G 1/97** (OJ 2000, 322), the board held that only the board which had taken a decision could decide whether it required correction. Furthermore, establishing whether correction was necessary involved studying the facts, implying in general and up to a certain point that such requests were admissible. The current board thus ruled that the request for correction was admissible. However, it also held that this particular request did not fulfil the requirements of R. 89 EPC 1973, was unfounded and should therefore be refused.

In **T 212/97** the board pointed out that R. 89 EPC 1973 (now R. 140 EPC) permitted the opposition division to correct an obvious mistake in the copy of the decision notified to the parties. In the case at issue, a fourth person had been named as a member of the opposition division although no such person had been mentioned in the original document.

In **J 12/85** (OJ 1986, 155), the board held that a board of appeal could only examine appeals from decisions of other instances of the EPO (Art. 21(1) EPC). A decision on this request first had to be rendered by the examining division before the matter could be referred to the board of appeal. It also held that an applicant for a European patent could

only be "adversely affected" within the meaning of Art. 107 EPC by a decision to grant the patent if such a decision was inconsistent with what he had specifically requested.

In **J 16/99** the board held that when correction of the priority date of a granted patent is requested, there may be a case for correction under R. 89 EPC 1973 (now R. 140 EPC) of the EPO's decision to grant. The board found that R. 89 EPC 1973 was applicable since, being applicable to errors of transcription and obvious mistakes in a decision of the EPO, it allowed the correction of errors in, inter alia, decisions to grant, without the limiting requirement that proceedings be pending.

The board also found that the formalities officer who had taken the decision under appeal had no authority to take a decision under R. 89 EPC 1973. Such decisions had to be made by the examining division (see **G 8/95**, OJ 1996, 481), and were not one of the category of decisions which could be delegated to formalities officers (see the Notice of the Vice-President of DG 2 of the EPO, OJ 1984, 317, as revised by the further Notice, OJ 1989, 178 - the version applicable at the time of the decision under appeal - and again revised, with no effect on the point at issue here, by Notice in OJ 2014, A6).

In **T 226/02** the board considered that the opposition division had acted *ultra vires* in taking a decision under R. 89 EPC 1973 to correct a decision of the examining division. The board held that only the body which had taken a decision was entitled to correct it so as to put it in the form which it had intended it to take. Thus, only the examining division was entitled to correct its own decision. This finding was endorsed by the board in **T 1495/09**, which held that, in the case at issue, pursuant to R. 140 EPC, the opposition division in opposition proceedings had no competence to correct the decision taken by the examining division and would thus have acted *ultra vires* if it had corrected the grant decision. The same applied to the board of appeal in opposition-appeal proceedings (Art. 111(1), second sentence, EPC 1973).

#### **4. Procedural status of third parties**

In **T 1259/09**, in the course of the opposition proceedings, opponents had requested a correction of the decision to grant pursuant to R. 140 EPC. The opposition division forwarded this request to the examining division. In a communication the examining division informed the opposition division that no correction of the grant decision would take place. The opponents filed an appeal against this communication of the examining division. The dispute at issue was whether the appellants (opponents), by filing their request for correction, had initiated proceedings before the examining division which were separate from the ex parte examination proceedings with the consequence that they had become a party to the proceedings before the examining division. The board held that by filing a request for correction of the grant decision under R. 140 EPC a third party does not become a party to the examination proceedings.

## M. Inspection of files, European Patent Register and stay of proceedings

1.	Inspection of files	768
1.1.	General	768
1.2.	Exclusion from inspection under Rule 144 EPC	769
2.	European Patent Register	771
2.1.	General	771
2.2.	Registration of licences	771
2.3.	Transfer	772
3.	Stay of proceedings under Rule 14(1) EPC	773
3.1.	Rule 14(1) EPC	773
3.1.1	General	773
3.1.2	Opening of proceedings before a national court	774
3.2.	Rule 14(3) EPC	775

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### 1. Inspection of files

#### 1.1. General

Art. 128 EPC governs the inspection of European patent applications. Paragraphs 1, 2 and 5 regulate file inspection prior to publication of the application under Art. 93 EPC and are therefore exceptions, as an application must normally be kept secret until it is published. Thus file inspection may be granted under Art. 128(1) EPC if the applicant consents or under Art. 128(2) EPC if the applicant himself has invoked his rights under the application. Paragraphs 3 and 4 on the other hand regulate file inspection after the application has been published (see in this chapter III.M.1.2).

According to **J 5/81** (OJ 1982, 155), under Art. 128 EPC, the confidential treatment of patent applications ceases on publication of the application, not on expiry of the 18-month period mentioned in Art. 93(1) EPC. Any person who can prove that the applicant has invoked the rights under the European patent application against him may obtain inspection of the files **before the publication of the application** and without the consent of the applicant under Art. 128(2) EPC.

According to **J 14/91** (OJ 1993, 479), rights under a European patent application could be considered invoked under Art. 128(2) EPC where their invocation was formulated in relation to the first filing in a contracting state but the subsequent European application was mentioned at the same time. Any dispute between the applicant and a third party concerning the latter's right to inspect the files pursuant to Art. 128(2) EPC was best decided in oral proceedings convened at short notice.

In **J 27/87** the board confirmed the Receiving Section's decision to refuse a request pursuant to Art. 128(2) EPC, because there was no proof that the applicants had invoked their rights under the application against the appellants. The extracts from correspondence in which the applicants' representative asserted that his clients had



developed a new technology and mentioned the patent application were not deemed sufficient evidence.

In the case before the board in **T 1101/99**, a **formalities officer** acting for the opposition division rejected the request for inspection of the file. The board noted that the term 'granting of inspection' set out in the Notice of the Vice-President of DG 2 of the EPO concerning the entrustment to formalities officers of certain duties normally the responsibility of the opposition divisions of the EPO (dated 28.4.1999, OJ 1999, 504, point 13) apparently referred only to a positive decision, whereas in the decision under appeal the request for inspection was rejected. The board found that there was no justification for interpreting the delegation of duties beyond its actual wording such that it would also cover the rejection of requests for file inspection.

## 1.2. Exclusion from inspection under Rule 144 EPC

Under Art. 128(4) EPC, after publication of the European patent application, the files relating to it may be inspected on request, subject to the restrictions laid down in the Implementing Regulations. R. 144 EPC (previously R. 93 EPC 1973) indicates those parts of the file which are to be excluded from inspection pursuant to Art. 128(4) EPC. These include documents excluded from inspection by the President of the EPO (R. 144(d) EPC).

The President exercised this power to exclude documents in Art. 1(2) of her decision of 12 July 2007 (OJ SE 3/2007, 125), which provides that: "Documents or parts thereof ... (a) shall be excluded from file inspection at the reasoned request of a party or his representative if their inspection would be prejudicial to the legitimate personal or economic interests of natural or legal persons".

In **T 2522/10** the board summarised that the test for exclusion or non-exclusion is clear and straightforward – would the document in question serve the purpose of informing the public about the patent or patent application in issue? While the answer to that question will depend on the facts of each case, if the answer once ascertained is "yes", then there may be no exclusion and the matter need not be considered further. If the answer is "no", then consideration must be given to a further question, namely whether inspection would be prejudicial to the legitimate personal or economic interest of natural or legal persons.

Examples where file inspection would not have served the purpose of informing the public about the patent are to be found in the decisions **T 379/01**, **T 1401/05** and **J 23/10**. In each of these cases the material which was the subject of a request for exclusion from file inspection had no relevance to the subject matter of the patent (Decision of the President dated 12 July 2007, OJ SE 3/2007, 125).

In **T 379/01** the board stressed that the provisions concerning the exclusion of documents from file inspection stipulated exceptions from the principle of public inspection of files pursuant to Art. 128(4) EPC 1973, thus requiring a **narrow construction** of those provisions. The board concluded that a merely **abstract** prejudice

to hypothetical personal or economic interests was not a sufficient bar. The party requesting such exclusion should rather show that public access to certain documents would be prejudicial to specific and concrete personal or economic interests.

In **J 23/10** it could be gathered from the document in question that the applicant paid the renewal fees for certain applications for which they were not the registered applicant. These applications had been transferred to them but this had not been made public. It was still the assignor who was mentioned in the register. In the Board's view, this is information about internal relationships between the parties concerned, the publication of which could be prejudicial to their economic interests, while being irrelevant for the assessment of the patent application as such and therefore to be excluded from file inspection.

In **T 264/00** two internal documents, belonging respectively to the appellant and to the respondent and concerning the outcome of a confidential meeting between two of their employees, contained confidential information on the conception, manufacture and marketing of some of the respondent's products. The board held that the dissemination of this information might effectively be prejudicial to legitimate economic interests. Pursuant to R. 93(d) EPC 1973, therefore, the documents had not been made available to the public.

In **T 2254/08** the board decided that the inspection of documents that were marked confidential on filing but were publicly accessible on the internet was not prejudicial to the economic interests of the appellant (proprietor).

In **T 99/09** the document for which inspection had been requested contained precise technical details, particularly as to the source of the constituents of a medicinal product available on the market and certain specifications for the product's manufacture. Given the technical nature of the document, the board concluded that its disclosure might indeed be prejudicial to the appellant's economic interests. Since the respondents had not objected to or commented on the request to exclude the document from inspection, it was excluded under Art. 1(2)(a) of the EPO President's decision of 12 July 2007 (OJ SE 3/2007, 125) in the light of Art. 128(4) and R. 144(d) EPC.

In **T 1839/11** the board came to the conclusion that where a filed document contains information, some of which serves the purpose of informing the public about the patent but some of which does not, the filing of a version of the document in a form from which the latter information has been redacted may form the proper basis for an order excluding the unredacted document from file inspection under R. 144 EPC, the redacted version being open to file inspection.

Filed documents which, following a substantial procedural violation, were to be withdrawn from the part of the file available for public inspection and which did not fall under the exclusions listed in R. 93 EPC 1973 had to be returned to the filing party if it so requested (**T 811/90**). Similarly, documents marked "confidential" which did not belong to classes of documents to be excluded from file inspection were returned to the party concerned without note being taken of their contents (**T 516/89**, OJ 1992, 436; see also

the later decision of the President of the EPO, OJ 2001, 458). See also **T 760/89** (OJ 1994, 797) in Chapter III.G.3.4 "Return of filed evidence".

## **2. European Patent Register**

### **2.1. General**

Art. 127 and R. 143 EPC (previously R. 92 EPC 1973) govern entries in the European Patent Register. R. 143 EPC gives a list of items that are to be entered in the Register, additional entries required being specified in the EPO President's decision dated 15 July 2014 concerning the information given in the European Patent Register, which was adopted under R. 143(2) EPC. The Register shows the state of the proceedings and the legal status of patents rights. Entries are made in it until the end of the opposition period or of opposition proceedings, as appropriate.

According to **J 5/79** (OJ 1980, 71), no entries can be made in the Register prior to publication of the European patent application (Art. 127 EPC 1973 – unchanged in that respect).

An entry in the European Patent Register recording the withdrawal of a patent application fulfils the same function as a publication in the European Patent Bulletin in that it amounts to a notification to the public (**J 25/03**, OJ 2006, 395; see also **J 14/04** and **J 12/03**). The withdrawal of an application cannot be retracted once it has been published in the European Patent Register (**J 2/15**).

Under Art. 20 EPC in conjunction with the EPO President's decision dated 21 November 2013 concerning the responsibilities of the Legal Division (OJ 2013, 600), the Legal Division is usually responsible for decisions on entries and deletions in the European Patent Register (for exceptions – in cases where a request can be granted directly – see EPO President's decision dated 21 November 2013 concerning the entrustment to non-legally qualified staff of certain duties incumbent on the Legal Division, OJ 2013, 601). Appeals against such decisions are a matter for the Legal Board of Appeal, not the technical boards (Art. 106(1) and Art. 21(2) EPC). The entitlement of the proprietor entered in the Register cannot be questioned in either opposition or appeal proceedings (see **T 553/90**, OJ 1993, 666).

### **2.2. Registration of licences**

As to the recording in the Register of European Patents of an exclusive licence under a patent **already granted**, the Legal Board of Appeal ruled in its decisions **J 17/91** (OJ 1994, 225) and **J 19/91** that registration was no longer possible once the patent had been granted because the EPO had renounced jurisdiction in favour of the national offices of the contracting states designated in the request for grant.

### 2.3. Transfer

Art. 72 EPC provides that an assignment of a European patent application must be made in writing and requires the signatures of the parties to the contract. Under R. 22 EPC, a transfer of a European patent application is recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the EPO that the transfer has taken place. This is in line with the PCT system (R. 92bis.1 PCT).

In **J 12/00** the board summarised the preconditions for registering a transfer of a European patent application (now enshrined in R. 22 EPC) as follows: (i) a request of an interested party; (ii) the production of documents satisfying the EPO that the transfer has taken place; and (iii) the payment of an administrative fee. Documents relating merely to the obligation to transfer the right, but not to the transfer itself, were not sufficient to satisfy the EPO. Nor, according to the board, was it enough to cite registrations in different countries on the basis of documents other than assignment documents (similarly **J 4/10**).

In **T 128/10** the board held that the three requirements under R. 22 EPC in conjunction with R. 85 EPC, as formulated in **J 12/00**, did not need to be fulfilled at the same time. If they were met on different dates, the transfer would only have effect vis-à-vis the EPO at the date on which all the requirements mentioned above were fulfilled.

In **J 38/92** and **J 39/92** the Legal Board of Appeal ruled that a transfer could only be recorded in the European Patent Register on the basis of an official document in accordance with R. 20(1) EPC 1973 if that document **directly** verified the transfer (similarly **J 4/10**). It did not suffice if a judgment was submitted which mentioned another document from which it was possible to verify the transfer.

In appeal proceedings, assessing whether there are documents satisfying the EPO that a transfer has taken place in accordance with R. 20(1) and (3) EPC 1973 and recording the transfer in the Register is a matter for the department of first instance responsible for making the entry in the Register. Accordingly, in appeal proceedings, substitution of another party for the original applicant is possible only once the relevant department of first instance has made the entry or where there is clear-cut evidence of a transfer (**J 26/95**, OJ 1999, 668; see also **T 976/97**, **T 1751/07**).

A transfer can be recorded in the European Patent Register even after deemed withdrawal of a patent application, if it is still possible that restitutio is available and the successor in title has taken, together with his request for registering the transfer, procedural steps suitable for restoring the application (**J 10/93**, OJ 1997, 91).

In **J 17/12** the board held that the transfer of a European patent application may not be recorded in the European Patent Register at a time when proceedings for the grant of the application are stayed under R. 14(1) EPC. There is nothing to stop the filing, during the suspension of grant proceedings, of a request to transfer the application, but no action will be taken on the request during the suspension. While the fact of the transfer

may not be apparent from the register, it will be apparent from an inspection of the public file, as will the decision to stay the grant proceedings itself.

In **J 17/14** the board decided that the reversal of a completed transfer in the Register was not necessarily justified simply because doubts subsequently arose as to whether the claimed succession had been satisfactorily proven. There were cases where it might be more appropriate to stay the grant or opposition proceedings in favour of the party originally registered.

### 3. Stay of proceedings under Rule 14(1) EPC

#### 3.1. Rule 14(1) EPC

##### 3.1.1 General

Under R. 14(1) EPC (R. 13(1) EPC 1973) the EPO must stay the proceedings for grant ex officio if a third party provides it with evidence (under the EPC 1973, 'proof') that he has instituted proceedings against the applicant seeking a decision within the meaning of Art. 61(1) EPC (see **J 28/94**, OJ 1997, 400; **T 146/82**, OJ 1985, 267; **J 10/02**, **J 6/10**, **J 7/10**), unless the third party communicates to the EPO in writing his consent to the continuation of such proceedings. The patentee will not be heard but may file a request with the Legal Division not to suspend proceedings. An appeal may be filed against the Legal Division's decision adversely affecting the applicant, proprietor or third party respectively (**J 28/94**, OJ 1997, 400).

Decision **J 15/06** followed **J 28/94** (OJ 1997, 400). The communication ordering suspension was considered to be a preliminary procedural measure "sui generis" which was justified as a preventive measure to preserve the third party's possible rights to the patent in dispute and took immediate effect. The respondent's withdrawal of its request for suspension of the proceedings significantly changed the procedural situation in the appeal proceedings. However, the existence of a legitimate interest of a third party was an unwritten prerequisite for a further stay of the proceedings under R. 13 EPC 1973. The withdrawal was therefore equivalent to and to be interpreted as consent to the continuation of the proceedings pursuant to R. 13(1) EPC 1973. See also **J 18/06**.

The grant proceedings ended on the date on which the European Patent Bulletin mentioned the grant (Art. 97(4) EPC 1973). In the interim period, **proceedings for grant** were still **pending** before the EPO and a request for suspension of proceedings under R. 13 EPC 1973 was admissible (**J 7/96**, OJ 1999, 443). See also **J 33/95**, **J 36/97**, **J 15/06**, according to which the EPO can also order suspension pursuant to R. 13(1) EPC 1973 after the publication of the mention of the grant of a patent was acknowledged provided that an allowable request had been filed before the publication. Suspension of the proceedings for grant meant that the legal status quo existing at the time they were suspended was maintained, i.e. neither the EPO nor the parties might validly perform any legal acts while the proceedings were suspended (**J 38/92** and **J 39/92**).

In **J 20/05**, **G 1/09** and **J 9/12** the boards established that R. 14 EPC prevents the filing of a divisional application if the proceedings for grant concerning the earlier application are stayed. In **J 9/12** the board held that an application filed after the effective date of the stay of proceedings concerning the parent application, but before communication of stay, is to be treated as a divisional application.

In **J 10/02** the appellant argued that in the case where an appeal was lodged against a decision to suspend grant proceedings, the provision of R. 13 EPC 1973 appeared to be in conflict with the provisions of Art. 106(1) EPC 1973. The board, however, pointed out that the suspensive effect of an appeal served to provide an appellant with provisional legal protection in the sense that no action should be taken to implement the decision of the department of first instance in order not to deprive the appeal of its purpose. However, if the grant proceedings were continued and the appellant were to arrive at a definitive end to the grant proceedings in its favour, this would be more than the appellant could achieve if it succeeded with the appeal under consideration.

### 3.1.2 Opening of proceedings before a national court

According to **T 146/82** (OJ 1985, 267), suspension had to be ordered if satisfactory proof of the opening of relevant proceedings before a national court was given to the EPO by a third party, provided that the European patent application had not been withdrawn or was not deemed to have been withdrawn.

In **J 6/03** the legal board held that R. 13(1) EPC 1973 referred to proceedings which resulted directly, i.e. generally and automatically, in decisions mentioned in Art. 61(1) EPC 1973. The provision was therefore not applicable in respect of decisions of courts of third states (here, Canada).

According to **J 36/97** neither the jurisdiction of the national court whose decision was to be recognised nor the validity of such decision might be reviewed by the boards of appeal (see also **J 8/96** and **J 10/02**). When and how legally relevant civil proceedings were opened in a contracting state was likewise determined by national law (**J 7/00**).

In **J 9/06** the Legal Board pointed out that, according to **G 3/92** (OJ 1994, 607), only the courts of the contracting states have jurisdiction to decide claims to entitlement to the right to the grant of a European patent. It was not possible for the EPO, nor was it its function in the context of the examination of a request to suspend proceedings under R. 13 EPC 1973, to examine whether the subject-matter disclosed in a European patent application in respect of which suspension was requested corresponded to the disclosure of another application, ownership of which was disputed before a national court.

In **J 15/13** the board held that while it is established case law that the board is not allowed to examine the substance and merits of a national entitlement case, the board's power of examination cannot be limited to the mere check whether the claim submitted with the entitlement suit is directed to the transfer of the application but - to a certain extent - also allows and may even require a consideration of the grounds given in the

complaint of the entitlement suit. The board has to verify that the national proceedings are in accordance with R. 14(1) EPC, since to request a stay of the grant proceedings is a strong weapon which can be misused.

### **3.2. Rule 14(3) EPC**

Under R. 14(3) EPC (R. 13(3) EPC 1973), upon staying the proceedings for grant, the EPO may set a date on which it intends to resume the proceedings for grant, regardless of the stage reached in the national proceedings under R. 14(1) EPC. It is clear from the wording of R. 14(3) EPC that this is a discretionary decision (**J 33/03**).

When exercising its discretion under R. 13(3) EPC 1973, the board in **J 10/02** took into account the fact that the entitlement proceedings only concerned part of the invention and the duration of the suspension.

In parallel decisions **J 6/10** and **J 7/10** the legal board held that some aspects of the exercise of discretion under R. 14(3) EPC are (i) how long the proceedings before the national courts/authorities have been pending (with a period of more than four years held to be considerable both for grant proceedings to be stayed and for entitlement proceedings to be pending in first instance) (ii) the duration of the suspension of grant proceedings, and (iii) requests for suspension of grant proceedings filed at a late stage.

In **J 15/13** the board held that the filing of the request under R. 14(1) EPC at the last possible moment may only be taken as an argument for the resumption of the grant proceedings if such behaviour appears to be a misuse of the respondent's right to a stay of the grant proceedings.

In **J 13/12** the board decided in the light of **J 33/03** that, unlike the position under R. 14(1) EPC, R. 14(3) EPC gave the EPO discretion to decide whether proceedings were to be resumed. In exercising its discretion under R. 14(3) EPC, it had to weigh the interests of the applicant up against those of the third party which had brought a national action to determine rights against the applicant. The Guidelines for Examination, as internal administrative guidelines, could also be consulted; but they gave no indication that the national proceedings had to be finally closed, where applicable after exhaustion of all legal remedies, before a date for resuming the grant proceedings could be set, or at any rate before they could actually be resumed.

The board held in **T 146/82** (OJ 1985, 267) that if, in accordance with R. 13(3) EPC 1973, the EPO set a date on which it intended to continue the proceedings for the grant of the European patent, the date might be varied or the order staying the proceedings might be discharged at the subsequent request of the applicant or of the third party who applied for the order.

## N. Observations by third parties

1.	Introduction	776
2.	Formal requirements	777
2.1.	Language of the documents	777
2.2.	When can third-party observations be filed?	777
2.3.	Pending proceedings	777
2.4.	Anonymously filed observations	778
2.5.	Reasons for observations	779
3.	Third party's legal status	779
3.1.	General issues	779
3.2.	Third party's procedural rights	780
4.	Third-party observations in opposition proceedings	781
4.1.	Third-party observations and the scope of opposition	781
4.2.	Introducing a fresh ground for opposition in opposition proceedings	781
4.3.	Introducing a fresh ground for opposition in appeal proceedings	782
5.	Third-party observations filed at a late procedural stage	782
5.1.	Opposition proceedings	782
5.2.	Appeal proceedings	783
6.	Remittal following filing of observations	784

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### 1. Introduction

Under Art. 115 EPC, any third party may present, following publication of the European patent application, observations concerning the patentability of the invention to which the application or patent relates. There are no fees or deadlines for presenting such observations. The third party is not a party to the proceedings. R. 114(1) EPC requires that any such observations be filed in an official language of the EPO, while R. 114(2) EPC states that they will be communicated to the applicant or patent proprietor. Third-party observations are an integral part of the files and, as such, open to inspection under Art. 128 EPC. More information can be found in the Guidelines (see e.g. A-VII, 3.5, A-XI, 2.1, D-X, 4.5 and E-V, 3 – November 2015 version), the President's decision of 10 May 2011 and the Notice from the EPO dated 10 May 2011 concerning the filing of third-party observations (OJ 2011, 418).

Observations must be restricted to the substantive requirements of the EPC (see Art. 52 to 57 EPC). Most observations concern lack of novelty and/or lack of inventive step. In the proceedings for petition for review **R 18/11** third-party observations were filed. The Enlarged Board considered the observations to be inadmissible, because according to Art. 115 EPC such submissions had to concern patentability, and patentability issues could not be the subject of review proceedings.

Art. 115 EPC helps to ensure that no legally invalid patents are granted or maintained. The public must be able to rely as far as possible on the legal validity of a patent granted



by the EPO and the provision is designed to protect this public interest (**T 156/84**, OJ 1988, 372; **T 60/91**, OJ 1993, 551; **T 1495/09**).

## 2. Formal requirements

### 2.1. Language of the documents

Under R. 114(1) EPC, any observations by a third party must be filed **in writing** in an official language of the EPO, i.e. English, French or German; otherwise, they are deemed not to have been received. Observations not filed in an official language and so deemed not to have been received are nevertheless added to the file and so accessible to the public under Art. 128(4) EPC. Third-party observations will be communicated to the applicant or patent proprietor even if they have not been filed in one of the prescribed official languages (Art. 14(4), R. 114(1) EPC).

R. 114(1) EPC also explicitly provides for applicability of R. 3(3) EPC, which states that **documentary evidence** and, in particular, publications substantiating an argument may be filed in any language. The EPO may, however, require that a translation in one of its official languages be filed, within a period to be specified. If a translation is not filed in due time, the EPO may disregard the document in question.

### 2.2. When can third-party observations be filed?

Art. 115 EPC specifies that observations cannot be filed until after publication of the European patent application but sets no upper time limit for their presentation by persons wishing to make adverse observations concerning the patentability of inventions claimed in patent applications/patents. This means that observations can also be filed during opposition proceedings, even after expiry of the opposition period, and during appeal proceedings (**T 390/90**, **G 9/91**, OJ 1993, 408, **T 1756/11**). Art. 115 EPC explicitly covers all proceedings before the EPO and so applies, in principle, to revocation and limitation proceedings too.

### 2.3. Pending proceedings

The provision of Art. 115(1), second sentence, EPC that a third party shall not be "a party to proceedings before the European Patent Office" assumed that proceedings were pending before the EPO.

In **T 580/89** (OJ 1993, 218), observations submitted by a third party were not added to the file until after the decision had been taken and therefore not considered.

In **T 690/98** the question arose of whether observations filed by a third party could give rise to a reassessment by the Office of its own motion, under Art. 114(1) EPC 1973, of the patentability of the subject-matter of the contested patent, even if the appeal proved to be inadmissible. In the board's view, the answer was no, since the admissibility of an appeal, according to Art. 110(1) EPC 1973, was a prerequisite for examination of the appeal. The substance of the contested decision could only be examined when

admissibility was established. Therefore, objections by third parties lodged at the appeal stage were not to be examined by the Office of its own motion as there no appeal proceedings were pending.

#### **2.4. Anonymously filed observations**

The EPO President's decision and the EPO notice concerning the filing of third-party observations under Art. 115 EPC (OJ 2011, 418 and 420) allow unsigned third-party observations to be filed anonymously, but only at first instance.

In the *inter partes* proceedings **T 735/04**, document D6, a patent application by one of the patent proprietors, was cited in anonymous third party observations. Since D6 was highly relevant for the patentability of the claimed subject-matter and could cause the patent to be revoked, it was introduced into the proceedings.

In **T 146/07** anonymous third-party observations were received by the board at a very late stage. According to R. 114(1) EPC, any observations by a third party must be filed in writing. The board stated that this requirement implied that the observations have to be signed (see R. 50(3) and 86 EPC) in order to allow an identification of the third party. Identification is particularly important in the context of opposition proceedings in order to allow the competent organ of the EPO to verify whether the observations have indeed been filed by a third-party rather than by a party to the proceedings. Otherwise, a party might be tempted to submit late observations and/or documents by means of anonymous third party observations in order to avoid negative procedural consequences such as apportionment of costs. The board was aware that anonymously filed third-party observations might nevertheless be adopted by a party to the proceedings as its own or may even trigger objections by the competent organ of the EPO of its own motion (see above **T 735/04**). In the absence of such a further procedural act, anonymous third-party observations are to be disregarded altogether. This view is in line with the decisions **G 1/03** and **G 2/03** (OJ 2004, 413 and 448) in which the Enlarged Board of Appeal refused to take into account an anonymously filed third-party statement. In **T 1439/09** the board saw no need to depart from this line of reasoning. Therefore, the anonymous observations filed under Art. 115 EPC were deemed not to have been filed and were disregarded by the board.

In view of these decisions, the board in **T 1756/11** held that anonymous third-party observations made at a very late stage in the opposition appeal proceedings should not be given formal consideration in order to preclude hidden procedural abuse by the parties. Likewise in **T 1181/12** the board did not take into consideration third-party observations which were submitted anonymously during the appeal proceedings.

In **T 1336/09**, however, the board came to the conclusion that in this *ex parte* case the anonymous character of the third-party observations did not bar them from being admitted into the procedure. In respect of the anonymous character of the observations under Art. 115 EPC, the board noted that the Decision of the President of the EPO and a Notice from the EPO concerning the filing of third-party observations under Art. 115 EPC (OJ 2011, 418 and 420) allowed third-party observations to be filed without signature and

anonymously. The board stated that the above dispositions were in line with earlier decisions of the boards, which did admit such observations, without apparent misgivings in relation to their anonymous character (**T 735/04**, **T 258/05**). Unlike **T 146/07**, which had concerned an *inter partes* appeal, the case at hand here (**T 1336/09**) concerned *ex parte* proceedings, in which the appellant was the sole party and could raise new issues or submit new prior art at any time - as could the board of its own motion by virtue of Art. 114(1) EPC. Accordingly, the risk of anonymous third-party observations providing a cover for procedural abuse could largely be excluded.

## **2.5. Reasons for observations**

R. 114(1) EPC requires, among other things, that third-party observations state the grounds on which they are based.

In **T 189/92** the board held that it was the responsibility of the third party to ensure that the facts and evidence filed were not only unequivocally clear but also as complete as possible, so that they could be handled directly by the investigating instance without doubt and without further inquiry.

In **T 908/95**, the evidence adduced to show fulfilment of the criteria for establishing public prior use, in particular public availability, did not substantiate or prove such fulfilment to the extent that the allegation could be accepted. The board found that the additional inquiries needed to prove it, which might even include the hearing of witnesses, could only be conducted with the co-operation of the "third party", but that this was impossible where the person in question was not a party to the proceedings. The third party's observations therefore had to be disregarded (see also **T 73/86**).

In **T 301/95** (OJ 1997, 519), the opposition division had disregarded third-party observations as to a claim of public prior use, as the alleged facts had not been proven with near certainty.

In **T 866/01** the board stated that observations by a third party are regularly taken into consideration by the department which is responsible for deciding on the grant, maintenance or revocation of a patent, if such observations provide legal or technical information relevant to the decision to be taken by that department. Since in the case at issue the submissions contained no information which would be considered relevant to the present decision, they did not fall within the category of observations by a third party.

## **3. Third party's legal status**

### **3.1. General issues**

Art. 115 EPC 1973 provided that "any person" may present observations, whilst the German version referred to "jeder Dritte" and the French to "tout tiers". The revised EPC has aligned the English version with the German and French, so that it now refers to "any third party". See **T 338/89** of 10.12.1990 and **T 811/90**.

In **T 1224/09** the board pointed out that the only requirement in Art. 115 and R. 114 EPC relating to the entitlement to submit third party observations was the requirement that the third party would not be a party to the proceedings. There is no requirement to state whether the third party was acting in its own name or on behalf of someone else.

In **T 811/90**, the patentee had filed an appeal against a decision of the opposition division concerning the removal of certain documents from the public part of the file. The opponent was not a party to the impugned decision and was consequently not entitled to be a party to the proceedings before the board. His request was therefore inadmissible but was admitted as an observation by a "third party".

Similarly the board in **T 446/95** held that the intervention of a company was inadmissible, so its auxiliary requests were also inadmissible. However, there was nothing to prevent the company's observations and the documents it had filed from being dealt with under Art. 115 EPC 1973 (**T 223/11**).

In **T 7/07**, the board held that the patent in suit had not been granted for Lithuania under the EPC, as Lithuania was an extension state and therefore could not be designated for a European patent. The board agreed with the findings in **T 1196/08** that an intervention based on proceedings for infringement of a patent that has effect in a particular state solely on the basis of national law is inadmissible. The intervener's submissions were consequently regarded as third-party observations under Art. 115 EPC.

In **T 887/04** of 14 November 2006, the board found that, although the intervention had to be held inadmissible, account had to be taken of document D5 cited by the intervener under Art. 115 EPC 1973 for the purposes of examining novelty and inventive step, because, despite its belated submission, it was highly relevant.

### **3.2. Third party's procedural rights**

According to Art. 115 EPC a third party does not become a party to the proceedings. In principle, therefore, third parties have none of the procedural rights associated with such status, in particular the right to appeal and the right to be heard (**T 1756/11**). Their observations are to be examined as submitted and assessed with regard to credibility (**T 951/93**, **T 1196/08**).

In **T 951/91** the board found that by interpreting Art. 115 EPC 1973 in the light of their object and purpose, it was clear that they were intended exclusively to cut down, and not to extend, the rights of third parties, still less to extend their rights beyond the rights of parties to the EPO.

As a third party within the meaning of Art. 115 EPC is not a party to the proceedings and has no more than an opportunity to "present observations", the admissibility of these observations is entirely a matter for the board. While it is well-established by case-law that third-party observations can be considered, both at first instance and on appeal, there is no obligation on the board beyond such consideration and no right of a third

party to be heard on the admissibility of its observations or any evidence in support of them. The actual parties to proceedings naturally have the right to be heard in relation to such observations, but their admissibility is entirely a matter for the board (**T 390/07**). Parties to the proceedings can comment at any stage on new facts and evidence emerging from third-party observations filed after expiry of the opposition period, if they think that these could influence the decision. The opposition division or the board of appeal, exercising its discretion, is then obliged to rule on whether or not to admit the late-filed comments into the proceedings (**T 1756/11**).

In **T 283/02**, the opposition division had duly forwarded the observations by third parties to the patentee, who had made no comment. The failure of the opposition division to mention these observations in its decision did not constitute a procedural violation, even though a mention would have been desirable.

#### **4. Third-party observations in opposition proceedings**

##### **4.1. Third-party observations and the scope of opposition**

Examination of an opposition is limited to the extent to which the patent is opposed in the notice of opposition. If the opponent limits the notice of opposition to certain matters, the remaining matters are not opposed within the meaning of Art. 101 and 102 EPC 1973 or the subject of any proceedings within the meaning of Art. 114 and 115 EPC 1973 (**G 9/91** and **G 10/91**, OJ 1993, 408 and 420). The opponent thereby deliberately refrains from exercising his right under the EPC to oppose the other matters covered by the patent and, consequently, the EPO has no competence to deal with them at all. (**T 737/92**, **T 653/02**, **T 31/08**).

Following **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), the board in **T 580/89** of 28 April 1993 concluded that it had no power to examine the patentability of the subject-matter of claims which had not been opposed in the notice of opposition but were the subject of observations by the third party under Art. 115 EPC 1973 which had not reached the EPO until after the decision of the opposition division had been taken.

##### **4.2. Introducing a fresh ground for opposition in opposition proceedings**

An opposition division may, in application of Art. 114(1) EPC, of its own motion raise a ground for opposition not covered by the statement pursuant to R. 76(2)(c) EPC but referred to by a third party under Art. 115 EPC after the expiry of the time limit laid down in Art. 99(1) EPC. The Enlarged Board emphasised that the consideration of grounds not properly covered by the statement should only take place before the opposition division in cases where, prima facie, there were clear reasons to believe that such grounds were relevant and would in whole or in part prejudice the maintenance of the patent. The possibility under Art. 114(2) EPC of disregarding facts and evidence in support of fresh grounds not submitted in due time should, of course, also be kept in mind (**G 9/91**, OJ 1993, 408; **T 356/94**, **T 1053/05**).

### 4.3. Introducing a fresh ground for opposition in appeal proceedings

In an appeal procedure the provisions of Art. 114(1) EPC 1973 have to be interpreted in a more restrictive manner than in an opposition procedure and, accordingly, fresh grounds for opposition raised by an opponent or referred to by a third party under Art. 115 EPC 1973 after expiry of the time limit laid down in Art. 99(1) EPC 1973 may in principle not be introduced at the appeal stage, unless the patentee agreed. (**G 9/91**, **G 10/91**, OJ 1993, 408, 420).

In **T 667/92** of 27 November 1996, the board disregarded third-party observations because the patentee had not consented to their admission.

In **T 1667/07** some documents which were copies of submissions made by third parties during the examination of the application were submitted as evidence in support of fresh grounds for opposition raised for the first time on appeal. The board pointed out that since it cannot consider the fresh grounds of opposition put forward by the appellant for the first time in appeal proceedings - as the patent proprietor opposed to their introduction into the proceedings - it cannot consider **evidence** submitted in their support either.

### 5. Third-party observations filed at a late procedural stage

The board in **T 1756/11** held as follows: although the Art. 114(2) EPC provision on late-filed submissions mentions only the parties to the proceedings, established case law holds that submissions (i.e. facts and evidence) emerging from third-party observations not filed until after expiry of the opposition period are likewise to be treated, by way of a legal fiction, as "late": this means that Art. 115 EPC cannot serve to extend third parties' rights, let alone extend them beyond the rights of parties to the proceedings (see **T 951/91**, OJ 1995, 202). In other words, where third-party observations are filed after the time limit under Art. 99(1) EPC, the principle enshrined in Art. 114(1) EPC of examination by the EPO of its own motion is to be applied on the fictional basis that those observations are late, i.e. they are subject to the criteria developed in the case law for the boards' exercise of discretion in deciding whether to admit late-filed submissions within the meaning of Art. 114(2) EPC (see **T 580/89**, OJ 1993, 218).

#### 5.1. Opposition proceedings

In **T 1756/11** the board observed that, in view of the notice from the EPO concerning the filing of third-party observations in first-instance proceedings (see OJ 2011, 418 and 420), the opposition divisions should at least comment on the relevance of third-party observations, for example in the summons to oral proceedings.

In **T 301/95** of 28 March 2000, a third party had alleged public prior use after expiry of the period for opposition, i.e. belatedly. Under Art. 114(2) EPC 1973, it was at the discretion of the opposition division and the board of appeal whether or not to consider the belated submissions, but in deciding whether to do so, the most important criterion was the relevance of the belatedly cited prior art. The observations were not considered.

A document submitted under Art. 115 EPC 1973 during opposition proceedings, but after the time limit for filing the notice of opposition had expired, was discussed in the appeal proceedings, but not taken into account as it was found not proven to be publicly available at the relevant time and thus did not form part of the state of the art (**T 314/99**).

## 5.2. Appeal proceedings

Irrespective of a third party's legal status, the principle that the EPO must examine the facts of its own motion in first-instance administrative proceedings does not have the same legal importance in judicial appeal proceedings, in particular in *inter partes* proceedings (**G 9/91** and **G 10/91**, OJ 1993, 408, 420).

In **T 1756/11** the board observed that the boards usually have to disregard late-filed third-party observations in opposition appeal proceedings of their own motion, unless they relate to amendments to the claims or other parts of the patent made during the opposition or appeal proceedings. In that case, a board can, under certain circumstances, in the course of examining these amendments either disregard a third party's late-filed submission or, where appropriate, admit it into the proceedings and consider it at its discretion; see Art. 12(4) and 13(1) and (3) RPBA.

In **T 1224/09** a third party had submitted documents D53 to D55 (Japanese patent applications) at the start of the appeal proceedings. The board considered documents D53 to D55 to be prima facie relevant, as they had led to the refusal of the corresponding application before the Japanese Patent Office. The board stated that third party observations could be submitted at any time as long as proceedings were pending. Admitting and considering such observations, however, was an issue to be decided by the competent department of the EPO. In the case of the boards of appeal, the principles set out in Art. 13 RPBA seemed to be a reasonable basis on which the discretion to admit the third party observations was to be exercised, i.e. in view inter alia of the complexity of the new subject-matter, the current state of the proceedings, the need for procedural economy and, where oral proceedings were arranged, whether the board or the other parties could reasonably be expected to deal with the third party observations without adjournment of the oral proceedings. The board decided to admit documents D53 to D55 into the appeal proceedings.

In **T 637/09** the board stated that the admission into the appeal proceedings of third-party observations filed in the course of these proceedings is at the board's discretion. When exercising its discretion the board took into account that it should not accord the third party within the meaning of Art. 115 EPC more favourable treatment than would be given to an actual party seeking to introduce such submissions at that stage of the proceedings. The third-party observations filed shortly before the oral proceedings were not admitted into the proceedings since their admission would have accorded the third party more favourable treatment than would have been given to an actual party.

In **T 953/02** the respondent had challenged the submission under Art. 115 EPC 1973 because of a signature which was deficient, i.e. not that of a natural person. The submission by the third party was filed substantially less than one month before the oral

proceedings. The board did not admit it into the proceedings. This also removed any need to consider the arguments set out in the respondent's letter or the literature enclosed.

In **T 771/13** the observations were received by the EPO some days before oral proceedings. The novelty objection was not based on state of the art under the EPC. Moreover, the remaining documents and objections were not prima facie more relevant than those raised previously. Consequently there was no need to decide whether or not to admit these late-filed observations.

The observations under Art. 115 EPC were filed more than 1 1/2 years before the oral proceedings so that the parties and the board had sufficient time to consider the document. In fact, appellant I had already reacted in the written proceedings to the submission of the third party by filing amended claims and a declaration. The board had also notified the parties that it considers document D 27 to be relevant. None of the parties had requested that the submission of the third party be disregarded. Thus, the board decided to admit the submission of the third party into the proceedings (**T 458/07**).

## **6. Remittal following filing of observations**

A board may choose to remit a case to the department of first instance as a result of observations filed under Art. 115 EPC. See, for example, **T 249/84** and **T 176/91**.

In **T 929/94**, a preliminary examination by the board of the third-party observations and the supporting material showed that an entirely new case based on new facts and evidence had been presented against the patentability of the claimed invention in these observations. In order to preserve the applicant's right to review through appeal of any adverse decision of the department of first instance, the board remitted the case for examination of and decision upon such new material, as requested by the applicant.

In **T 41/00**, a document submitted during the appeal proceedings by a third party under Art. 115 EPC 1973 appeared to come closer to the claimed subject-matter than any of the prior-art citations considered during the examination proceedings. However, since it remained open to question whether the document had been available to the public at the patent's priority date, the case was remitted to the department of first instance.

In **T 848/06** the board intended to remit the case to the department of first instance. The board concluded that it would not be appropriate for the board to take into account the third party observations so as not to prejudice their consideration by the said department.

In **T 30/01** the case was remitted to the department of first instance for further prosecution. The board stated that the opposition division would also have to consider whether to admit or disregard the observations presented during the appeal proceedings by the third party and partially incorporated by reference in the respondent's own case.



## O. Notifications

1.	Forms of notification	785
1.1.	Notification by postal services	785
1.2.	Notification by means of electronic communication	786
1.3.	Notification by delivery by hand and delivery by public notice	787
2.	Notification to representatives	787
3.	Notification to third parties	788
4.	Spheres of risk and apportioning the burden of proof	789

Notifications are governed in detail by Art. 119 EPC and R. 125 to 130 EPC. Notification may be made by post, delivery by hand, public notice or, as provided for in R. 127 EPC, by means of electronic communication. More specific provision for the last means was made in the President's decision of 11 March 2015 (OJ 3/2015, A28) and Administrative Council decision CA/D 6/14 of 15 October 2014 (OJ 2/2015, A17). Together these form the basis for continuation of the EPO's pilot project, originally launched by the decision of the President of 4 July 2012 (OJ 8-9/2012, 486, which has ceased to have effect), during which it is progressively introducing new technical means for the electronic communication of patent applications, other documents, notifications and further information. Under the above-mentioned Council decision CA/D 6/14 (OJ 2/2015, A17), a set of amendments to the Implementing Regulations concerning notification and the use of electronic tools in proceedings before the EPO entered into force on 1 April 2015. In particular amendments to R. 2, 125, 126, 127 and 129 EPC were adopted, and these are explained in the sections on the individual forms of notification. Amended R. 125(1) EPC clarifies what documents must be notified and serves merely as an explicit legal basis for the EPO's existing practice of not formally notifying notices and communications from which no time limits are reckoned.

### 1. Forms of notification

#### 1.1. Notification by postal services

In R. 126 EPC, and also in R. 2(1), 125(2) and 133(1) EPC, references to "post" have been replaced by "postal services" and "postal service providers". This gives the Office the freedom to choose any postal service provider it regards as suited to serving notification.

R. 126 EPC stipulates that decisions incurring a period for appeal or a petition for review, summonses and other such documents as determined by the President must be notified by registered letter with advice of delivery or equivalent. All other notifications by postal services must be by registered letter. Under R. 126(2) EPC the letter is deemed to be delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it is incumbent on the EPO to establish that the letter has reached its destination or, as the case may be, to establish the date on which the letter was delivered to the

addressee. Notification is deemed to have been effected even if acceptance of the letter has been refused. Under R. 126(4) EPC, the law of the state in the territory of which the notification is made applies to other matters concerning notification, e.g. whether delivery to a person other than the addressee constitutes effective notification to the latter.

In **J 9/96** the Legal Board of Appeal held that notification of a communication posted as an ordinary letter in accordance with R. 78(2) EPC 1973 (no longer applicable since 1.1.1999) was deemed to have been made when despatch had taken place. However, if the communication did not reach the addressee and was not returned to the EPO, the legal fiction of deemed notification could not be applied, unless the EPO could establish that it had duly despatched the communication (see also **J 27/97** and **J 32/97**). On the question of apportioning the burden of proof and spheres of risk in connection with notification irregularities, see in this chapter III.O.4.

## **1.2. Notification by means of electronic communication**

Under the new R. 127 EPC, notification may also be effected by means of electronic communication. However, for this to happen, users must have agreed to receive communications by such means. In spite of the new legal basis, this form of notification was at the time of publication still restricted in practice to the documents listed on the EPO website, which in particular do not include documents relating to appeal proceedings.

R. 127(2) EPC extends the safeguards that already apply for notification by post to electronic notification. It defines the date on which an electronic document is deemed to be delivered as the tenth day after its transmission. In case of dispute, the Office must prove that the electronic document reached the addressee, or the date on which it reached him. This provision is not limited to any specific technical solution or tool, such as the Mailbox service.

The President's decision of 11 March 2015 (effective as of 1 April 2015) is now the legal basis for the EPO's Mailbox service. It defines the date of transmission, which triggers the ten-day period under R. 127(2) EPC, as the date indicated in the document ("the date of the document"), provided the addressee can access it in the Mailbox by that date. In other words, the ten-day period cannot be considered to have started before the date of the document. If the addressee disputes the date of transmission, it is up to the EPO to establish it. The ten-day period then starts on the date thus established (Art. 9 of the decision, OJ 2015, A28).

Facsimile ("fax") transmission of notifications is generally not admissible (**J 27/97**) and therefore does not constitute valid notification even if receipt is proven. The situation was different in **T 580/06** where notification of a shortfall under point 6.4 ADA was sent only by fax. However, this form of notification was in keeping with point 6.4 ADA in conjunction with R. 77(2)(d) EPC 1973. The President had not laid down conditions for notifications by fax within the meaning of that rule; in particular, postal confirmation of the fax had not been made compulsory. Thus the notification had been made in due form. In the board's view, the "OK" on the fax transmission report was to be regarded as

evidence of complete and error-free transmission, on which the fax became the recipient's responsibility.

### **1.3. Notification by delivery by hand and delivery by public notice**

Under R. 128 EPC notification may be effected on the premises of the EPO by delivery by hand of the document to the addressee, who must on delivery acknowledge its receipt. Notification is deemed to have been effected even if the addressee refuses to accept the document or to acknowledge receipt thereof.

If the address of the addressee cannot be established, or if notification in accordance with R. 126(1) EPC has proved to be impossible even after a second attempt, notification is effected by public notice (R. 129(1) EPC). In this case, the EPO informs the parties and the public of the date on which the document is deemed to have been delivered by publishing a notice in the European Patent Bulletin. The document is deemed to have been delivered one month after publication of the notice.

## **2. Notification to representatives**

If a representative has been appointed, notifications must be addressed to him in accordance with R. 130(1) EPC (previously R. 81(1) EPC 1973) from the time of his appointment. This only applies if a representative is actually appointed before a notification is posted since a notification has to be made on the basis of the facts on file at the time of posting (**J 22/94**). If several representatives have been appointed for a single party, notification to any one of them is sufficient (**T 1281/01**).

In **J 17/98** the board stated that the filing of a general authorisation does not, without any additional information linking the authorisation to a specific case and/or to the appointment of a representative, imply the appointment of a professional representative (see also decision **J 20/96**).

In its decision **J 5/04**, the board made it clear that the initial designation of a representative at the time when the international application had been filed with a receiving Office other than the EPO (here: INPI) did not meet the requirements for the valid designation of the representative for the regional phase before the EPO.

In **T 812/04**, the board pointed out that R. 101(6) EPC 1973, in conjunction with R. 81(1) EPC 1973, clearly indicated that, until the termination of an authorisation had been communicated to the EPO, the latter was obliged to notify communications, decisions or other documents to the duly appointed representative and that these notifications alone would have valid effects. The fact that the appellant had filed the notice of appeal himself imposed no obligation on the Registry of the boards of appeal to inquire about the legal status of relations between the applicant (client) and the duly appointed representative or to send the documents and communications subsequently directly to the client direct.

In **J 19/92** the Legal Board of Appeal held that notifications to an applicant's representative were duly made if they were despatched before the representative relinquished his brief. The notification to the applicant did not therefore have to be repeated after the brief had been relinquished. On the contrary, it was the representative who was obliged to inform his client of the notification. In **T 247/98** the board confirmed that what determined whether a R. 81(1) EPC 1973 notification was to be sent to the representative was the legal situation at the time when the document was despatched (see also **T 1281/01**).

However, in **T 703/92** the written decision and minutes of the oral proceedings were sent not to the authorised representative but to the opponents. The board found that, as the provision relating to notification had not been observed, the question whether a notification had effectively taken place depended (in accordance with R. 82 EPC 1973) on whether and when the representative had received the full decision.

In **T 172/04** the notification concerned had been received by an employee authorised to receive post on behalf of the representative. That the representative himself only had knowledge of the notification several days or weeks later was therefore irrelevant, as the only legal condition to consider, i.e. delivery to the addressee, was established. This finding was upheld in **T 743/05**, in which the board observed that the addressee is a person to whom something is addressed and that the authorised employee of the representative's office's signature on the advice of delivery met this definition. A different interpretation (i.e. that it had to be brought to the attention of the professional representative himself), would lead to uncertainty for all the users of the European Patent system, as the answer to the question whether notification had effectively taken place could in that case depend entirely on the honesty, goodwill or organisational skills of the professional representative (similarly **T 261/07**).

In **J 28/10** the representative's office was located in a large building in a business-park and incoming mail for the law firm was left at the doorman's desk. The doorman was the employee of a security company, this company having a contractual relation with the company that administrated the business-park where the representative rented office space. This led the board to the conclusion that a letter which is delivered to a recipient, who is also identified as recipient for previous deliveries should be deemed delivered by the postman to an authorised recipient, acting within the mail reception process implemented at the representative's office and accepted by him.

### **3. Notification to third parties**

In **T 261/07** the decision to revoke the patent was delivered (by registered letter with advice of delivery) to a person who was not an employee of the patentee (to whom the notification was addressed), but of a company that received letters on behalf of the patentee. No acknowledgement of receipt was on file for the patentee, who claimed never to have received the decision. Following **T 172/04** and **T 743/05**, the board held that for reasons of legal certainty, delivery to the addressee is effected once a person authorised by the addressee has received the letter. In **T 1535/10** too, the board held that, where the recipient did not operate his own mail office and instead made use of an

external mail office, he had to accept that the external office would be treated as if it were his own in matters relating to the delivery of communications subject to deadlines. Any delay in forwarding such communications on the part of the external office would thus be attributed to the recipient's sphere.

In **J 35/97**, a communication was handed to a third party not authorised by the appellant to accept it. The said party was in the addressee's business premises, but not an employee. In the board's view, that meant that notification under Section 12(1) and (2) RPCPS had not occurred. Nor did the party qualify under any of the categories of "substitute addressee". There was also no evidence that the appellant had ever seen the communication. The board therefore found the EPO had not shown notification to have been properly effected.

#### **4. Spheres of risk and apportioning the burden of proof**

R. 126(2) EPC states: "Where notification is effected in accordance with paragraph 1, the letter shall be deemed to be delivered to the addressee on the tenth day following its handover to the postal service provider, unless it has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be." In cases where the EPO is not able to prove the actual date of notification, a letter, for instance, sent by the addressee himself which indicates the date of receipt is accepted as proof. If it is evident from an addressee's reply that he has received the document, although he does not mention the date of its notification, the date on which that reply was written is to be regarded as the date of notification (Guidelines E-I, 2.5 – November 2015 version, re R. 125(4) EPC). The risk associated with electronic notification under the new R. 127 EPC is apportioned in the same way.

In **T 1535/10**, the board held that responsibility for obstacles to and delays in the receipt of decisions to be notified under R. 126(1) EPC had to be assigned according to spheres of risk. The Office was liable for both the risks arising in its own sphere and "transport risks". However, it distinguished such risks from those within the recipient's sphere of organisation and influence, e.g. the risk that employees or other authorised recipients failed to forward a letter delivered to the business address, or delayed in doing so. For a presumption that a letter had entered the recipient's sphere of organisation and influence, it sufficed that it had been delivered to his address and that he was in a position to take note of it, irrespective of whether he had actually taken (final) possession of it and noted its content (see also **T 580/06**).

In keeping with the bulk of the boards' case law, it was decided in **J 14/14** that it is clear from the wording of R. 126(2) EPC that, in the event of any dispute as to whether a notification has been received by the addressee, the onus is on the EPO to establish the fact and date of delivery. In the case, the only proof of delivery that the EPO had in respect of the communication in question, was a letter from Deutsche Post, referring to a registered letter sent to the appellant's representative and stating that it was delivered to a person authorised to receive it. This was deemed insufficient to fulfil the requirements

of R. 126(2) EPC since there was no proof that the appellant's representative or any other named individual signed a document acknowledging receipt of the letter and no communication from the foreign postal service was disclosed (see also **J 9/05** and **J 18/05**, where a similar confirmation letter by the Deutsche Post was held not to be sufficient to prove the receipt of an EPO notification).

In decisions **T 529/09** and **T 1304/07** however, the boards held that seeing as the appellant did not submit any further arguments or evidence in order to demonstrate that the Deutsche Post's confirmation failed to establish that the registered letter reached its destination, the evidence on file had to be regarded as sufficiently reliable and complete for proving the proper delivery of the letter.

In **T 247/98** the board stated that when establishing the meaning of the term "im Zweifel" in the German version of R. 126(2) EPC, account should be taken of the French and English versions, which assume that there is a dispute ('en cas de contestation', 'in the event of any dispute'). A dispute ('Zweifel', literally 'doubt' in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting. The mere absence of the advice of delivery or the receipt from the file was not in itself sufficient to give rise to a dispute ('Zweifel') within the meaning of this rule.

## **P. Applications by non-entitled persons**

Art. 61 EPC deals with the remedies available where a person other than the patent applicant is held by a national court to be the person entitled to the grant of a European patent. The Article remains unchanged in substance. For further details, see R. 16 EPC and R. 17 EPC.

In **G 3/92** (OJ 1994, 607), the Enlarged Board of Appeal was called upon to consider the application of Art. 61(1)(b) EPC 1973 in the following circumstances:

The appellant had lodged a European patent application in 1988. The search report revealed the existence of a prior application filed in 1985 for substantially the same invention by a third party, to whom the appellant had revealed the invention in confidence in 1982. This prior application had been published, and in 1986 deemed to be withdrawn for non-payment of the examination fee. Thereupon the appellant claimed from the UK Patent Office Comptroller, and was granted, entitlement to a patent for the invention disclosed in the prior European application under Section 12(1) UK Patents Act 1977. The appellant was thus allowed under Section 12(6) UK Patents Act 1977 to file a new application in the UK to be treated as having the same filing dates as the prior European application. The appellant then filed a new European patent application in respect of the invention disclosed in the prior application under Art. 61(1)(b) EPC 1973 in 1990.

The referring Legal Board of Appeal took the view in its interlocutory decision **J 1/91** dated 31.3.1992 (OJ 1993, 281) that the Comptroller's decision was a final decision within the meaning of Art. 61 EPC 1973. However, whilst entitlement to a patent was a matter for national courts to decide, those courts had no power directly to provide a remedy under the Convention, that being a matter to be dealt with by the EPO under Art. 61 EPC 1973.

The Enlarged Board of Appeal held that when it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Art. 61(1) EPC 1973, files a new European patent application in respect of the same invention under Art. 61(1)(b) EPC 1973, it is not a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed.

The Legal Board of Appeal therefore ruled in **J 1/91** dated 24.8.1994 that the conditions of Art. 61(1)(b) EPC 1973 had been met and accordingly remitted the patent application to the Receiving Section for further prosecution.

For stay of proceedings before the EPO in case of entitlement suit, see also Chapter III.M.3 "Stay of proceedings under Rule 14(1) EPC".

## Q. Rules relating to Fees

1.	General	792
2.	Payment of fees	793
2.1.	Methods of payment	793
2.2.	Debit orders	793
2.3.	Indication of purpose of payment	794
3.	Date of payment	795
3.1.	Fiction of fee payment in due time - ten-day fail-safe arrangement	795
4.	Insufficient payments - small amounts lacking	795
5.	Reduction of the examination fee	797
6.	Partial refund of the examination fee	797

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### 1. General

The Rules relating to Fees (RFees) determine the amounts of the fees levied by the EPO and the ways in which they are to be paid (Art. 51(4) EPC), They also contain provisions regulating the due date for fees, the particulars to be indicated concerning payments, the date of payment, insufficient payments and certain refunds and reductions.

According to the Legal Board of Appeal in **J 7/07**, no provision of the EPC states explicitly that the EPC takes precedence over the Rules relating to Fees in cases of conflict between them. However, the EPC is clearly the higher legal norm, and in case of conflict, by analogy with Art. 164(2) EPC 1973, the provisions of the EPC should take precedence over the provisions of the Rules relating to Fees. Also on general legal principles, the Implementing Regulations should take precedence over the Rules relating to Fees. See also Chapter III.D.1.2.2 "Applicability of R. 132 EPC to the Rules relating to Fees".

The EPC 2000 required a revised version of the Rules relating to Fees, which also entered into force on 13.12.2007 (see Administrative Council decision of 7.12.2006, OJ 2007, 10; also Administrative Council decision of 25.10.2007, OJ 2007, 533). Since then, further amendments have come into effect (see European Patent Convention, 16th edition 2016, and OJ 2014, A4 and A5). The relevant chapter of the Guidelines for Examination (November 2015 version) is Part A-X. Up-to-date fee information on fees is available in the Official Journal of the EPO under the rubric "Guidance for the payment of fees, expenses and prices" and on the EPO website at [www.epo.org/fees](http://www.epo.org/fees).

Besides the cases set out below, decisions concerning individual procedural fees are to be found in the relevant chapters of this book.



## 2. Payment of fees

### 2.1. Methods of payment

Fees due to the Office may be paid by the methods foreseen in Art. 5 RFees (see also **R 2/09**). Art. 5(1) RFees provides for payment or transfer to a bank account held by the Office. Under Art. 5(2) RFees further payment methods may be allowed by the President of the EPO (see in particular Chapter III.Q.2.2 below).

### 2.2. Debit orders

Under Art. 5(2) and Art. 7(2) RFees the EPO makes deposit accounts available for the settlement of fees and costs of other services provided by the EPO. These are governed by the Arrangements for deposit accounts (ADA) and their annexes, the latest version of which entered into force on 1 April 2015 (see Supplementary Publication 3, OJ 2015; see also point 5.3 as revised with effect from 1.4.2016, OJ 2016, A14).

Already in **T 152/82** (OJ 1984, 301) it was held that the EPO must execute a debit order in accordance with the substance of that order where the intention was clear, even though the amount specified was clearly incorrect. This also applied where a national form was used in error, as in **T 170/83** (OJ 1984, 605). A timely filed statement that a debit order for payment of a fee had been issued was itself considered such a debit order in the absence of any record of the original (**T 17/83**, OJ 1984, 306).

In **T 1265/10** the board considered in the particular circumstances of the case that the crossing of Section X of the notice of opposition (EPO Form 2300) to indicate enclosure of a fee payment voucher (which enclosure, however, was not found at the EPO) was a declaration of the intention to pay the opposition fee. A debit order had to be unambiguously recognisable and show a clear and unambiguous intention to make a particular payment (**T 170/83**, OJ 1984, 605; **T 152/82**, OJ 1984, 301; **T 152/85**, OJ 1987, 191). As stated in **T 170/83**, an authorisation to be derived from the circumstances required that the authorising person (account holder) was known and clearly identifiable, and that certain fees due to the EPO for a known procedure were meant to be paid by the withdrawal from such account (and not in any other way). Following **T 806/99**, which was based on almost identical facts, the board found these conditions to be fulfilled. This was sufficient for payment of the fee.

In **J 14/12** the question was whether for the renewal fees paid on a divisional application additional fees were also due. The board found that, for some of the renewal fees, a letter filed within the four-month period of R. 51(3), second sentence, EPC requesting (in general terms) debiting of the fees falling due with the filing of that divisional application was, when read in conjunction with the internal fee calculation sheet filed with the application, sufficient to fulfil the requirements for the content of a valid debit order (see point 6.3 ADA, version valid from 1.4.2009, Supplement to OJ 3/2009). Hence, those renewal fees were timely paid and additional fees were not due.

Since 1.4.2014, for debit orders not filed online it has become mandatory under point 6.2 ADA to use the standard payment forms (EPO Form 1010, PCT/RO/101 or PCT/IPEA/401; see Supplementary Publication 4, OJ 2014; also OJ 2014, A24, and OJ 2015, A64).

In case **T 773/07**, which concerned the Arrangements for deposit accounts in force until 12.12.2007 (Supplement to OJ 1/2005), the appellant's deposit account held insufficient funds to cover the appeal fee. The board rejected the argument that this fee could or should have been booked before six other fees on the relevant date. It was not for the EPO cashier to choose priorities between fees to be paid, all the more so since it was the responsibility of the account holder to ensure that the account contained sufficient funds at all times (point 5.2 ADA).

In **T 871/08** the opponent had indicated that the appeal fee would be paid by online debit order, but also requested that, if this was not done by one day before expiry of the Art. 108 EPC 1973 time limit, the Office should debit the fee. The board held that the payment of the appeal fee was exclusively the responsibility of the appellant or its representative, who could not discharge themselves by shifting the responsibility to the Office, let alone with a conditional order. However, in **T 2364/12** a different conclusion was reached in the circumstances of that case.

It is to be noted that point 6.3 ADA now expressly states that debit orders must be unconditional (with effect from 1.4.2009, Supplement to OJ 3/2009) and furthermore provides that debit orders filed online may specify a deferred execution date (with effect from 1.4.2014, Supplementary Publication 4, OJ 2014).

As confirmed in **T 270/00**, if an automatic debit order is revoked after the decisive payment date for the appeal fee, this is too late to affect the payment. Valid payment of the appeal fee is a matter of fact, which cannot be undone and is not at the disposal of the appellant.

### **2.3. Indication of purpose of payment**

According to **J 16/84** (OJ 1985, 357, headnote), which concerned the application of the former Art. 7(2) RFees (now Art. 6(2) RFees), if when a fee is paid the purpose of the payment has evidently been given incorrectly, this deficiency is not prejudicial if the intended purpose can be established without difficulty from the remaining information. The inadvertent use of a fee by the EPO for a different purpose from that evidently intended by the person making the payment has no effect on the purpose intended by that person.

In **J 19/96** the board noted that **J 23/82** (OJ 1983, 127) held that the indication of the purpose of a payment within the time limit for payment was not a mandatory requirement for payment to have been made in due time and, according to Art. 7(2) RFees (now Art. 6(2) RFees), could thus still be given later. However, the current board doubted whether this meant that it was generally possible to change the purpose of a payment

after expiry of the relevant time limit with retroactive effect to the date on which the payment was made.

**J 23/82** and **J 19/96**, which concerned designation fees for individual contracting states under the earlier law, are reported in the "Case Law of the Boards of Appeal", 6th ed. 2010, VI.F.2.4.

### 3. Date of payment

Where an amount is paid into or transferred to a bank account held by the Office, the date on which the amount of the payment or transfer is **actually entered** in its account is considered to be the date on which the payment has been made to the Office (Art. 7(1) RFees, formerly Art. 8(1) RFees). Thus, where an appeal fee was mistakenly transferred to a bank account held by the German Patent Office (GPO), neither the date on which the transfer was entered in the GPO's account nor the date on which the order to transfer the amount to the GPO was issued could be taken into account to establish whether a fee due to the EPO had been paid in due time (see **T 45/94** and **T 1130/98**).

#### 3.1. Fiction of fee payment in due time - ten-day fail-safe arrangement

Under Art. 7(3), (4) RFees, provided that certain requirements are met, the period for payment of a fee is considered to have been observed even if payment is not **received** until after expiry of the period in which it should have been made. If the payment was **undertaken** no later than ten days before expiry of said period, no surcharge becomes payable under Art. 7(3) RFees. However, as confirmed in **J 25/12**, payment of a surcharge does not create a possibility to **pay** a missing fee amount **after expiry** of the period for payment. For the application of the rule see **T 842/90** and **J 20/00**. In the latter case, which concerned the payment of a renewal fee, the board held that it applied, because in effect the due date for payment of a renewal fee marks the last day of a period (R. 37(1) EPC 1973; cf. R. 51(1) EPC) during which this fee can be validly paid.

Art. 7(3) RFees does not apply to key dates after which payments reaching the EPO are affected by a fee increase (**J 18/85**, OJ 1987, 356).

According to **J 7/08**, a period for payment may be deemed to have been observed within the meaning of Art. 8(3) RFees 1973 (cf. Art. 7(3) RFees) even if the receipt of the funds after the expiry of the period is no longer attributable to the original transfer order, but to another payment transaction initiated in the meantime (see also **J 22/85**, OJ 1987, 455).

#### 4. Insufficient payments - small amounts lacking

Under Art. 8 RFees, a time limit for payment is in principle deemed to have been observed only if the full amount of the fee has been paid in due time. However, the EPO has 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). See also **T 343/02**, where the underpayment of less than 2% due to the unexpected deduction of bank charges was overlooked. The board in **J 25/12** did not doubt that the underpayment could be regarded as a small amount, but stressed that the EPO could exercise its discretion to overlook small amounts only if justified. This was not so here since the representative had been informed about the changed fee rates and invited to pay the amount lacking within a time limit – which, however, he had failed to do.

In the cases set out below the amount lacking corresponded to the 20% language-based fee reduction according to former R. 6(3) EPC and Art. 14(1) RFees. Under the revised provisions (in force from 1.4.2014 – see Decision of the Administrative Council of 13 December 2013, OJ 2014, A4), this reduction applies only to the filing and examination fees and certain categories of applicant, and the amount is set at 30%.

According to **T 290/90** (OJ 1992, 368), whether it is justified to overlook a small amount lacking 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 held that in the circumstances 20% of the opposition fee could properly be regarded as a small amount, because it was inappropriate to punish the appellant for contending that he was entitled to a reduction in the opposition fee (under R. 6(3) EPC 1973), and the missing 20% was paid soon after expiry of the period.

However, in **T 905/90** (OJ 1994, 306, Corr. 556) the board found that the meaning of 'smallness' could best be determined by comparing the amount of shortfall with the amount of the full fee. A difference of 20% clearly could thus not, on purely arithmetical grounds, be regarded as small. It was with very small or trifling amounts that the former Art. 9 RFees (see now Art. 8 RFees) was designed to deal so as to prevent a loss of rights where an inadvertent error of some kind had led to a slight underpayment of an amount due in respect of the relevant proceedings.

In **J 27/92** (OJ 1995, 288) the examination fee was underpaid by about 20%, amounting to DEM 560. Distinguishing **T 905/90**, the board defined the concept of a "small amount lacking" as a fixed proportion of the amount of the fees to be paid. At most, 20% of the fee to be paid might be regarded as small within the meaning of the provision. Moreover, the choice of 20% would achieve the desirable end of making it possible to apply the provision to cases where a party paying fees mistakenly sought to take advantage of the (now former) 20% reduction in fees available under R. 6(3) EPC 1973 and former Art. 12(1) RFees (see now Art. 14(1) RFees). In the circumstances of the case the board decided that it was justified to overlook the deficit as the applicant not only paid it without delay, but also appeared to have been misled into paying only 80% of the fees as a result of information provided by the EPO. For a different approach, see **T 642/12**, in which the board, following **T 905/90**, considered that "small amounts lacking" are to be read as "insignificant or negligible amounts".

Reference is also made to decision **T 152/82** (OJ 1984, 301), relevant to incorrect amounts in debit orders (see in this chapter III.Q.2.2 above).

#### **5. Reduction of the examination fee**

In **J 1/09**, the Legal Board held that R. 107(2) EPC 1973 governed the reduction of the examination fee after the entry of an international application into the European phase. It did not apply to divisional applications. Art. 12(2) RFees 2003 only laid down the level of the reduction. For the conditions for the reduction it referred to R. 107(2) EPC 1973 (see also **J 14/07**).

#### **6. Partial refund of the examination fee**

The Legal Board ruled in **J 25/10** (OJ 2011, 624, see headnote) that following the withdrawal of a European patent application, a refusal by the examining division of a request for a 75% refund of the examination fee, on the basis that substantive examination has already begun (Art. 11(b) RFees), must be based on facts which objectively demonstrate that this is so. See also **J 9/10**. Following these two decisions the EPO made adjustments to the system for refunding search and examination fees - see Notice dated 29 January 2013 (OJ 2013, 153).

**R. Representation**

1.	Professional representatives	799
1.1.	List of professional representatives (Article 134(1) EPC)	799
1.2.	Duty of persons without residence nor place of business within a contracting state to be represented by a professional representative	800
1.3.	Professional representatives during the transitional period	801
1.4.	Procedural steps performed by a person other than the professional representative	802
2.	Legal practitioners entitled to act as professional representative	803
2.1.	General issues	803
2.2.	Register of legal practitioners	804
2.3.	Qualifying conditions according to Article 134(8) EPC	805
3.	Appointment of a common representative (Rule 151 EPC)	806
4.	Authorisations for appointment of a representative	808
4.1.	Filing of the authorisation	808
4.2.	General authorisations	811
4.3.	Sub-authorisations	813
4.4.	Authorisation of an association of representatives	814
5.	Oral submissions by an accompanying person	815
5.1.	Enlarged Board's landmark decision G 4/95	815
5.2.	Application of the case law established by the Enlarged Board	817
5.3.	Oral submissions by former members of the boards of appeal	824
5.4.	Oral submissions by qualified patent lawyers of non-EPC contracting states	826
6.	Distinction between presentation of facts and evidence and presentation of arguments	826

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As recalled in **J 1/04** for instance, there is no obligation for an applicant having a principal place of business within an EPC contracting state to be represented in proceedings established by the Convention. If, however, the applicant wishes to be represented, he must authorise either an employee or a professional representative or legal practitioner.

The basic conditions applicable to representation by employees (Art. 133(3), first sentence EPC) are set out in the EPO's Guidelines for Examination A-VIII, 1.5 "Signed authorisation" and 1.7 "Invitation to file an authorisation" – November 2015 version. Regarding an employee of a **group of companies**, **T 2308/10** says that an employee of a company in such a group is not entitled to represent another company belonging to the same group. **T 298/97** had already established that, there being no provision in the Implementing Regulations pursuant to Article 133(3), last sentence, EPC, the EPC did not currently allow the representation of one legal person by an employee of another economically related legal person.

In **J 8/10** (OJ 2012, 472), which deals with a number of points relating to representation, the board observed that the main provision governing entitlement to act in EPO

proceedings is Art. 134 EPC, legal practitioners' entitlement to act being regulated in particular by its paragraph 8. R. 152 EPC governs the filing and effects of authorisations.

The following section looks at problems addressed by the boards arising in cases where the parties are represented in proceedings, either by choice (see previous paragraphs) or by obligation (because they have no residence or principal place of business in a contracting state).

Art. 133 EPC contains the general principles governing representation with respect to proceedings under the EPC. It remains unchanged with the entry into force of the EPC 2000 (13 December 2007), save for minor editorial streamlining and changes aimed at increasing the consistency of the text of the EPC as a whole. Art. 134 EPC on representation before the EPO is likewise substantively unchanged but features some editorial amendments, in particular to take account of the deletion of Art. 163 EPC 1973, now largely superseded. The substance of the "grandfather clause" of Art. 163 EPC 1973 has in effect been integrated in Art. 134(3) EPC in simplified form as a permanent feature of the EPC designed to deal with the situation of national representatives of states acceding to the EPC in the future. The revised Art. 134 EPC is applicable as from the entry into force of the EPC 2000.

The Guidelines (November 2015 version) explain the developments in the area of representation, most notably in: A-III, 2 "Representation"; A-III, 16.2 "Period allowed for remedying deficiencies"; A-VIII, 1 "Representation", also D-I, 7 "Representation"; E-II, 8.5 "Submissions by the parties"; and E-III, 1.6.1 "General remarks", last paragraph. They also refer to the decisions of the EPO President dated 12 July 2007 (OJ SE 3/2007, A.3 and L.1.). Readers can find analyses of those decisions in, for example, **T 267/08**, **J 8/10** and **T 1744/09**.

On the signature of documents see the Guidelines (November 2015 version), A-VIII, 3 "Signature of documents", in particular A-VIII, 3.2 and 3.3, along with A-VIII, 2.5, and the decisions cited there, including the decision of the EPO President dated 26 February 2009 (OJ 2009, 182).

On notification to representatives, please see also R. 130 EPC, the Guidelines E-I, 2.4 – November 2015 version, and Chapter III.O.

The HTML version of the EPC on [www.epo.org](http://www.epo.org) provides regularly updated links, in particular to decisions of the President, in the footnotes to the relevant provisions.

## **1. Professional representatives**

### **1.1. List of professional representatives (Article 134(1) EPC)**

Art. 134(1) EPC stipulates that professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO. The requirements for entry in this list are laid down in Art. 134(2) EPC. In the context of

Art. 134(1) EPC, it is also useful to consult Rule 154 EPC "Amendment of the list of professional representatives", as well as the decision of the EPO President, OJ 2013, 600, and the Notice from the EPO, OJ 2015, A55.

The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters (**D 14/93**, OJ 1997, 561).

In **J 1/78** (OJ 1979, 285) the appellant was entered on the list of professional representatives before the EPO under the letter "V" as "von F., A.". The object of his appeal was to obtain a ruling which would enable him to be entered under the letter "F" as, for example, in the telephone directory. The decision found that the entry was made in accordance with the principles laid down by the President of the EPO whereby the full surname must be entered in alphabetical order. Under German law, former titles of nobility ("von") form part of the surname. The board noted that the purpose of entry on the list was to confer upon the person whose name was entered the right to appear in the European patent grant procedure. A distinction had to be made between entry for the purposes of conferring a right and publication of the list, which latter was not prescribed in the EPC 1973. The EPO issues a directory from time to time for the purposes of meeting public demand for information. In this directory, the person entered on the list could be allowed an additional entry under another letter should he so desire.

## **1.2. Duty of persons without residence nor place of business within a contracting state to be represented by a professional representative**

According to Art. 133(1) EPC, no person shall be compelled to be represented by a professional representative in proceedings established by the EPC. However, Art. 133(2) EPC stipulates that natural or legal persons not having either a contracting state residence or their principal place of business within the territory of one of the contracting states must be represented by a professional representative and act through him in all proceedings established by the Convention (**T 1157/01** reviews the applicable law), other than in filing the European patent application (see **T 451/89** and **T 883/90**). The Implementing Regulations may permit other exceptions.

In **T 213/89** the Japanese inventor replied directly to the EPO with a set of revised application documents, and accompanied by a letter to his representative indicating that the revised documents had also been sent to the representative. The board noted that no confirmation by the representative was received that any of the submissions directly received from the inventor should be regarded as an official reply to an EPO action. Since persons not having a residence or their principal place of business within the territory of one of the contracting states must act through their representative in the proceedings, the said submissions received direct could not be taken into account.

Likewise in **T 717/04**, the representative lodged the appeal for the applicant on 11 March 2004 and paid the prescribed appeal fee simultaneously. The statement of grounds of appeal was received on 18 May 2004. On 27 February 2007, a letter from the appealing applicant, a natural person with an address not within the territory of one of the contracting states, was faxed to the EPO with arguments and a new set of claims to be



taken into account. According to Art. 133(2) EPC 1973, since the appealing applicant's address was not within the territory of one of the contracting states, the board concluded that filing claims and arguments such as those in the appealing applicant's letter of 27 February 2007 would have required professional representation. As these submissions were neither made nor endorsed by the representative, the board could not take them into account.

In **J 9/13** the Receiving Section refused the European patent application pursuant to Art. 90(5) EPC, because the applicant, resident in Moscow, had not appointed a professional representative as required by Art. 133(2) EPC. The appellant (applicant) contended that Art. 133(2) EPC did not apply to residents of the Russian Federation. The Russian Federation was a party to the "Partnership and Cooperation Agreement (PCA). The board stressed that neither the European Patent Organisation nor the European Patent Office is part or member of the European Union. This was inter alia confirmed by the Enlarged Board of Appeal in decision **R 1/10**. Therefore, neither the European Patent Organisation nor the European Patent Office are bound by the provisions of the PCA, neither of them is a "party" or "other party" pursuant to Art. 98 of the PCA. For this reason alone, this international agreement could not serve as a legal basis for according to the appellant the same treatment as that which is accorded to residents of EPC countries with regard to proceedings established by the EPC. The appeal was deemed not to have been filed (R. 152(6) EPC by analogy).

### 1.3. Professional representatives during the transitional period

One of the conditions for including a professional representative on the EPO list is that he has passed the European qualifying examination (EQE). During a transitional period after the EPC 1973 first entered into force, this requirement could be waived under the conditions laid down in Art. 163 EPC 1973 (see **J 19/89**, OJ 1991, 425; **J 10/81**). For all states acceding to the EPC 1973 at its inception, this period ended on 7.10.1981 (decision of the Administrative Council dated 6.7.1978, OJ 1978, 327). Art. 163 EPC 1973 was one of the transitional provisions, now superseded, and has therefore been deleted in the new EPC 2000.

After the above date, under Art. 163(6) EPC 1973, a person with his place of business or employment in a state newly acceding to the EPC 1973 may, during a period of one year as from that state's accession, be added to the list under the conditions laid down in Art. 163(1) to (5) EPC 1973, i.e. without having to pass the EQE. Art. 163(6) EPC 1973 retains all its significance as a grandfather clause and is therefore preserved in the EPC 2000 to deal with the situation of national representatives of states acceding to the EPC in the future. The substance of the **grandfather clause** of Art. 163 EPC 1973 has therefore been **integrated in Art. 134(3) EPC 2000** in simplified form, as a permanent provision of the EPC.

The reunification of Germany posed its own problems, in **J 18/92**, **J 30/92**, **J 31/92**, **J 32/92** and **J 33/92**, regarding the admission of professional representatives. The appellants argued that the provisions of Art. 163(6) EPC 1973 should be applied to patent attorneys, even where they had qualified in West Germany and not the former

GDR. In the board's view, Art. 163(6) EPC 1973 could only be applied by analogy to those finding themselves in a similar situation to the patent agents of a country acceding to the EPC. This requirement was fulfilled only by patent agents from the former GDR and not by their colleagues who had already been admitted in the West. The board held that it would be strange if those who were admitted as patent agents in a contracting state were able to become authorised representatives without having to pass the examination merely by way of analogy with people working in a country which had just become a member. The appeals were accordingly dismissed.

#### **1.4. Procedural steps performed by a person other than the professional representative**

In **J 28/86** (OJ 1988, 85) the Legal Board of Appeal held that a request for examination filed by a person who was not entitled to act as a representative in accordance with Art. 134 EPC 1973 was invalid. The board noted that the situation did not change because the representative had later been entered on the list of professional representatives. In this capacity he had neither approved nor resubmitted the invalid request he had made earlier.

In decision **T 665/89** the board addressed the question of the admissibility of an opposition by an opponent whose residence was not in a contracting state, where the notice of opposition was signed by a person who was neither a professional representative (Art. 134(1) or Art. 134(7) EPC 1973) nor an employee of the opponent (Art. 133(3) EPC 1973). The board of appeal concluded that the actions of the unauthorised person ought to be judged as if the signature were missing, and thus assumed that the **deficiency** was remediable. The opponent supplied the missing correct signature at the EPO's invitation within the time limit laid down. The document thus retained the original date of receipt in accordance with R. 36(3), third sentence, EPC 1973 (**G 3/99** cites **T 665/89** in point 20 of the Reasons).

In **T 803/03** the board examined the relevant EPO case law (**J 28/86** and **T 665/89**) and its implications for the case at issue, which concerned an abandonment order signed by a non-entitled person.

**R 18/09** the Enlarged Board of Appeal, referring in detail to **G 3/99**, stated that concerning the principle that a plurality of persons acting in common be treated as a single party (a "group party") and the requirement that such a group party acts through a common representative which both apply to petition proceedings. It was also held in **G 3/99** (point 20 of the Reasons) that there is no practical need to acknowledge the validity of procedural acts of one member of a group party who is not its common representative. Such a procedural act is treated by the EPO in the same way as a missing signature. Where an appeal is filed by a non-entitled person, it shall be considered as not duly signed and the common representative be invited to sign it within a given time limit. (See also **G 3/99** under III.R.3. "Appointment of a common representative (R. 151 EPC)").

In **J 32/86** the board held that the mere appointment of a professional representative to meet the requirement of Art. 133(2) EPC 1973 (the appellant had his residence in the USA) did not automatically have the legal effect of validating acts previously performed by an applicant himself. The EPO was however obliged to give the representative a fair chance to remedy any deficiency of this kind that might have occurred before his appointment and which could still lawfully be remedied by him.

## **2. Legal practitioners entitled to act as professional representative**

### **2.1. General issues**

According to Art. 134(1) EPC, professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on the above list. However, Art. 134(8) EPC (former Art. 134(7) EPC 1973) provides that professional representation in such proceedings may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the contracting states and having his place of business within such state, to the extent that he is entitled, within the said state, to act as a professional representative in patent matters. The arrangements for legal practitioners set out in Art. 134(8) EPC therefore constituted an exception.

In **J 8/10** (OJ 2012, 472), the board observed that, if a legal practitioner wishes to act under Art. 134(8) EPC, the EPO considers whether he meets the conditions of that provision (i.e. is qualified in a contracting state and has his place of business and the right to act as a professional representative in patent matters in that state). For professional representatives it does not need to consider whether they are entitled to act before it, because it has its own list of those who are (Art. 134(1) EPC). If the legal practitioner fulfils the conditions, the EPO enters his name on a list which – like the list of associations of representatives – it keeps as an internal working tool and does not publish.

In **J 19/89** (OJ 1991, 425) it was observed that despite all the differences in the designations and career backgrounds of the persons included in the ranks of legal practitioners, the profession had developed on an essentially equal footing in the contracting states as a result of Europe's common legal history and shared legal culture. The board noted that the last clause of Art. 134(7), first sentence, EPC 1973 was necessary because under national law even an actual legal practitioner might be precluded to some degree from acting as a professional representative in patent matters. That clause prevented a "Rechtsanwalt", "legal practitioner" or "avocat" from having more extensive powers of representation before the EPO than he was entitled to before his national patent office. Art. 134(7) EPC 1973 was therefore a special rule limited in scope to the corpus of legal practitioners, which existed under various designations in all the contracting states. Members of the profession of Rechtsanwalt and comparable professions in the contracting states were entitled under Art. 134(7) EPC 1973 to act as professional representatives before the EPO, not by virtue of their status as individual Rechtsanwälte but by virtue of the institution of the profession of Rechtsanwalt as such.

In **J 18/99** the main issue was whether or not the appellant, a legal practitioner (abogado) qualified in Spain and having his place of business in Spain, was entitled under Art. 134(7) EPC 1973 to undertake professional representation of third parties in proceedings before the EPO. The board concluded that for the application of Art. 134(7) EPC 1973 all that was significant was that a legal practitioner qualified in a contracting state was - as such - entitled, within that state, to act as a representative in patent matters. The Convention did not distinguish for this purpose between entitlement to act as a "simple" representative or as a "professional" representative of clients (reference being made to the "travaux préparatoires"). Following the examination of national provisions and conclusions drawn by the OHIM (Communication No. 2/96 of its President of 22 March 1996, point 1), the board concluded that under the current Spanish law, any legal practitioner qualified in Spain and having his place of business in Spain was entitled to represent clients in patent matters before the Spanish Patent and Trademark Office if he presented an authorisation from the party.

## 2.2. Register of legal practitioners

The register of legal practitioners must be clearly distinguished from the list of professional representatives established in accordance with Art. 134(1) to (4) EPC.

Whereas, according to Art. 134(4) EPC 1973, the entry of a person's name in the list of professional representatives entitles them to act in **all proceedings** established by the EPC 1973, the EPC 1973 does not contain any corresponding provision for legal practitioners. Their competence to undertake representation before the EPO is not general, but depends directly on their complying with the provisions of Art. 134(7) EPC 1973 (**J 27/95**).

The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters; it would be jeopardised if legal practitioners without such qualifications were included on the list. Accordingly, the conditions for entry on the list of professional representatives under Art. 134(2) EPC 1973 also apply to legal practitioners (**D 14/93**, OJ 1997, 561).

According to the practice of the EPO, legal practitioners who indicate their intention to undertake representation in proceedings before the EPO and present an authorisation are entered in a register of legal practitioners, provided that they comply with the requirements of Art. 134(8) EPC. The Legal Division is responsible for checking these requirements and for the registration of names in, or deletion from, the register of legal practitioners (see also **J 27/95**).

In **J 18/99**, an issue concerned the appellant's registration as a legal practitioner under Art. 134(7) EPC 1973. The board noted that the appellant, a legal practitioner ("abogado") in Spain, had requested registration as a legal practitioner entitled to act in proceedings established by the EPC in accordance with Art. 134(7) EPC 1973 without filing a signed authorisation, whereas according to the practice of the Legal Division legal practitioners were registered only if they had filed a signed authorisation from a party.

The board therefore remitted the case to the Legal Division with the order to register the appellant, provided that he filed the signed authorisation.

### 2.3. Qualifying conditions according to Article 134(8) EPC

In **J 19/89** (OJ 1991, 425) the Legal Board of Appeal considered whether a patent attorney under national law should, in view of his legal qualifications and entitlement to act as a professional representative in national patent matters, be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC 1973 and hence be authorised to act before the EPO. The board decided that irrespective of his specialist qualifications and powers of representation in national patent matters, a **patent attorney** under national law could not be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC 1973, and therefore was not entitled to act as a professional representative before the EPO (see also **D 14/93**, OJ 1997, 561).

In **T 643/01** the appellant (patent proprietor) contended in particular that the opponent's reply of 28 January 2002 was inadmissible on the ground that it had been signed by Mr R., who was a legal practitioner and member of the Paris Bar but who was allegedly unable to show that he possessed an authorisation conforming to the requirements of R. 101(1) EPC 1973. The appellant requested that, if the signatory concerned was relying on his official status as a professional representative before the EPO, the board should find that French law prohibited such a plurality of offices, since the exercise of the profession of barrister could not properly be combined simultaneously with that of industrial property attorney. In the appellant's view, these provisions should be transposed into the law of the EPC. The board held, in the case at issue, that the signatory of the impugned pleadings of 28 January 2002 was entitled to act before the EPO and held the appropriate authorisation for that purpose. Mr R. and Mr D., legal practitioners and members of a partnership, were indeed members of the Paris Bar, and the names of both appeared on the list of professional representatives before the EPO. They were therefore both entitled to act in one capacity or the other before the EPO under Art. 134(1) and (7) EPC 1973. The board held that a decision on the legality, in France, of simultaneously exercising the profession of barrister and acting as a professional representative before the EPO fell solely within the jurisdiction of French professional and judicial bodies.

In **J 27/95**, the Legal Board of Appeal first made it clear that the competence of legal practitioners to undertake representation before the EPO depended directly on their complying with the provisions of Art. 134(7) EPC 1973. Thus, each time a legal practitioner made a request to act as a professional representative in proceedings before the EPO, the Legal Division had the right to examine whether he or she satisfied the conditions under Art. 134(7) EPC 1973. If such a request was refused, it could be refiled and reconsidered on the basis of new facts at any time. In its decision the board pointed out that according to Art. 134(7) EPC 1973 a legal practitioner qualified in a contracting state had to have "his place of business in such State". The board noted that in all three languages of the EPC 1973 the expression "his place of business" (in contrast to "a place of business") was used. The board stated that this formulation made it clear that

the place of business within the meaning of Art. 134(7) EPC 1973 was the place (if any) at which a person practised his or her profession as legal practitioner.

### **3. Appointment of a common representative (Rule 151 EPC)**

In **J 35/92** the first-named of two individual joint applicants had transferred his rights in the application to a company, which had appointed another representative who had then purportedly withdrawn the application. The second applicant did not agree with the withdrawal. The department of first instance held that the company was entitled unilaterally to withdraw the application by virtue of R. 100(1) EPC 1973, according to which the first-named applicant could be regarded as the representative of both, but the board of appeal disagreed. R. 100 EPC 1973 applied only where no joint professional representative had been appointed, whereas in the case in question the original applicants had appointed a representative, who continued to act for the second applicant. The board therefore concluded that the purported withdrawal of the application by the first-named applicant was invalid. The parties were given two months to appoint a joint professional representative, failing which one would be appointed by the EPO.

In **J 10/96** the Legal Board of Appeal ruled that where several applicants were represented jointly by a professional representative, who during the course of proceedings ceased to represent his clients, the correct procedure to be followed was that contained in R. 100(2), second sentence, EPC 1973, according to which the applicants were to be requested by the EPO to appoint a common representative within two months. If this request was not complied with, the EPO was empowered to appoint the common representative.

In **G 3/99** (OJ 2002, 347) the Enlarged Board of Appeal dealt with the question of the admissibility of joint oppositions and joint appeals. The decision makes it clear that an opposition filed in common, apart from the fact that it is filed by more than one person, is as much a single opposition as an opposition filed by only one person. Consequently, the common opponents are obliged to act in common through their duly determined common representative. In an opposition filed in common, there must in all cases be a common representative (Art. 133(4) and R. 100 EPC 1973), and only that common representative is entitled to act in the opposition proceedings on behalf of all the common opponents taken as a whole.

The decision further notes that an individual common opponent not being the common representative, or a subgroup of the group who filed the opposition in common, but without their common representative, is not allowed to act or intervene on his own or on behalf of one or more or all of the other individuals. Thus, only the common representative is entitled to sign the filed documents (R. 100 and R. 36(3) EPC 1973), the signature of other individuals not being required. At any stage of the procedure, be it the opposition or the appeal procedure, it may also occur that the joint member who is the common representative intends to withdraw from being a joint member, i.e. to withdraw from the proceedings. In such circumstances, he must notify his decision to the EPO with the procedural consequence that, for the determination of a new common representative, the provisions of R. 100(1) EPC 1973 have to be applied for the

opposition procedure by virtue of the last sentence of that rule and, for the subsequent appeal procedure, by virtue of R. 66(1) EPC 1973.

It may also occur that the common representative ceases to act in the procedure without the EPO being informed thereof. In both cases, the other joint members must take the appropriate action to continue the procedure in due time and to inform the EPO of the new common representative, if appointed. However, there is no practical need to acknowledge the validity of procedural acts of a joint member who is not the common representative. Since a procedural act performed by a non-entitled person is treated by the EPO in the same way as a missing signature (see **T 665/89**), each joint member or any other person acting on his behalf can perform such an act to avoid missing a time limit, provided the deficiency is remedied within a further time limit set by the board in the communication under R. 36(3) EPC 1973 notified to the common representative and sent for information to the non-entitled person who performed the act. The deficiency can be remedied if the procedural act is signed by the common representative. If, for whatever reason, this person ceases to be a joint member, the signature must be provided by a new common representative appointed pursuant to R. 100 EPC 1973.

**G 3/99** was applied in **T 1154/06** in connection with the necessity of appointing a professional representative if the first-named of multiple patent proprietors was not resident in a contracting state. (See **R 18/09**, in which the Enlarged Board referred to these two decisions and held that both the principle that a plurality of persons acting in common must be treated as a single party (a "group party") and the requirement that such a group party acts through a common representative apply to petition proceedings.)

In **T 1654/13** it was submitted that the appeal filed by the common representative of the joint patent proprietors had to be understood as having been filed on behalf of both patent proprietors as joint appellants. The wording used in the notice of appeal, referring only to the first of the two patent proprietors, i.e. Unilever N.V., thus had to be understood only in relation to the request for the reduction of the appeal fee. The board, citing Art. 118 EPC and calling to mind **R 18/09** and **T 1154/06**, decided that there was no doubt that Unilever N.V. and Unilever PLC were joint appellants. The appeal was admissible.

In decision **T 1366/04** the appeal had been filed by the first of two joint patent proprietors only. The board held that the requirements of Art. 118 EPC were met and that there was no doubt about the identity and appellant status of the two patent proprietors.

Decision **T 418/07** concerns a different case, where shortly before the oral proceedings the respondent (patent proprietor) appointed a second firm of representatives as joint representatives in addition to the firm already acting and asked the board to send copies of all correspondence to both firms. In this case of **multiple representatives**, the board held that while it is open to a party to appoint as many representatives as it may wish, the board is not aware of any requirement on it or on other parties to send correspondence to more than one representative of one party. If a party wants to retain multiple representatives, it must make its own arrangements for copying correspondence

to them all. Parties cannot expect the board to provide copying services for their convenience.

The issue of the validity of an appeal filed by a person who is not the common representative named under R. 151 EPC (R. 100 EPC 1973) in the notice of opposition is dealt with in the Chapter IV.E. "Appeal procedure".

#### 4. Authorisations for appointment of a representative

At various points in the following sections there are references to the issue of whether an authorisation actually exists, a problem in a number of cases.

##### 4.1. Filing of the authorisation

R. 101 EPC 1973 has been redrafted as **R. 152 EPC 2000**. R. 152(6) EPC, in particular, now reads: "If **a required** authorisation is not filed in due time, any procedural steps taken by the representative, other than the filing of a European patent application, shall **be deemed not to have been taken**, without prejudice to any other legal consequences provided for by this Convention." See also the decision of the EPO President dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, 128, L.1.), and **J 8/10** (OJ 2012, 470), which is reported in this chapter III.R.4.4 below. It is also useful to read the aforementioned 2007 decision in conjunction with the decision of the EPO President dated 26 April 2012 concerning notification of representation changes by professional representatives (OJ 2012, 352). See also the Guidelines A-VIII, 3.2 and 1.5 "Signed authorisation" – November 2015 version. Those Guidelines also deal in A-VIII, 2.5 with the exceptions applicable to authorisations in the context of filing documents after filing the patent application (e.g. Article 2 of the decision of the EPO President dated 10 September 2014, OJ 2014, A98, which excludes authorisations from filing using the EPO's web-form filing service; Article 2 of the decision of the EPO President dated 20 April 2012, OJ 2012, 348, which excludes authorisations from those documents that may be admissibly filed by e-mail during video conferences; and Article 3 of the decision of the EPO President dated 12 July 2007, OJ SE 3/2007, 8, A.3, which forbids the filing of authorisations by fax) and in the Guidelines A-VIII, 1.7 – November 2015 version with invitations to file an authorisation.

In **J 12/88** it turned out that the former representative of the appellant had acted before the EPO on behalf of the appellant without being instructed to do so and using a forged authorisation. The board considered all these proceedings to be null and void. There had never been a valid European patent application before the EPO. All fees paid to the EPO on behalf of the appellant never had been due and had to be reimbursed.

In **T 850/96** the appellant had alleged that the opposition was not admissible because the signatories of the notice of opposition did not file an authorisation. According to him an employee must declare with the notice of opposition that he acts as a professional representative. Otherwise he must file an authorisation. In the case under consideration both signatories of the notice of opposition were professional representatives. The board held that Art. 1(1) of the decision of the President of the EPO of 19 July 1991



(OJ 1991, 489) stipulates that a professional representative whose name appears on the list maintained by the EPO **and who identifies himself as such** shall be required to file a signed authorisation only in the circumstances set out in Art. 1(2) and (3) of this decision of the President (now decision of 2007, OJ SE 3/2007, 128). In the case at issue, the deficiency had not been the lack of a signed authorisation, but the failure of the signatories of the notice of opposition to identify themselves as professional representatives (see also **T 1744/09** citing **T 850/96** saying that a professional representative identifying himself retroactively is not precluded. **T 1744/09** addresses other interesting topics like verbal or written authorisation; "invalid signature").

In **T 425/05**, the respondent (patent proprietor) requested the board at the start of the procedure to declare the appeal inadmissible, on the one hand because it had been filed at a date when the original opponent (company I) had been dissolved and had therefore ceased to have legal existence, and on the other because the mistake in the notice of appeal could not be a mere clerical error on the part of the professional representative which could easily be corrected, since the representative manifestly could not act on behalf of company F, which had not yet authorised him to do so. The board began by establishing that the representative's authorisation to act on behalf of company I had never been contested or rescinded. It was equally evident that the original opponent, company I, no longer had legal existence, as it had been dissolved and its assets had passed into the hands of company F, its associate and sole shareholder. The board concluded that company F had succeeded company I as opponent, and therefore also as the client of the representative. Thus the appeal filed by the representative, whose authorisation, confirmed in the meantime, had never been rescinded, had been implicitly, but necessarily, filed on behalf of his actual client, company F; the identification of company I as the opponent (appellant) in the notice of appeal was due to a clerical error which had since been corrected. Citing **T 425/05**, see **T 1744/09** concerning the admissibility of an opposition and the appeal.

In **T 267/08** a change of representation had been notified by the new representative together with the notice of appeal. The previous representative had not contacted the EPO to indicate that his authorisation had terminated. In such cases, the procedure to be followed was governed by R. 152 EPC in combination with the decision of the President of the European Patent Office dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, L.1). This decision stated that in cases of a change of representation, and where the EPO had not been notified of the termination of the previous representative's authorisation, "the new representative must file, together with the notification of his appointment, an individual authorisation (original and one copy) or a reference to a general authorisation already on file. If he does not, he shall be requested to do so within a period to be specified by the European Patent Office."

In the case at issue, the board invited the new representative under R. 152(2) EPC to file an authorisation, as the board had realised that the authorisation failed to name the correct opponent. The new representative sent the authorisation by fax but failed to file the original version. Interpreting decision of the President L.1, the board concluded that where only a copy of the authorisation was filed in response to the invitation under

R. 152(2) EPC the EPO was under no legal obligation to additionally request the filing of the original.

The board stated that the filing of a valid authorisation for the opponent (appellant) must, of necessity, entail the **filing of the original**, and a professional representative should know this. The board considered that it should be sufficient to simply request that an authorisation be filed. The acceptable form of the authorisation was derivable from decision of the President L.1. Responsibility for filing a valid authorisation could not be devolved to the board. The legal consequence of this was that the procedural steps taken by the new representative were deemed not to have been taken (R. 152(6) EPC). Consequently the notice of appeal was deemed not to have been filed and an appeal did not exist. In the absence of an appeal, there was no basis for payment of the appeal fee, which was therefore reimbursed.

In **T 637/09** the appellant informed the board and the respondent that Mr M, who was already acting as its professional representative, would be joined by Mr S, another professional representative. Mr S's authorisation to represent the appellant was challenged by the respondent at the start of the oral proceedings. The board observed that under R. 152(10) EPC a party may be represented by several representatives acting jointly. In any case, Mr S's appointment as a joint representative was not a change of representative within the meaning of Art. 1(2) of the Decision of the EPO President dated 12 July 2007 on the filing of authorisations (OJ SE 3/2007, 128, L.1.) and he was therefore not required to file a signed authorisation as stipulated there in order to be able to represent the appellant. Nor did the board have any reason to doubt that Mr S was authorised to represent the appellant. In the circumstances of the case, there was no need to file a (further) authorisation under Art. 1(3) of the decision. The board concluded that Mr S was duly authorised to represent the appellant along with Mr M. (See also the Notice from the EPO, OJ 2013, 535, section II "Authorisation of several representatives singly pursuant to Rule 152(10) EPC").

In **T 1542/10**, a letter was filed on 10 January 2011 by professional representative P. The letter indicated "Nokia Siemens Networks OY" as opponent and used the same internal reference number as that indicated by representative B in the notice of opposition. In addition it referred to an enclosed power of attorney. According to this authorisation representative B authorised P to represent "Nokia Siemens Networks GmbH & Co. KG". In reply, the appellant (patent proprietor) took the view that the letter which had been filed by representative P on 10 January 2011 did not qualify as a written reply by the respondent for the purposes of Art. 12(1)(b) RPBA and should instead be regarded as a third party observation pursuant to Art. 115 EPC. It was argued that the letter was submitted on behalf of a **legal person different** from the respondent since the enclosed authorisation did not indicate the respondent's name but that of Nokia Siemens Networks GmbH & Co. KG. The appellant further maintained that the respondent having thus failed to reply to the grounds of appeal had lost its status as a party as of right according to Art. 107, second sentence, EPC or at least its entitlement to submit observations regarding the appellant's case set out in the statement of grounds of appeal. Under the given circumstances it was quite obvious to the board from an objective perspective that the indication of the name Nokia Siemens Networks GmbH & Co. KG in the authorisation

was made erroneously. The fact that the board's registry did not receive an answer after it had sent out a communication pointing out that no valid authorisation had been submitted by the respondent's new representative did not entail any negative consequences for the respondent. In particular it was noted that the communication **did not specify any time limit** so that the sanction provided for by R. 152(6) EPC could not apply. Neither was the lack of response a sufficient reason for retrospectively giving a different meaning to the letter dated 10 January 2011 since that meaning had to be assessed objectively as understood at the time when the letter was received. In view of the authorisations submitted by the respondent in its letter dated 13 June 2013 and at the oral proceedings, the board had **no doubt** that representative P had been authorised to represent the respondent. It followed that the letter dated 10 January 2011 had to be regarded as a written reply to the appellant's statement of grounds of appeal for the purposes of Art. 12(1)(b) RPBA.

The board in **T 1700/11** ruled that if a European representative files an opposition on behalf of a party but fails to file a signed authorisation in due time in response to a request to do so from the board, the opposition is deemed not to have been filed (R. 152(1) and (6) EPC). The board held that this legal fiction resulted in a loss of rights (R. 112(1) EPC) and that an examination of the admissibility of the opposition, which had not been filed according to the legal fiction, was out of the question.

In **T 534/07** it was decided that the validity of procedural acts undertaken by the representative for his client was not affected by the existence of a conflict of interest.

See also Chapter IV.E.2.4. "Entitlement to appeal", and in particular **T 1324/06** where the very existence of the authorisation was challenged.

#### **4.2. General authorisations**

This subsection deals inter alia with the extent of the powers conferred.

In **J 9/99** (OJ 2004, 309) the board decided that the Legal Division had authority to check the authorisation of a representative named in a general authorisation and to issue a formal decision to reject the registration of a general authorisation. A decision not to register a general authorisation can only be issued in respect of a request from a party to the proceedings within the meaning of R. 101(2) EPC 1973, i.e. either an authorising or an authorised party.

In **J 11/93** the applicant submitted in his statement of grounds of appeal that the official communication should have been sent to the authorised European representative since he had been duly empowered to act on behalf of the applicant by a general authorisation filed with the EPO in respect of another European patent application. Instead of this the communication was sent directly to the applicant, a US company.

The board observed that the usual form recommended for general powers had not been used and nothing in the document filed with the co-pending application allowed the Receiving Section to infer that the applicant intended the said document to be regarded

as a general power rather than a specific one. The board confirmed that the authorisation in suit had never been registered by the EPO as being a general one, and that even if it had been so registered it would then have been incumbent on the applicant to communicate the number allotted to the general authorisation so that the Receiving Section could take it into consideration before sending the communication to the applicant at its last known address, rather than to the representative. Under these circumstances the board considered that when the letter sent directly to the applicant was issued no European professional representative had yet been appointed by the applicant. Hence the provisions of R. 81 EPC 1973, according to which - if a representative (i.e. a European one) had been appointed - notifications were to be addressed to him, could not apply but consequently only those of R. 78(2) EPC 1973 (version as in force up to 31.12.1998) relating to notifications in respect of addressees not having either a residence or place of business in one of the contracting states and who had not appointed an authorised representative.

In **J 17/98** the Legal Board of Appeal had to rule on whether communications concerning the deemed withdrawal of applications had been correctly notified to the applicants, who were residents of a non-EPC contracting state, even though general authorisations were held by the EPO on their behalf. The applicants argued that the communications relating to deemed withdrawal should in fact have been notified to the representatives appearing in the general authorisations on file with the EPO. The board held that the filing of a general authorisation to act on behalf of a specific applicant and the notification of the appointment of a representative in an individual application were two **separate** procedural acts. By definition, general authorisations did not refer to specific cases and did not allow the EPO to assume, without further information from the applicant, that a specific representative had been appointed in a particular case. From the Convention it was clear that the filing of a general authorisation did not imply the appointment of a professional representative in a specific case. In such clear cases directly following from the provisions of the Convention the principle of the protection of legitimate expectations did not require the EPO to issue comprehensive legal advice extending beyond the form in question, provided it was in itself clear and unambiguous (see also Chapter III.O.2 "Notification to representatives").

In case **J 1/04**, the relevant question in this case was whether the notifications of the communications were correctly addressed to the appellant. In the appeal proceedings the appellant no longer contested that the registered letters had come into the hands of its employee, who had picked them up at a local post office. The appellant criticised the EPO's practice of sending communications directly to the applicant, even if the latter had appointed a national representative in the international phase, as discriminative and as disregarding the express wish of the applicant not to handle matters himself.

The board first noted that Art. 133 EPC 1973 makes it clear that there is no obligation for an applicant having a principal place of business within an EPC contracting state to be represented in proceedings established by the Convention. If, however, the applicant wishes to be represented, he must authorise either an employee or a professional representative or legal practitioner. Whatever possibility the applicant prefers, if he does not wish to handle matters himself and therefore wishes to be represented, he must

appoint a representative who is entitled, in accordance with the provisions of Art. 134 EPC 1973, to undertake representation before the EPO. In the case at issue the applicant did not do this, although the EPO had expressly pointed out to the applicant that an authorisation for the international phase did not comprise an authorisation for the European phase and that disregard thereof could lead to a loss of rights. The board held that the requirement that only persons fulfilling the conditions for representation before the EPO under Art. 134 EPC 1973 are entitled to undertake representation before the EPO was not of a discriminative nature. Furthermore, as long as the applicant did not appoint a representative who was entitled to represent him before the EPO, the general principle applied that procedural acts had to be performed by the EPO in relation to the registered applicant as being the party to the proceedings. Thus, notifications had to be addressed to the registered applicant and they had been correctly made if they were addressed to the applicant (appellant) in the case at issue. The appeal was dismissed.

In **T 1378/05** the appeal had been validly filed by legal representative G. on the basis of a "mere" authorisation to act "in matters concerning European patent application 'Method for authorisation in file transfer systems'" in proceedings before the German Patent Office, the Federal Patent Court and the - German - Federal Supreme Court. Thus there was no authorisation for proceedings before the European Patent Office. The appellant filed such an authorisation within the two-month time limit set by the board and therefore "in due time" within the meaning of R. 101(4) EPC 1973. The opponent argued that there was clear evidence to show that the authorisation filed subsequently by the patent proprietor was backdated. The filing of this substantively false document could not fulfil the requirement of filing a correct authorisation, so for this reason, too, the appeal had to be deemed not to have been filed. The board could not accept the opponent's argument. It also noted that it did not have to be decided whether the principle of the protection of legitimate expectations already made it imperative in this case to regard the appeal as validly filed by legal representative G., after he had been regarded as the patentee's representative throughout the proceedings so far as well as in the published patent specification. The opponent itself had only challenged this ten years later, after a file inspection at the appeal stage. The appeal was therefore to be deemed filed and was, moreover, admissible in other respects.

In **T 1865/07**, the board noted that, in the circumstances of the case, giving an incorrect general authorisation number was of no consequence.

### **4.3. Sub-authorisations**

In **T 227/92** it was held that a sub-authorisation from a professional representative to a person who was not a professional representative within the meaning of Art. 134 EPC 1973 was invalid. The latter person's role was therefore limited to that of technical adviser to the professional representative.

In **T 382/03** the previous representative, Mr E. of UDL, filed a fax to announce that Mr U., who was not a member of that association, would appear for respondent 1 at the oral proceedings before the board. Mr E. did not notify the board that his association's authorisation was terminating. Hence, that was a situation where the President's

decision required the new representative, Mr U., to prove that he was authorised to act on behalf of respondent 1. As Mr U. did not refer to a general authorisation from respondent 1, proof of an individual authorisation had to be provided to the board. In principle, that could be done by filing a direct individual authorisation from opponent 1, or by filing a sub-authorisation from an authorised representative who was entitled to sub-authorise a third representative. In view of the sub-authorisation from UDL submitted by Mr U. at the oral proceedings, the only issue remaining was whether or not UDL was entitled to give such a sub-authorisation. As Mr G. had filed notice of opposition 1 without filing an authorisation, there was no evidence on file that Mr G. had obtained the power to give sub-authorisations. In the board's view, the issue of whether or not a board considers a representative to be authorised by a party was a matter of proof including a free evaluation of the evidence and overall circumstances in an individual case. To define an appropriate standard of proof with respect to a representative's authorisation, the board took account of the purpose for requiring an authorisation.

For an example of a professional representative entitled by a chain of sub-authorisations to make submissions on behalf a party, see **T 1081/06**.

In **T 1676/08**, the board had no reason in the circumstances of the specific case to doubt that Mr S, a legal practitioner entitled to act as a representative, was duly sub-authorised (Art. 133 and R. 152(1) EPC and Art. 2, first sentence, of the decision of the President dated 12 July 2007 on the filing of authorisations, OJ SE 3/2007, 128). Moreover, on the same day of the oral proceedings, the professional representative, Mr M, stated as a precautionary measure that he endorsed any submission made by Mr S during these oral proceedings.

In **T 1693/10**, the contested sub-authorisation given to a second professional representative had eventually been withdrawn. This second representative was regarded from then on as assisting the first representative as an "accompanying person" within the meaning of **G 4/95** but was not permitted to speak at the oral proceedings because at least one of the criteria laid down in that decision for such permission had not been met.

#### **4.4. Authorisation of an association of representatives**

The Administrative Council's decision CA/D 9/13 of 16 October 2013 on the interpretation of the term "association of representatives" (OJ 11/2013, 500) endorsed the interpretation in **J 16/96** (below). For more information on this subject, see also the Notice dated 28 August 2013 on matters concerning representation before the EPO (OJ 11/2013, 535).

As explained in **J 8/10** (OJ 2012, 470), the EPO keeps a list of associations of representatives as an internal working tool which it does not publish.

In **J 16/96** (OJ 1998, 347) the EPO Legal Division had informed a company X that its patents department could not be registered as an association of representatives. Such an association meant one consisting solely of professional representatives in private practice. The Legal Board concluded that there was no basis in the Convention for the

EPO's practice of restricting R. 101(9) EPC 1973 (now R. 152(11) EPC) to professional representatives "in private practice". An **association** within the meaning of that provision could therefore **also** be formed by **professional representatives not in private practice**. There was no reason to interpret the term "association of representatives" in a way which limited its meaning. (**J 16/96** cited on this point in **T 656/98**). As mentioned in the introduction to this point, Decision CA/D 9/13 endorsed the Legal Board's interpretation in **J 16/96**.

Case **J 8/10** (OJ 2012, 470) was about whether legal practitioners too could belong to associations of representatives under R. 152(11) EPC (R. 101(9) EPC 1973), with the board discussing various practical aspects and their legal consequences. The Legal Board interpreted R. 152(11) EPC as referring to an association of professional representatives. Therefore, legal practitioners were not covered by the legal fiction of R. 152(11) EPC.

## **5. Oral submissions by an accompanying person**

According to the decision **G 4/95** (OJ 1996, 412) oral submissions by an accompanying person in opposition or opposition appeal proceedings cannot be made as a matter of right, but only with the permission and at the discretion of the board. When exercising its discretion decision **G 4/95** specified the main criteria to be considered (see below).

This section begins by presenting the case law established by **G 4/95** and then illustrates by way of examples how the boards have applied it since.

### **5.1. Enlarged Board's landmark decision G 4/95**

In **J 11/94** (OJ 1995, 596), the Legal Board of Appeal referred the following question to the Enlarged Board of Appeal: might a board of appeal exercise discretion in deciding whether or not a person not entitled under Art. 134(1) and (7) EPC 1973 to represent parties to proceedings before the EPO could make submissions during oral proceedings in addition to the pleadings by the professional representative? Further, if such discretion existed, what criteria did the board have to observe when exercising it?

The Enlarged Board of Appeal also had to decide on a question referred to it by the board in **T 803/93** (OJ 1996, 204), namely whether, and if so in what circumstances, a person other than the professional representative (that is, an accompanying person) might make oral submissions on behalf of a party concerning either legal or technical issues, during oral proceedings under Art. 116 EPC 1973 before an opposition division or a board of appeal. This question went beyond the circumstances of **J 11/94**, which concerned ex parte proceedings involving only legal issues.

The Enlarged Board gave its answer in two decisions: **G 2/94** (OJ 1996, 401) referring to **J 11/94**, and **G 4/95** (OJ 1996, 412) occasioned by **T 803/93**.

In **G 4/95** (OJ 1996, 412) the Enlarged Board noted that the appointment of a professional representative by a party involved the authorisation and identification of the

professionally qualified person who was responsible for the presentation to the EPO of all submissions made by the party. Such presentation of a party's case was the essential core of the function of a professional representative under Art. 133 EPC 1973. During oral proceedings, a professional representative was expected to present the entire case of the party that he or she represented.

The Enlarged Board considered separately the presentation of facts and evidence, on the one hand, and the presentation of arguments, on the other hand.

As to the presentation of facts or evidence by an accompanying person, the Enlarged Board held that such oral submissions during oral proceedings - in addition to the complete presentation of the party's case by the professional representative - are not excluded under the EPC. They may be allowed under the overall discretionary control which the EPC gives to the EPO with respect to the filing of facts and evidence.

As to the question whether an accompanying person may make oral submissions during oral proceedings by way of argument, the Enlarged Board pointed out that Art. 133 EPC 1973 made no distinction between written and oral proceedings in connection with the requirements for representation. Thus a professional representative was responsible for all written and oral submissions made on behalf of the party who had appointed him. However, in the context of the **written procedure** provided under the Convention for oppositions and opposition appeals an appointed professional representative could submit additional documents signed by a third person (for example a professor of law or science). Provided that they were submitted under the responsibility and control of the professional representative, they did not have to be excluded from consideration in the proceedings in which they were filed. Similarly, during **oral proceedings** under Art. 116 EPC 1973 in the context of opposition or opposition appeal proceedings, a person accompanying the professional representative of a party was not excluded from making oral submissions in relation to either legal or technical issues on behalf of that party to the proceedings under the control of the professional representative, and in addition to the complete presentation of the party's case by the professional representative.

The Enlarged Board further held that such oral submissions could not be made as a matter of right, but only with the permission of and at the discretion of the EPO. The following **criteria** should be considered by the EPO when exercising its discretion:

- (i) The professional representative should request permission for such oral submissions to be made. The request should state the name and qualifications of the accompanying person and should specify the subject-matter of the proposed oral submissions.
- (ii) The request should be made sufficiently in advance of the oral proceedings so that all opposing parties are able properly to prepare themselves in relation to the proposed oral submissions.



(iii) A request made shortly before or at the oral proceedings should, in the absence of exceptional circumstances, be refused unless each opposing party has agreed to the making of the oral submissions requested.

(iv) The EPO should be satisfied that oral submissions by an accompanying person were made under the continuing responsibility and control of the professional representative.

In **G 2/94** (OJ 1996, 401) the Enlarged Board made it clear that there was no difference as a matter of principle between the admissibility of such oral submissions in *ex parte* proceedings and in *inter partes* (opposition) proceedings, and that this matter had been fully considered in the context of opposition proceedings in **G 4/95** (OJ 1996, 412). The Enlarged Board noted that it was important that the board should control the proceedings. The board should exercise its discretion in accordance with the circumstances of each individual case. The main criterion to be considered was that the board should be fully informed of all relevant matters before deciding the case. The board should be satisfied that the oral submissions were made by the accompanying person under the continuing responsibility and control of the professional representative.

## 5.2. Application of the case law established by the Enlarged Board

The decisions reported below show how the criteria established by the Enlarged Board have been applied, both in oral proceedings before the boards and when scrutinising decisions taken by the department of first instance. Irrespective of the outcome – i.e. whether or not the person accompanying a party was authorised to make oral submissions – the boards have considered the various criteria in the light of the circumstances of the individual case. It is therefore useful to consult their reasoning no matter what the scenario and it would be artificial to divide the cases up according to the conclusion eventually reached. Nevertheless, to give the reader a quick overview, they are first listed according to the outcome, together with some keywords for orientation but without any details of the reasons given.

In the following cases, the accompanying person was **not authorised** to make oral submissions: **T 334/94** (request not made early enough); **T 1208/06** (inventor not the proprietor); **T 89/04** (classed as accompanying person – request made just three days before the oral proceedings); **T 2135/08** (no information on experts' qualifications and subject-matter of oral submissions); **T 1706/06** (request not made early enough – consent not given by the other party); **T 302/02** (submissions of the expert of a party on subject-matter not specified in some detail beforehand); **T 1676/08** (examination of the criteria – numerous procedural points raised); **T 2552/11** (insufficient information to enable other party to prepare); **T 520/07** (request made during oral proceedings – same submissions by same person at first instance – appeal proceedings separate); **T 8/13** (person closely followed the whole case from beginning); **T 378/08** (standard application of the criteria in specific case of an EQE candidate); **T 1693/10** (sub-authorisation withdrawn – "accompanying representative" an accompanying person within the meaning of **G 4/95** – no request that an oral presentation be made by the "accompanying representative" – alleged conflict of interests).

In the following cases, the accompanying person was **authorised** to make oral submissions: **T 899/97** (request made early enough in circumstances); **T 475/01** (persons accompanying both parties – one party representing itself); **T 1212/02** (professional representative's colleague – pragmatic approach); **T 754/08** (former patent attorney); **T 1207/06** (presentation of the entire case – not established); **T 919/07** (accompanying persons authorised if contribution relevant to discussion); **T 1458/11** (trainee in professional representative's law firm – objection on appeal to scope of submissions not upheld).

In the following decisions, the boards held that **G 4/95** did not apply: **T 621/08** (patent proprietor); **T 1687/08** (lawyer).

In **T 1027/13**, the board concluded that it was not established that the department of first instance in exercising its powers of discretion had examined the criteria laid down in **G 4/95**.

In **R 3/08**, the Enlarged Board looked at the specific question of whether an accompanying person can validly raise a procedural objection pursuant to R. 106 EPC. More details can be found at the end of this section.

The facts and reasons leading to the decisions listed above are detailed below:

In **T 334/94** the board emphasised that for a legal or technical expert to be allowed to make submissions at oral proceedings on behalf of a party and under the control of that party's representative, certain criteria relating to Art. 113(1) EPC 1973 had to be fulfilled. **G 4/95** had ruled that the party wanting such submissions to be made had to ask permission sufficiently in advance of the oral proceedings to give the other parties time to prepare. Only in exceptional circumstances should the EPO allow such a request if made just before the date of the hearing, unless all the other parties agreed. The board noted that the Enlarged Board had not defined what "sufficiently in advance" meant, or laid down a deadline for making such requests. In its view, the **deadline of one month** before the proceedings for filing submissions or new sets of claims was a minimum. On that basis, nominating an accompanying expert one week before the proceedings was not acceptable.

In **T 899/97** the appellant (opponent) requested that a technical expert be allowed to speak during the oral proceedings in order to explain the physical phenomena that occurred when a prior art separator was used. Pointing out that the relevant letter from the appellant had reached him only two weeks before the oral proceedings, and referring to **G 4/95** (OJ 1996, 412) and **T 334/94**, the respondent requested that this technical expert be refused permission to speak. The board considered the particular circumstances of the case, i.e. that no time limit for making further submissions had been set by the board with the summons to oral proceedings; that the respondent (patent proprietor), although he had had two weeks' notice of the technical expert's appearance at the oral proceedings, had not taken any immediate action in this respect, but merely objected to his being heard at the beginning of the oral proceedings; that the respondent, when referring to the criteria (ii) and (iii) mentioned in headnote 2(b) of decision **G 4/95**,

had not indicated any specific preparatory measure that had been rendered impossible or hindered by the relatively late presentation by this technical expert; that this technical expert was one of the authors of the test report (R2) filed by the appellant with the statement of grounds, that the board had raised some questions on this specific technical issue in the annex to the summons to oral proceedings, and that these technical issues had already been discussed before the department of first instance. With these circumstances in mind, the board held that the appellant's request that the technical expert be heard had been submitted sufficiently in advance of the oral proceedings, and that the respondent had been able "to properly prepare" himself for that expert's oral submissions, including his explanations concerning the physical phenomena occurring in prior art separators as tested in R2 (see **G 4/95**). With this in mind the board held that the request to hear the technical expert had been submitted sufficiently in advance of the oral proceedings by the appellant, and that the respondent had been able "to properly prepare" himself in relation to the oral submissions" by this technical expert, including explanations concerning the physical phenomena occurring in prior art separators as tested in R2.

The strict approach of allowing **only** the authorised professional representative to present the party's case and make oral submissions contradicts the position explicitly expressed by the Enlarged Board in **G 4/95** (as held in **T 1027/13**, reported below, in relation to a categorical refusal to hear a technical expert on the ground that this would have amounted to circumventing the rules on representation).

In **T 621/98**, during oral proceedings, the board was faced with the question of whether the patent proprietor, who was professionally represented, needed to announce in advance his intention to make submissions during the proceedings, pursuant to **G 4/95** (OJ 1996, 412). The board ruled that the patent proprietor was a party to the proceedings and as such was not to be treated as an accompanying person. As a party to the proceedings he had a right to take part in them.

In **T 1208/06** the inventor was not identical to the patent proprietor, so **T 621/98** did not apply. In the circumstances, and applying the criteria of **G 4/95**, the board held the opposition division to have acted correctly by categorising the inventor as an "accompanying person" and not as a party to the proceedings within the meaning of Art. 99(3) EPC and by rejecting the proprietor's request.

In **T 89/04** Mr D. was a vice president of the company OpenTV. Since the company ACTV, Inc. was recorded in the Register of European Patents as the patentee, OpenTV, which was a different legal person, was not a party to the proceedings in accordance with Art. 99(4) and 107, second sentence, EPC 1973. Decision **T 621/98**, to which the patentee/respondent referred, did not apply to the case at issue, since it dealt with a different situation, where the professional representative was accompanied by the patentee. Mr D. was considered to be a person accompanying the representative and, therefore, the criteria set out in decision **G 4/95** had to be met. A request which, as in this case, was made three days before oral proceedings, i.e. not sufficiently in advance, should, in the absence of exceptional circumstances, be permitted only if the opposing party agreed. Since the board saw no exceptional circumstances, and the appellant

(opponent) objected that he could not prepare himself properly, the board did not allow Mr D. to make oral submissions on behalf of the respondent (patentee) at the oral proceedings.

In **T 475/01** the board, exercising its discretion under the Convention and taking account of the criteria established by **G 4/95** allowed oral submissions by the persons accompanying both parties at the oral proceedings. Unlike the respondent, the board took the view that neither the EPC nor the above Enlarged Board decision could be held to imply that **a party that represented itself** in proceedings was to be treated differently to a professional representative in respect of oral submissions by accompanying persons.

In **T 1212/02** the appellant did not consent to a colleague of the representative of the respondent (opponent) making submissions before the board during oral proceedings. While the representative herself was authorised to act as a professional representative within the meaning of Art. 134 EPC 1973, the same was not true of her colleague, even though he too worked in the patent department of the same firm, the respondent's holding company, and was familiar with the case in point. The appellant (patentee) observed that no provision had yet been made under Art. 133(3) EPC 1973 to allow the employees of one legal person to represent another legal person. As the appellant had argued, it was true that no legal provision had been made for the representative of one company to be undertaken by an employee of another company connected with the former company. It was also true that it was a matter for the board's discretion to allow a person who was not the professional representative authorised for the case in point to make oral submissions on legal or technical issues before the board, provided the criteria established in **G 4/95** were met. To save time, the board in the case at issue decided on a pragmatic approach and allowed the professional representative's colleague to make submissions, but only after the representative had given an express assurance that she took full responsibility for such submissions.

In **T 754/08**, it had been announced that Mr R., a former patent attorney of the appellant (opponent) in this case, would make technical statements during the oral proceedings. It was not disputed that Mr R. had the knowledge of a technical expert in the field of the patent in suit. However, in the respondent's/patent proprietor's view, since Mr R. was the former patent attorney of the appellant in this case, his submissions would be those of a professional representative. Since he was not authorised to act in the latter function, he should not be allowed to speak during the oral proceedings. The board decided that the conditions set out in the decision **G 4/95** were applicable to **any accompanying person**. Therefore, there was no reason to exclude a former European patent attorney as such. Since the conditions were met the board saw no reason not to allow Mr R. to make oral submissions during the oral proceedings.

In **T 1693/10**, the appellant's representative had eventually withdrawn a sub-authorisation – challenged by the other party – given to a second professional representative with the result that this second representative had to be regarded as assisting the appellant's representative as an "accompanying person" within the meaning of **G 4/95**. Nevertheless, since at least one of the criteria laid down in that decision had

not been met (no request from the appellant that the accompanying person be permitted to make oral submissions), he was not authorised to address the board during the oral proceedings. The board, however, dismissed the objection raised by the respondent under Rule 106 EPC to the fact that the accompanying representative was beside the appellant's professional representative during the oral proceedings and not in the audience. One of the grounds for dismissal was that the respondent had failed to indicate how the mere presence of the accompanying person beside the appellant's professional representative infringed the rights invoked, which included the right to a fair hearing, a right not on the exhaustive list in Art. 112a(2) EPC. The board was in addition not competent to decide on possible conflicts of interest. The respondent's mere assertion that the accompanying person, who had worked for the firm of the respondent's representative, had had access to confidential information on the matter at issue had not been substantiated. Since the respondent had in any event not objected to the appellant's actual representative, there was no need to decide on the question.

Concerning the admissibility of oral presentations by three technical experts, the board in **T 2135/08** concluded that none of the three criteria i), ii) and iii) of **G 4/95** were met, among other reasons since the requesting party had failed to state -even at the oral proceedings- the qualifications of these three persons and to specify the subject-matter of their proposed oral submissions. In **T 1706/06**, quoting **G 4/95**, the board said that a request made shortly before the oral proceedings should, in the absence of exceptional circumstances, be refused unless each opposing party has agreed to the making of the oral submissions requested. In the case in point the patent proprietor did not agree. Moreover the board considered that the filing of the request for the technical expert of the opponent to be heard was made "shortly" before the oral proceedings. No exceptional circumstances existed; the board refused the request for the technical expert to be heard. To cite a different example, in case **T 1207/06** the patent proprietor questioned the admissibility of the presentation of submissions at the oral proceedings by the person accompanying the representative of the opponent, objecting that the accompanying person tried to **present the entire** opponent's **case**, which, according to **G 4/95**, was not allowed. The board in **T 1207/06** did not agree with this objection and was satisfied that the four criteria in **G 4/95** had been met.

The board in **T 302/02**, applying **G 4/95**, did not allow the expert to make submissions. If an expert were allowed to make submissions on subject-matter not specified in some detail beforehand, the other party or parties would be placed at a disadvantage since they could not prepare themselves properly, and this would be against the spirit and purpose of decision **G 4/95** and should only be permitted if none of the parties to the proceedings objects. In **T 1676/08**, concerning the admission of an oral presentation from the accompanying person, Mr L, the board examined one by one the four main criteria established in **G 4/95**. Referring also to **T 302/02**, the board ultimately refused to allow Mr L to make submissions on behalf of the appellants as an accompanying person at the oral proceedings.

In **T 2552/11**, the board did not permit oral submissions from Mr J. The statement by the appellant (opponent) that Mr. J would "refer to the prior art documents cited by the

opponent" was very general, and not sufficient to enable the respondent (patent proprietor) to prepare itself properly.

In **T 919/07**, where the requests in writing concerning oral submissions by accompanying persons did not indicate what such submissions could contribute to the evidence on the file, the board exercised its discretion by deciding that the accompanying persons should be heard in the event that the board wished to ask them questions.

In **T 520/07** the board did not share the respondent (patentee's view) that the appellant could not be surprised by its request, the same accompanying person having already made submissions in oral proceedings before the opposition division. In all procedural matters, appeal proceedings were completely separate from first-instance ones, so requests made in the latter had no effect for the former.

In **T 1687/08**, at oral proceedings held before the opposition division on 25 February 2008, the division had refused Mr J permission to speak on behalf of the patent proprietor/ appellant. The board found in the case at issue that the requirements for representation by a legal practitioner were fulfilled, i.e. that the letter dated 16 January 2008 represented an authorisation which established that Mr J was entitled to represent the patent proprietor. The board stated that from the minutes of the oral proceedings and the decision under appeal it was apparent that the opposition division had not considered Mr J to be a legal practitioner under Art. 134(8) EPC. Instead, it had treated him as an accompanying person, and therefore applied the requirements set out in decision **G 4/95** (OJ 1996, 412). In particular they had based their refusal to allow Mr J to speak on the failure of the patent proprietor to announce his intention that Mr J should be able to make oral submissions before the date set in the summons to oral proceedings pursuant to R. 71a EPC 1973. Since the patent proprietor had requested Mr J's participation in the oral proceedings as a legal practitioner under Art. 134(8) EPC, not as an accompanying person within the meaning of decision **G 4/95**, the division's decision not to allow him to speak had been taken under the wrong legal provision. The board concluded that such a denial by the opposition division of the right of representation had to be considered as a substantial procedural violation. Nor was the board convinced by the respondent's arguments that the authorisation in the letter of 16 January 2008 was late-filed because R. 71a EPC 1973 was applicable to the filing of authorisations. R. 71a(1) EPC 1973 concerned only the filing of "written submissions" and "facts and evidence"; authorisations did not fall into either of those categories. The decision under appeal was set aside, the case remitted and the appeal fee reimbursed.

In **T 1027/13**, on the day of the first instance oral proceedings, the chairman had categorically forbidden Mr H ("accompanying person" within the meaning of **G 4/95**) to address the opposition division and to communicate with Mr W (representative), apparently under the impression that Mr H had not only been present to make submissions regarding some specific legal or technical points, but had actually been **intending to present the complete case** in place of the **newly appointed representative** Mr W (former representative had fallen ill, shortly before the day of the oral proceedings). The patent proprietor and the opposition division had concluded that Mr H was trying to act as the representative of the opponent, thereby circumventing the

provisions of Art. 133 and 134 EPC. The patentee also contested that there was proper control and supervision by Mr W since he had declared that he was not prepared to defend the case in oral proceedings. It was disputed whether any submissions of Mr H would have then been made under the responsibility and continuing control of the authorised representative Mr W. No objective indications were at hand which could convincingly establish this. The question to be decided by the board was whether or not the categorical refusal to let Mr H make oral submissions or even communicate with the authorised representative merely amounted to a very strict but, nevertheless, correct exercise of discretionary power, still in line with the principles stated in **G 4/95** or, instead, to an inappropriate exercise of this discretion, going beyond the discretionary remit. The board stated that as a consequence of this conduct of the oral proceedings, the representative of the opponent appeared to have been totally deprived of any support he was expecting to get from the announced accompanying person Mr H, i.e. a person very familiar with all aspects of the case from its very beginning. The categorical refusal in effect had been keeping the opponent from taking position in an "efficient and effective manner" on the contentious issues of the case, which would also have included the obviously very important supporting oral contributions by Mr H. It could not be gathered from the minutes of the first instance oral proceedings that the criteria of **G 4/95** had actually been considered by the opposition division in deciding not to let Mr H speak. Considering this and the contradictory assertions of the parties regarding what had happened at the oral proceedings, the board concluded that it was not established that the criteria of **G 4/95** had actually been addressed as such.

In a communication the board in **T 8/13** stated that the request to allow another person who was not a professional representative to make submissions on behalf of the appellant (opponent) during the oral proceedings would not be allowable in view of the conditions set by Art. 134 EPC and having regard to decision **G 4/95**. In reply to the board's preliminary view expressed in its communication, the appellant argued that Ms. L, attending the oral proceedings together with the appellant, had closely followed the whole case from the beginning and should therefore have been allowed to present the case. Moreover, the appellant suffered from asthma and could therefore only plead the case with difficulty. Also, the appellant stated that it was at a disadvantage in view of the fact that the respondent was represented by two professional representatives. The board was not persuaded by these arguments and refused the appellant's request, as already preliminarily mentioned in its communication. Ms. L was neither a representative according to Art. 134 EPC nor was she presented as a technical expert to be heard on a technical question. The personal involvement with the case or her relationship to the appellant also did not qualify Ms. L to have made submissions as an accompanying person in accordance with the conditions set out in **G 4/95**. In regard to the appellant's medical condition, the appellant was informed by the board that it was prepared to interrupt the proceedings from time to time should this be required.

For a classic application of the requirements set out in **G 4/95** to a party's contention that, since the accompanying person was preparing for the European qualifying examination, he ought to be given a training opportunity, see **T 378/08**.

In case **T 1458/11** appellant 2 (patent proprietor) was represented by a professional representative, Mr Ch, accompanied by Mr H, a **trainee in the law firm** of Mr Ch. Mr H had not been announced prior to the oral proceedings before the opposition division. Appellant 2 requested that Mr H be allowed to speak "on selected issues during the oral proceedings under his (Mr Ch's) supervision and responsibility". Appellant 1 (opponent) agreed to this with the proviso that Mr H would "not make the complete case". The opposition division allowed Mr H to speak "on selected issues under Mr Ch's responsibility". After the impugned decision was pronounced, appellant 1 submitted that, according to its observations, Mr H had spoken "for more than 50% of the time" and that this was not what had been agreed at the beginning of the oral proceedings. According to **G 4/95**, the opposition division had the duty to ensure that the oral submissions made by an accompanying person satisfy the conditions that they are made **in addition to** the complete presentation of the party's case by its professional representative and under the continuing responsibility and control of the professional representative. According to appellant 1, the submissions made by Mr H did not comply with the conditions set forth in **G 4/95**, i.e. were not in addition to the complete presentation of appellant 2's case by the professional representative, Mr Ch. The board considered the submissions of the parties and the content of the **minutes of the oral proceedings** before the opposition division. It was not possible to establish, on an objective basis, whether the submissions made by the accompanying person were in addition to the complete presentation of the professional representative or whether they went beyond that or even amounted to a presentation of substantially the complete case of the party. It was incumbent on appellant 1 to inform the opposition division of any alleged negligence of the opposition division's duty as soon as it became aware of it. This immediate reaction was required since a party to the proceedings must take an active part and must on its own initiative submit in due time whatever will support its position (cf. **R 2/08**, point 8.5 of the Reasons). In the case at hand, appellant 1 should and could have informed the opposition division. Furthermore, nothing indicated that appellant 1 was taken by surprise or that it was not prepared, or at least could not have been prepared, for the oral submissions made by the accompanying person (**G 4/95**, point 10 of the Reasons, second paragraph). The board failed to see that a procedural violation occurred during the proceedings before the opposition division.

In **R 3/08** the question arose whether an accompanying person can validly raise a procedural objection pursuant to R. 106 EPC. However, in the circumstances this question did not need to be answered since, based on the affidavit of Mr S.L., it was credible that the professional representative himself explicitly supported his procedural objections. Even if, in the absence of further evidence, the exact circumstances of the representative's intervention was not established, the board was prepared to assume in favour of the petitioner that the objections raised in that phase of the oral proceedings met the requirements of R. 106 EPC.

### **5.3. Oral submissions by former members of the boards of appeal**

In **J 11/94** (OJ 1995, 596) the authorised representative was accompanied during oral proceedings by a former chairman of the Legal Board of Appeal who had retired about a year and a half previously. The professional representative requested permission for the



former board member to make submissions in addition to his own arguments. The case referred to the Enlarged Board therefore encompassed the question whether special criteria applied to the exercise of a board's discretion in relation to a request for the making of additional oral submissions by a former board of appeal member.

The Enlarged Board noted in **G 2/94** (OJ 1996, 401) that there was a potential conflict between what might be seen as a right of former board of appeal members to seek subsequent employment on the basis of their special knowledge by making oral submissions during proceedings before the EPO, and the need for proceedings before the EPO to be conducted free from any suspicion of partiality. The existence of such a potential conflict was well recognised in the context of national judicial systems where it was clear that persons accepting appointments as judges were subject to restrictions if they wished to work in private legal practice after having served as judges. The existence of such restrictions reflected the generally recognised principle of law that parties to legal proceedings were entitled to a fair hearing before judges who could not reasonably be suspected of partiality. It concluded that the above potential conflict had to be resolved with a view to avoiding any suspicion of partiality during the conduct of proceedings before the EPO. The public interest in the proper conduct of proceedings before the EPO had to prevail over the personal interests of former board of appeal members who wished to make oral submissions on behalf of parties to the proceedings.

It was therefore necessary to place **restrictions** on the admissibility of such oral submissions, at least for a reasonable period of time following termination of a person's appointment as a member of a board of appeal. In the absence of specific legislation, the point in time following termination of his or her appointment after which a former member of the boards of appeal might make oral submissions in proceedings before the board of appeal was **a matter within the judicial discretion** of the boards of appeal. The Enlarged Board found that during either ex parte or inter partes proceedings, a board of appeal should refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, unless it was completely satisfied that **a sufficient period of time** had elapsed following termination of such former member's appointment to the boards of appeal, so that the board of appeal could not reasonably be suspected of partiality in deciding the case if it allowed such oral submissions to be made.

The board of appeal should normally refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, until at least **three years** have elapsed following termination of the former member's appointment to the boards of appeal. After three years have elapsed, permission should be granted except in very special circumstances. Before the expiry of three years, there would normally be too great a risk that the public would consider the making of such submissions in oral proceedings to give an unfair advantage to the party on whose behalf a former member appeared.

**T 585/06** dealt with the presence of a former member of the boards of appeal at the oral proceedings before the opposition division and acting as consultant of the patent proprietor. The former member had not acted as an authorised representative but only

as the patent proprietor's consultant. He had not addressed the opposition division. This amounted to an important difference from the facts of case **G 2/94** (see Chapter IV.E.8.4.6 g) "Reimbursement of Appeal Fee - Partiality").

#### **5.4. Oral submissions by qualified patent lawyers of non-EPC contracting states**

Another question of law decided in **G 4/95** above was whether, having regard in particular to the provisions of Art. 133 and Art. 134 EPC 1973, a person who was not qualified in accordance with Art. 134 EPC 1973 but was a qualified patent lawyer in a country which was not an EPC contracting state might present some or all of a party's case as if he were qualified under Art. 134 EPC 1973. The Enlarged Board decided that no special criteria applied to the making of oral submissions by qualified patent lawyers of countries which were not contracting states to the EPC. The criteria set out above were equally applicable to such patent lawyers (see **T 774/05** with respect to "US patent attorney", and **T 756/09**, below, with respect to "Australian patent attorney").

In case **T 756/09**, the request for oral submissions by Dr M, an Australian patent attorney, was made only ten days before the oral proceedings and the appellant (opponent) had denied its agreement both in writing and at the beginning of the oral proceedings. Hence, according to the case law of the boards of appeal, a person accompanying the professional representative should not be allowed to make oral submissions unless exceptional circumstances could be identified. In support of its request, the respondent (patent proprietor) essentially submitted that Dr. M would not make submissions in the capacity of a technical expert, but as a patent attorney who was very familiar with the case, had advised the professional representative before the oral proceedings and would continue to do so during the oral proceedings. Taking into account the circumstances of the case, in particular that Dr. M was not a technical expert and thus was **not** expected to elaborate on technical aspects of the case in a manner which might take the appellant **by surprise**, the board concluded that submissions made directly by Dr. M under the supervision of the professional representative would not put the appellant (opponent) at a disadvantage and might contribute to an efficient debate. Hence, despite its late filing, the board decided to accede to the respondent's request for oral submissions by an accompanying person with the proviso that such submissions would be stopped if new technical facts or arguments were introduced into the debate.

#### **6. Distinction between presentation of facts and evidence and presentation of arguments**

In **G 4/95** the Enlarged Board noted that the distinction between the presentation of facts and evidence, on the one hand, and the presentation of arguments, on the other hand, was of basic importance under the EPC. It noted, as discussed in **T 843/91** (OJ 1994, 818), a practice developed in the boards of appeal "to allow contributions by experts under the control of the authorised representative when it considers it would be useful for the good understanding of the case", thus mirroring the practice within the opposition division. In decision **T 843/91** it was suggested that the legal basis for admitting such oral submissions by "experts" was Art. 117 EPC 1973. In this connection, the Enlarged Board did not accept that Art. 117 EPC 1973 provided a legal basis for

hearing oral submissions by an accompanying person involving the presentation of facts and evidence, as was suggested in decision **T 843/91** for example. Art. 117 EPC 1973 and its implementing rules, R. 72 to R. 76 EPC 1973, were solely concerned with setting out the procedure relevant to the formal "taking of evidence". Such procedure necessarily involved as a precondition for its use the making of a decision to take evidence within the meaning of Art. 117 EPC 1973, and that decision had to set out all the matters prescribed in R. 72(1) EPC 1973, as the first stage in the procedure.

## S. Guidelines for Examination in the European Patent Office

1.	Guidelines not binding on boards	828
2.	Guidelines binding (in principle) on departments of first instance	830
3.	The boards' application of the Guidelines in specific cases	832

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In accordance with Art. 10(2)(a) of the European Patent Convention (EPC), the President of the European Patent Office (EPO) adopted, effective as at 1 June 1978, the Guidelines for Examination in the European Patent Office. By decision of the President dated 28 July 2015 the Guidelines have been amended pursuant to Art. 10(2) EPC in accordance with the policy of revising them annually. The **version in force** at the time of this case law report's publication is the **November 2015** edition (available online at [www.epo.org](http://www.epo.org)), and this is the only valid official version as from 1 November 2015 (OJ 2015, A74, concerning updating of the Guidelines). Please note that the Guidelines do not constitute legal provisions. For the ultimate authority on practice at the EPO reference should be made firstly to the EPC itself, including the Implementing Regulations, and secondly to the interpretation put upon the EPC by the boards of appeal and the Enlarged Board of Appeal (Guidelines, General Part, 3 "General remarks" – November 2015 version). Apart from important issues relating to interlocutory revision, the Guidelines do not deal with the appeals procedure (Guidelines, General Part, 5 "Survey of the processing of applications and patents" – November 2015 version).

It should be borne in mind that the edition of the Guidelines referred to in the following abstracts of board decisions is that applied by the board in question and may have been worded differently from the November 2015 version.

### 1. Guidelines not binding on boards

The Guidelines for Examination are not binding on the boards of appeal (settled case law; see, for instance, **T 1561/05** of 17 October 2006, point 1.5 of the Reasons).

In **T 1561/05** the board confirmed that the Guidelines for Examination in the EPO were not binding on the boards of appeal (applying **T 162/82**, OJ 1987, 533). **T 1561/05** of 17 October 2006 is also referred to in **J 7/10**.

In **T 740/98** the board noted, among other things, that the legal system established under the Convention did not treat the Guidelines as binding.

In **T 1356/05** (also **T 1360/05**) the board stated that no provision of the Guidelines could override an article or rule of the EPC.

In **T 500/00** the appellant argued that the disclaimer had been made in good faith according to the Guidelines and in accordance with the practice of the boards of appeal at the time of making the disclaimer. The board pointed out that the Guidelines were not

rules of law and noted that what counted was not whether the opposition division had acted in accordance with the Guidelines, but whether it had acted in accordance with the Convention. In any event, the principle of good faith could not have been successfully invoked in this case.

In **T 552/02** the appellants (proprietors) essentially based their assertion on a passage in the Guidelines. They also submitted that Art. 15(2) RPBA (as in force until 12 December 2007) obliged the board to state its grounds if it gave a different interpretation of the EPC 1973 to that provided for in the Guidelines. On the latter point the board said (a) that the members of the board were not bound by any instructions and had only to comply with the provisions of the EPC 1973, which meant the board was not bound by the Guidelines, and (b) that Art. 15(2) RPBA 2003 did not oblige the board to state grounds for deviating from the Guidelines but simply stipulated that it should "state the grounds for its action if it consider[ed] that [its] decision [would] be more readily understood in the light of such grounds".

As to the alleged lack of consistency between what was in fact the established case law and the Guidelines for Examination, the board in **T 1741/08** noted that it was not bound by the Guidelines, an important factor in the judicial independence of the boards of appeal (Art. 23(3) EPC). An alleged divergence between the Guidelines for Examination and case law therefore could not be a sufficient basis for challenging the case law by means of a **referral** to the Enlarged Board of Appeal.

The board in **T 2311/10**, unlike the examining division, found that in connection with amendments the three-point or essentiality test (see Guidelines H-V, 3.1 and 3.2.1 – June 2012 version) was unhelpful or even misleading when assessing the admissibility of an intermediate generalisation taken from the description for the purpose of delimitation from subsequently identified prior art. Since the November 2014 version, the Guidelines no longer refer to the three-point or essentiality test (**T 331/87**) in the context of intermediate generalisations.

The appellant (applicant) in **T 1363/12** relied on the revised Guidelines (H-IV, 2.3 – November 2014 version [NB: Guidelines H-IV, 2.2, last paragraph – November 2015 version]) in support of a general submission that a more lenient standard than the "gold" standard should be applied when assessing compliance with Art. 123(2) EPC. Quite apart from the fact that the boards of appeal are not bound by the Guidelines for Examination, as was acknowledged by the appellant, it is to be noted that the principles established by the Enlarged Board of Appeal for the assessment of the requirement of Art. 123(2) EPC could not be changed **by issuing amended Guidelines**. Consequently, the appellant's suggestion that the above statement was somehow applicable at the time of the oral proceedings before the board was wrong: there had been no change in the standard to be applied under Art. 123(2) EPC. Furthermore, while the passage from the Guidelines might well be correct when applied to particular factual situations similar to that which arose in **T 2619/11**, any more general principle could not be derived from this decision.

The fact that the Guidelines are not binding on the boards of appeal does not mean that the boards do not apply them or quote them as a source of inspiration (see in this chapter III.S.3).

## **2. Guidelines binding (in principle) on departments of first instance**

The Guidelines state (General Part, page 5, point 3 – November 2015 version): "The Guidelines are intended to cover normal occurrences. They should therefore be considered only as general instructions. The application of the Guidelines to individual European patent applications or patents is the responsibility of the examining staff and they may depart from these instructions in exceptional cases. Nevertheless, as a general rule, parties can expect the EPO to act in accordance with the Guidelines. ... It should be noted also that the Guidelines do not constitute legal provisions. For the ultimate authority on practice in the EPO, it is necessary to refer firstly to the European Patent Convention".

In **T 647/93** (OJ 1995, 132) the board stated that it was normally desirable for examining divisions to act in accordance with the Guidelines, but pointed out that these were not rules of law, so failure to follow a procedure set out in them was not in itself a substantial procedural violation (**T 51/94**, **T 937/97**).

In **T 162/82** (OJ 1987, 533) and **T 42/84** (OJ 1988, 251), two boards of appeal ruled on the discretionary power of examining divisions to depart from the EPO Guidelines. According to these two decisions, the Guidelines were only general instructions intended to cover normal occurrences. Thus, an examining division could depart from them provided it acted in accordance with the EPC. In reviewing the decision of an examining division, a board of appeal would wish to ensure uniform application of the law and judge whether the division had acted in accordance with the Convention, not whether it had acted in accordance with the Guidelines.

In **T 500/00** the board noted that what counted was not whether the opposition division had acted in accordance with the Guidelines, but whether it had acted in accordance with the Convention.

In **T 1388/10**, the board observed that the Guidelines merely offered general guidance covering normal occurrences. Their application in specific individual cases was the responsibility of the examining division, which could depart from them in exceptional cases. Also, the Guidelines were not the law – unlike the EPC and its Implementing Regulations. When reviewing examining division decisions, the boards did not assess whether the division had complied with the Guidelines. Rather, they considered whether it had exercised its discretion within the limits set by the EPC and its Implementing Regulations.

In **T 905/90** (OJ 1994, 306, Corr. 556) the board held that specific communications or other actions within the framework of particular proceedings and official statements such as guidelines were not the only sources of legitimate expectations; these could also properly arise from the actual general conduct or established practice of organs of the

EPO. All changes in these practices should be officially announced at the earliest possible moment in order to avoid misleading the parties.

In **J 27/94** (OJ 1995, 831) the board stated that there might be cases in which the public had a legitimate expectation that the department of first instance would not deviate from the established case law. This might apply if the relevant case law had become enshrined in the consistent practice of the department of first instance, and in particular if this had been made known to the public in published Guidelines, Legal Advice or Notices from the EPO. In such a situation, an applicant might legitimately expect that a practice allowing or even recommending a particular way of proceeding would not be changed without appropriate advance information. In the case at issue, the Guidelines had remained unchanged, which in fact led to the reasonable expectation that the practice based on them would likewise not be changed. The department of first instance processing this case had therefore not been obliged by the principle of the protection of legitimate expectations.

The board in **T 1607/08** recalled that the Guidelines published by the EPO were one of the sources of legitimate expectations. Therefore, where the Guidelines gave the clear indication that the continuation of the opposition proceedings had to be communicated to the patent proprietor, the latter was entitled to expect that such information would be given before a decision on the substantive issues was issued. Otherwise, as in the case at issue, the decision to revoke the contested patent would come as a surprise to the patent proprietor.

In **T 182/90** (OJ 1994, 641), **T 119/91**, **T 523/91**, **T 366/92** and **T 397/94** the boards of appeal stated that it was **not** a substantial procedural violation within the meaning of R. 67 EPC 1973 if a request to be called back by or have an interview with the primary examiner was ignored. It was a matter for the examiner's discretion to decide whether to conduct such informal discussions in accordance with the Guidelines, bearing in mind the particular circumstances of the case (see also **T 300/89**, OJ 1991, 480).

The examining division's failure to follow a procedure set out in the Guidelines is not in itself a substantial procedural violation unless it also constitutes a violation of a rule or principle of procedure governed by an article of the Convention or one of the Implementing Regulations. This is because the Guidelines are not legally binding (**T 42/84**, OJ 1988, 251; **T 51/94**, **J 24/96**, OJ 2001, 434).

In **T 246/08** the board noted that the Guidelines for Examination indicated Art. 113(2) EPC 1973 as the legal basis for refusing an application in the circumstances of the case before it, i.e. in which no agreed claim text existed. The board, however, preferred the approach of the examining division (see Art. 78(1)(c) EPC 1973). It held that although an examining division should normally apply the Guidelines, failure to do so was neither a mistake in law nor a procedural violation. For the reasons set out, in this particular instance the board saw the deviation as a matter for approval rather than reproach.

In **T 313/10** the examining division had argued, using their own criteria, that a method performed by a computer was excluded. This was contrary to the established jurisprudence as set out in the Guidelines.

In **J 29/10**, point 2.3 of the Reasons, the Legal Board referred to the General Part of the Guidelines, as then worded, before going on to explain what matters, in its view, the Guidelines were not intended to cover.

In **T 1020/15** the board cited, in addition to applicable EPC provisions, numerous passages from the Guidelines (E-IX, 1.2; C-VIII, 1, 3 and 4; G-IV, 7.5.3; E-X, 7.1(i), 7.3 and 7.4) in support of its finding that the examining division's decision was vitiated by four substantial procedural violations.

According to the board in **T 755/14**, contrary to the appellant's view, although the search and examining divisions had failed to follow the procedure established in the Guidelines for considering unity, their substantively incorrect assessment of the unity issue could not be regarded as or equated to a substantial procedural violation within the meaning of R. 103(1) EPC, especially as the Guidelines were not legally binding. The board was also unable to identify any substantial procedural violation in the action then taken by the examining division.

### **3. The boards' application of the Guidelines in specific cases**

Although the boards are not bound by the Guidelines, this does not mean that they do not take them into account or turn to them for inspiration when reaching their decisions. It should be borne in mind that the edition of the Guidelines referred to in the decisions summarised below to illustrate the related case law is that applied by the board in the specific case concerned and not necessarily that currently in force (November 2015 version).

In **T 651/91** the board cited with approval the Guidelines, confirming that a generic disclosure did not normally deprive any specific example falling within that disclosure of novelty.

In **T 523/89** the board saw no reason to disagree with the general principle of interpretation laid down in the Guidelines.

In **T 631/97** (OJ 2001, 13) the board found that the interpretation of R. 46(1) EPC 1973 was in agreement with that of the Enlarged Board of Appeal in Opinion **G 2/92**. It also found that the Guidelines were fully consistent with **G 2/92** and R. 46 EPC 1973.

In **T 587/98** (OJ 2000, 497) the board found that the claims were not "conflicting" claims within the meaning of the Guidelines.

The Enlarged Board in **G 3/14** (OJ 2015, A102) observed that neither the EPC itself nor the Implementing Regulations made any distinction between independent and dependent claims when it came to their compliance with the requirements of the EPC at



the examination stage. Although not part of the express legal framework of the EPC, the Guidelines likewise made no distinction between independent and dependent claims when it came to objections of lack of clarity (see e.g. Part F-IV, 4.1 – November 2014 version; this part is unchanged in the November 2015 version).

In **T 32/95** (ex parte) the board found that, once the applicant had indicated sound reasons for doubting whether a cited document belonged to the state of the art, the examiner should have acted as recommended in the Guidelines, i.e. not pursued the matter further if additional investigation failed to produce sufficient evidence to remove that doubt.

In **T 802/97** the board noted that when applying Art. 96(2) EPC 1973, the established practice of the examining divisions was set out in particular in the Guidelines for Examination in the EPO.

In **T 946/96** the board noted that if an examining division refused its consent to a further amendment under R. 86(3) EPC 1973, the recognised correct procedure for the examining division to follow was clearly set out in the Guidelines.

In **T 300/89** (OJ 1991, 480) the board held, in relation to the appellant's complaint as to the failure of the examiner to telephone as requested, that the practice in relation to such informal communications was clearly set out in the Guidelines.

In **T 839/95** the board noted that an interlocutory decision in the case of an allowable auxiliary request was foreseen in the instructions to examiners only for auxiliary requests in opposition proceedings.

In **T 736/95** (OJ 2001, 191), having regard to the Enlarged Board of Appeal's decisions in **G 10/91** (OJ 1993, 420) and **G 1/95** (OJ 1996, 615) and to the Guidelines for Examination in the EPO, the board concluded that the department of first instance at least had to examine whether a fresh ground was relevant. The aim of first-instance proceedings was to avoid invalid patents.

The applicant's request "to render a decision on the record" was not to be construed as a waiver of the right to a fully reasoned first-instance decision, even in the light of the suggested procedure in the Guidelines (see **T 1309/05**, **T 583/04**).

In **T 1709/06** the board noted that although the Guidelines for Examination E-X, 4.4, suggested a procedure for issuing a decision "on the state of the file" taking a standard form, a number of decisions of the boards of appeal (see **T 1309/05**, **T 1356/05**) had pointed out that such a standard decision form did not meet the "reasoned" requirement of R. 68(2) EPC 1973 (now R. 111(2) EPC).

In **T 1123/04** the board noted that R. 68(2) EPC 1973 (now R. 111(2) EPC) stipulated that decisions of the European Patent Office which were open to appeal had to be reasoned. The criteria for the "reasoning" were, for instance, elaborated in the Guidelines.

The board in **T 1741/08** remarked that it would seem that while the statement in Guidelines G-II, 3.7, was not actually inconsistent with the case law of the boards of appeal, the optimistic tone might sometimes mislead (potential) applicants.

The reasons given in the EPO notice of 8 November 2013 on handwritten amendments for changing a practice that had been applied for years at first instance and was also recognised in the Guidelines do not warrant changing the established practice of the boards of appeal and the related case law (**T 37/12**, citing **T 1635/10**, point 5 of the Reasons).

With regard to the requirements of Art. 84 EPC, the appellant in **T 1882/12** argued that Guidelines C-III, 4.9 [F-IV, 4.9 in the November 2015 version] on optional features did not impose a ban on the terms "preferably", "preferred" and "more particularly" to which the examining division had objected, but rather required that they be looked at carefully in their specific context to ensure that they did not introduce ambiguity. In the appellant's view the examining division's procedural violation was essentially that it had incorrectly assessed the clarity requirement because the claim wording in the case in point had not been carefully examined, which was **inconsistent with the Guidelines and hence contrary to the principle of equal treatment**. Yet the mere fact that other examining divisions had not raised such objections in similar cases did not imply a breach of the principle of equal treatment. As the appellant itself had submitted, the Guidelines prescribed a careful examination.

In **T 1060/13** the board, in explaining the conditions under which interlocutory revision must be granted by the examining division, drew attention to an inconsistency both in the Guidelines of June 2012, applicable to the case, and with the version of September 2013. However, the text quoted has been amended in the meantime and is no longer to be found as such in the Guidelines dated November 2015 (E-X, 7.4.2). In particular, the reference to the obiter dictum has been deleted.

In **T 2068/14** the board had to consider whether the decision of the examining division was adequately reasoned. The board endorsed the following statement in the Guidelines, as it reflected the jurisprudence of the boards of appeal: "It is particularly important that special attention should be paid to important facts and arguments which may speak against the decision made. If not, the impression might be given that such points have been overlooked" (Guidelines of September 2013, then applicable (idem Guidelines November 2015, E-IX, 5, Reasoning of decisions).

## IV. PROCEEDINGS BEFORE THE EPO

### A. Preliminary and formalities examination

1.	Introduction	836
2.	Responsibility for formalities examination	836
3.	Where and how applications may be filed	837
4.	Persons entitled to file application	837
5.	Accordance of a date of filing	838
5.1.	Requirements for according a date of filing	838
5.2.	Identity of the applicant	840
5.2.1	Requirement for information identifying the applicant (Rule 40(1)(b) EPC)	840
5.2.2	Correction of designation of applicant (Rule 139 EPC)	840
5.3.	Legal effect of accordance of a date of filing	841
5.4.	Subsequent filing of missing parts of the description or missing drawings (Rule 56 EPC)	842
5.4.1	Legal provisions	842
5.4.2	Interpretation of Rule 56 EPC	843
5.4.3	Whether to apply R. 56 EPC or R. 139 EPC	844
5.5.	Corrections under Rule 139 EPC	845
5.5.1	Legal provisions	845
5.5.2	No replacement of invention	845
5.5.3	Extent of competence of the Receiving Section	847
5.6.	Change of date of filing	847
6.	Examination of formal requirements	848
6.1.	Requirements of a European patent application (Article 78 EPC)	849
6.2.	Designation of the inventor	850
6.3.	Any other requirement laid down in the Implementing Regulations	851
6.3.1	General provisions governing the presentation of application documents (Rule 49 EPC)	851
7.	Designation of states	851
7.1.	Legal provisions	851
7.2.	Effect of non-payment of the designation fee	852
7.2.1	Deemed withdrawal	852
7.2.2	Designation of states in divisional applications	852
7.2.3	No correction of non-payment of fee under R. 88 EPC 1973	853
7.3.	Correction of designation of states (Rule 139 EPC)	853
8.	Priority	855
8.1.	Filing of priority documents	855
8.2.	Correction of priority declarations	855
8.2.1	Introduction	855
8.2.2	Correction of priority declarations under R. 88 EPC 1973	855
	a) Requirement for mistake to have been made	855
	b) Time limit for request for correction	856
8.2.3	Rule 52(3) EPC	858
9.	Deemed withdrawal of the application (Rule 100(3) EPC)	858
10.	Publication of the application	859

## 1. Introduction

The EPO first examines whether a patent application satisfies the requirements for the **accordance of a date of filing** in accordance with the Implementing Regulations (Art. 80 EPC, Art. 90(1) EPC and R. 40 EPC). Only if an application is accorded a date of filing is the **examination as to formal requirements** commenced (Art. 90(3) EPC).

## 2. Responsibility for formalities examination

Under Art. 16 EPC, the Receiving Section is responsible for the examination on filing and the examination as to formal requirements of European patent applications. It retains responsibility up to the time when the Examining Division becomes responsible for the examination of the European patent application under Art. 94 EPC (R. 10 EPC).

The limitation in time of the Receiving Section's responsibility was previously in Art. 16 EPC 1973. The move to the Implementing Regulations ensures greater flexibility in determining when competence passes within the EPO from one department to another.

The Receiving Section is also no longer limited to the EPO's branch in The Hague as it was under Art. 16 EPC 1973. According to **T 1012/03**, the amendments to Art. 16 and 17 EPC deleting the allocation of the Search Divisions and Receiving Section to the branch at The Hague clearly indicate that the EPC no longer restricts the competence of the President of the EPO to decide which transactions shall be carried out at Munich and which at The Hague.

In **G 1/02** (OJ 2003, 165) the Enlarged Board of Appeal pointed out that Art. 90 EPC 1973 and Art. 91 EPC 1973 entrusted to the Receiving Section certain duties relating to formalities examination of applications on filing, and the section's decisions may give rise to a loss of rights (see Art. 91(3) EPC 1973) which are appealable (see Art. 106 EPC 1973). The Receiving Section is composed entirely of formalities officers who - just like their counterparts working with opposition divisions - receive specialist training but are not required to have studied a technical subject or law at university.

In **J 18/84** (OJ 1987, 215) the Legal Board of Appeal distinguished the respective areas of responsibility of the Receiving Section and the Legal Division regarding the designation of the inventor. The examination of an initial designation of inventor complying with Art. 81 EPC 1973 fell exclusively to the Receiving Section as one of its formalities examination responsibilities under Art. 16 and 91 EPC 1973. (These responsibilities are now in Art. 16 and 90(3) EPC). However, once entries began in the Register of European Patents - which under Art. 127, 2nd sentence, EPC 1973 coincided with the publication of the European patent application - the Legal Division might be competent for disputed corrections.

In **J 13/02**, the board took the view that the fact that the EPC 2000 versions of Art. 16 to 18 EPC were already applicable in accordance with Art. 6 of the Revision Act did not alter the fact that the Receiving Section's competence came to an end once a valid request for examination has been made with the result that the examining division had to examine whether the application met the requirements of the EPC 1973 (Art. 94(1) EPC 1973 in conjunction with Art. 96(2), 97(1) and 97(2) EPC 1973).

See in this chapter IV.A.5.5.3 for the extent of competence of the Receiving Section in respect of requests for correction under R. 139 EPC.

### **3. Where and how applications may be filed**

Under Art. 75 EPC a European patent application may be filed with the EPO or, if the law of a Contracting State so permits, (and subject to Art. 76(1) EPC) with the central industrial property office or other competent authority of that State.

According to **J 3/80** (OJ 1980, 92), the obligation to forward European patent applications filed nationally to the EPO rests upon the relevant central industrial property office and not upon the applicant (see also **J 1/12** in this chapter IV.A.5.1; see also Chapter III.E.2.2 "Time limit for applicant to observe").

The form of filing is regulated by R. 2 EPC and may be by hand, by post or by technical means of communication. Details and conditions are laid down by the President of the EPO. Documents purporting to be documents filed subsequently for the purposes of R. 2(1) EPC must be deemed not to have been received if they are filed with technical means not approved by the President of the EPO (**T 765/08**).

### **4. Persons entitled to file application**

A European patent application may be filed by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it (Art. 58 EPC). An application may also be filed either by joint applicants or by two or more applicants designating different Contracting States (Art. 59 EPC).

In proceedings before the EPO, the applicant is deemed to be entitled to exercise the right to a European patent (Art. 60(3) EPC). This fiction only relieves the EPO of any need to investigate the existence of the entitlement. However, when a person referred to in Art. 60(1) EPC, other than the applicant, disputes the entitlement to the grant of a European patent, the entitlement may be modified under the conditions provided for in Art. 61 EPC.

The Enlarged Board held in **G 3/92** (OJ 1994, 607) that when it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Art. 61(1) EPC, files a new European patent application in respect of the same invention under Art. 61(1)(b) EPC, 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.

## **5. Accordance of a date of filing**

### **5.1. Requirements for according a date of filing**

The date of filing of the European patent application shall be the date on which the requirements laid down in the Implementing Regulations are fulfilled (Art. 80 EPC, which is applicable to European patent applications filed on or after 13.12.2007). Detailed provisions concerning the requirements have been moved to the Implementing Regulations (R. 40 EPC). The requirements include:

- an indication that a European patent is sought;
- information identifying the applicant or allowing the applicant to be contacted (see in this chapter IV.A.5.2);
- a description or reference to a previously filed application.

The patent application must be filed with the EPO or other competent authority in accordance with Art. 75(1) EPC.

If a date of filing cannot be accorded following the examination under Art. 90(1) EPC, the application is not dealt with as a European patent application (Art. 90(2) EPC).

According to **G 2/95** (OJ 1996, 555), Art. 80 EPC 1973 stipulated the minimum requirements which had to be met in order for a filing date to be accorded. According to Art. 80(d) EPC 1973 (see now R. 40 EPC), the documents filed by the applicant had to contain a description and one or more claims (in accordance with Art. 14 EPC 1973, which was substantially amended in the EPC 2000). However, the description and claims did not have to comply with the other requirements of the EPC 1973. It was sufficient for the application documents to clearly contain a description and one or more claims. However, if they did not contain a description or claims, the requirements for according a filing date under Art. 80(d) EPC 1973 were not met and could not be created subsequently by way of a correction under R. 88 EPC 1973 (see now R. 139 EPC and this chapter IV.A.5.5). If the application documents met the requirements of Art. 80 EPC 1973, the European patent application was accorded a filing date.

In **J 18/86** (OJ 1988, 165) the board stated that under R. 24 EPC 1973 in conjunction with Art. 75(1)(b) EPC 1973 the date of filing of a European application was always the date on which the application documents were actually received, either by the EPO directly or by a competent national authority. Nothing in the EPC 1973 admitted of the possibility of applying a provision of any national law to the determination of the date of filing of a European patent application.

In **J 4/87** (OJ 1988, 172), the board held that in the event of an unforeseeable postal delay causing non-compliance with a time limit, if R. 85(2) EPC 1973 (relating to general interruption or subsequent dislocation in the delivery of mail in a Contracting State) was not applicable so as to extend the time limit, the EPO had no discretion to extend it. Applying the principles set out in **J 18/86** above, the date of filing was the actual date of receipt by the EPO or a competent national authority. See also **J 13/05**.

In **J 12/05**, the Legal Board, citing **J 4/87** and **J 18/86**, held that the EPC did not permit backdating of the filing date. It went on to state that, even where the conditions for extending the priority period under either R. 84a EPC or R. 85 EPC were met, this did not result in a change of the actual filing date. Instead, there arose a legal fiction that the priority period had been observed, even though the filing date was actually later than that period's expiry date.

In **T 382/94** (OJ 1998, 24), the claims and description had been filed in German, but the drawings contained text matter in English. The board held that the EPC 1973 did not make the accordance of a filing date dependent on any text matter in the drawings being in a language in accordance with Art. 14(1) or (2) EPC 1973. If the drawings were filed in full on the date of filing, they formed part of the application as filed, even if they contained text matter in an official language other than the language of proceedings. The language requirements for a European patent application were amended under the EPC 2000, see Chapter III.F.1 "Language of filing and date of filing of a European patent application".

In **J 1/12** the appellant had filed a European patent application with the UK Patent Office with the same documents as those underlying the later application before the EPO. The application in the UK never reached the EPO. The Legal Board therefore had to consider whether, contrary to Art. 80 EPC 1973, it was justified to assign the application the earlier filing date (Art. 75(1)(b) EPC 1973). Art. 77(2) EPC 1973 provides that European patent applications filed within the member states are to be forwarded to the EPO within six weeks after filing. Art. 77(5) EPC 1973 supplements this provision by providing that European patent applications which do not reach the EPO before the specified time limit are deemed to be withdrawn. It followed that the application filed with the UK Patent Office was deemed to have been withdrawn. No re-establishment of rights is provided for. In such a situation the legislator expressly provides in the last sentence of Art. 77(5) EPC 1973 for the refund of the filing, search and designation fees. In addition, Art. 135(1)(a) and 136(2) EPC provide facilities for a conversion of the lost European patent application into national patent applications. It followed that the legislator of the EPC clearly recognised the harsh consequences of Art. 77(5) EPC 1973 for an applicant. But, having recognised the problem, the legislator did not provide the applicant with any means to regain the lost application.

## 5.2. Identity of the applicant

### 5.2.1 Requirement for information identifying the applicant (Rule 40(1)(b) EPC)

R. 40(1)(b) EPC provides that the date of filing of a European patent shall be the date on which the documents filed by the applicant contain, inter alia, 'information identifying the applicant or the allowing the applicant to be contacted'. (The latter option was added in the EPC 2000). The requirement for information identifying the applicant was previously contained in Art. 80(c) EPC 1973.

In **J 25/86** (OJ 1987, 475) it was pointed out that the requirement under Art. 80(c) EPC 1973 for "information identifying the applicant" was to be considered as having been met whenever it was possible to establish beyond reasonable doubt the identity of the applicant on the basis of all data contained in the documents filed by the applicant or his representative.

As noted in this chapter IV.A.4, under Art. 60(3) EPC the EPO assumes the applicant to be entitled to the European patent.

In **T 948/10** the EPO was wrongly informed that the applicant company's name had changed, and amended it accordingly. As neither the appellant's representative nor the examining division/Client Data Registration department had had any reason to believe that the party to the proceedings was anyone other than the original applicant, the board found that this error did not invalidate the procedural steps taken taken by the applicant before the first-instance departments ("falsa demonstratio non nocet"), and that the EPO should correct the mistake itself.

### 5.2.2 Correction of designation of applicant (Rule 139 EPC)

Under R. 139 EPC linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request. The decisions below consider the application of the EPC 1973 (R. 88 EPC 1973, which was not amended in substance). The provisions concerning identification of the applicant have been amended (see in this chapter IV.A.5.2.1).

In **J 7/80** (OJ 1981, 137), the board held that if the wrong applicant was named in an application and the wrong applicant and the correct applicant were both companies forming part of the same group of companies then the mistake could be corrected under R. 88 EPC 1973, if there was sufficient evidence to support the request for correction.

Following **J 7/80** (OJ 1981, 137) it was held in **J 18/93** (OJ 1997, 326), **J 17/96** and **J 31/96** that a correction substituting the name of the applicant was allowable under R. 88 EPC 1973 if there was sufficient evidence to support the request for correction. This rule was not in conflict with the provisions of Art. 61 EPC 1973, which concerned ownership disputes. R. 88, second sentence, EPC 1973 was not applicable. It was only necessary to verify whether there was sufficient evidence to support the request under R. 88 EPC 1973 for correction of the applicant's name; where the correction of a mistake



was requested and R. 88, second sentence, EPC 1973 was not applicable, the EPO had to be satisfied that a mistake had been made, what the mistake was and what the correction should be. In **J 8/80** (OJ 1980, 293), the board added that, in order to avoid any abuse, the burden of proving the facts had to be a heavy one.

A correction under R. 88, first sentence, EPC 1973 was retroactive to the original date of filing (**J 3/91**, OJ 1994, 365; **J 2/92**, OJ 1994, 375) and the application was restored to the form which it should have taken on the filing date if the error had not been made (**J 4/85**, OJ 1986, 205).

In **J 17/97** and **J 18/97** the representative had filed the parent application in the name of Int. Inc., but the divisional application in the name of S.medica. Due to the different identities of the applicants, the Receiving Section had refused to treat the application as a divisional application. In its decisions, the Legal Board did not allow the request for correction to replace the name of the applicant of the divisional application with the name of the applicant of the parent application pursuant to R. 88 EPC 1973 because the appellant had not proved that the divisional application had been filed in error by S.medica and should have been filed by Int. Inc.

### **5.3. Legal effect of accordance of a date of filing**

According to **T 1409/05** (OJ 2007, 113) a legally effective - in the terminology of the EPC, an accorded - filing date had several different legal effects. Amongst others:

(a) it marked the beginning of the pendency of a European patent application; Art. 80 EPC 1973 in conjunction with Art. 90(1)(a), 90(2) EPC 1973;

(b) it marked the notional date on which the applicant formally claimed to have deposited his invention with the EPO; and

(c) the filing date defined the state of the art and hence the extent of search and examination, for the purposes of Art. 54(2) and (3) EPC 1973.

The legal effects (a) to (c) ensued immediately when the filing date was accorded. Further legal effects of the filing date unfolded upon publication of the patent application:

(d) It marked the date which counted as the filing date so as to affect other applications for the purposes of Art. 54(3) EPC 1973.

The filing date unfolded still further legal effects on grant:

(e) it marked the starting date for the granted protection envisaged by Art. 64(1) EPC 1973, cf Art. 63(1) EPC 1973; and

(f) the filing date marked the legally confirmed date by which the applicant had deposited the invention for which protection was granted, and as such, recognised the claim of (b).

The board went on to point out that the difference between the legally relevant dates (a) to (f) was clearly shown by the fact that logically they did not need to coincide, although this was the core assumption in the patent granting system established by the EPC.

A filing date for a "normal" application was accorded as soon as the requirements of Art. 80 EPC 1973 were met - apart from other formal issues, such as language etc. If an application was deemed to have been accorded a filing date, an application came into existence. In other words, there was a pending application, and the legal effects (a) to (c) above were obtained.

Conversely, a pending application had always to be deemed to have been accorded a filing date. It was true that the EPC used the notion of an application that was not deemed to have been accorded a filing date; cf Art. 90(2) EPC 1973. However, such a purported application would legally never be pending, as there would be no application; cf Art. 90(2) EPC. Such a purported application was neither searched nor examined, and neither filing, search, examination nor annual fees needed to be paid thereafter. A purported application which did not have a filing date simply did not exist as an application *sensu stricto* for the purposes of the EPC. This showed that a pending application without a filing date would be in a legal limbo. In other words, the notion of according a filing date was synonymous with the legal recognition of the existence of a pending European patent application.

The board in **T 382/94** (OJ 1998, 24) found that the accordance of a date of filing could by its very nature relate only to the **whole** of the application documents filed in accordance with Art. 80 EPC 1973. The EPC 1973 did not contain any provision which prescribed that the filing date could be accorded to only a part of these documents. As a result, according to Art. 123(2) EPC the limits for changing or correcting the parts of an application affecting the disclosure (ie the description, claims and drawings) were defined by "what a skilled person would derive ... from the whole of these documents as filed" (**G 3/89** (OJ 1993, 117)). The content of the European patent application as filed was established with the description, claims and, where appropriate, the drawings (following **G 2/95**, OJ 1996, 555).

#### **5.4. Subsequent filing of missing parts of the description or missing drawings (Rule 56 EPC)**

##### 5.4.1 Legal provisions

If the examination under Art. 90 EPC to determine whether the application satisfies the requirements for the accordance of a date of filing reveals that parts of the description, or drawings, appear to be missing, the EPO invites the applicant to file the missing parts within two months (R. 56(1) EPC). The rule's counterpart under the EPC 1973, R. 43 EPC 1973 referred only to missing drawings. The reference to missing parts of the description was added in the EPC 2000. Thus, in **J 7/97**, under the EPC 1973, where a European patent application had been filed with the EPO by fax, but one page of the description was missing, this was not considered an 'obvious error' and a filing date was granted for the application but omitting the page which was not faxed.

Where the applicant files missing parts of the description or missing drawings within two months of the date of filing or of a communication by the EPO inviting him to file the missing parts, the application is re-dated to the date on which the missing parts were filed. However, if the application claims priority, the missing parts of the description or the missing drawings are completely contained in the earlier application and all the requirements of R. 56(3) EPC are fulfilled, the application is not re-dated but retains the date on which the requirements laid down in R. 40(1) EPC were fulfilled (R. 56(3) EPC).

R. 56 EPC applies only to applications filed after the entry into force of EPC 2000 (**J 3/06**, OJ 2009, 170). According to the Legal Board, applications filed before 13 December 2007 can be seen to be subject to EPC 2000 as regards the applicability of the Implementing Regulations when the article corresponding to the rule in question also applies to patent applications filed prior to 13 December 2007 under Article 1 of the Administrative Council's decision of 28 June 2001. However, a rule in the Implementing Regulations can be assumed to apply to a particular EPC 2000 article when it puts a more detailed construction on that article, in keeping with the purpose of "implementing" the EPC. This is not true of the relationship between Art. 90 and R. 56 EPC because R. 56 EPC does not elucidate Art. 90 EPC. In the context of the system as a whole, R. 56 EPC relates to Art. 80 EPC (filing date), which is not in the catalogue of provisions stated to be also applicable to pending procedures as soon as EPC 2000 was to enter into force. Consequently, the rules relating to it do not apply either.

In **T 2166/10** the patent proprietor filed an appeal against the decision of the opposition division revoking his patent, which had been granted on the basis of a Euro-PCT application. Some of the pages of the description had been missing from the original application and the opposition division held that only the originally filed pages were entitled to the international filing date. The subject-matter as granted consequently extended beyond the content of the application as filed.

In the board's judgment, there was no doubt that the preliminary examination and the patent in suit were partly based on new description pages which had been submitted in the course of the international preliminary examination procedure by way of amendment and which were missing from the application as originally filed. The applicant had never raised the issue of the missing pages or requested a correction of the filing date (cf. **J 3/00**). Nor did the applicant subsequently file a request for correction of an error in the decision to grant. The board therefore concluded that the opposition division was correct when it held that the application as filed therefore did not include the missing pages of the description.

#### 5.4.2 Interpretation of Rule 56 EPC

According to **J 27/10**, the same interpretation is to be given to the term "parts of the description ... appear to be missing" in R. 56(1), first sentence, EPC as to the term "missing parts of the description" in the subsequent paragraphs of R. 56 EPC for deciding if a part is missing from the description. The term "description" in "missing parts of the description" in R. 56 EPC refers to the description which was originally filed in order to obtain a filing date and not to any other description. The incomplete originally

filed description is to be completed by the missing parts which must be added to the already filed text of the description. Thus an interpretation of R. 56 EPC that some, or all, of the description that was originally filed in order to obtain a filing date could be amended, replaced or deleted is incorrect.

In **J 15/12** the board made it clear, with reference to **J 27/10**, that R. 56 EPC could also not be used to replace drawings. R. 56(1), first sentence, EPC was confined to drawings referred to in the description or claims but which appeared to be missing. In **J 12/14** the board stated that the filing of drawings where the re-production of the figures is of low visual quality cannot be remedied by R. 56 EPC.

In **J 2/12** the Legal Board found that where (a) the description as filed with an application includes references to numbered drawings and (b) drawings with corresponding numbering are also filed with the application, different drawings may nevertheless be filed later under R. 56 EPC as "missing drawings" if it can be established without having to apply technical knowledge that the drawings originally filed with the application are not the drawings referred to in the description and that the later-filed drawings are the drawings referred to in the description. In the case at issue, it was immediately apparent that the figures referred to in the description were not the figures as originally filed. In other cases it might be that such a conclusion could not be reached so readily, but as it was so clear in this case, the Legal Board did not have to consider where in general the dividing line should be drawn.

#### 5.4.3 Whether to apply R. 56 EPC or R. 139 EPC

The decisions below consider the application of the equivalent rules under the EPC 1973;

- R. 43 EPC 1973 (now R. 56 EPC), which, however, referred only to missing drawings. The reference to missing parts of the description was added in the EPC 2000; and
- R. 88 EPC 1973 (now R. 139 EPC), which provides, inter alia, that mistakes in any document filed with the EPO may be corrected on request. However, if the request concerns, inter alia, the description or drawings, the 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.

In **J 19/80** (OJ 1981, 65) it was held that if a **part** of a drawing was missing, the missing part was not to be considered as a missing drawing for the purposes of R. 43 EPC 1973; the whole figure was to be considered as an incorrect drawing. The correction of drawings was dealt with in R. 88 EPC 1973. Moreover, the evidence required to support a request for correction of a drawing by adding a missing part had to be unambiguous. However, according to **G 3/89** and **G 11/91** (OJ 1993, 117 and 125), the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) might be corrected under R. 88, second sentence, EPC 1973 only within the limits of what a skilled person would have derived directly and unambiguously, using common general knowledge, and seen objectively

and relative to the date of filing, from the whole of these documents as filed. Such a correction was of a strictly declaratory nature and thus did not infringe the prohibition of extension under Art. 123(2) EPC 1973. Documents not meeting this condition might not be used for a correction under R. 88, second sentence, EPC 1973 even if they were filed together with the European patent application. These included, inter alia, priority documents, the abstract and the like.

In the explanatory remarks to EPC 2000 in CA/PL/06, it was explained that R. 56(1) EPC is not intended to apply to missing **parts** of the drawings. If the Receiving Section notes that a part of a drawing is missing, it will treat the application, for the purpose of R. 56 EPC, as if the complete drawing were missing and will invite the applicant to re-submit the complete drawing.

According to **J 1/82** (OJ 1982, 293), if a sheet including two complete figures was late-filed, these could not be considered incorrect drawings for the purposes of R. 88 EPC 1973 - the late filing of one or more complete figures was dealt with in R. 43 EPC 1973.

## **5.5. Corrections under Rule 139 EPC**

### 5.5.1 Legal provisions

Under R. 139 EPC (formerly R. 88 EPC 1973), mistakes in any document filed with the EPO may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the 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. Re corrections under R. 139, second sentence, EPC see also Chapter II.E.4 "Correction of errors in the description, claims and drawings – Rule 139 EPC".

### 5.5.2 No replacement of invention

The decisions below are mainly about applying R. 88 EPC 1973, which however has not substantively changed; in R. 139 EPC, only minor editorial amendments to all three language versions have been made.

In **G 2/95** (OJ 1996, 555) the Enlarged Board held that the complete documents forming a European patent application, that is the description, claims and drawings, cannot be replaced by way of a correction under R. 88 EPC by other documents which the applicants had intended to file with their request for grant (overruling **T 726/93**, OJ 1995, 478). The interpretation of R. 88 EPC 1973 had to be in accord with Art. 123(2) EPC 1973. This meant that a correction under R. 88 EPC 1973 was thus bound by Art. 123(2) EPC 1973, in so far as it related to the content of the European patent application as filed (see **G 3/89** (OJ 1993, 117)). Such a correction could therefore be made only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to

the date of filing, from the whole of the documents forming the content of the European patent application (referring to **G 3/89**).

The content of the European patent application was formed by the parts of the application which determined the disclosure of the invention, namely the description, claims and drawings (referring to **G 3/89**). As a result of the prohibition of extension under Art. 123(2) EPC 1973, documents other than the description, claims and drawings could only be used in so far as they were sufficient for proving the common general knowledge on the date of filing (referring to **G 3/89**). On the other hand, documents not meeting this condition could not be used for a correction even if they were filed together with the European patent application. These included, inter alia, priority documents, the abstract and the like (referring to **G 3/89**). See also **J 5/06**.

In decision **J 21/94**, taken on 20.1.1997 and terminating the appeal proceedings following the referral to the Enlarged Board of Appeal dealt with in **G 2/95** (OJ 1996, 555), the Legal Board concluded that the originally disclosed invention B could be accorded a filing date even if there were contradictions between the request for grant (which related to invention A) and the application documents (which disclosed invention B). If a further invention (here invention A) was disclosed during grant proceedings, it could not be given a filing date unless it was clear that protection for this invention was now sought.

In **J 5/06**, the board referred to **J 21/94** and stated, if an application is accorded a date of filing pursuant to Art. 80 EPC 1973, the technical content of the application is definitively established (**G 2/95**). Exchanging this technical content with another one is a technical modification. The application of the strict requirements of either Art. 123(2) or R. 88 EPC 1973, second sentence, is not limited to those circumstances when a minor part of a complete description needs to be interpreted relative to the rest, but these requirements are applicable to any suggested amendment or correction. This means that the technical content of the application as filed cannot simply be discarded, even if it does not correspond to the intention of the applicant, but must be considered when deciding whether an amendment or correction is allowable or not. The intention of the applicant at the time of filing (or even later) is immaterial in establishing the technical content of a patent application.

In **J 16/13** the appellant requested correction of the wrongly filed description and claims under R. 139 EPC. The board stated that the skilled person would have immediately recognised the mismatch between the drawings and the other parts of the description. However, it was not "immediately evident that nothing else would have been intended than what is offered as the correction". R. 139 EPC required certainty as to the only correction possible; here, that was lacking. The board noted that the case before it was similar to **J 5/06**, in which it had been confirmed that the earlier case law (up to **T 726/93**) holding that R. 88 EPC 1973 had to be applied in the light of the applicant's intentions had clearly now been overturned (see **G 2/95**, **J 21/94**, **G 3/89**), and the request that the patent specification be corrected under R. 139 EPC was refused.

### 5.5.3 Extent of competence of the Receiving Section

R. 139 EPC, second sentence, (previously R. 88 EPC 1973) lays down as a condition for acceptance of a request for correction concerning a description, claims or drawings that a correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. This often requires a technical examination of the file, so that the question has arisen under R. 88 EPC 1973 whether the Receiving Section was competent to deal with the correction in such a case.

In decision **J 4/85** (OJ 1986, 205) the board made it clear that the duties of the Receiving Section did not include a technical examination of the file; it should not, therefore, take a decision on a request for correction necessitating such an examination, but should leave the request in abeyance until the file had been transferred to the examining division (likewise **J 5/12**).

However, in **J 33/89** (OJ 1991, 288) the board pointed out that the Receiving Section remained competent for decisions on requests for correction of drawings under R. 88, second sentence, EPC 1973 unless the request necessitated a technical examination. In **J 12/14** the board agreed, and decided that the question of what technical features the figures in the drawings showed with respect to the claimed invention was not part of the formal examination procedure before the Receiving Section.

In **J 5/01** the board decided that the wording of Art. 16 EPC 1973 and Art. 18 EPC 1973 as they stood left no room for an interpretation according to which the responsibility for a European patent application could be split between the Receiving Section and the examining division. The clear and mutually exclusive allocation of this responsibility in the EPC prevailed over considerations of procedural or cost economy (likewise **T 2411/10**; contrary to **J 8/82**, OJ 1984, 155). Thus, relying on the point in time at which a request for correction was made rather than on the two acts mentioned in Art. 16 EPC 1973 (request for examination or indication under Art. 96(1) EPC 1973) would be *contra legem*.

The board pointed out that corrections under R. 88 EPC 1973 were not a matter which formed part of the examination on filing or of the examination as to formal requirements (Art. 90 and 91 EPC 1973). Rather, the wish or the need for a correction might arise during the whole grant procedure and even afterwards, e.g. during opposition proceedings. For corrections necessitating a technical examination see **J 4/85**, OJ 1986, 205.

### 5.6. Change of date of filing

The Legal Board of Appeal held in **J 14/90** (OJ 1992, 505) that re-dating an application could not be justified on the grounds that the later date would permit the granting of a European patent for a new Contracting State. The designation of a state formed part of the request for grant of a patent, and hence belonged to the documents making up a patent application, which meant that in principle there was no reason why the filing date of an application should not be changed to the date on which a further state was

designated. What was lacking were the necessary legislative provisions which would make this possible. In the case before the board there were no special circumstances, as had been the case with decision **J 5/89**. On the contrary the public interest and the need for consistency ruled out a re-dating.

In **J 5/89** the Legal Board of Appeal had stated that it was clear that Art. 80 EPC set a date **before** which a date of filing could not be accorded to an application, but it did not follow that an application could not be given a **later** filing date with the consent of the applicant, provided that there was no detriment to the public interest, in circumstances in which the applicant had been **misled** by the EPO into not filing a new application entitled to that later filing date. See also Chapter III.A. "The principle of the protection of legitimate expectations".

**J 18/90** (OJ 1992, 511) followed **J 14/90** (OJ 1992, 505) in holding that the express designation of a new Contracting State in a European patent application shortly before entry into force of the EPC for that state was no justification for deferring the filing date until the date of entry into force. However, the Legal Board added in **J 18/90** that such express designation might, after checking with the applicant, be interpreted as meaning that the applicant did not want a filing date earlier than the date on which the EPC entered into force for the state concerned.

In **T 683/06** the appeal had been lodged against a decision of the examining division to refuse a divisional application. The parent application had been sent by fax during the night. Some of the documents had arrived before midnight, some of them after midnight. According to the examining division's contested decision, the divisional application extended beyond the content of the parent application (Art. 76(1) EPC) because the claims in the divisional application were supported only by those parts of the documents for the parent application which had arrived by fax after midnight and in the light of the applicant's decision in favour of the earlier filing date did not belong to the parent application.

In its main request, the appellant sought to have the date after midnight recognised as the parent application's date of filing. However, the EPC makes no provision for a filing date once fixed to be changed subsequently. Only R. 56 EPC enables the filing date to be moved back if missing drawings or parts of the description are filed later. The correction of errors in filed documents in accordance with R. 139 EPC may also result in a change of filing date. But the case in point involved no such correction. Nor was a correction possible under R. 140 EPC.

## **6. Examination of formal requirements**

Under Art. 90(3) EPC, if the patent application is accorded a date of filing, the EPO examines, in accordance with the Implementing Regulations, whether the following requirements have been satisfied:

- Art. 14 EPC, concerning the language of the patent application (see Chapter III.F.1);



- Art. 78 EPC, concerning the requirements of a European patent application (see in this chapter IV.A.6.1);

- Art. 81 EPC, concerning the designation of the inventor (see in this chapter IV.A.6.2);

as well as any requirements laid down in the Implementing Regulations, and, where applicable;

- Art. 88 EPC, concerning claiming priority (see in this chapter IV.A.8);

- Art. 133 EPC, concerning general principles of representation (see Chapter III.R);

- any other requirement laid down in the Implementing Regulations (see in this chapter IV.A.6.3).

Under Art. 90(4) EPC, where the EPO notes that there are deficiencies which may be corrected, it shall give the applicant an opportunity to correct them. If any deficiency noted under Art. 90(3) EPC is not corrected, the patent application shall be refused unless the EPC provides a different legal consequence (Art. 90(5) EPC).

In **J 18/08** the board stated that Art. 90(5) EPC provides that if any deficiency noted in the examination under paragraph 3 is not corrected, the European patent application shall be refused unless a different legal consequence is provided by the Convention. From this it follows that if an appeal is filed against such a refusal, the board has to examine whether the deficiency noted has been corrected or not. The present case was different from the situation where the non-observance of a time limit automatically leads to the application being deemed to be withdrawn. In such a case the legal consequence automatically ensues when an act required within a specific time limit is not performed, without any decision to be taken concerning the refusal of the application (R. 112 EPC). By contrast, if the application is refused under Art. 90(5) EPC the deficiency on which the decision is based can be corrected at the appeal stage.

### **6.1. Requirements of a European patent application (Article 78 EPC)**

Under Art. 78(1) EPC a European patent application shall contain:

- a request for the grant of a European patent;
- a description of the invention;
- one or more claims;
- any drawings referred to in the description or the claims;
- an abstract

In addition it shall satisfy the requirements laid down in the Implementing Regulations.

Under Art. 78(2) EPC a European patent application is subject to the payment of the filing fee and the search fee. If the filing fee or the search fee is not paid in due time, the application shall be deemed to be withdrawn.

In **J 13/04**, the patent application had been validly filed with the French Patent Office INPI. The board observed that, under Art. 78(2) EPC 1973, the time limit for payment of the filing and search fees in the case at hand could not be determined on the basis of either the date on which the application was forwarded to the EPO or the date on which the receipt had been issued under R. 24(2) EPC 1973 but rather only on the basis of the date on which the application had been received by the competent national authority, provided that the date of that filing was also the date of filing within the meaning of Art. 80 EPC 1973.

## 6.2. Designation of the inventor

The European patent application shall designate the inventor. If the applicant is not the inventor or is not the sole inventor, the designation shall contain a statement indicating the origin of the right to the European patent (Art. 81 EPC).

A European patent application must also contain a request for the grant of a European patent (Art. 78(1) EPC). Under R. 19 EPC, the request for grant of a European patent shall contain the designation of the inventor. If the designation of the inventor is not made in accordance with this Rule, the EPO shall inform the applicant under R. 60(1) EPC that the application will be refused unless the designation is made within sixteen months of the date of filing of the application, or, if priority is claimed, of the date of priority. This period is deemed to have been observed if the information is communicated before completion of the technical preparations for the publication of the patent application.

R. 19(1) EPC requires consent to the rectification of a designation of inventor to be given by a "wrongly designated" person. In **J 8/82** (OJ 1984, 155), the Legal Board of Appeal held that a person already named whose name is not to be cancelled from the designation is not a "wrongly designated" person within the meaning of the Rule and his consent to the addition of the name of another person is not required. (The Legal Board of Appeal's finding in this decision on the allocation of responsibility between the Receiving Section and Examining Division for making a decision concerning such requests was overruled in **J 5/01**, see in this chapter IV.A.5.5.3).

The issue which arose in **J 1/10** was whether the legal position regarding designation of the inventor is changed by early publication of the European patent application at the applicant's request under Art. 93(1)(b) EPC, which can mean that the European patent application as published does not tell the public who the inventor is. In the board's judgment, early publication under Art. 93(1)(b) EPC did not affect the time period under R. 60(1) EPC for filing the designation of the inventor. If it did, it would shorten the 16-month period for filing that designation. However, there was no legal basis for assuming any connection between early publication and a reduction in the 16-month period. Nor

could this be inferred from R. 60(1) EPC or the provisions governing the procedure for rectifying deficiencies (Art. 90(3) and (4) EPC).

### **6.3. Any other requirement laid down in the Implementing Regulations**

#### **6.3.1 General provisions governing the presentation of application documents (Rule 49 EPC)**

General provisions governing the presentation of the application documents are to be found in R. 49 EPC. These include the requirement in R. 49(2) EPC that the documents making up the application shall be presented so as to allow electronic and direct reproduction in an unlimited number of copies. The application which was the subject of **J 4/09** was rejected by the Receiving Section on the ground that it was in breach of this provision. The Legal Board of Appeal disagreed, observing, first of all, that the fact that the drawings had become part of the EPO's electronic file and did not differ noticeably from the filed versions went against the receiving section's view.

It went on to say that it was not part of the examination as to formal requirements to consider what precisely could be gathered from the drawings. Rather, it was the applicant who determined the scope of disclosure by selecting the application documents and their form, so that their informative value was his responsibility. An analysis going beyond the points to be examined on filing under R. 46 and 49(1) to (9) and (12) EPC was impermissible. In particular, it was not permissible for improved drawings to result in a disclosure which could not be found in the original version of the application; nor could the applicant be compelled to change the drawings and so sacrifice a disclosure which, in his view, could only take this form.

## **7. Designation of states**

### **7.1. Legal provisions**

Under Art. 79(1) EPC **all** the contracting states which are party to the EPC at the time of filing of the patent application are deemed to be designated in the request for grant of a European patent. This is different from the situation under the EPC 1973, where contracting states had to be positively designated in the request for grant. This practice caused problems since, in principle, a later designation made after the filing date of the European patent application was inadmissible. Applicants continue to have the option of withdrawing designations pursuant to Art. 79(3) EPC.

Under Art. 79(2) EPC the designation of a contracting state **may** be subject to the payment of a designation fee (under the EPC 1973 it was stated, 'The designation of a Contracting State **shall** be subject to the payment of the designation fee.' - emphasis added). Since 1.4.2009, a flat designation fee has been payable for one or more contracting states designated (Art. 2(3) RFees).

The time limit for the payment of designation fees is within six months of the date on which the European Patent Bulletin mentions the publication of the European search report (R. 39 EPC, formerly Art. 79(2) EPC 1973).

The revised Art. 79 EPC is applicable to all European patent applications filed on or after 13.12.2007.

For case law on Art. 79(2) EPC 1973 (as in force until 30.6.1997), please refer to the "Case Law of the Boards of Appeal of the European Patent Edition", 5th Edition 2006, VII.A.4.1 "Article 79(2) EPC (old version)".

## **7.2. Effect of non-payment of the designation fee**

### 7.2.1 Deemed withdrawal

Since 1.4.2009 a single designation fee has been payable in respect of **all** the Contracting States of the EPC. R. 39 EPC in force from that date provides that the designation fee shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report. Where the designation fee is not paid in due time or the designations of all the Contracting States are withdrawn, the European patent application shall be deemed to be withdrawn. Under the EPC 1973 the same time limit was to be found in Art. 79(2) EPC.

Under Art. 121 EPC, where a designation is deemed withdrawn for any contracting state in respect of which the designation fee has not been paid (R. 39(2) EPC), the applicant may now apply for further processing, unless he has waived his rights to receive a R. 112(1) EPC communication and to request further processing by crossing the appropriate box in the Request for grant form.

R. 39 EPC as amended from 1.4.2009 applies to European patent applications filed on or after that date, as well as international applications entering the regional phase on or after that date.

### 7.2.2 Designation of states in divisional applications

Art. 76(2) EPC 1973 stipulated that a European divisional application could not designate contracting states which were not designated in the earlier application.

In **G 4/98** (OJ 2001, 131), the Enlarged Board of Appeal held, overruling **J 22/95** (OJ 1998, 569), that, without prejudice to Art. 67(4) EPC 1973, the designation of a contracting state party to the EPC 1973 in a European patent application did not retroactively lose its legal effect and was not deemed never to have taken place if the relevant designation fee had not been paid within the applicable time limit.

The Enlarged Board of Appeal further held that since in its opinion no general retroactive effect was attached to the fact that a designation was deemed to be withdrawn, the deemed withdrawal necessarily took effect upon expiry of the time limits mentioned in

Art. 79(2) EPC 1973 and R. 15(2), 25(2) and 107(1) EPC 1973, as applicable, and not upon expiry of the period of grace provided by R. 85a EPC 1973.

Art. 76(2) EPC has therefore been amended to ensure that only those contracting states which remain designated in the earlier application at the time of filing of a divisional application are deemed to be designated in the divisional application. (Similarly, the EPO can only act as the "designated Office" for states designated in an international application in respect of which the EPC was in force on the date on which the international application was filed; **J 30/90**, OJ 1992, 516).

#### 7.2.3 No correction of non-payment of fee under R. 88 EPC 1973

In **J 21/84** (OJ 1986, 75) it was held that if the designation fee for a state was paid, neither within the time limit under Art. 79(2) EPC 1973 nor within the period of grace under R. 85a EPC 1973 together with the surcharge, such failure could not be corrected on the basis of and in conjunction with the correction of an error according to R. 88 EPC 1973.

Concerning the indication of the purpose of fee amounts paid in respect of designation fees under the earlier law, see "Case Law of the Boards of Appeal of the EPO", 6th edition 2010, VI.F.2.4 "Designation fees".

### 7.3. Correction of designation of states (Rule 139 EPC)

Under R. 139 EPC linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request. The decisions below consider the application of the EPC 1973 (R. 88 EPC 1973, which was not amended in substance). However, under Art. 79(1) EPC **all** the contracting states which are party to the EPC at the time of filing of the patent application are now deemed to be designated in the request for grant of a European patent. Applicants continue to have the option of withdrawing designations pursuant to Art. 79(3) EPC (see in this chapter IV.A.7.1).

According to **J 10/87** (OJ 1989, 323) a request for retraction of a withdrawal of the designation of a Contracting State filed after publication of the patent application may have been allowable under R. 88 EPC 1973 in appropriate circumstances, in particular if;

- (a) the public had not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal was applied for;
- (b) the erroneous withdrawal was due to an excusable oversight;
- (c) the requested correction did not result in a substantial delay of the proceedings; and
- (d) the EPO was satisfied that the interests of third parties who may possibly have taken notice of the withdrawal by inspection of the file are adequately protected.

**J 17/99** explained that with respect to corrections of designations in Euro-PCT applications, the same principles applied as for Euro-direct applications (see also Chapter VI. "The EPO acting as a PCT authority").

**J 27/96** concerned a Euro-PCT application which originally designated all the contracting states for a European patent, but on entry into the regional phase only designated and paid fees for ten. The board acknowledged that correction of a mistake pursuant to R. 88 EPC 1973 by adding the designation of a state had in principle been allowed by the Legal Board of Appeal (see **J 3/81**, OJ 1982, 100). However, it could remain undecided whether R. 88 EPC 1973 could have been applied to the designations purported to be missing, as the lack of fee payment in due time was not a mistake that could be corrected under R. 88 EPC 1973 and was therefore a failure which could not be remedied (referring to **J 21/84**, OJ 1986, 75). Nor could the appellant's auxiliary request to replace expressly designated states with other non-designated states succeed - the designated states were not designated erroneously - rather the error lay in the omission of the non-designated states. Moreover, were there a retroactive effect of the correction, this did not mean that the applicant would be reinstated into the procedural phase when designations had to be made and fees paid or that, in consequence, the whole procedure in that phase would be available to him again. Correction of a mistake was an isolated procedural measure and not a case of re-establishment into a procedural phase as a whole.

In **J 3/01** the Legal Board of Appeal was concerned with the same problem, in that the appellant's request was aimed at a reinstatement into an earlier procedural phase by means of a correction under R. 88 EPC 1973. The board held that correction under R. 88 EPC 1973 did not reverse the effect of decisions already taken on the basis of the uncorrected document and did not re-open a procedural phase already terminated or a time limit already expired. In other words, a procedural loss of right only indirectly caused by the incorrect document would not be remedied by a later correction of the document pursuant to R. 88 EPC 1973. This principle also characterised the functional and essential difference between a correction under R. 88 EPC 1973 on the one hand and *restitutio in integrum* pursuant to Art. 122 EPC 1973 on the other hand (see also **J 25/01**). The board concluded that correction under R. 88 EPC 1973, to include designation of the UK following failure to pay the designation fee, was not allowable, as it would be in breach of Art. 122(5) EPC 1973, according to which re-establishment into periods for payment of designation fees was not allowable.

In **J 16/08** the request for correction of the designation of states was allowed in the unusual circumstances of the case. Following the case law summarised in **J 7/90** (OJ 1993, 133) and endorsed in **J 6/02**, the board applied the three conditions to be met by such a request for correction in order for it to be allowable - firstly, that the error was an excusable oversight; secondly, that the request for correction was filed without undue delay upon discovery of the error, and thirdly, that the request for correction was, in the public interest, made early enough to enable publication of a warning with the European patent application. No such warning was required in the circumstances of this case, as the application had erroneously been published showing all contracting states as designated. Third parties were therefore not prejudiced by the correction, since no

publication had ever indicated that the territorial scope of the invention was limited to two contracting states.

## 8. Priority

### 8.1. Filing of priority documents

An applicant desiring to take advantage of the priority of a previous application must file a declaration of priority and any other document required, in accordance with the Implementing Regulations (Art. 88 EPC). Under R. 52(2) EPC, a declaration of priority shall preferably be made on filing the European patent application, but it may still be made with sixteen months of the earliest priority date claimed. This is a significant relaxation of the requirements as compared to R. 38(2) EPC 1973, under which at least the date and the state of the previous application had to be indicated on filing.

Similarly, R. 53 EPC (R. 38(3) EPC 1973) provides that an applicant claiming priority shall file a copy of the previous application within sixteen months of the earliest priority date claimed.

In **J 1/80** (OJ 1980, 289) it was stated that as R. 38(3) EPC 1973 permitted an applicant to file certified copies of the priority documents at any time before the end of the sixteenth month after the date of priority, there was only a deficiency which he must be given an invitation to correct if the priority documents had not been filed at the end of the period.

### 8.2. Correction of priority declarations

#### 8.2.1 Introduction

Under the EPC 1973, the correction of priority declarations was allowed under R. 88 EPC 1973. The possibility to correct the declaration of priority was expressly introduced into the EPC 200 in R. 52(3) EPC.

#### 8.2.2 Correction of priority declarations under R. 88 EPC 1973

##### a) Requirement for mistake to have been made

Under the EPC 1973, the Legal Board allowed correction of state designations under R. 88, first sentence, EPC 1973 (now R. 139 EPC), early on (**J 8/80**, OJ 1980, 293; **J 12/80**, OJ 1981, 143; **J 3/81**, OJ 1982, 100; **J 21/84**, OJ 1986, 75). Shortly afterwards the rather strict principles developed in these decisions were also applied in cases where correction of priority declarations was at stake. Although a mistake correctable under R. 88, first sentence, EPC 1973 could be an incorrect statement or the result of an omission, all the previous cases related to omitted priority declarations (**J 3/82**, OJ 1983, 171; **J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121; **J 11/89** and **J 7/90**, OJ 1993, 133).

In the four decisions **J 3/91** (OJ 1994, 365), **J 6/91** (OJ 1994, 349), **J 9/91** and **J 2/92** (OJ 1994, 375), the Legal Board refined the principles to be applied to corrections of priority declarations. In **J 6/91** it analysed and summarised the previous case law, pointing out that the applicant had to prove a **mistake**, i.e. that the document filed with the EPO did not express the true intention of the person on whose behalf it was filed. In the earlier decisions the **burden of proof** on the applicant was defined as a heavy one. In **J 9/91**, however, the board took the view that the omission of a priority declaration would, in nearly every case, be an error. Thus, as a general rule, there was no need in cases of this kind to require special evidence to discharge the burden on the applicant of proving that a mistake had been made.

b) Time limit for request for correction

Despite the fact that R. 88, first sentence, EPC 1973 allowed correction without any time bar, the Legal Board followed the established case law requiring a request for correction of a priority claim to be made sufficiently early for a warning to be included in the publication of the application (**J 3/82**, OJ 1983, 171; **J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121). This principle was upheld because the EPO, when exercising its discretionary power under R. 88, first sentence, EPC 1973 had to balance the applicant's interest in gaining optimum protection and a third party's interest in maintaining legal security and, in particular, in ensuring that the published application data were correct.

The board in **J 6/91** noticed, however, that the previous case law in special circumstances already allowed the correction even without such a warning:

(i) if the EPO was partly responsible for the fact that no warning was published (**J 12/80**, OJ 1981, 143) and/or

(ii) if the interest of the public was not seriously affected because

- the mistake was obvious (in this sense, implicitly, **J 8/80**, OJ 1989, 293);

- under certain circumstances, where only a second or further priority was added (**J 4/82**, OJ 1982, 385; **J 14/82**, OJ 1983, 121; **J 11/89**);

- the public was otherwise informed about the full scope of protection sought by the applicant (**J 14/82**, OJ 1983, 121).

In **J 3/91**, **J 6/91** and **J 2/92** it was held that even after publication of a European patent application without a warning, the priority declaration could be corrected under R. 88, first sentence, EPC 1973 provided that there was an **obvious discrepancy** in the published application indicating that something was wrong. In such a case the interests of third parties were not adversely affected by the correction.

In **J 3/91** the board held that an experienced practitioner could have noticed the obvious discrepancy because the claimed Japanese priority date (31.12.1983) and the European



application date (3.1.1984) were close together and the Japanese file number was mentioned.

In **J 6/91** the international application in suit claiming priority from a US continuation-in-part application was itself presented as a continuation-in-part application and referred back to an earlier US application. In view of this and other special circumstances, the board allowed the addition of a (first) priority claim referring to the earlier US application.

In **J 2/92** the US priority date claimed for a PCT application was, owing to a clerical error, a Saturday when the USPTO was closed, instead of the previous Friday. The correct date was indicated on the priority document. Owing to a further clerical error in the request for transmittal of priority documents under R. 17.1(b) PCT (a typing error in the document number), the Receiving Office - in this case the USPTO - transmitted the wrong document to WIPO. The board allowed its replacement even after publication of the international application, adding, however, that this might not always be possible (see also **T 33/06**).

In the parallel cases **T 972/93** and **T 973/93** the examining division had refused a request for the priority date to be corrected. European patent application E1 claimed the priority of a French application F1, from which two French divisional applications F2 and F3 were filed within the priority year claiming the priority of the parent application. At issue in **T 972/93** and **T 973/93** were European applications E2 and E3, which claimed the priority of F2 and F3 respectively. In error however, the filing date of F2 and F3 was given as the priority date. This mistake was detected during examination proceedings, after E2 and E3 had been published with the wrong priority date, because E1 was discovered as a prior right within the meaning of Art. 54(3) EPC 1973 (Art. 54 EPC has been substantially amended - see Chapter I.C. "Novelty").

The board of appeal allowed the correction (following **J 6/91**, OJ 1994, 349), ruling that the mistake was apparent, because only eight months separated the filing date of E2 and E3 from the incorrect priority date, whereas the priority year was usually exploited to the full. The interests of third parties had not been adversely affected because the precautionary filing of two European divisional applications with respect to E1, which had the same content as F2 and F3, made it possible to gain protection for the subject-matters of E2 and E3 with the priority of F1.

On the other hand, in **J 7/94** (OJ 1995, 817) the board did not allow the correction. It held that the mere fact that an existing priority was not claimed could not justify adding this priority by correction. The correction of priority data, not requested sufficiently early for a warning to be included in the publication of the application, was only allowable if it was justified by special circumstances (confirming **J 6/91**, OJ 1994, 349). See also **T 796/94**.

In **J 11/92** (OJ 1995, 25) it was held that an incomplete priority declaration could be corrected, by the addition of an omitted priority in special circumstances, even after publication of the European patent application without a warning to the public that a request for correction had been made, provided that the public had been informed about the full scope of European patent protection sought, by way of a second European or

Euro-PCT patent application, filed as a precautionary measure by the applicant in due time (referring to **J 6/91**, OJ 1994, 349).

In **T 713/02** (OJ 2006, 267), the board held that the examination of a request for correction of priority data after the publication of the application was not to be restricted to that portion of the facts and circumstances which in a decision of a board of appeal in another case were considered not to preclude the correction. Therefore, in the case before the board, it could not be ignored that the requested correction by addition of an earlier priority date would eliminate from the state of the art pursuant to Art. 54(2) EPC 1973 a highly relevant document, which the applicant had previously de facto accepted as comprised in that state of the art (see, however, the Notice from the European Patent Office regarding decision **T 713/02** (OJ 2006, 293), according to which the EPO's departments of first instance do not, for the time being, follow the findings that no decisions, except where a total loss of rights should be remedied, may be taken in the applicant's favour prior to the decisions terminating the granting procedure).

### 8.2.3 Rule 52(3) EPC

New R. 52(3) EPC introduced the possibility to correct the declaration of priority. New R. 52(2) EPC and (3) EPC apply the time periods laid down in the PCT for the addition or correction of priority claims to Euro-direct applications, with the necessary terminological adjustments, in order to avoid treating Euro-PCT and Euro-direct applications differently. Pursuant to R. 52(3) EPC, an applicant may correct a declaration of priority within 'sixteen months from the earliest priority date claimed, or, where the correction would cause a change in the earliest priority date claimed, within sixteen months from the correct earliest priority date, whichever sixteen-month period expires first, provided that such correction may be submitted until the expiry of four months from the date of filing accorded to the European patent application'. However, for easy publication, a declaration of priority may not be made or corrected after a request under Art. 93(1)(b) EPC has been filed (R. 52(4) EPC).

## 9. Deemed withdrawal of the application (Rule 100(3) EPC)

R. 100 EPC concerns the examination of appeals. If the applicant fails to reply in due time to an invitation under R. 100(2) EPC, the European patent application is deemed to be withdrawn under R. 100(3) EPC. These provisions were previously contained in Art. 110(2) and (3) EPC 1973 respectively.

The Legal Board held in **J 29/94** (OJ 1998, 147) that if the appellants failed to reply in due time to an invitation under Art. 110(3) EPC 1973, the European patent application was deemed withdrawn, even if the appeal related to formal points, as the effect of the appeal, namely that the board of appeal was now competent for the case, applied to the entire application (see Chapter IV.E.1.2 "Devolutive effect of appeal").

## 10. Publication of the application

Art. 93 EPC concerns the publication of the European patent application, which should take place as soon as possible after the expiry of a period of eighteen months from the date of filing, or, if priority has been claimed, from the date of priority, unless the applicant requests earlier publication. Under R. 67(1) EPC (R. 48 EPC 1973), the President of the EPO shall determine when the technical preparations for publication of the patent application are deemed to have been completed. The application shall not be published if it has been finally refused or withdrawn or is deemed to be withdrawn before the termination of the technical preparations for publication (R. 67(2) EPC).

In **J 5/81** (OJ 1982, 155) it was stated that the key date for completion of the technical preparations for publication under Art. 93 EPC 1973 specifiable pursuant to R. 48(1) EPC 1973 could be said to give the applicant a certain minimum period of time within which his withdrawal of the application also prevented its publication. If the application was not withdrawn until after the key date, the applicant could no longer rely on its not being published. Nevertheless, the EPO was allowed by law to prevent publication, at its own discretion.

**B. Examination procedure**

1.	Stage before substantive examination	862
1.1.	Amendments made by the applicant of his own volition under Rule 137(2) EPC	862
1.2.	Request for examination (Rule 70 EPC)	863
1.2.1	General issues	863
1.2.2	The invitation to confirm early request for examination (R. 70(2) EPC)	864
2.	The first stage of substantive examination	865
2.1.	Beginning of "substantive examination"	865
2.2.	One invention to be the subject of examination	866
2.3.	Consolidation of proceedings	866
2.4.	Communications under Rule 71(1) and (2) EPC	866
2.4.1	Invitation to correct deficiencies and to propose amendments (Rule 71(1) EPC)	866
2.4.2	Content of Rule 71(2) EPC communication	867
2.5.	Refusal after a single communication	869
2.5.1	General issues	869
2.5.2	Failing to make a "bona fide" response	870
2.6.	Amendments under Rule 137(3) EPC	872
2.6.1	Discretion of the examining division under Rule 137(3) EPC	872
2.6.2	Consent under Rule 137(3) EPC in oral proceedings	875
2.6.3	The burden of proposing amendments	875
2.6.4	Reasons for the exercise of discretion	876
2.6.5	Second communication under Rule 71(3) EPC: the consent of the examining division	878
2.7.	Failure to reply to the communication from the examining division (Article 94(4) EPC)	878
2.7.1	Reply within the meaning of Article 94(4) EPC	878
2.7.2	Waiver of the applicant's right to present comments	879
2.8.	Issue of a further communication under Article 113(1) EPC	879
2.8.1	General issues	879
2.8.2	Arguments taken into account in the decision of the examining division	880
2.8.3	Information on non-compliance: the essential reasoning	881
2.8.4	Essential reasoning based on an IPER	882
2.8.5	Fresh argument based on grounds and evidence communicated beforehand	883
2.8.6	Bona fide attempt by the applicant to overcome the objections	883
2.8.7	Form of the communication under Article 113(1) EPC	884
2.9.	Informal communications	885
2.9.1	Telephone conversations	885
2.9.2	Interviews	886
3.	The grant stage in examination	887
3.1.	Rule 71(3) EPC communication: the text for approval	887
3.2.	Approval of the text by the applicant	888
3.2.1	General issues	888
3.2.2	Clear and unambiguous approval of the text	888

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3.2.3	Decisions with no text submitted or agreed by the applicant (Article 113(2) EPC)	890
	a) General issues	890
	b) Auxiliary request issues	891
3.2.4	Examination procedure under the previous system (Rule 71 EPC and Rule 51(4) EPC 1973)	893
3.3.	Amendments or corrections filed in response to the communication under Rule 71(3) EPC	894
3.3.1	Amendments where Rule 71(3) EPC communication is the first communication	894
3.3.2	Amendments and corrections requested according to Rule 71(6) EPC	894
3.3.3	Criteria for admitting amendments filed in reply to the Rule 71(3) EPC communication	894
3.3.4	Claims fees due in response to Rule 71(3) EPC communication	898
3.4.	Amendment after approval of the text for grant	898
3.5.	Examination after remittal for further prosecution	900
3.6.	Amendments after the decision to grant	901
3.7.	Withdrawal of amendments and abandonment of subject matter	902
3.7.1	General issues	902
3.7.2	Effects of non-payment of claims fees	903
3.8.	Withdrawal of the patent application	903
3.8.1	General issues	903
3.8.2	Correction of the withdrawal of the application under Rule 139 EPC	906
3.9.	Refusal of a European patent application under Article 97(2) EPC (former Article 97(1) EPC 1973)	909
3.10.	Entry into force of a decision to grant a European patent	910
3.11.	Errors in the Patent Bulletin	912
4.	Additional searches during examination	913
4.1.	Rule 63 EPC governing incomplete search	913
4.1.1	Introduction	913
4.1.2	Additional search necessary: limited discretion of the examining division	914
4.1.3	Declaration under Rule 63(2) EPC	916
	a) Notoriously well-known technical features	916
	b) Subject-matter not having technical character	917
4.1.4	Invitation to restrict the claims under Rule 63(3) EPC	917
4.2.	Non-payment of further search fees under Rule 64 EPC	918
5.	Amendments relating to unsearched subject-matter - Rule 137(5) EPC	918
5.1.	General issues	918
5.2.	The purpose of Rule 137(5) EPC	919
5.3.	Applicability of Rule 137(5) EPC	920
5.3.1	General issues	920
5.3.2	Extent of the European search report	920
5.3.3	Subject-matter of amendment not combining with the originally claimed invention	923
5.4.	Criteria for consent to amendments under R. 137(5) EPC	924
5.4.1	Amendment not affecting the notion of unity of invention	924
5.4.2	Amendments filed to meet an objection	926

5.5. Non-compliance with Rule 137(5) EPC: a ground for refusing an application 926

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**1. Stage before substantive examination****1.1. Amendments made by the applicant of his own volition under Rule 137(2) EPC**

R. 137(2) EPC specifies that "Together with any comments, corrections or amendments made in response to communications by the European Patent Office under R. 70a (1) or (2) EPC, or R. 161(1) EPC, the applicant may amend the description, claims and drawings of his own volition".

Thus, following receipt of the search report and search opinion, and prior to the first communication from the examining division, the applicant must (subject to certain exceptions) respond to the search opinion, by filing amendments to the description, claims or drawings and/or filing his observations on the objections raised in the search opinion. Any amendments filed at this stage are made by the applicant **of his own volition** in accordance with R. 137(2) EPC (Guidelines C-II, 3.1 – November 2015 version).

A reply to the search opinion and any amendments made by the applicant of his own volition should be on file when the substantive examination phase starts (see R. 70a, 137 and 161 EPC) (CA/81/10 Rev. 1, R. 71). The applicant's response required by R. 70a EPC (or filed voluntarily in response to search opinions not requiring a response) will be taken into account by the examining division when drafting the first communication.

In **T 1178/08** the board stated that in accordance with Art. 123(1) EPC in conjunction with R. 137(2) and (3) EPC, an applicant is to be given at least one opportunity to amend the application of his own volition. No further amendments may be made without the consent of the examining division. It noted that the EPC and the Implementing Regulations do not contain explicit provisions concerning the admissibility of amendments in appeal proceedings. R. 66(1) EPC 1973 sets out that the provisions relating to proceedings before the department which has made the decision from which the appeal is brought are applicable *mutatis mutandis* in such a case. Thus the board held that an appellant is not entitled, as a matter of right, to present amendments of his own volition at the appeal stage, but as a matter of discretion to be exercised by the board. Art. 12 and 13 RPBA set out the provisions governing the basis of appeal proceedings and amendments to a party's case which are binding upon the boards of appeal (Art. 23 RPBA). In **T 979/02** the board found that by virtue of Art. 111(1) EPC and R. 66(1) EPC, these provisions (i.e. R. 86(3) EPC 1973) are also applicable to appeal proceedings *mutatis mutandis*.

## 1.2. Request for examination (Rule 70 EPC)

### 1.2.1 General issues

According to Art. 94(1) EPC, the EPO shall, in accordance with the Implementing Regulations, examine on request whether the European patent application and the invention to which it relates meet the requirements of the EPC. The request shall not be deemed to be filed until the examination fee has been paid (Art. 94(1), second sentence, EPC; former Art. 94(2) EPC 1973). If no request for examination has been made in due time, the application shall be deemed to be withdrawn (Art. 94(2) EPC).

R. 70 EPC regulates the practical arrangements for filing the request for examination, including the form and the time limit. R. 70(1) EPC stipulates that the applicant may request examination of the European patent application up to **six months** after the date on which the European Patent Bulletin mentions the publication of the European search report. The request may not be withdrawn.

In **J 21/98** (OJ 2000, 406) the board stated that the request for examination constituted an autonomous step, which had to be kept quite separate from the (previous) step of filing the European patent application. In particular, the provision of Art. 94(1) EPC 1973, pursuant to which, for the examination of the application to be started, the applicant had to file a written request, showed that, according to the EPC, the patent application was not considered as the only necessary step to be taken by the applicant to obtain the grant of a patent, since a further step was necessary, consisting in a written request for examination - that meant a new declaration of intention to continue the grant procedure. Thus the applicant was given the right to know the outcome of the search report before deciding whether to ask for the prosecution of the grant procedure by means of the request for examination, which implied the payment of the related fee, or to drop said procedure. The provisions of the Convention were indeed clearly aimed at giving the applicant the possibility to properly consider the convenience of a further prosecution of the grant procedure in the light of the outcome of the search report.

In **J 12/82** (OJ 1983, 221) the board found that the unequivocal terms of Art. 94 EPC 1973 did not permit any wide interpretation - in fact the Article required that the request be written, filed within a certain period and accompanied by payment of the fee within the same period. In addition it should be noted that the authors of the EPC 1973, i.e. the contracting states, gave the request filed within the time limit extensive effects: it could not be withdrawn (Art. 94(2), last sentence, EPC 1973), yet on the other hand, if it was filed late the patent application was automatically deemed to be withdrawn (Art. 94(3) EPC 1973). The board held that the mere payment of the examination fee within the time limits provided for in Art. 94(2) EPC 1973 could not be a substitute for filing the request itself in good time.

In **J 4/00** the board held that a request for examination under Art. 94 EPC 1973 required, over and above payment of the examination fee, that the underlying intention of an applicant that his application should proceed to examination was manifested in a written statement made by the applicant or his representative addressed to the EPO and

received there in time. While this requirement was quite distinct from that of payment of the examination fee, there was no prescribed form of words for a request for examination which could be contained in the same document as a debit order or other payment instruction. To qualify as a request for examination, in the circumstances of the case the only reasonable interpretation of the text filed with the EPO had to be that the applicant thereby wanted to inform the EPO that he wished to have the application examined pursuant to Art. 94 EPC 1973.

#### 1.2.2 The invitation to confirm early request for examination (R. 70(2) EPC)

Under R. 70(2) EPC (former Art. 96(1) EPC 1973) if the request for examination has been filed before the European search report has been transmitted to the applicant, the European Patent Office shall **invite the applicant** to indicate, within a period to be specified, **whether he wishes to proceed further** with the application, and shall give him the opportunity to comment on the search report and to amend, where appropriate, the description, claims and drawings.

Following a decision of the Legal Board of Appeal (**J 8/83**, OJ 1985, 102), it is the practice of the Office to send the invitation provided for in R. 70(2) EPC also in cases where a supplementary European search report is to be drawn up on a Euro-PCT-application. The six months time limit should also be applicable in this case (see CA/29/09).

In **J 8/83** (OJ 1985, 102) and **J 9/83** the board found that if a supplementary European Search report has to be drawn up in respect of an international application which was deemed to be a European patent application, the applicant was entitled to receive the invitations provided for in Art. 96(1) EPC 1973 and R. 51(1) EPC 1973. Since in the case of such an international application, responsibility for examination of the application did not pass to the examining division until the applicant had indicated under Art. 96(1) EPC 1973 that he desired to proceed further with his application, the applicant might obtain a refund of the examination fee if in response to the invitation under Art. 96(1) EPC 1973 he withdrew his application, or allowed it to be deemed to be withdrawn.

The board noted that the provisions of Art. 96(1) EPC 1973 and R. 51(1) EPC 1973 clearly operated in the respective interests of applicants, third parties and the EPO by encouraging applicants to review their applications critically and realistically in the light of the European search report, before substantive examination began. The opportunity given by the EPO to obtain a refund of the substantial fee for examination by withdrawing the application at that stage, or allowing it to be deemed to be withdrawn, provided an additional incentive to withdraw cases which were unlikely to succeed.



## 2. The first stage of substantive examination

### 2.1. Beginning of "substantive examination"

Responsibility for examining the application passes from the Receiving Section to the examining division at the time when a request for examination is filed. This is subject to two exceptions: (i) if the applicant has filed a request for examination before the European search report has been sent to him, then the examining division is responsible only from the time when the confirmation of the request is received by the EPO following an invitation under R. 70(2) EPC; (ii) if the applicant has filed a request for examination before the European search report has been sent to him and has also waived the right to receive an invitation to confirm under R. 70(2) EPC, then the examining division is responsible only from the time when the search report is sent to the applicant (Guidelines C-II, 1 – November 2015 version).

In order for examination of a European application can begin, the applicant is required to file a request for examination, which, however, is not deemed to be filed until after the examination fee has been paid.

In **J 9/10** the board held that a communication pursuant to Art. 94(3) EPC on EPO Form 2001A which was automatically generated by a computer and posted by a formalities officer without the involvement of an examiner appointed to the examining division did not constitute a legally effective act of the examining division and therefore could not be regarded as the beginning of "substantive examination" pursuant to Art. 10b(b) RFees (inserted by decision of the Administrative Council of 10 June 1988, as last amended by decision of the Administrative Council of 15 December 2005).

The fulfilment of the second condition for the refund of the examination fee according to Art. 10b(b) RFees, gave rise to the questions of what "substantive examination" was and what kind of act or acts amounted to the beginning of "substantive examination". The board noted that to ensure predictability and verifiability of the application of Art. 10b(b) RFees, the beginning of "substantive examination" had to be interpreted as requiring a concrete and verifiable act of the examining division as regards "substantive examination" after having assumed responsibility for the examination of the application (**J 25/10**). The board held that if a communication of a particular examining division was to be legally valid, it had to have been written on behalf of and represent the views of the members who had been appointed to that division to examine the issues forming the subject of the communication. There was, however, no indication in the file that the appointed primary examiner had actually authenticated the communication under Art. 94(3) EPC before it was despatched by the formalities officer. Therefore, the communication could not be attributed to the examining division, but only to the formalities officer whose name was indicated on EPO Form 2001A. Further, the board found that the formalities officer, although acting in good faith, had had no power to issue the communication pursuant to Art. Art. 94(3) EPC. Such power was transferred to formalities officers by R. 11(3) EPC in conjunction with the Decision of the President of the European Patent Office dated 12 July 2007 concerning the entrustment to non-

examining staff of certain duties normally the responsibility of the examining or opposition divisions (OJ SE 3/2007, 106).

## **2.2. One invention to be the subject of examination**

In **T 158/12** the appellant's view was that there was no article or rule in the EPC which would prevent the applicant from changing from one invention to another – if they were searched – during examination. The board considered, however, that the articles and rules present in the EPC form a statutory system which clearly lead to the conclusion that there was no provision allowing the payment of multiple examination fees for a patent application. The board stated that for one application, only one examination is to be carried out as the result of the single examination fee which has been paid. Having once chosen one invention (or one group of inventions) to be made the subject of examination, this choice could not be altered once examination of that invention has commenced. The board was of the opinion that this approach based on the statutory provisions of the EPC was confirmed in opinion **G 2/92**. Hence, the appellant's view that the examination of an application could be based on more than one invention was not supported by this opinion of the Enlarged Board of Appeal.

## **2.3. Consolidation of proceedings**

In **J 17/92** the possibility of consolidating proceedings and the preconditions it laid down for such consolidation were subject to review by the boards of appeal. The board held that allowing consolidation was something both permissible and desirable under the EPC, in accordance with the desire expressed in the preamble to the EPC that such protection be obtainable in the contracting states by means of a single procedure for the grant of patents. Consolidation was not only in the interest of applicants, but also in that of the public not to have to take account of two separate European patents with the same text. The board noted that the conditions to be imposed on consolidation should not be more restrictive than necessary. It therefore took the view that the condition that the two applications at issue as filed had to be identical was too stringent. In the case at issue, the board found that if the form of claims with which the applicant wished to proceed in the consolidated applications was acceptable either as an amended set of claims or as being identical to the set of claims as filed, consolidation should be possible. In the board's view, such an amended set of claims should prima facie not prevent consolidation.

## **2.4. Communications under Rule 71(1) and (2) EPC**

### **2.4.1 Invitation to correct deficiencies and to propose amendments (Rule 71(1) EPC)**

The applicant's response to the search opinion required by R. 70a EPC (or filed voluntarily in response to search opinions not requiring a response) will be taken into account by the examining division when drafting the first communication (Guidelines C-II, 3 – November 2015 version).

If deficiencies persist in the application even after the applicant has filed his response to the search opinion, the examining division will issue a communication according to Art. 94(3) and R. 71(1) and (2) EPC in subsequent examination proceedings and will consider the applicant's reply thereto before issuing a decision or a summons to oral proceedings (Guidelines C-III, 4 – November 2015 version).

According to Art. 94(3) EPC if the examination reveals that the application or the invention to which it relates does not meet the requirements of the EPC, the examining division shall invite the applicant, **as often as necessary**, to file his observations and, subject to Art. 123(1) EPC to **amend the application**. In line with EPO practice, it has now been made clear that the EPO may not only invite the applicant to file his observations, but may also invite him to amend the application in accordance with Art. 123 EPC.

Further, according to R. 71(1) EPC (former R. 51(2) EPC 1973) in any communication under Art. 94(3) EPC the examining division shall, where appropriate, invite the applicant to **correct any deficiencies** noted and to amend the description, claims and drawings within a period to be specified.

In **T 301/10** the board stated that according to the established case law developed in relation to Art. 96(2) EPC 1973 and also applicable to Art. 94(3) EPC, the expression "as often as necessary" in this article indicates that the examining division has discretion which has to be exercised objectively in the light of the circumstances of the case (see, for instance, decisions **T 162/82** (OJ 1987, 533), **T 300/89** (OJ 1991, 480), and **T 726/04**).

Under Art. 113(1) EPC, however, it is not necessary to give the applicant repeated opportunities to comment on the examining division's submissions if the main objections to the grant of a European patent remain the same. A further invitation to present comments following a substantiated communication in which deficiencies were recorded is only appropriate if it would appear likely that, in the light of the applicant's reply, the examination proceedings would terminate in the granting of a patent (see **T 84/82**, OJ 1983, 451; **T 161/82**, OJ 1984, 551; **T 162/82**, OJ 1987, 533; **T 243/89**, **T 300/89**, OJ 1991, 480; **T 793/92** and **T 516/93**).

#### 2.4.2 Content of Rule 71(2) EPC communication

According to R. 71(2) EPC (R. 51(3) EPC 1973) any communication under Art. 94(3) EPC (Art. 96(2) EPC 1973), shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.

If no search opinion has been issued (see Guidelines C-VI, 3; F-V, 13.1(ii) and B-XI, 1.1), the examiner's first communication under Art. 94(3) EPC will, as a general rule (see B-XI, 3) and by analogy with the search opinion, cover all objections to the application (Guidelines C-III, 4 – November 2015 version).

In **T 937/09**, the board observed that, according to R. 71(2) EPC, any communication under Art. 94(3) EPC had to contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent. This rule thus contained two requirements: applicants had to be informed, first, of each EPC requirement deemed not to be met and, second, for each such requirement, of the legal and factual reasons why it was deemed not to be met.

In **J 32/95** (OJ 1999, 733) the board held that the objection raised by the appellant that the examining division had unduly dealt with the application in a piecemeal manner was also unfounded. According to the Guidelines C-III, 5 (see also November 2015 version), cited by the appellant, the examiner's first letter should, as a general rule, cover all objections to the application. Pursuant to R. 51(3) EPC any communication shall, where appropriate, cover all the grounds against the grant of the European patent. Thus, whether and to what extent this is to be done is a matter of procedural expediency. This means that the examining division has to weigh the aspects of the case involved. In particular, the likelihood that the objection raised can be overcome, the kind of amendments which can be expected, and any objections which could yet remain thereafter have to be weighed against the amount of additional work involved for the examining division.

In the case at issue, an objection concerning lack of novelty was raised in the first communication against all claims of the application. Such a far-reaching objection can normally only be overcome by substantial amendment of the claims. Therefore, claims amended in this way, if filed, have to be largely re-examined with respect to the prior art. In the view of the board, R. 51(3) EPC therefore does not require that an examining division should immediately raise the objection that the claims on file lack inventive step in relation to other documents, if it is of the opinion that all the claims in the application are anticipated by one document. By contrast, in its second communication concerning the amended claims filed by the appellant, the examining division, although maintaining the non-novelty objection against new claim 1, also raised an objection of lack of inventive step. Thus the board came to the conclusion that the appellant's submission that the examining division had breached R. 51(3) EPC by issuing several communications was unfounded (see also **T 937/09**).

In **T 2311/10**, the board held that whether and to what extent the examining division covered all the grounds against the grant of the European patent in a communication of was a question of procedural economy (see **J 32/95**) and a matter for the division's discretion.

In **T 161/82** (OJ 1984, 551) the board noted that a distinction had to be made between the grounds on which a decision was based (ie the requirements of the EPC which were not satisfied by the application or the invention to which it related) and the reasoned statement explaining in greater detail why the examining division was of the opinion that such grounds existed (see R. 51(3) EPC 1973). Art. 113(1) EPC 1973 did not require an applicant to be given repeated opportunity to comment on arguments of the examining division so long as the decisive objections to the grant of the European patent remained

the same except for some supplementary observations concerning the applicant's arguments which did not convince the examining division.

In **T 20/83** (OJ 1983, 419) the board noted that Art. 96(2) EPC 1973 prescribed that the examining division had to draw all obstacles to patentability to the applicant's attention. This conclusion related to the requirements for patentability as laid down in the EPC itself. The validity of a patent in various contracting states was however not an immediate condition under the EPC (see **T 830/91**, OJ 1994, 728).

In **T 98/88** the board pointed out that R. 51(3) EPC 1973 did not make it compulsory for communications in accordance with Art. 96(2) EPC 1973 to set out all the grounds against the grant of the patent. The board's view in this case was that deferral of the examination in respect of the requirements under Art. 52 EPC 1973 until a clear version of the claims had been received did not conflict with R. 51(3) EPC 1973 (see also **T 677/97**).

## **2.5. Refusal after a single communication**

### 2.5.1 General issues

According to the jurisprudence of the boards of appeal, an examining division may refuse an application after a single communication if it does not consider that there is a prospect of a positive result (see **T 201/98**, **T 79/91**, **T 1969/07**), without warning (**T 1002/03**, **T 1969/07**). The refusal of an application after the first communication is justified if decisive objections against patentability remain (see **T 84/82**, **T 161/82**, **T 300/89**, **T 95/04**), particularly where the claimed subject-matter has not been substantially modified (see also **T 66/83**, **T 304/91**, **T 63/93**).

In **T 821/96** the board stated that, according to the established case law, it was left to the examining division's discretion to decide whether to issue a further invitation to present comments under Art. 96(2) EPC 1973. A further invitation would only be appropriate if it appeared likely that, in the light of the applicant's reply, the examination proceedings would terminate in the granting of a patent (see also **T 201/98**).

In **T 449/03** the board stated that the appellant's allegation that the applicant was generally entitled to receive at least two communications in the examination proceedings before a negative decision on patentability was unfounded (see **T 84/82**, OJ 1983, 451). However, where features are added to a claim in response to an official communication, it is only in exceptional cases that a further communication may be dispensed with (cf. **T 161/82**, OJ 1984, 551): for example where it can be held that the features added to the claim are implicit to the specific part of the prior art document already held against the subject-matter of the claim, so that the objection against patentability communicated to the applicant remains the same.

In **T 5/81** (OJ 1982, 249) the appellant submitted that, in the only communication sent, the examiner had failed to comment on claim 5, an omission which was contrary to Art. 96(2) EPC 1973 and R. 51(3) EPC 1973. The board noted that an appeal might

relate only to a decision subject to appeal within the meaning of Art. 106(1) EPC 1973 and not to preparatory measures. Art. 96(2) EPC 1973 and R. 51(3) EPC 1973 applied exclusively to that **preparatory procedure**. A failure to comply with these requirements could not be taken into consideration unless it had some influence on the decision to refuse, as in the case of a breach of Art. 113(1) EPC 1973. The appellant's objection was unfounded, not only for this reason, but also because the examiner commented on the content of the claim in question by drawing attention to the possibility of formulating an independent claim based thereon. Since the appellant did not make use of that possibility, the examining division was not obliged to discuss it when refusing the application. The allusion thereto in the reasons for the decision did not form part of the ratio decidendi and was intended solely to demonstrate that the examining division was aware of the fact that the application might contain patentable subject-matter. A refusal under these circumstances was not open to challenge (see also **T 228/89**, **T 347/04**, **R 14/10**).

#### 2.5.2 Failing to make a "bona fide" response

In **T 802/97** the board noted that when applying Art. 96(2) EPC 1973 to determine in a specific case whether an applicant should be given a further opportunity to present comments or amendments before refusing an application **after** a single official communication, the established practice of the examining divisions as set out in particular in the Guidelines is to **warn** the applicant who had made a **bona fide attempt** to deal with the examining division's objections, e.g. by a telephone conversation or by a short further written action, that the application will be refused unless he can produce further more convincing arguments or makes appropriate amendments within a specified time limit. Only when the applicant has not made any real effort to deal with the objections raised in the first communication, should the examining division consider immediate refusal of the application, this however being an exceptional case (see also **T 587/02**).

In **T 1388/10** the appellant argued that the refusal of its application had been flawed because refusal directly after a first examining communication was allowed only if the applicant failed to make a "bona fide" response to that communication, whereas in the present case it had indeed made a "bona fide" attempt to overcome the examining division's objections. Its application should therefore not have been refused without a further "warning".

The board noted that examining divisions have discretion over how often to invite an applicant to comment. It also had to be borne in mind that the Guidelines merely offered general guidance covering normal occurrences. Their application in specific individual cases was the responsibility of the examining division, which could depart from them in exceptional cases. Also, the Guidelines were not the law – unlike the EPC and its Implementing Regulations. The board pointed out that when reviewing examining divisions' decisions it did not assess whether the division had complied with the Guidelines. Rather, it considered whether the division had exercised its discretion within the limits set by the EPC and its Implementing Regulations. In the case before it, the board held that the examining division's decision not to issue a second communication

under Art. 94(3) EPC fell within the discretion available to it, and its exercise of that discretion had not been flawed.

In **T 201/98** the board accepted that in the case at issue the appellant's response to the single communication was a bona fide attempt to deal with the examining division's objections. However it was the established jurisprudence of the boards of appeal that an examining division did not exceed its discretionary power by immediately refusing an application, provided that the decision complied with Art. 113(1) EPC 1973, i.e. was based on grounds on which the appellant had had an opportunity to present comments, see **T 84/82** (OJ 1983, 451) and **T 300/89** (OJ 1991, 480). In the case before it, the board considered that the decision of the examining division was based on grounds on which the appellant had had an opportunity to present comments in accordance with Art. 113(1) EPC 1973.

In **T 677/97**, the board took the view that the pre-decision examination procedure did not meet the minimum legal standard set by the EPC in Art. 96(2) EPC 1973 and R. 51(2) and (3) EPC 1973. R. 51(3) EPC 1973, by virtue of the phrase "where appropriate", allowed the examining division discretion to issue a first communication which is less than comprehensive. This interpretation of the EPC had also been approved in decision **T 98/88**. It was incumbent on the examining division under Art. 96(2) EPC 1973 to send a second communication containing a reasoned statement as to why the objection under Art. 56 EPC was maintained. In making this finding the board was not departing from the established jurisprudence of the EPO boards of appeal which recognised that it was within the discretion of an examining division to issue a refusal decision after a single communication. In the circumstances of the case at issue, however, an immediate refusal was not a reasonable exercise of this discretion. The limits on the examining division's discretion in this respect were explained in decision **T 951/92** (OJ 1996, 53).

The board stated that if a communication under R. 51(3) EPC 1973 and pursuant to Art. 96(2) EPC 1973 did not set out the essential legal and factual reasoning which would lead to 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) EPC 1973, unless and until a communication had been issued which contained such essential reasoning. If a decision was issued in the absence of a communication containing such essential reasoning, Art. 96(2) EPC 1973 was also contravened, since in order to avoid contravening Art. 113(1) EPC 1973 it was "necessary" to issue a further communication (following decision **T 640/91**, OJ 1994, 918).

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 (**T 181/95**, **T 958/99**, **T 1578/05**).

In **T 1002/03** the board stated that it was established jurisprudence of the boards of appeal that an examining division did not exceed its discretionary power pursuant to Art. 96(2) EPC 1973 ("as often as necessary") by proceeding to an immediate refusal after a first communication, provided that the decision complied with Art. 113(1) EPC 1973, i.e. was based on grounds on which the appellant had had an opportunity to present comments. In the case in point, the examining division's first and only official communication under Art. 96(2) EPC 1973 stated that the deficiencies mentioned in the IPER gave rise to objections under the corresponding provisions of the EPC. In reply to the official communication the appellant filed a new set of claims in which only claim 1 had been amended to overcome the objection of lack of clarity in the IPER. In the board's view no **special warning** in the official communication was necessary in these circumstances. Accordingly the appellant's right to be heard (Art. 113(1) EPC 1973) was not violated and the examining division did not exercise its discretion in an unreasonable way by refusing the application after a single official communication (see also **T 1969/07**).

## 2.6. Amendments under Rule 137(3) EPC

### 2.6.1 Discretion of the examining division under Rule 137(3) EPC

Under Art. 123(1) EPC, a European patent application or a European patent may be amended in proceedings before the EPO, in accordance with the Implementing Regulations. R. 137(3) EPC is of particular relevance.

R. 137(3) EPC stipulates that no further amendment may be made without the consent of the examining division. Thus the applicant may amend only if the examiner consents to the amendments proposed. Giving the examining division this discretion is intended to ensure that the examination procedure is brought to a conclusion in as few actions as possible (Guidelines C-IV, 3; H-II, 2.3 – November 2015 version). In exercising its discretion the examining division must consider all relevant factors; in particular, it must balance the applicant's interest in obtaining a patent which is legally valid and the EPO's interest in bringing the examination procedure to a close in an effective way (in accordance with the principles set out in **G 7/93**). Furthermore, the exercise of discretion under R. 137(3) EPC needs to be reasoned.

In giving or withholding such consent, the examining division has to exercise its discretion responsibly and in accordance with the principles as set out in the decision **G 7/93** (OJ 1994, 775) which, although made in relation to amendments made in the pre-grant stage, are of general validity. The Enlarged Board pointed out that in the exercise of its discretion under R. 86(3) EPC (now R. 137(3) EPC), an examining division is required to consider **all relevant factors** which arise in a case. In particular, it must consider both the applicant's interest in obtaining a patent which is legally valid in all of the designated states, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent, and must balance these interests against one another (**T 1982/07**). Once an examining division has exercised such discretion, a board of appeal should only overrule it if it comes to the conclusion either that the examining division did not exercise its discretion in accordance with the right



principles or that it exercised its discretion in an unreasonable way and had thus exceeded the proper limit of its discretion (see **T 237/96** with particular reference to **G 7/93**, OJ 1994, 775, **T 182/88**, OJ 1990, 287, **T 937/09**, **T 1214/09**).

In **T 1074/10** the board noted that the convergence criterion (whether the respective versions of the sets of claims converge or diverge) had been accepted by the boards of appeal and has also been applied by the boards themselves (see e.g. **T 240/04**; **T 1685/07**; **T 1969/08**). R. 86(3) EPC 1973 - and, equivalently, R. 137(3) EPC - leaves open entirely how the examining division should exercise its discretion. In particular, neither defines a convergence criterion nor a criterion based on prima facie compliance with the requirements of the EPC. The board was of the opinion that the "divergence" of a request from earlier requests in the sense that it changes substantially the issues at stake could be contrary to the EPO's interest in bringing the procedure to a close. Therefore, the board agreed with the cited jurisprudence and considered that **divergence of a request is one factor** amongst others which a deciding instance may consider when exercising its discretion under R. 86(3) EPC 1973. The decision of the examining division not to admit a request was therefore not wrong merely because this criterion was used, as the board understood the appellant to be arguing. Hence, the appellant's argument failed.

In **T 996/12** the appellant objected that the examining division had exercised its discretion under R. 137(3) EPC not only unreasonably, but also by applying the wrong principles as to the inadmissibility of the last amendments. The board stated that, in general terms, the way in which the examining division should exercise its discretion to allow amendment of an application depends upon the circumstances of each individual case and on the stage of the pre-grant procedure which the application has reached. It noted that a board of appeal reviews this exercise of discretion not in the form of how it would have decided in the case, but whether it was exercised according to the wrong principles, without taking into account the right principles, or whether it was exercised in an unreasonable way. In this respect, the board noted that the applicable Guidelines did not support the concept of converging claim sets being a requirement for allowing amendments or, conversely, a diverging claim set not being acceptable. The examining division referred to two board of appeal decisions, **T 1685/07** and **T 745/03**, for this criterion. Apart from the fact that these decisions apply particularly to the situation where a patent proprietor submits a plurality of auxiliary requests in addition to a main request in opposition appeal proceedings, it needed to be stressed that its underlining justification was to be found in the efficiency of these appeal proceedings, the latter being of a judicial nature in contrast to the purely administrative character of the proceedings before, for instance the examining division or the opposition division. The board found that this fundamental distinction *eo ipso* made the unqualified application of this criterion by the department of first instance of the EPO questionable. The appellant's objection that the examining division had exercised its discretion wrongly as to the inadmissibility of the last amendments was held not well-founded.

In **T 573/12** the board noted that according to R. 137(3) EPC (in the applicable version of December 2007, which is identical to former R. 86(3) EPC 1973) any amendment after the reply to the first communication needs the consent of the examining division. This

means that the examining division has discretion. One of the criteria applied in this context and accepted by the boards of appeal is whether the amendment *prima facie* overcomes objections previously raised. However, as set out in **G 7/93** (OJ 1994, 775), an examining division, when considering whether to admit an amendment or not, is required to consider all relevant factors which arise in the case. In particular it must consider and balance the applicant's interest in obtaining a patent and the EPO's interest in bringing the examination procedure to a close. In the case at issue, the examining division's first communication was rather vague and assessed the invention in rather general terms, without analysing the individual features. The appellant's subsequent amendment added some features to the independent claims. In the board's judgment, this was a *bona fide* reaction. Additionally, it was the first amendment which was dependent on the examining division's consent and the minutes showed that the examining division could and did discuss the added features. Admitting the request would not have involved excessive or unjustified additional work. Furthermore, the Guidelines (Part C-VI, 4.7 – April 2010 version) stated: "Regarding less extensive amendments, the examiner should adopt a reasonable approach, trying to balance fairness to the applicant against the need to avoid unnecessary delay and excessive and unjustified additional work for the EPO." Given the above circumstances, the board held that the examining division did not properly balance all relevant factors and thus could not endorse the examining division's conduct.

In **T 937/09**, the board held that, under the second sentence of R. 137(3) EPC (as adopted by decision of the Administrative Council of 7 December 2006; see 13th edition of the "European Patent Convention", European Patent Office, 2007), it was for the examining division to decide in a proper exercise of discretion whether to admit amendments to a European patent application after the first communication. In the board's view, this meant that the examining division had to admit amendments filed by the applicant together with the reply to a communication giving reasoned notice of a particular deficiency for the first time, if it could already have raised an objection to that deficiency in its first communication, and if the amendments could be regarded as an objectively suitable attempt to correct the deficiency.

In **T 166/86** (OJ 1987, 372) the board held that under R. 86(3) EPC 1973, further amendments - which included the submission of a separate set of claims for a given contracting state - could only be made with the consent of the examining division (see Legal Advice No. 4/80, OJ 1980, 48). The examining division had to take the decision on whether to consent to the requested amendment after due assessment of the particular circumstances. In particular, this involved balancing the EPO's interest in the speedy completion of the proceedings against the applicant's interest in obtaining a patent which was legally valid in all the contracting states. The examining division would not be able to refuse its consent to an amendment if, for good reasons, the applicant was only at that late stage in a position to request the amendment, or if the requested amendment was obviously essential for him and to take it into account would not appreciably delay the grant procedure. In the board's view, the latter situation was the case here.

In **T 640/91** (OJ 1994, 918) the board stated that the requirement in Art. 96(2) EPC 1973 that the examining division must invite the applicant to file his observations "as often as

necessary" implicitly recognised that in certain circumstances the examining division would be legally **obliged** to invite further observations from the applicant before issuing a decision. Having regard to Art. 113(1) EPC 1973, there was a "necessary" legal obligation for an examining division to invite further observations from an applicant before issuing a decision adversely affecting him, where the division might be inclined to issue an immediate decision on the ground that he had shown lack of good faith in his previous observations. The board pointed out, moreover, that it was in principle not the function of an examining division to assess either the degree of collaboration from applicants or their good faith when deciding whether or not to invite further observations in the exercise of its discretion under Art. 96(2) EPC 1973. The exercise of this discretion depended primarily upon whether or not there was a reasonable prospect that such an invitation could lead to the grant of a patent (see also **T 855/90**, in which the board found that the examining division had exercised its discretion unreasonably).

In **T 229/93** the board found that in the circumstances of the case at issue the examining division should have considered refusing to consent to the amendments pursuant to R. 86(3) EPC 1973, since the filing of such amendments after the expiry of the time limit for answering the first communication of the examining division in the form of a completely retyped description was contrary to the requirement of procedural economy (see **T 113/92**).

In **T 951/97** the board noted that whether or not consent was given was at the discretion of the examining division and depended on the facts of the individual case, on the nature of the grounds for seeking an amendment, and equally on the stage of the procedure. It was easier to secure an amendment at an earlier rather than at a later stage (see **T 529/94** and **T 76/89**).

#### 2.6.2 Consent under Rule 137(3) EPC in oral proceedings

R. 116(2) EPC supplements R. 137(3) EPC with a special provision on amendments to the application where oral proceedings are to be held, under which the examining division has discretion to disregard such amendments if they are not filed before the date fixed in the summons to such proceedings. However, whilst meeting the deadline for filing further requests for amendments to the application fixed in the summons under R. 116 EPC does not render R. 137(3) EPC inapplicable, requests filed by that deadline can only be refused under R. 137(3), sentence 2, EPC in a proper exercise of discretion which must take account of the factors set out above (**T 937/09**).

#### 2.6.3 The burden of proposing amendments

In **T 300/89** (OJ 1991, 480) the board pointed out that, even if it were possible for the examiner to envisage amendments which might lead to the grant of a patent, the burden lay with the applicant to propose amendments if he so wished (including various alternatives in the form of auxiliary requests). These amendments could be proposed in the applicant's observations in reply to the first communication (Art. 96(2) EPC 1973) from the examining division, where any objections were raised (**T 599/92**). It also held that an applicant had a right to request oral proceedings at any time, but if he wished to

avoid the risk of an adverse decision being issued without oral proceedings being appointed, he should request oral proceedings at the latest in his observations in reply to such (here, first) communication under Art. 96(2) EPC 1973.

In **T 301/10** the board stated that it is incumbent upon the appellant to maintain unamended or to amend - optionally on an auxiliary basis - the application documents upon which examination is to be carried out and a decision eventually to be reached (Art. 94 and 97 EPC together with Art. 113(2) EPC 1973) (see supra **T 300/89**, point 9.1 of the Reasons), and not upon the examining division to prolong the examination procedure beyond the procedural framework set out in the EPC (see in this respect Art. 123(1) EPC together with R. 86(3) EPC 1973) until the applicant opts for amending the application and eventually "exhausts" all possibilities for amendment, as this would seriously undermine the principle of procedural economy.

#### 2.6.4 Reasons for the exercise of discretion

In **T 182/88** (OJ 1990, 287) and **T 166/86** (OJ 1987, 372), the board decided that a separate set of claims submitted at a late stage in the proceedings was admissible under the particular circumstances. It added that the EPO's user-friendly reputation should clearly be excluded from consideration during the exercise of any discretion by the EPO. The showing of consideration towards parties before the EPO should not be confused with the proper exercise of discretion according to the law. It was also held that when a decision hinged on the exercise of discretion, the **reasons should be given**.

In **T 309/09**, the board doubted that the number of auxiliary requests could generally be considered a factor on the basis of which their admission under R. 137(3) EPC could properly be denied outright. Whilst it did not wish to rule out that a large number of auxiliary requests might be a sufficient reason in specific cases, it decided that the question could be left unanswered in the case before it, as in any event six auxiliary requests could not automatically be considered excessive. Nor did it have to consider whether **a lack of convergence among the requests** was relevant in this connection, because the contested decision did not contain any explicit analysis of specific cases which might support such a conclusion, even though any convergence criterion applied would at any rate have had to be assessed separately for each individual request. The board concluded that the examining division had been entitled to exercise discretion and had done so in accordance criteria which were essentially correct in the light of **G 7/93**, but that, contrary to R. 111(2) EPC, it had failed to give adequate reasons in support of its exercise of discretion in the contested decision. Discretionary decisions could not be taken arbitrarily and - like all decisions open to appeal - had to be substantiated. Even deficient reasoning was a fundamental procedural error on the basis of which the matter could be remitted back to the department of first instance under Art. 11 RPBA.

In **T 246/08** the board stated that it is the established jurisprudence of the boards of appeal that the power of the examining division to consent to amendments under R. 137(3) EPC is a discretionary power that has to be exercised after considering all the relevant factors of the specific case and balance in particular the applicant's interest in obtaining an adequate protection for his invention and the EPO's interest in bringing the

examination to a close in an effective and speedy way. Moreover, the exercise of a discretionary power has to be reasoned, otherwise it would be arbitrary. It followed that a refusal of consent to amend made in advance of any amendment being submitted could not be a reasonable exercise of discretion pursuant to R. 137(3) EPC. Indeed in the judgment of the board it was ipso facto a substantial procedural violation since it risked deterring an applicant from making an amendment which could not reasonably have been forbidden. (see also **T 872/90**).

In **T 1105/96** (OJ 1998, 249) the board noted that the admissibility of any main or auxiliary request which was filed after the reply to the first communication from the examining division was a matter within the discretion of the examining division (R. 86(3) EPC 1973). Such discretion must be exercised lawfully having regard to the relevant circumstances. In a case such as this, where an examining division had indicated that a further request in the form of an amended text for the main claim of an application would be allowable, it was difficult to imagine any circumstances in which it would be lawful for the examining division to deny the admissibility of such request, in the exercise of such discretion. Certainly, in the circumstances of the case at issue, the rejection in advance of such a further auxiliary request unless all preceding requests were abandoned was an abuse of procedure, an unlawful exercise of discretion under R. 86(3) EPC 1973 and thus a substantial procedural violation within the meaning of R. 67 EPC 1973.

In **T 233/12** the board noted that R. 137(3) EPC provides that any second and "further amendment" to the description, claims and drawings requires the consent of the examining division. This makes admission of such a further amendment a matter of discretion for the examining division. According to **G 7/93**, the board should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance with the right principles, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion.

The board pointed out that the criterion that an amended set of claims is prima facie not allowable is, in general, an accepted principle (amongst others) to be taken into account in the assessment of whether consent under R. 137(3) EPC should be given to the amendment. While a prima facie finding that a claim is not allowable may, by its very nature, be justified in briefer terms than a fully reasoned conclusion, the reasons for a prima facie finding may not be so short as to reduce the finding to a mere allegation. Moreover, the amount of reasoning required to justify a prima facie finding was amongst the parameters which the examining division had to balance in view of the circumstances of each individual case when exercising its discretion. In particular, if, as in this case, an applicant files an amendment together with arguments as to why the amendment, in its view, satisfies a particular requirement of the EPC, the examining division cannot merely assert the contrary without giving an indication as to why the applicant's argument failed. That is, a prima facie finding must not simply ignore the arguments on file which appear to directly contradict it. For these reasons, the board concluded that the examining division had not exercised its discretion under R. 137(3) EPC in a reasonable way.

### 2.6.5 Second communication under Rule 71(3) EPC: the consent of the examining division

If the examining division gives its consent under R. 137(3) EPC to these amendments and/or the correction and considers them allowable without issuing a further communication under Art. 94(3) EPC, it issues a **second communication** under R. 71(3) EPC based on the amended/corrected text, after which it then proceeds to the grant of the patent pursuant to Art. 97(1) EPC (see below in this chapter IV.B.3.1 "R. 71(3) EPC communication: the text for approval"). Where amendments or corrections are not admitted, or where they are admitted but not considered allowable, examination will be resumed (Guidelines H-II, 2.5.3 – November 2015 version).

### 2.7. Failure to reply to the communication from the examining division (Article 94(4) EPC)

According to Art. 94(4) EPC, if the applicant fails to reply in due time to any communication from the examining division, the application shall be deemed to be withdrawn. Art. 94(4) EPC corresponds in essence to Art. 96(3) EPC 1973.

#### 2.7.1 Reply within the meaning of Article 94(4) EPC

In **J 37/89** (OJ 1993, 201), the Legal Board of Appeal construed Art. 96(3) EPC 1973 to mean that an applicant who merely requests an extension of the term for reply which request is then refused, 'fails to reply' within the meaning of that sub-paragraph, with the consequence that the application must be deemed withdrawn.

In **T 160/92** (OJ 1995, 35) the board held that Art. 96(3) EPC 1973 did not require "a complete reply", but only "a reply" in order to avoid the consequence of having the application deemed to be withdrawn. A letter of reply to a communication of the examining division filed in due time by the applicant and dealing with substantial points of this communication constituted a reply within the meaning of Art. 96(3) EPC 1973 and thus, from the point of view of procedural law, ruled out the possibility of deemed withdrawal.

Both of these decisions **J 37/89**, **T 160/92** also expressed the view that a letter of reply did not have to be (substantively) complete or cogent in order to qualify as a reply within the meaning of Art. 96(3) EPC 1973 (**T 685/98**, OJ 1999, 346).

In **J 29/94** (OJ 1998, 147) the board observed - in relation to Art. 110(3) EPC 1973 - that there was another form of reply which could result in a refusal, and not in the deemed withdrawal of the application; if the applicant did not want to reply in substance to the communication, it was permissible for him to ask for a decision on the file as it stood.

In **J 5/07** the board held that the filing of a divisional application did not constitute a response to an invitation by the examining division in the parent application within the meaning of Art. 96(3) EPC 1973. The board noted that a divisional application was legally and administratively separate and independent from the grant proceedings

concerning the parent application (see **G 1/05** (OJ 2008, 271; points 3.1 and 8.1 of the Reasons; **T 441/92**). The filing of a divisional application leaves the text of the patent application objected to unamended.

In **T 861/03**, the board found that filing a request for an interview with the processing examiner without also submitting substantive observations on deficiencies identified in the communication under Art. 96(2) EPC 1973 did not amount to an adequate reply for the purposes of Art. 96(3) EPC 1973, under which the legal consequence of failing to submit such a reply was that the application was deemed to be withdrawn.

#### 2.7.2 Waiver of the applicant's right to present comments

In unclear cases there can be no presumption that an applicant has waived his right to be heard under Art. 113(1) EPC. Hence a refusal decision pursuant to Art. 97(2) EPC (former Art. 97(1) EPC 1973) based on such a presumption and taken before expiry of the term originally set for reply to a communication contravenes Art. 113(1) EPC and thus involves a substantial procedural violation (**T 685/98**).

In **T 685/98** (OJ 1999, 346) the board noted that prior to a valid refusal under Art. 97(1) EPC 1973 the applicant must either have exercised his right to comment or have waived this right. It held that a simple procedural request made by the applicant after receipt of the R. 51(2) EPC 1973 communication could not be treated as a waiver of the right to present comments during the remainder of the four-month term set for reply. When the applicant neither replied in substance to the objections raised nor waived his right to present comments, then the refusal of the application was ultra vires and voidable ab initio because under Art. 97(1) EPC 1973 the application was to be refused, if no different sanction was provided for by the Convention. However, Art. 96(3) EPC 1973 provides a different sanction for failure to reply, namely the deemed withdrawal of the application.

### 2.8. Issue of a further communication under Article 113(1) EPC

#### 2.8.1 General issues

If it appears that the previous communications were insufficiently reasoned or incomplete, or if the applicant has filed amendments and/or arguments since the previous communication, the examiner should carefully consider Art. 113(1) EPC before issuing a refusal. A further communication may have to be issued with sufficient reasoning, unless oral proceedings are to be held (see Guidelines C-V, 15.4 – November 2015 version).

Under Art. 113(1) EPC, the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

In **T 645/11** the board stated that Art. 113(1) EPC 1973 guarantees that proceedings before the EPO will be conducted openly and fairly (see **J 20/85**, OJ 1987, 102, point

4(a) of the Reasons; **J 3/90**, OJ 1991, 550). The right to be heard ensures that the parties to proceedings are not taken by surprise by grounds mentioned in an adverse decision (see decisions **T 669/90**, OJ 1992, 739 and **T 892/92**, OJ 1994, 664, for example). That requires, firstly, that a party be given an opportunity to comment on the grounds and evidence alleged against it. In particular, it means that if a decision to refuse is taken on the basis of grounds which have not previously been presented to the applicant, then the decision does not comply with the provisions of Art. 113(1) EPC 1973. It is not sufficient that the applicant be presented with an assertion that the application fails to comply with some provision of the EPC. There must also be an explanation of why it fails to comply. The right to be heard also requires the deciding instance demonstrably to hear and consider any relevant comments (**T 763/04**, or **T 246/08**).

In **T 690/09** the board stated that if a request for amendment is refused, the examining division must inform the applicant of the reasons for not admitting the amendments in order to satisfy the right to be heard according to Art. 113(1) EPC. The applicant will typically be invited to request grant on the basis of a preceding acceptable version of the claim set if such a version exists. Otherwise, if the applicant maintains his request for amendment, the application has to be refused under Art. 97(2) EPC, since there is no text which has been approved by the applicant and allowed by the examining division (see Art. 113(2) EPC 1973, decisions **T 647/93**, OJ 1995, 132; **T 946/96** and **T 237/96**).

In **T 246/08** the board stated that established jurisprudence has interpreted this provision to mean that the comments presented must be considered in the ensuing decision (**J 7/82**, OJ 1982, 391). Thus a decision which fails to take explicitly into account potentially refutative arguments submitted by a party, i.e. arguments which may militate against or cast doubt on the decision in question, contravenes Art. 113(1) EPC 1973, thereby constituting a substantial procedural violation. In brief, a decision must show that all potentially refutative arguments adduced by a party are actually refutable (see also **T 1170/07**).

In **T 1854/08** the applicant was informed by e-mail that the three newly filed requests were not admitted into the proceedings because they introduced substantial obscurities. The board stated that the applicant had not been given any opportunity to present his comments to overcome the negative position expressed in the e-mail. Contrary to that, he had had to gather from the e-mail that it was no longer possible to convince the examining division. This followed from the fact that the refusal to admit the newly filed request was not presented as a provisional opinion of the division but as a decision which could not be overturned. This contravened Art. 113(1) EPC.

#### 2.8.2 Arguments taken into account in the decision of the examining division

According to the jurisprudence of the boards of appeal, the examining division does not have to address each of the party's arguments (see e.g. **T 1969/07**, **T 1557/07**, or **R 19/10**).



In **T 1557/07** the board stated that with regard to the allegation that the examining division did not fully and accurately deal with all the relevant arguments submitted by the applicants, the examining division was under no obligation to address each and every argument presented by the party concerned. In the case at issue, the examining division had commented on the crucial points of dispute thus giving the applicants a fair idea of why their submissions were not considered convincing. This allegation was therefore also not conclusive. In conclusion, the examining division had not committed a substantial procedural violation.

In **R 19/10** the petitioner submitted that Art. 113(1) EPC not only enshrined a party's right to be heard before a decision was issued against it, but also guaranteed its right to have the relevant grounds fully taken into account in the written decision. The Enlarged Board of Appeal stated that it agreed in principle. However, this principle was not without any limitation, as explained in decision **T 1557/07**, referred to by the petitioner itself: provided that the reasons given enable the parties concerned to understand whether the decision was justified or not, the deciding organ is under no obligation to address each and every argument presented by the party concerned.

In **T 802/97** the board held that if a decision included several grounds, it should meet the requirements of Art. 113(1) EPC 1973 with respect of each of the grounds. In the board's judgment, if a decision of the EPO included several grounds supported by respective arguments and evidence, it was of fundamental importance that the decision as a whole met the mandatory requirements of Art. 113(1) EPC 1973. Leaving it up to the deciding body to suggest which of the grounds were to be considered as the basis of the decision and which were not - and did not therefore need to comply with the requirements of Art. 113(1) EPC 1973 - could only lead to legal uncertainty and confusion of the parties. An exception from the above principle could be obiter dicta which were not part of the grounds on which a decision is based.

### 2.8.3 Information on non-compliance: the essential reasoning

In **T 951/92** (OJ 1996, 53) the board held that if a communication under R. 51(3) EPC 1973 and pursuant to Art. 96(2) EPC 1973 did not set out the essential legal and factual reasoning to support a finding that a requirement of the EPC had not been met, then a decision based on such a finding could not be issued without contravening Art. 113(1) EPC 1973, unless and until a communication had been issued which did contain the essential reasoning. If a decision was issued in the absence of a communication containing essential reasoning, Art. 96(2) EPC 1973 was also contravened, since in order to avoid contravening Art. 113(1) EPC 1973 it was "necessary" to issue a further communication (see also **T 520/94**, **T 750/94**, OJ 1998, 32; **T 487/93**, **T 121/95**, **T 677/97**).

In **T 951/92** (OJ 1996, 53) the board summed up the case law by stating that Art. 113(1) EPC 1973 was intended to ensure that, before a decision refusing an application for non-compliance with a requirement of the Convention was issued, the applicant had been **clearly** informed by the EPO of the essential legal and factual reasons on which the finding of non-compliance was based. This was so that in advance

of the decision he knew both that the application might be refused and why, and also so that he might have a proper opportunity to comment upon the reasons and/or to propose amendments so as to avoid refusal of the application. Thus the term "grounds or evidence" in Art. 113(1) EPC 1973 should **not** be **narrowly** interpreted. In particular, in the context of the examination procedure the word "grounds" did not refer merely to a ground of objection to the application in the narrow sense of a requirement of the Convention which was considered not to be met. The word "grounds" should rather be interpreted as referring to the **essential reasoning**, both legal and factual, which led to refusal of the application (**T 187/95**). In other words, before a decision was issued an applicant had to be informed of the requirement which he had to meet and had to have an opportunity of meeting it (see also **T 520/94**, **T 750/94**, OJ 1998, 32; **T 487/93** and **T 121/95**).

In **T 907/91** the examining division refused the application without informing the applicant of its grounds for not accepting the amended documents submitted after receipt of the first communication and after oral proceedings. The board held this action to be in breach of Art. 113(1) EPC 1973 because, prior to issuing the contested decision in written or oral proceedings, the examining division should have given its reasons for refusing to accept the amended documents. Such grounds could be of a formal nature or relate to substantive patent law, depending on the relevant provisions. However, other grounds could also be brought to bear, based on generally recognised principles of procedural law (see Art. 125 EPC 1973), such as the applicant's attempt to delay proceedings by submitting an excessively large number of requests for amendments in clear abuse of the patent grant procedure.

In **T 763/04** the board stated that Art. 113(1) EPC enshrines a party's right to be heard before a decision is issued against it. In accordance with the established jurisprudence of the boards of appeal (see **J 7/82**, OJ 1982, 391 and **T 94/84**, OJ 1986, 337) this right also guarantees the right to have the relevant grounds fully taken into account in the written decision. The board held that Art. 113(1) EPC 1973 will be contravened where, as in the case before it, facts and arguments, which from the appellant's submissions are clearly central to his case and which may speak against the decision taken, are completely disregarded in the decision in question. The board stated that Art. 113(1) EPC 1973 requires not merely that a party be given the opportunity to voice comments, but more importantly that the deciding instance demonstrably hears and considers these comments. In summary, the right to be heard in accordance with Art. 113(1) EPC 1973 is contravened if the decision of the first instance fails to mention and to take into consideration important facts and arguments which may speak against the decision in question (see also **T 206/10**; **T 246/08**).

#### 2.8.4 Essential reasoning based on an IPER

In **T 275/99** the board held that the requirements of Art. 113(1) EPC 1973 were met if the appealed decision was entirely based on the grounds, facts and evidence which were already known to the appellant from the extensive international preliminary examination report (IPER) which had been drawn up for the description and the claims of the international application corresponding exactly to the European application refused and

which had been incorporated by way of reference in an official communication of the examining division.

In **T 587/02** the board held that if the only communication preceding the decision to refuse an application merely draws attention to an International Preliminary Examination Report (IPER), the requirements of Art. 113(1) EPC are met provided the IPER constitutes a reasoned statement as required by R. 51(3) EPC 1973, using language corresponding to that of the EPC.

In **T 1870/07** the single communication from the examining division pursuant to Art. 96(2) EPC 1973 merely signalled agreement with the IPER. The board did not see any objection to citing an IPER from an International Preliminary Examining Authority other than the EPO, provided that it constituted a reasoned statement (see, for example, **T 951/92**). However, in its view, the IPER failed to meet the requirements of a reasoned statement. In the communication of the examining division, there was no logical chain of reasoning which would have permitted the appellant to understand and deal with the novelty objection, either by amendment or counterargument. Art. 113(1) EPC 1973 was, therefore, not satisfied.

#### 2.8.5 Fresh argument based on grounds and evidence communicated beforehand

According to the case law of the boards of appeal, the use of a fresh argument in a decision still based on grounds and evidence communicated beforehand is not precluded.

The board pointed out in **T 268/00** that the right to be heard pursuant to Art. 113(1) EPC 1973 only precluded a decision's being taken on the basis of fresh evidence and grounds, while the use of a **fresh argument**, here based on a particular technical opinion, in a decision still based on grounds communicated beforehand was not precluded. Hence the technical argument in the decision under appeal addressed by the appellant, whether fresh or not, did not violate any of the appellant's rights. As to the technical substance of that argument, whilst the appellant might neither agree with the finding of the examining division nor with the technical argument given, a divergence of views between the examining division and the appellant on the substantive issue of inventive step did not amount to a procedural violation (see also **T 1557/07**, **T 815/089**).

#### 2.8.6 Bona fide attempt by the applicant to overcome the objections

In a case where an applicant has made a bona fide attempt to overcome the objections raised by the examining division, Art. 113(1) EPC may require such an attempt to be confirmed in the light of amended claims and substantial comments of the applicant (**T 734/91**, **T 582/93**).

In **T 734/91** the appellant had filed a fresh set of claims in reply to a communication of the examining division, the subject-matter of claim 1 being considerably changed in the light of the objection of lack of novelty raised by the examining division. These were **substantial amendments** in the light of the objections raised by the examining division.

The effort by the appellant was therefore considered to represent a bona fide attempt to overcome these objections. Claim 1 as amended had not been dealt with in the communication by the examining division but only in the contested decision. Thus the appellant did not have an opportunity to present his comments with regard to the grounds for refusal of this amended claim 1. The board stated that the examining division has to communicate the grounds against the grant of a patent to the applicant before refusing an application. In doing so it has to exercise its discretion to decide when it is deemed necessary and appropriate to invite the applicant's comments. This has to be done objectively in the light of the circumstances of each case (**T 162/82**, OJ 1987, 533). This does not mean that the applicant should be given repeated opportunity to comment on the same objections (**T 161/82**, OJ 1984, 551; **T 42/84**, OJ 1988, 251; **T 243/89**). In a case where an applicant has made a bona fide attempt to overcome the objections raised by the examining division, Art. 113(1) EPC 1973 may require such an attempt to be confirmed in the light of amended claims and substantial comments of the applicant (see also **T 998/05**).

In **T 763/04** the board held that the appellant, who had made a bona fide attempt to address the sole objection raised, could have legitimately expected the examining division out of fairness to use the discretion afforded by Art. 96(2) EPC 1973 to offer at least one further opportunity to address the objection. The board considered the refusal after the third communication, which was the first R. 51(3) EPC 1973 compliant communication as regards the ground of lack of novelty, without the issuance of a further communication, to represent a violation of the general principle of good faith and fair proceedings underlying the proceedings before the EPO.

In **T 92/96** the board found that, after notification of a correctly reasoned communication from the examining division, the applicants had had an opportunity to comment on the objections set out therein, but had confined themselves to suggesting a **minor correction** to the claim. The examining division decided to refuse the application, since the applicants had made no real effort to reply to the objections. In the board's view, the applicants had therefore suffered no prejudice. Consequently, the examining division had not committed a procedural violation, particularly with regard to Art. 113(1) EPC 1973.

#### 2.8.7 Form of the communication under Article 113(1) EPC

In **T 1237/07** the board pointed out that the right to present comments enshrined in Art. 113(1) EPC 1973 did not necessarily need to be exercised in writing but could be satisfied by way of oral proceedings.

In **T 497/02** the board found that Art. 113(1) EPC 1973 merely requires applicants to be afforded the opportunity to present their comments on the grounds on which the EPO bases its decision: it does not require a written communication nor does it specify how much time applicants should be afforded to consider and present their comments.

## 2.9. Informal communications

### 2.9.1 Telephone conversations

In **T 300/89** (OJ 1991, 480) the board held, in relation to the appellant's complaint as to the failure of the examiner to telephone as requested, that the practice in relation to such informal communications was clearly set out in the Guidelines. Such informal communications and the practice relating to them should be clearly distinguished from the formal examination procedure governed by Art. 96(2) EPC 1973 and R. 51 EPC 1973. The examiner's discretion as to whether to make such an informal communication had to be exercised in accordance with the Guidelines, having regard to the particular circumstances of each individual case. An exercise of such discretion adversely to an applicant, such as in the case in question, could not by its nature be a procedural violation, however, because the procedure for such conversations was informal in the sense that it was not governed by the EPC 1973, but was additional to the procedure provided by the EPC 1973. In any event, in the board's view, in the case in question no criticism could properly be made of the examiner in relation to his failing to telephone the appellant.

In **T 160/92** (OJ 1995, 35) the appellant claimed that in two telephone conversations with the primary examiner he was misled into believing that a refusal was not imminent, as a further communication would be issued as the next step of the procedure. The board noted that telephone calls between examiners of the EPO and applicants, in some situations, could be a tool for speeding up an otherwise slower procedure. However, one should be warned against expecting too much from them in critical situations, as misunderstandings could happen more easily than in writing, sometimes promoted by the fact that one of the two participants in the conversation might not be fully prepared for dealing with the case. It was with good reason that the procedure before the EPO was in principle, with the exception of oral proceedings under Art. 116 EPC 1973, a written procedure. Moreover, in the examination (as well as in the opposition) procedure the primary examiner was only one of a division of three examiners, it being well-known that his individual statements could not be binding for the division. Furthermore, telephone conversations were not provided for in the Convention and did not, as such, form part of the formal procedure before the EPO. The board held that the answer to the controversial question whether the applicant was misled about the possibility of imminent refusal of the application must be sought by focusing on the procedurally relevant content of the file.

In **T 1905/07** the board held that such an oral communication could in principle allow the applicant to exercise the right to present comments enshrined in Art. 113(1) EPC 1973, either orally (for instance in the oral proceedings planned for the next day) or in writing. However, presenting new grounds in a telephone conversation should not be equated with presenting the same grounds in formal oral proceedings or in a formal written communication. First, mere verbal communication by telephone was more prone to misunderstandings. Secondly, a party also had a right to be heard by the organ which took the decision, i.e. the examining division in the case at issue. A telephone conversation with only one of the examiners of that division did not safeguard this right in

the same way as oral proceedings. Whether or not a party's fundamental right to be heard had been infringed depended on the particular circumstances of the case.

### 2.9.2 Interviews

In principle, the refusal of a request for an interview with the examiner concerned does not contravene any of the rules of procedure contained in the Convention. If the applicant requests a personal consultation, the request should be granted unless the nature of the issue to be discussed requires formal proceedings or the examiner believes that no useful purpose would be served by such a discussion. (Guidelines C-VII, 2, November 2015 version).

In **T 98/88** it was held that Art. 116 EPC 1973 gave every party the absolute right to oral proceedings, but not the right to an interview with a particular member of an examining division. It is for the examiner concerned to decide whether such an interview should take place (see also **T 589/93**). In **T 193/93**, the board held that examiners were under no obligation to grant an "interview" (**T 235/85**, **T 909/95**).

In **T 409/87** the board noted that Art. 116 EPC 1973 makes it clear that whether or not the EPO considers it to be expedient, a party is entitled to oral proceedings upon request (see **T 299/86**, OJ 1988, 88). However, a request for an interview is clearly not, by itself, a request for oral proceedings and there is no obligation upon the examining division to grant such request for an interview when, as set out in the Guidelines, the examiner believes that no useful purpose would be served by such a discussion (see **T 19/87**, OJ 1988, 268, **T 909/95**). As an interview, in contrast to oral proceedings, is not a procedural step provided by the Convention, the refusal to grant a request for an interview is not a decision open to appeal and, therefore, does not fall under the provision of R. 68(2), first half-sentence, EPC 1973.

In **T 283/88** the board stated that if a request for oral proceedings has been made, such proceedings must therefore be appointed. This is in contrast to a request for an interview before the examining division, in which case the examining division may refuse such a request if it considers that no useful purpose would be served by such a discussion (cf. Guidelines). As pointed out in the decision in case **T 19/87**, if there is any doubt in any particular case as to whether or not oral proceedings have been requested, it is clearly desirable as a matter of practice that clarification should be sought from the party concerned.

In **T 366/92** the statement that the applicant "would welcome the opportunity to discuss the case with the Examiner at an informal interview ..." did not constitute a request for oral proceedings under Art. 116 EPC 1973.

In **T 299/86** (OJ 1988, 88) the board held that the right of a party to request oral proceedings under Art. 116 EPC 1973 was in no way affected by the fact that such party could have also requested and/or attended an interview with the examiner.

In **T 808/94** the board stated that informal interviews (also called "personal consultation") and/or informal consultations by telephone which were carried out by the primary examiner alone could not replace duly requested oral proceedings under Art. 116 EPC 1973, which were to take place before all members of the examining division (Art. 18(2) EPC 1973).

### **3. The grant stage in examination**

By decision of the Administrative Council CA/D 2/10 of 26 October 2010 (OJ 2010, 637), R. 71 EPC's paragraphs 3 to 7 of were amended, its paragraphs 8 to 11 were deleted and new R. 71a EPC was inserted. The provisions as amended entered into force on 1 April 2012.

R. 71 EPC governing the last phase of the grant proceedings has been split into two separate rules: new R. 71 EPC focuses on the work of the examining division and R. 71a EPC on issues which arise when the grant procedure is concluded and which are mainly dealt with by the formalities officer acting on behalf of the division.

#### **3.1. Rule 71(3) EPC communication: the text for approval**

New R. 71 EPC reinstates the pre-2002 practice concerning changes to the text intended for grant suggested by the examining divisions. The new text of R. 71(3) EPC (R. 51(4) EPC 1973), which entered into force on 1 April 2012, reads as follows: "Before the examining division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it and of the related bibliographic data. In this communication the examining division shall invite the applicant to pay the fee for grant and publishing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within four months."

Thus once the examining division has decided that a patent can be granted it must inform the applicant of the text on the basis of which it intends to do so. Under the new regime, this text may include amendments and corrections made by the examining division on its own initiative which it can reasonably expect the applicant to accept. (Guidelines C-V, 1.1 – November 2015 version, Text for approval).

In **T 1849/12** the appellant asked for the withdrawal of the examining division's communication, and requested that the examining division be instructed to issue the communication under R. 71(3) EPC without delay - specifically before the expiry of 18 months from the priority date - and therefore to grant the European patent as quickly as possible. The board noted that Art. 93(2) EPC provided for the possibility of granting a patent before the expiry of the 18-month period. An earlier grant was thus not ruled out, provided the examining division had already concluded that the application met all the requirements of the EPC. As this was not yet so in the case at issue, the possibility provided for in Art. 93(2) EPC of granting a patent before the 18 months expired did not apply. The board did not see any conflict in this regard between the provisions of Art. 93(2) and 97(1) EPC. Under the Convention, the granting of a patent was conditional upon the mandatory examination of all EPC requirements. A patent could only be

granted if the examining division considered all examination requirements met. Contrary to the appellant's claim, the examining board had no discretion in this regard. It had to be taken into account that the EPO was responsible for safeguarding the interests of the public, in addition to those of the appellant, and the public had to be able to rely on it doing so. Nor was the requirement of novelty over the prior art according to Art. 54(3) EPC a subordinate one, as the appellant appeared to claim. Rather, the lack of novelty over prior art according to Art. 54(3) EPC was a ground for both opposition under Art. 100(a) EPC and revocation under Art. 138(1)(a) EPC.

## 3.2. Approval of the text by the applicant

### 3.2.1 General issues

The new provisions decided by the Administrative Council, which entered into force on 1 April 2012 (CA/D 2/10 of 26.10.2010, OJ 2010, 637), are not intended to change the current procedure for cases where the applicant agrees with the text communicated to him under R. 71(3) EPC. This means that if the applicant pays the fees and files the translations within this period (and files or requests no corrections or amendments to the text proposed for grant in the R. 71(3) EPC communication), he will be **deemed to have approved** the text intended for grant (R. 71(5) EPC) (Guidelines C-V, 1.1 – November 2015 version).

The above also applies where the R. 71(3) EPC communication was based on an auxiliary request, provided that the applicant does not reply to the R. 71(3) EPC communication by requesting that a grant be based on a higher ranking request. This means that, in the absence of any indication to the contrary, the above acts imply approval of the text of the auxiliary request upon which the R. 71(3) EPC communication was based as well as the abandonment of all higher ranking requests. The above also applies where the R. 71(3) EPC communication included proposals by the examining division for amendments or corrections of the text intended for grant. Consequently, provided the applicant does not reject these proposed amendments or corrections in his reply, the completion of the above acts constitutes approval of the text containing the amendments or corrections as proposed by the examining division (Guidelines C-V, 2 – November 2015 version, "Grant of a patent").

### 3.2.2 Clear and unambiguous approval of the text

A number of decisions commented on below relate to earlier versions of former R. 51(4) EPC 1973 (now R. 71(3) EPC, version 2012). Nevertheless, they may also be applicable to the new R. 71(3) EPC.

In **J 12/83** (OJ 1985, 6) the board held that an applicant for a European patent could be "adversely affected", within the meaning of Art. 107 EPC 1973, by a decision to grant the patent if the patent were granted with a text not approved by the applicant, contrary to Art. 97(2)(a) EPC 1973. Approval, for the purposes of that Article, had to be established "in accordance with the provisions of the Implementing Regulations" (here R. 51(4) EPC 1973).



In **J 13/94** the board observed that any approval of the text, in accordance with R. 51(4) EPC 1973, might thus have serious procedural consequences for applicants. Hence, according to the case law of the Legal Board of Appeal, declarations by applicants should only be treated as valid approval under R. 51(4) EPC 1973 if they were clear and unambiguous which, in particular, implied that:

the approval was not subject to any condition (**J 27/94**, OJ 1995, 831);

it was clear to which text the applicant had given his approval (**J 29/95**, OJ 1996, 489).

In **J 27/94** (OJ 1995, 831) the board held that in the interests of legal certainty a procedural declaration had to be unambiguous (confirming **J 11/94**, OJ 1995, 596). This implied that it must not be subject to any condition, leaving it open whether the EPO could proceed further on the basis thereof. It found that the examining division should not have treated the letter in question as valid approval under R. 51(4) EPC 1973, because it contained a condition which made the approval invalid. The approval of the text intended for grant was a necessary requirement for the next step in the proceedings, i.e. the communication under R. 51(6) EPC 1973. It had to be clear for the EPO when receiving the declaration whether or not it was an appropriate basis for the despatch of this communication. In the interests of legal certainty the board stated that procedural declarations had to be unambiguous. The examining division should have objected to the invalid approval, with the eventual consequence foreseen in R. 51(5), first sentence, EPC 1973.

In **T 971/06** the board noted that the approval by an applicant or patent proprietor under Art. 97(2)(a) EPC 1973 was a principle underlying all decisions of the EPO (see Art. 113(2) EPC 1973). Accordingly, it was perfectly clear that it was an absolute pre-condition of any decision of the examining division to grant a patent that an applicant had to have consented to the proposed text. If that pre-condition were not fulfilled, the only courses of action open to the examining division were to refuse the application under Art. 97(1) EPC 1973 or, if possible amendments or corrections remain to be considered, to continue the examination. So strict was the approval condition that, as the case law showed, the only valid approval was that which was unconditional, unambiguous and clear (see **J 13/94** of 4 October 1996; **J 27/94**, OJ 1995, 831; and **J 29/95**, OJ 1996, 489). The board held that in the absence of a valid approval, the examining division had no power to make a decision to grant and any decision to grant purportedly made without the applicant's valid approval could have no legal effect. Any such purported decision was therefore a nullity.

In **T 872/90** the board held that, in view of the requirement of Art. 113(2) EPC 1973 according to which the EPO would consider and decide on the European application only in the text submitted to it, or agreed, by the appellant, former claims which had been replaced by newly filed claims could no longer be considered to constitute a text agreed to by the applicant.

In **T 1/92** (OJ 1993, 685) the board held that the applicant's approval of the text is only binding if it is still unambiguously present at the expiry of the R. 51(4) EPC 1973 period.

### 3.2.3 Decisions with no text submitted or agreed by the applicant (Article 113(2) EPC)

#### a) General issues

Art. 113(2) EPC states that the EPO shall examine, and decide upon, the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent.

The applicant may reply to the communication under R. 71(3) EPC by simply disapproving of the text proposed therein and not paying any fees or filing the translations of the claims. In such cases, the application is not deemed to be withdrawn under R. 71(7) EPC. However, the application could be refused under Art. 97(2) EPC for failure to comply with Art. 113(2) EPC, because there is no text agreed to by the applicant (see Guidelines C-V, 4.9 – November 2015 version, "Applicant disapproves of the text proposed for grant").

In **T 690/09** the board stated that the application would be refused under Art. 97(2) EPC, if there is no text which has been approved by the applicant and allowed by the examining division (see Art. 113(2) EPC 1973, decisions **T 647/93**, OJ 1995, 132; **T 946/96** and **T 237/96**).

In **T 1093/05** the board noted that to grant a patent in a text not approved by the applicant was in breach of Art. 97(2)(a) and 113(2) EPC 1973 and thus a substantial procedural violation. The board stated that in those circumstances it was established board of appeal and Enlarged Board of Appeal case law that an examining division was bound by its final decision on an application, which could be set aside only following an admissible, reasoned appeal (see **G 12/91**, OJ 1994, 285; **G 4/91**, OJ 1993, 707; **T 371/92**, OJ 1995, 324; **T 1081/02**; **T 830/03**). In view of this established case law, the board could not subscribe to the view expressed in **T 971/06** that an erroneous decision was a nullity and therefore no appeal needed to be filed against it.

In **T 237/96** the board noted that in circumstances in which, as in the case in question, amendments proposed by the applicant were not allowed by the examining division by virtue of R. 86(3) EPC 1973 and the applicant did not give its agreement to any other version of the application documents, the established practice of the EPO, sanctioned by consistent case law, was to refuse the application on the ground that there was no version approved by the applicant within the meaning of Art. 113(2) EPC 1973 on which a patent could be granted.

Some decisions showed a different approach concerning the legal basis for refusing an application where no agreed claim text existed. In **T 246/08** the board held that the substantive legal requirement for the continued presence of claims in an application was expressed in Art. 78(1)(c) EPC, not in Art. 113(2) EPC. It noted that Art. 78(1)(c) EPC 1973 was a requirement of the application not only for according a filing date, but also for substantive examination and grant, whereas Art. 113(2) EPC 1973 was silent as to the legal consequence of the absence of an agreed text (**T 2112/09**).

In **T 32/82** (OJ 1984, 354) the board held that in accordance with Art. 113(2) EPC 1973, it could only decide on the European patent application in the text submitted to it or agreed by the applicant. It followed that when deciding the appeal the board had no authority under the Convention to order the grant of a European patent containing claims which were different from those submitted by the applicant in their content or interdependency. Even if the board had indicated to an applicant that a dependent claim might be allowable if rewritten as an independent claim but the applicant had not expressly requested the board to consider it as such, the board was not obliged to do so.

In **T 647/93** (OJ 1995, 132) the board stated that the provision of Art. 113(2) EPC 1973, that the EPO shall 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, 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 at issue, the examining division does not make use of the possibility of granting interlocutory revision under Art. 109 EPC 1973, after the mistake has been pointed out in the grounds of appeal (see **T 121/95**).

#### b) Auxiliary request issues

Where it is not clear which higher request the applicant wishes to pursue, the examining division must request the applicant to clarify this in resumed examination proceedings. (Guidelines C-V, 4.9 – November 2015 version).

In **T 1255/04** (OJ 2005, 424) the board held that in a case where there is a request considered allowable on which a R. 51(4) EPC 1973 communication is to be sent, but there are also not allowed higher-ranking requests, the communication under R. 51(4) EPC 1973 is deficient if it is not accompanied by reasons why the higher-ranking requests are not allowed. This communication should also expressly mention the option of maintaining the disallowed requests, thus reminding the applicant and the examining division of the possibility for the applicant of asking for a written appealable decision on these higher-ranking requests (decision **T 1181/04** followed). It pointed out that if the applicant maintains a still pending higher-ranking request discussed at the oral proceedings before the examining division, that request cannot be refused under R. 86(3) EPC 1973. The decision under appeal, by merely stating that the application was refused because there was no version approved of by the applicant within the meaning of Art. 113(2) EPC 1973 on which a patent could be granted, was inadequately reasoned because it did not give the substantive reasons why what the applicant did not approve of was not in conformity with the patentability requirements of the EPC.

In **T 169/96** the board held that according to Art. 113(2) EPC 1973, the EPO was bound to the requests of the applicant or proprietor. In case of main and auxiliary requests, this meant that the EPO was also bound to the order of the requests. Before a decision could be taken on the basis of an auxiliary request, the main request had to be examined and decided upon (**T 484/88**, dated 1 February 1989). This principle was violated by the

examining division. The applicants were only invited to indicate their approval of the text according to auxiliary request III. Therefore, their express disapproval related necessarily only to this version of the application. There was nothing in the file which could be interpreted as a withdrawal of the main request and the auxiliary requests I and II. Hence, these requests were pending when the decision under appeal was taken and the failure to give a decision on these requests was a violation of Art. 113(2) EPC 1973. The failure to deal with the requests preceding auxiliary request III violated also R. 68(2) EPC 1973. If a decision related to several requests, it had to give reasons for the rejection of each one (**T 234/86**). The fact that the first examiner had expressed a preliminary view in a previous communication which might be applicable to these requests could not replace reasons in the decision itself. Whereas the reasons of a decision might, in the interest of procedural economy, refer in appropriate cases to previous communications, it had to be clear from the decision which considerations led the division to its conclusions (**T 234/86**, see also **T 1439/05**).

In **T 255/05** the board observed that the appellant's "auxiliary request" was not one single request but encompassed numerous requests. It was totally undefined in which order these four requests and any such combination requests should be considered by the board. The board noted that according to Art. 113(2) EPC 1973, the EPO should consider or decide upon the European patent application only in the text submitted to it, or agreed, by the applicant. It was therefore the applicant's responsibility to define the text on the basis of which it requested a patent to be granted. In the case of auxiliary requests this included the requirement that the applicant had also to indicate the order in which the requests were to be examined. This was so because filing an auxiliary request meant that such a request was only filed in the event that the preceding request was not allowed by the board. As a consequence, when the appellant, even after having been invited to do so by the board, did not clearly indicate the order in which its several requests were submitted and what the exact content of each of these requests was, there was no text submitted or agreed by the applicant within the meaning of Art. 113(2) EPC 1973 and no request which could be considered by the board. Therefore, the appellant's "auxiliary request" had to be disregarded.

In **T 888/07** the board held that, if the examining division refused to consent to the latest submitted set of amended claims, put forward to substitute for the claims previously on file under R. 86(3) EPC 1973, the previous set of claims that the examining division had consented to consider but which the applicant had not maintained as an auxiliary request was not automatically revived. It noted that in accordance with Art. 113(2) EPC and established case law (see e.g. **T 237/96**) a decision could not be based on the previous set of claims. Art. 113(2) EPC 1973 stated that the European Patent Office had to consider and decide upon the European application or patent only in the text submitted to it, or agreed to, by the applicant or proprietor. Deciding to refuse an application on the grounds that the claims previously on file were not allowable would have contravened Art. 113(2) EPC 1973, since these claims were no longer pending.

### 3.2.4 Examination procedure under the previous system (Rule 71 EPC and Rule 51(4) EPC 1973)

Under the system existing before 1 April 2012, R. 51 EPC 1973 implemented the examination procedure established in Art. 96 and 97 EPC 1973. In particular, R. 51(4) EPC stipulated that the examining division had to communicate to the applicant the text in which it intended to grant the patent and invite him to pay the fees and file the translation. According to the last sentence of this provision, the payment of the fees and the filing of the translation was considered to be implicit approval of the text proposed by the examining division.

In **T 1181/04** (OJ 2005, 312) the board noted that the function of a communication under R. 51(4) EPC 1973 was to establish whether the applicant approved the proposed text of the patent as foreseen in Art. 97(2)(a) and Art. 113(2) EPC 1973. If, after receiving the communication under R. 51(4) EPC 1973, the applicant approved the version of the patent proposed by the examining division and fulfilled the formal requirements for grant, the examining division would issue a decision to grant according to Art. 97(2) EPC 1973. If he did not approve, the application was refused according to Art. 97(1) EPC 1973, since the EPC did not provide any other sanction in this case. The board pointed out that the way in which R. 51(4) EPC 1973 and Art. 97(1) and (2) EPC 1973 operated indicated that a communication under R. 51(4) EPC 1973 was not intended to terminate the examination procedure but was rather a **preparatory action** and was therefore not appealable. An appeal against a communication under R. 51(4) EPC 1973 would therefore normally be considered inadmissible.

The board noted that the communication under R. 51(4) EPC 1973 from the examining division gave the appellant the impression that no possibility was available to him other than to pay and accept the proposed text or not to pay and lose the application. This impression was even stronger because reasons for turning down the higher-ranking requests were also contained in the document and no indication was given as to how to proceed if the appellant wished to maintain these higher-ranking requests. The board observed that where approval was not given, this also had a legal consequence, namely the refusal of the application in accordance with Art. 97(1) EPC 1973. The legal consequence of the non-existence of the applicant's approval was not the same as that foreseen for the failure to pay the fees or to file the translation. In the former case the application was refused, whereas in the latter it was deemed to be withdrawn. The board noted that the fact that an applicant's disapproval of the text proposed for grant had special legal consequences also made it necessary to ensure that disapproval was clearly established by the examining division.

The board noted that the communication sent to the applicant reflected an EPO practice that did not provide for a procedure to be followed in the event that the applicant did not agree with the version proposed by the examining division. The board found that this practice was not justified by the EPC. The applicant's approval of the text proposed for grant by the examining division was an essential and crucial element in the grant procedure and its existence or non-existence needed to be formally ascertained. Further, the applicant should have been given the opportunity to express his disapproval of the

text proposed for grant by the examining division with a communication under R. 51(4) EPC 1973 and to obtain an appealable decision refusing his requests. In **T 1255/04** (OJ 2005, 424) and **T 1226/07** the boards followed decision **T 1181/04**.

### **3.3. Amendments or corrections filed in response to the communication under Rule 71(3) EPC**

#### 3.3.1 Amendments where Rule 71(3) EPC communication is the first communication

The applicant's right to amend the application of his own volition after receipt of the examiner's first communication was shifted to the procedural stage of response to the opinion accompanying the European search report (see Decision of the Administrative Council, which entered into force on 1 April 2010, OJ 2009, 299).

Thus, by way of exception, in cases where the R. 71(3) EPC communication is also the first communication in examination proceedings, amendments filed in response thereto **must** be admitted into the proceedings under R. 137 EPC. However, where a further R. 71(3) EPC communication is sent in respect of such cases, any amendments filed in response thereto must be consented to by the examining division according to R. 137(3) EPC (see Guidelines C-V, 4.4- November 2015 version).

#### 3.3.2 Amendments and corrections requested according to Rule 71(6) EPC

R. 71(6) EPC reads as follows: "if the applicant, within the period under paragraph 3, requests reasoned amendments or corrections to the communicated text or keeps to the latest text submitted by him, the examining division shall issue a new communication under paragraph 3 if it gives its consent; otherwise it shall resume the examination proceedings" (see also Notice from the EPO dated 8 June 2015 concerning the possibility to waive the right to a further communication under R. 71(3) EPC, OJ 2015, A52; Guidelines C-V, 4.11 – November 2015 version).

All of the amendments or corrections requested by the applicant have to be reasoned, in particular those which have not been on file yet (CA/81/10, Rule 71 Rev 1).

Where amendments or corrections are not admitted, or where they are admitted but not considered allowable, examination will be resumed (Guidelines H-II, 2.5.3 – November 2015 version).

The boards of appeal have confirmed in their case law (e.g. **T 1064/04**) that the principles set out in **G 7/93** (OJ 1994, 775) also apply after the structural amendment of R. 51 EPC 1973 in 2002 (CA/81/10 Rule 71 Rev 1).

#### 3.3.3 Criteria for admitting amendments filed in reply to the Rule 71(3) EPC communication

The criteria for accepting or refusing requests for amendment under R. 137(3) EPC (former R. 86(3) EPC 1973), or correction under R. 139 EPC (former R. 88 EPC 1973),

have not been changed by new R. 71 EPC (former R. 51 EPC 1973), which entered into force on 01.04.2012 (OJ 2010, 637).

Decision **G 7/93** (OJ 1994, 775) dealt with the criteria for assessing the admissibility of late-filed amendments in examination. In particular, applying the principles of **G 7/93** to amendments filed in response to the communication under R. 71(3) EPC means that this communication does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure (**T 375/90**).

The Enlarged Board of Appeal noted that the question whether an approval submitted under R. 51(4) EPC 1973 becomes binding once a communication in accordance with R. 51(6) EPC 1973 has been issued depended rather upon the proper interpretation of Art. 123(1) EPC in conjunction with R. 86(3) EPC 1973. The Enlarged Board of Appeal came to the conclusion that the approval of a notified text submitted by an applicant pursuant to R. 71(3) EPC (former R. 51(4) EPC 1973) does not become binding. It stated that, in general terms, the way in which the examining division should exercise its discretion to allow an amendment of an application must depend upon the circumstances of each individual case, and must also depend upon the stage of the pre-grant procedure which the application has reached. It is clear from the wording of the provisions in R. 51(4) to (6) EPC 1973 that the underlying object of the R. 51(6) EPC 1973 communication is to conclude the granting procedure on the basis of the previously notified and approved text of the application. Thus although the examining division still has a discretion to allow amendments at this stage of the pre-grant procedure, such discretion must be exercised with the above underlying object in mind. In particular it held that admission of amendments at a late stage of the proceedings is to be the exception and not the rule.

In **T 1064/04** the board stated that the principles in **G 7/93** could be considered generally applicable to new requests put forward at a late stage of the proceedings, where the applicant had already had at least one opportunity to amend the application and the examining division has already completed substantive examination of the application. The board found that the examining division had exercised its discretion in a reasonable way in accordance with the applicable principles. A late stage of the examination proceedings had been reached at the end of the oral proceedings, and any amendments thereafter fell to be considered under the principles derivable from decision **G 7/93**. **T 1064/04** summarised the principles derived from decision **G 7/93** (OJ 1994, 775) on admission of amendments at a late stage of proceedings (see also **T 1540/11** and **T 1326/11**). The principles that can be derived from decision of the Enlarged Board of Appeal are:

(a) Until the issue of a decision to grant the patent, the examining division does have discretion under R. 86(3) EPC 1973 (now R. 137(3) EPC), second sentence, whether or not to allow the amendment of the application at a late stage, irrespective of whether the applicant has already agreed to a text (**G 7/93**, point 2.1 of the Reasons).

(b) The examining division is required to exercise its discretion considering all relevant factors, in particular the applicant's interest in obtaining a patent which is valid in all

designated states, and the EPO's interest in bringing examination to a close, and must balance these against one another (**G 7/93**, points 2.2 and 2.3 of the Reasons).

(c) Allowing a request for amendment at a late stage of the examination proceedings, that is, against the background that the applicant has already had at least one opportunity to amend the application and that the examining division has already completed the substantive examination of the application, will be an exception and not the rule (**G 7/93**, point 2.3 of the Reasons).

(d) It is not the function of a board of appeal to review all the facts 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 the discretion in the same way as the department of first instance. Rather a board of appeal should only overrule the way in which the department of first instance exercised its discretion if it comes to the conclusion either that the department of first instance has not exercised its discretion in the right way as set out in (b) above or has exercised its discretion in an unreasonable way, and thus exceeded the proper limits of its discretion (**G 7/93**, point 2.6 of the Reasons).

In **T 1399/10** the board held that if an examining division comes to the conclusion that a request is not prima facie allowable but introduces new deficiencies, it is justified for the division to refuse the request under R. 137(3) EPC.

In **T 1326/11** the decision under appeal dealt solely with the refusal under R. 137(3) EPC (2010) by the examining division to admit into the proceedings the request received after issuance of the communication under R. 71(3) EPC. Thus, the question to be decided on this appeal was whether this refusal was an appropriate exercise of the discretion given to the examining division under R. 137(3) EPC. Guided by the principles to be found on **G 7/93** as summarised in **T 1064/04**, the board dismissed the appeal and decided that the examining division correctly and reasonably exercised its discretion under R. 137(3) EPC not to admit the request through balancing the applicant's interest in obtaining a valid patent and the EPO's interest in bringing the examination to a close. The board was of the view that the complexity of the case only supported the decision of the examining division not to admit a request at a very late stage of proceedings, which had already involved two communications of the examining division and oral proceedings before it. Admitting the request at that late stage would have led to re-examination and consequently unduly lengthened the proceedings.

In **T 246/08** the board held that a refusal of consent to amend made in advance of any amendment being submitted cannot be a reasonable exercise of discretion pursuant to R. 137(3) EPC (former R. 86(3) EPC 1973) and is ipso facto a substantial procedural violation.

A number of decisions set out below relate to earlier versions of former R. 51(4) EPC 1973 (now R. 71(3) EPC). Nevertheless, they may also be applicable to the new R. 71(3) EPC.



In **T 375/90** the board noted the conditions defined by the boards of appeal limiting the extent of the discretion which may be exercised when applying R. 86(3) EPC 1973, where amendments were proposed by the applicant after issue of the R. 51(4) EPC 1973 communication:

(i) There is no discretion in the obligation to admit amendments which remove deficiencies constituting violations of the EPC 1973 (see **T 171/85**, OJ 1987, 160 and **T 609/88**).

(ii) In all other cases the EPO's interest in a speedy completion of the proceedings must be balanced against the applicant's interest in the grant of a patent with amended claims (see **T 166/86**, OJ 1987, 372; **T 182/88**, OJ 1990, 287 and **T 76/89**).

The board noted that the Guidelines H-II, 4 (see also Guidelines, November 2015 version) stated that the communication under R. 51(4) EPC 1973 did not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure and only minor amendments would be considered within the period under R. 51(4) EPC 1973. It followed from the foregoing considerations that the examining division (or the board acting within its competence), when applying the provisions of R. 86(3) EPC 1973, is **not completely free** to deny any examination of the respective amended documents (see also **T 989/99**).

In **T 999/93** the decision to refuse the application under R. 51(5), first sentence, EPC 1973 for lack of any approved text of the application (Art. 113(2) EPC 1973), was incorrect since the fact that the appellant never withdrew the main and first and second auxiliary requests as well as the appellant's letter of 6.4.1993 (disapproval of the text proposed for grant, but request for a decision on the main request) clearly showed that he indeed approved and proposed the text according to his higher-ranking requests (see also R. 51(5), second sentence, EPC 1973). The decision would instead have required reasoning as to the substance of the main, first auxiliary and second auxiliary requests.

In **T 237/96** the board held that the broadening of the scope of claim 1 requested by the applicant after receipt of the examining division's communication under R. 51(4) EPC 1973 so as to encompass one originally disclosed embodiment was not consistent with his previous submission that said embodiment was not part of the invention, raised new issues as to clarity and inventive step and was not supported by any argumentation in favour of the allowability of the amended claim. The board found that the examining division, in refusing to consent to the amendment under R. 86(3) EPC 1973, did not exercise its discretion in a wrong or unreasonable manner. Had it given its consent to the amended version of the claim, it would have been necessary to restart examination from the beginning, which, given the prima facie lack of clarity of the claim, would have led to a considerable delay.

In **T 1066/96** it was clear that further amendments could not be excluded wholesale in advance, but the discretion under R. 86(3) EPC 1973 had to be exercised on a case by case basis balancing the interests of the EPO and the applicant against one another

(see **G 7/93**, OJ 1994, 775). Therefore, in exercising its discretion under R. 86(3) EPC 1973 in a negative way, an examining division could only refuse an application if, before issuing a decision, it had informed the applicant of the fact that the further amendments requested would not be admitted and of the reasons for not admitting said amendments, thereby taking due account of the applicant's reasons for such late filing of further amendments. If the applicant maintained its request and its counterarguments were not considered convincing by the examining division, the application had to be refused under Art. 97(1) EPC 1973, since it contained no claims to which the applicant had agreed.

In **T 121/06** the board held that issuing a communication under R. 51(4) EPC 1973 in which amendments were proposed, which the applicant could not reasonably be expected to accept without further discussion, constituted a substantial procedural violation.

#### 3.3.4 Claims fees due in response to Rule 71(3) EPC communication

According to R. 71(4) EPC (in force since 01.04.2012) if the European patent application in the text intended for grant comprises more than fifteen claims, the examining division shall invite the applicant to pay claims fees in respect of the sixteenth and each subsequent claim within the period under paragraph 3 unless the said fees have already been paid under R. 45 or 162 EPC.

The appeal in **J 6/12** was lodged against the decision by the formalities officer acting for the examining division to refuse a request for a refund under R. 71(5) EPC of ten claims fees following amendments which had resulted in a smaller number of claims. R. 71(6) EPC (now R. 71(4) EPC), which entered into force in December 2007, was the legal basis for the invitation to pay claims fees. According to this provision, the "text [of the application] intended for grant" was the basis for charging additional claims fees. However, the Legal Board held that this text had only become final after the examining division had approved the filed amendments, and not already on the date of issue of the communication under R. 71(3) EPC. Fees which the appellant had been invited to pay at that earlier stage had not yet become payable and decreased in the measure that the appellant had reduced the number of claims in response to the communication under R. 71(3) EPC. The board stressed that the EPO could not retain fees of more than insignificant amounts which had been paid for no legal reason.

#### 3.4. Amendment after approval of the text for grant

R. 71a (2) EPC (Conclusion of the grant procedure) makes it clear that, until the decision to grant the European patent is issued, the examining division may resume the examination proceedings at any time.

The text for grant is communicated to the applicant by despatching a communication under R. 71(3) EPC, in which the applicant is furthermore invited to pay the fee for grant and publishing and to file a translation of the claims within a period of four months, which is non-extendable. Under R. 71(5) EPC if the applicant pays the fees and files the

translations within this period (and files or requests no corrections or amendments to the text proposed for grant in the R. 71(3) EPC communication), he will be deemed to have approved the text intended for grant (Guidelines C-V, 1.1 – November 2015 version).

According to the case law an examining division has discretion to allow amendments until issue of a decision to grant (see **G 7/93**, order 1, OJ 1994, 775 and **G 12/91**, OJ 1994, 285) (**T 690/09**).

Once the applicant has approved the text communicated to him pursuant to R. 71(3) EPC, by paying the fees and filing the translation of the claims, further requests for amendment will **only exceptionally** be admitted under the discretionary power of the examining division given by R. 137(3) EPC. A clear example of an admissible request is where the applicant files separate sets of claims for designated States that made reservations under Art. 167(2) EPC 1973 or for which prior national rights exist. Similarly, it is appropriate to admit minor amendments which do not require re-opening of the substantive examination and which do not appreciably delay the issue of the decision to grant (see **G 7/93**, OJ 1994, 775).

A refusal of amendments must be reasoned, and both Art. 113(1) and Art. 116(1) EPC must be observed. It must be shown that the conditions defined in **G 7/93** (OJ 1994, 775) are not met. This means that arguments must be given as to why the amendments are not minor in nature but in fact necessitate resuming substantive examination while considerably delaying the issue of a decision to grant the patent (Guidelines H-II, 2.6 - November 2015 version).

In decision **G 7/93** (OJ 1994, 775) the Enlarged Board stated that the wording in R. 86(3) EPC 1973 (now R. 137(3) EPC) "No further amendment may be made without the consent of the examining division" simply meant that the examining division might or might not give its consent to a request for amendment by the applicant. The approval of a notified text submitted by an applicant pursuant to R. 51(4) EPC 1973 was not rendered binding by virtue of a communication being issued in accordance with R. 51(6) EPC 1973. Even following the issue of such a communication and until the issue of a decision to grant the patent, it was left to the discretion of the examining division under R. 86(3), second sentence, EPC 1973 whether or not to allow amendment of the application. However, since the underlying object of a R. 51(6) EPC 1973 (earlier version) communication was to conclude the granting procedure on the basis of the approved text, a request for amendment which was received by an examining division after such a communication has been issued should be considered in a different way from a similar request for amendment received at a much earlier stage in the overall examination procedure, and in particular before approval by the applicant of a notified text. Such a request should be considered in the context of the very late stage in the pre-grant procedure at which it had been made, and against the background that the examining division had already completed its substantive examination of the application, and that the applicant had already had at least one opportunity to amend the application. Against such a background, allowing a requested amendment after the issue of a R. 51(6) EPC 1973 communication would be the exception rather than the rule.

The question remained in what kind of circumstances it would be appropriate to make an exception to the normal rule. In the Enlarged Board's view, the discretion to allow amendment should be exercised according to the same principles. Of course, an objection should only be raised by an examining division at that stage of the proceedings if it was prepared to allow amendments to meet the objection. When exercising its discretion following the issue of a R. 51(6) EPC 1973 communication, an examining division had to consider **all relevant factors**. In particular it had to consider and balance the applicant's interest in obtaining a patent which would be legally valid in all of the designated states, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent.

In **G 10/92** (OJ 1994, 633) the Enlarged Board stated that if examination proceedings were re-opened by the examining division after approval in accordance with R. 51(4) EPC 1973, because - for whatever reason - the proposed text for grant was to be amended, R. 51(4) EPC 1973 required that the applicant once again be informed of the text in which the examining division intended to grant the European patent. The same was true in appeal proceedings. The approval in accordance with R. 51(4) EPC 1973 given before the department of first instance was equally binding on an appeal. If the board of appeal then concluded that the patent had to be amended prior to grant, the applicant again had to approve the amended text, approval being stated before the board if the board was ruling on the issue, or to the examining division if the matter had been remitted.

In **G 10/93** (OJ 1995, 172) the Enlarged Board held that the examining division was not bound by the view - whether positive or negative - expressed in the examination pursuant to Art. 96(2) EPC 1973; examination proceedings could be re-opened "for whatever reason" after the approval in accordance with R. 51(4) EPC 1973.

In **T 171/85** (OJ 1987, 160) the board decided that if discrepancies or inconsistencies are found in the text communicated under R. 51(4) EPC 1973 to the applicant for a European patent, they may be removed in agreement between examining division and applicant even if the latter has already given his approval under R. 51(4) EPC 1973 to the (faulty) text.

### **3.5. Examination after remittal for further prosecution**

If a case is remitted from the boards of appeal for further prosecution, the examining division must check whether requests from examination proceedings prior to the appeal are still outstanding and must give the party an opportunity to comment (see **T 1494/05**) (Guidelines E-IX, 1.2 – November 2015 version).

If a department has to give a decision in a case which has already been remitted by the board of appeal for further prosecution to that department, it is bound by the ratio decidendi of the board of appeal, insofar as the facts, e.g. the subject-matter of the patent and the relevant state of the art, are the same (Guidelines E-IX, 9).

In **T 79/89** (OJ 1992, 283) the board rejected the appellant's main request, and remitted the case to the department of first instance for further prosecution on the basis of the auxiliary request. In this case, Art. 111(2) EPC 1973 was applicable, according to which the department of first instance shall be bound by the ratio decidendi of the board of appeal, insofar as the facts are the same. The ratio decidendi of the board of appeal's previous decision was that the subject-matter of the main request was not allowable, but that the grant of a patent in accordance with the auxiliary request was subject to a consideration of its patentability by the examining division. In this case, in the board's judgment, following the issue of the board's previous decision, the examining division clearly had no power to re-open examination on the basis of the claims which the appellant requested (with subject-matter corresponding to the previously rejected main request). Having examined the subject-matter of the auxiliary request for patentability and found no objection to it, the examining division was bound to issue a communication under R. 51(4) EPC 1973 with a text based on the auxiliary request. Furthermore, in the absence of approval of such text, in the board's judgment the examining division was bound to refuse the application, for the reasons set out in its decision. Since the examining division had no power to re-open examination in respect of the claims as requested by the appellant, in the context of the appeal in question the board necessarily had no power to re-open examination in respect of such claims, because it could only exercise power which was within the competence of the examining division (Art. 111(1) EPC 1973). Thus, the main request of the appellant had to be refused.

### 3.6. Amendments after the decision to grant

Once the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant, the examining division is bound by it (see **G 12/91**, OJ 1994, 285) and can only amend it to the limited extent provided for in R. 140 EPC. In the examination procedure, this corresponds to the date on which the centrally generated Form 2006, "Decision to grant a European patent pursuant to Art. 97(1) EPC", is forwarded to the postal service. This date is shown at the bottom right-hand corner of Form 2006. The examining division is no longer competent to decide on a request for amendments or corrections under R. 139 EPC if the filing of the request and the completion of the proceedings occur on the same date (**T 798/95**) (see Guidelines H-II, 2.6 – November 2015 version).

In **T 798/95** the decision to grant the European patent was handed over by the formalities section of the examining division to the EPO postal service for notification. The request for amendment of the application under R. 86(3) EPC 1973 was filed on the same day at 6.47 pm, thus after completion of the proceedings. Referring to **G 12/91** (OJ 1994, 285), the board held that a request for amendment under R. 86(3) EPC 1973 filed after completion of the proceedings up to grant before an examining division was to be disregarded, even if the filing of the request and the completion of the proceedings occurred on the same date.

### 3.7. Withdrawal of amendments and abandonment of subject matter

#### 3.7.1 General issues

A request to withdraw an amendment is itself a request for further amendment; thus, if this request occurs after reply to the first communication from the examiner, the corresponding amendment will be admitted only if the examiner consents.

In deleting subject-matter from an application, the applicant should avoid any statement which could be interpreted as abandonment of that subject-matter. Otherwise the subject-matter cannot be reinstated (see **J 15/85**, confirmed in **G 1/05** and **G 1/06**). (Guidelines H-III, 2.5 – November 2015 version).

In **J 15/85** (OJ 1986, 395) it was held that if an applicant cancels claims in a patent application but fails to state at the time that their deletion is without prejudice to the filing of a divisional application, the examining division is obliged to withhold its consent to the subsequent filing of a divisional application. However, a declaration of abandonment can be interpreted to the effect that there was no intention to abandon definitively the subject-matter of the application or patent. In **T 910/92** the applicants had expressly abandoned several claims in their application, but later retracted their declaration and requested that the claims deleted from the application be reinstated in a divisional application. The board considered under what circumstances it was possible to retract a declaration of abandonment. It referred to the case law, which required that the real intention of the party making the declaration be established, taking into account all the circumstances of the case, and concluded that in this case the appellants' real intention was not to abandon part of the original disclosure altogether, but to avoid the lack of unity that had arisen as a result of the change in the protection sought. In contrast to the case in **J 15/85** the board did not see any need in this case to protect the public interest by generally prohibiting the retraction of a declaration of abandonment. It could be expected that any third parties interested in the proceedings relating to the application in question would have asked to inspect the files at suitable intervals up until the conclusion of the proceedings (**G 1/06**, OJ 2008, 307; **G 1/05**, OJ 2008, 271; **J 2/01**, OJ 2005, 88 and **J 29/97**).

In **J 13/84** (OJ 1985, 34) the board applied the same criteria to the interpretation of a declaration of abandonment as the case law had developed for declarations of withdrawal of an application. In particular, all the circumstances had to be taken into consideration and not just the preceding declarations. In the case in question the applicants had deleted their claim 21 in response to a communication from the examining division, adding that "in accordance with the examiner's suggestion, we are filing a divisional application for the intermediate products ... and for their method of preparation". The Receiving Section took the view that the divisional application, with the former claim 21 as its subject-matter, was not filed within the period of two months prescribed in R. 25(1)(b) EPC 1973 (in the version which entered into force on 7.10.1977; the provision was deleted with effect from 1.10.1988). It argued that claim 21, which had already been divided out from the application on 6.6.1983 and therefore no longer formed part of the parent application on 31.8.1983 (the date of filing of the

divisional application), could no longer be converted into a divisional application. The board did not share this view and called for the declaration of abandonment to be interpreted in the same way as a declaration of withdrawal of an application, i.e. taking into account all the circumstances. It added that, generally speaking, and as stated in the summary of the Legal Board's decision in **J 11/80** (OJ 1981, 141), a request for withdrawal should only be accepted without question if it is completely unqualified and unambiguous.

The board also referred to decisions **J 24/82**, **J 25/82** and **J 26/82** (OJ 1984, 467), in which it was found that, where claims were withdrawn specifically under R. 25(1) EPC 1973 (in the version which entered into force on 7.10.1977), the applicant's restrictive intention was not to be interpreted in isolation on the strength of particular statements but in the context of the entire procedure. The board took the view that in this case no express intention to drop the claim ensued from the circumstances. The divisional application was therefore admissible.

In **T 118/91** the board ruled that the inclusion of a particular claim in a divisional application did not mean that claim had been dropped from the parent application.

### 3.7.2 Effects of non-payment of claims fees

If an applicant fails to pay claims fees, he is considered under R. 45(3) EPC (former R. 31 EPC 1973) to have abandoned the claims. Apart from resolving the specific question whether certain parts of the application were part of the description or were claims, decision **J 15/88** (OJ 1990, 445) made clear that such abandonment of certain claims could only cause a substantive loss of subject-matter if the subject-matter involved was contained only in the claims and not also in the description or drawings. The board held that an applicant who declined to pay claims fees when they were demanded ran the risk that features of a claim deemed to have been abandoned pursuant to R. 31(2) EPC 1973, which were not otherwise to be found in the description or drawings, could not subsequently be reintroduced into the application and, in particular, into the claims. The idea that there could be forced abandonment of subject-matter, in reliance on R. 31(2) EPC 1973, appeared rather to be in conflict with the principles of higher law to be deduced from Art. 52(1) EPC 1973 in conjunction with Art. 123(2) EPC 1973. An applicant normally had the right to derive subject-matter from any part of the description, claims or drawings as originally filed. This view has since been confirmed in other ex parte proceedings, namely **T 490/90**.

## 3.8. Withdrawal of the patent application

### 3.8.1 General issues

A valid notice of withdrawal which has been received at the EPO is binding on the applicant, although, in the case of withdrawal by mistake, R. 139 EPC (R. 88 EPC 1973) may be applicable (see e.g. **J 10/87**, OJ 1989, 323, and **J 4/97**; see also **T 1673/07**, **J 6/13**). However, a withdrawal cannot be retracted once the public has been officially informed of it (**J 1/11**, **J 2/15**). Decision **J 1/11** held that a publication in the European

Patent Register has the same legal effect as a publication in the European Patent Bulletin, unless otherwise specified (see also **J 2/15**).

A request for withdrawal of a European application should only be accepted without question if it is completely **unambiguous** and **unconditional** (cf. **J 11/87**, OJ 1988, 367; **J 27/94**, OJ 1995, 831; **J 19/03**) (see also **J 11/80**, OJ 1981, 141; **T 60/00**, **J 38/03**, and **T 1673/07**). In **J 11/87** (OJ 1988, 367) the board added that where there was even the slightest doubt as to the applicant's actual intent such a declaration should be construed as a declaration of withdrawal only if the subsequent facts confirmed that such had been his true intent.

In **J 15/86** (OJ 1988, 417) the board stated that there was a recognised difference between passive abandonment and active withdrawal of a European patent application. Each case in which there was a dispute as to the applicant's intention had to be considered on its own facts. A written statement by the applicant or his representative had to be interpreted in the context of the document as a whole and the surrounding circumstances. Similarly, **J 7/87** (OJ 1988, 422) ruled that the language used had to be interpreted in the light of the surrounding circumstances, from which it had to be clear that the applicant really wanted immediate and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal. Actual withdrawal did not depend on whether the applicant had used the term "withdrawal".

In **J 6/86** (OJ 1988, 124) the board considered the statement "the applicant wishes to abandon this application" as an unambiguous withdrawal of a European patent application, since nothing in the circumstances under which the statement had been made could be taken as qualifying such an interpretation. It is too late to ask for retraction of a notice of withdrawal once the withdrawal has been notified to the public in the European Patent Bulletin (see **J 15/86**, OJ 1988, 417). In this case it was alleged that the withdrawal had been made by mistake.

In **J 4/97**, the applicants informed the EPO three days after withdrawal that their request had been made erroneously and should be cancelled. The EPO informed the applicants that the withdrawal had come into force and was binding, and notification of the withdrawal was later published in the European Patent Bulletin. However, the board held that the withdrawal of the application could be corrected under R. 88 EPC 1973. The legal considerations contained in **J 10/87** concerning the retraction of a withdrawal of a designation of a contracting state applied equally to the withdrawal of a patent application as a whole. In particular, it had to be ascertained that the withdrawal had been due to an excusable error, that there was no undue delay in seeking retraction, and that the retraction of the withdrawal had not adversely affected the public interest or the interests of third parties.

In the circumstances of the case at issue, the board held that the mere fact that the withdrawal was retracted after only three days was a strong indication that it had indeed been made in error. The error resulted from confusion between two similar reference numbers assigned by the appellants to their patent applications. In the board's opinion this mistake could be considered as an excusable oversight. The public interest was not



affected because **the withdrawal was retracted before the corresponding entry was made in the Register** of European Patents and more than six weeks before the withdrawal was officially notified to the public in the European Patent Bulletin. Thus, at the time the general public was informed of the withdrawal, the public part of the file clearly showed that a request for cancellation of the withdrawal had been filed thereby warning third parties relying on the information published by the EPO. The interests of third parties could be protected if a national court applied Art. 122(6) EPC 1973 *mutatis mutandis*.

In **J 4/03** the Legal Board noted that the request for retraction of the withdrawal of the application had been made after notification of the withdrawal in the European Patent Bulletin, the means of official publication of the EPO. That meant that the public had already received the information that the application no longer existed so that the principal precondition for allowing a correction was not met (see also **J 7/06**).

In **J 14/04** the board rejected the request for correction of the withdrawal of the application. It agreed with **J 10/87** that the public interest lay in being able to rely on information officially published by the EPO. However, the board took the view that the Register of European Patents constituted an official publication (see also **J 37/03** and **J 38/03**), and as, at the time of the request for withdrawal, access to the Register was freely offered to the public on the Internet, the request for withdrawal was available to the public on the date the Register indicated the request for withdrawal was recorded. It was of no relevance whether the file was actually consulted on this date. Nor did the board consider that Art. 122(6) EPC 1973 could apply *mutatis mutandis* to cases of correction under R. 88 EPC 1973.

The Legal Board held in **J 25/03** (OJ 2006, 395) that entries in the Register of European Patents also amounted to **notification to the public** from the day of their publication as well as publication in the European Patent Bulletin. The board rejected the request for correction of the withdrawal of the patent application and added that it was of no relevance that only four days had elapsed between mention of the withdrawal in the Register and mention of the request for retraction of the withdrawal. Legal certainty would suffer unacceptably if further delay were permitted for retraction of the withdrawal in such circumstances where even after inspection of the complete file there would not have been any reason for a third party to suspect, at the time of the official notification to the public of the withdrawal, that the withdrawal could be erroneous and later retracted.

In **J 6/13** it was not disputed that the applicant's letter was an unambiguous withdrawal of the application. The board pointed out that an applicant is bound by its procedural acts notified to the EPO provided that the procedural statement was unambiguous and unconditional (**J 19/03**). The board held that there could be no **retraction of a withdrawal** if there was no reason for third parties to assume that the withdrawal was erroneous. Referring to decision **J 12/03** (citing with approval decision **J 25/03**, OJ 2006, 395), the board pointed out that in the interest of legal certainty for third parties, and taking into account the **public function of the Register**, a third party upon file inspection must have had good reason to suspect that the withdrawal was made in error in order to allow its retraction.

The board had to determine whether, in the current case, such good reason was present. The board took the view that, based on decisions **J 12/03** and **J 18/10**, the prospects of the application, however promising, were insufficient to infer an obvious or even potential contradiction with a subsequent withdrawal. Patent applications may be withdrawn due to considerations of business strategy, investor preference, shift in portfolios, agreements with competitors, etc. Due to financial considerations, most granted European patents are validated only in a limited number of countries. These considerations may come into play at any time, even after the recent payment of annuities, or after the communication of a positive search report. The favourable prospects of the application in this case would thus not lead a third party to the conclusion that the withdrawal was possibly made in error. Nor did they lead the representative who handled the case and who communicated the withdrawal to this conclusion, either. Therefore, the appeal was dismissed.

In **J 2/15** the board affirmed previous case law that the mention of a withdrawal in the European Patent Register is tantamount to official notice of such act to the public. For the case at issue the board held that such withdrawal was unambiguous, unconditional and became effective as of the date of receipt by the Office. A withdrawal after publication in the European Patent Register was thus no longer possible, and the examining division was therefore correct in rejecting the request for a retraction of the withdrawal made after such publication of the withdrawal.

### 3.8.2 Correction of the withdrawal of the application under Rule 139 EPC

In **J 1/11** it was not disputed by the appellant that retraction of the withdrawal was no longer possible once the withdrawal had been published in the European Patent Bulletin. The question at issue was whether a publication of the withdrawal in the European Patent Register should have the same legal consequences. The appellant argued that, despite the technical and functional approximation of Register and Bulletin, only the latter carried the presumption of an official publication. The board noted that both the European Patent Register according to Art. 127 EPC and the European Patent Bulletin according to Art. 129(a) EPC were official sources of information to the public. There was nothing that would allow a distinction as to which of the two was more official, reliable or decisive. This was not to say that the Bulletin had no functions other than those of information. Contrary to what the appellant alleged, entries into the Bulletin were no more "cast in stone" than those of the Register, and could be corrected either under R. 140 EPC, or by way of a decision. As far as the function of providing information to the public was concerned, the board was unable to deduce a fundamental difference between the Register and the Bulletin. The factual elements surrounding the official character of the information available support the general availability to the public of the entries in the Register of European Patents, from the day they appear in it (see also **J 2/15**). In conclusion, the board decided that the appellant's requests for retraction of the withdrawal of its application as a correction of an error under R. 139 EPC had to be refused.

The board pointed out that explicitly withdrawing a pending patent application is a declaration of the highest importance for the applicant, since all the legal effects of the

application, such as establishing a preliminary right, are finally abandoned. In the light of these consequences, utmost caution is therefore required when declaring the withdrawal of an application. A correction of errors in documents filed with the EPO under R. 139 EPC is only possible under strictly defined conditions. In the case at issue, the **request for retraction of the withdrawal** reached the EPO more than a month after the withdrawal was made and after it was recorded in the European Patent Register. Yet it is not primarily the EPO that is concerned with a withdrawal, but the public, for which a withdrawal is of potential interest. It is thus the public that can be regarded as the ultimate addressee of such a withdrawal. Therefore, a withdrawal cannot be retracted once the public has been officially informed of it. In a broader sense, this is also reflected in the principle that a declaration of intent can only be retracted if the retraction reaches the addressee either before said declaration or at the same time, a rule that can be found in the civil law systems of many contracting states of the EPC (see also **J 2/15**).

In **J 2/15** the applicant had pointed to a "fundamental inconsistency" between the decisions in cases **J 10/87** and **J 4/97** on the one hand, and **J 25/03** and **J 1/11** on the other. The board acknowledged that the reasoning of the more recent decisions had led a change in the case law due to the **evolution of technical means**. However, this could not be seen as an inconsistency in the case law where cases on the same subject-matter arrive at different results and have a different reasoning whilst being decided at the same time. The board was of the opinion that this inconsistency had been comprehensively addressed in decision **J 1/11**, and the board saw no need to elaborate on this further.

In **J 19/03** the board noted that it is obvious that corrections of procedural acts having an ab initio effect have a potentially serious impact on an application, in particular if they relate to its territorial extent or to whether the application is pending at all, and raise serious concerns as to legal certainty not only for the applicants vis-à-vis the EPO but also for the public. Therefore, the jurisprudence of the boards of appeal took as a starting point that, as a general rule, an applicant is bound by its procedural acts notified to the EPO provided that the procedural statement was unambiguous and unconditional (cf. **J 11/87**, OJ 1988, 367; **J 27/94**, OJ 1995, 831) and is not allowed to reverse these acts so that they can be considered as never filed (**J 10/87**, OJ 1989, 323; **J 4/97**; see also **J 2/15**). On the other hand, the boards of appeal considered that R. 88 EPC 1973 acknowledged as a further legal value the desirability of having regard to true, as opposed to ostensible, party intentions in legal proceedings (**T 824/00**, OJ 2004, 5) in appropriate circumstances. As a result of the conflict between these two legal principles, the case law read R. 88, first sentence, EPC 1973 as conferring a discretion on the competent instance to allow or not to allow a correction of an error since it is only stated in this rule that a respective error "may be corrected". The Legal Board decided that the notice of withdrawal did not contain a relevant error or mistake which could be corrected under R. 88, first sentence, EPC 1973. The board found that under R. 88, first sentence, EPC 1973, it was not sufficient to prove that a divergence had occurred between the true intention of the applicant and the declaration filed by its representative; rather it was additionally required that this divergence was caused by an error of the person who was competent to make the decision on the procedural act before the EPO. Therefore, as a rule, in cases where the party was represented by a professional

representative the error pursuant to R. 88 EPC 1973 must be an error of the representative in expressing his own intentions. This requirement was not met in the case in point.

In **J 10/08** the matter to be dealt with was the request of the appellant to retract this withdrawal under R. 139 EPC (2007) because it was, according to the appellant, made erroneously. This rule allowed correction of errors in documents filed with the EPO, these errors being defined as linguistic errors, errors of transcription and mistakes. In the case under consideration the document filed with the EPO did not show any kind of such an error. The error was not of a factual kind but of a mental one. Therefore it had to be examined whether the correction of such an error could also be subsumed under R. 139 EPC (2007). The board noted that the boards of appeal have dealt with this question in a great number of decisions. One of those decisions on the question of a possible retraction of a procedural declaration was **J 10/87** (OJ 1989, 323) with reference to earlier decisions. In this decision the board developed the preconditions under which a correction of a procedural declaration might be allowed, namely that the public had not been officially notified of the withdrawal by the EPO, that the erroneous withdrawal was due to an excusable oversight, that the requested correction would not delay the proceedings substantially and that the interests of third parties who might have taken note of the withdrawal by inspection of the file were adequately protected. The board accepted that it was not the intention of the appellant in the case before it to withdraw the application but that this was due to a misunderstanding between the various representatives of the appellant dealing with the case. In the case at issue, the board concluded that the public would not have been misinformed or misled by the information published in the European Patent Register and the withdrawal of the application could be retracted in the case before it by correction under R. 139 EPC (2007).

In **T 1673/07** the appellant argued that it should be allowed under R. 88 EPC 1973 (which corresponds to R. 139 EPC) to resile from the withdrawal of the designation of Germany and France, since it had been made under an erroneous assumption. The board, however, stated that, according to the established case law of the boards of appeal, one precondition for such a retraction was that the relevant request be made before the withdrawal has been officially notified to the public (see e.g. decisions **J 15/86**, OJ 1988, 417 and **J 25/03**, OJ 2006, 395). This was in the interests of legal certainty and balancing the interests of the applicant and of third parties, in particular in being able to rely on information officially published, and was an objective criterion which applied irrespective of the true intentions or mindset of the person who had made the relevant statement. In the case at issue the withdrawal had been published in the European Patent Bulletin about half a year before the validity of the withdrawal of the designations was contested for the first time. In conclusion, the withdrawal of the designation was valid and could not be retracted.

### 3.9. Refusal of a European patent application under Article 97(2) EPC (former Article 97(1) EPC 1973)

Under Art. 97(2) EPC (former Art. 97(1) EPC 1973) if the examining division is of the opinion that the European patent application or the invention to which it relates does not meet the requirements of this Convention, it shall refuse the application unless this Convention provides for a different legal consequence.

In **R 14/10** the Enlarged Board of Appeal held that there is no obligation under the EPC to carry out the examination of a European patent application or patent in its entirety, i.e. in respect of all pending claims if a claim considered unallowable has been maintained and no auxiliary request relating to a set of claims not comprising this unallowable claim has been submitted. In such a case the application or patent fails to meet a requirement of the EPC and is open to refusal or revocation (see **T 228/89**, point 4.2 of the Reasons referring to **T 5/81**, OJ 1982, 249, point 3 of the Reasons) (see also **T 293/86**, **T 398/86** and **T 98/88**).

In **T 162/88** it was stated that if the European patent application in the version submitted or approved by the applicant contained a claim which the examining division considered unallowable, the examining division had to refuse the European patent application in its entirety under Art. 97(2) EPC and not just the claim concerned (see also **T 117/88**, **T 253/89** and **T 228/89**).

In **T 11/82** (OJ 1983, 479) the board held that a European patent application had to satisfy the conditions laid down in the Implementing Regulations (see Art. 78(3) EPC 1973). If, in the opinion of the examining division, the application did not do so, the examining division was obliged by Art. 97(1) EPC 1973 to refuse it.

In several decisions the boards pointed out that it was highly desirable that the examining division should give an appealable decision with **sufficient reasoning** on all the issues that had been properly raised by the EPO during the examination proceedings and dealt with substantively in the applicant's reply. Such "complete" decisions streamlined the procedure rendering remittal to the department of first instance unnecessary; the board could decide all issues already raised in the department of first instance without depriving the appellant of the opportunity to have them considered at two instances (see **T 153/89**, **T 33/93** and **T 311/94**).

In **T 839/95** the examining division did not take a final decision as provided for in Art. 97 EPC 1973. Instead, it issued a decision indicated as an interlocutory decision under Art. 106(3) EPC 1973 rejecting the main and two auxiliary requests and stating that the invention claimed according to the third auxiliary request was found to meet the requirements of the Convention.

The board noted that an interlocutory decision in the case of an allowable auxiliary request is foreseen in the instructions to examiners only for auxiliary requests in opposition proceedings. It did not consider it appropriate for the department of the first instance to proceed in the same way in grant proceedings. In the board's judgment, the

purpose of the interlocutory decision in opposition proceedings was intended to save the proprietor the further cost of fulfilling the formal requirements under R. 58(5) EPC 1973 before there was a final decision on the version in which the patent could be maintained (**T 89/90**, OJ 1992, 456). A corresponding situation did not exist in grant proceedings because there was no adverse party who might object to the version to which the applicant had agreed. The appeal was admissible, since the appellant was adversely affected by the rejection of his preceding requests.

In **T 856/05** the appellant applicant had argued that since the decision of the examining division did not give any reasons for refusing claim 6, it was not reasoned, thereby contravening R. 68(2) EPC 1973. The board held that it was sufficient for the examining division, when deciding to refuse a European patent application under Art. 97(1) EPC 1973, to state one ground only which in their opinion would prejudice the grant of a European patent, since the EPC did not contain any provision which would allow a European patent to be partially granted. In the case at issue, the examining division was unable to grant a patent because it was of the opinion that the subject matter of claim 1 did not involve an inventive step. Consequently, the examining division was under no obligation to comment on the other claims.

In **T 1423/07** the examining division had refused the application on the basis of the Guidelines). The board stated that the EPC did indeed not contain any explicit provision which would prohibit double patenting. By invoking an "accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention", the above passage of the Guidelines made reference to Art. 125 EPC as a basis for not allowing double patenting. Therefore, what had to be evaluated was whether a European application could be refused on the grounds of double patenting on the basis of Art. 125 EPC.

The board found that there was a general principle of law generally recognised in the contracting states which did not allow **double patenting** arising from a granted national patent and a granted European patent, but this did not provide a basis for refusing a European application under Art. 97(2) EPC or Art. 97(1) EPC 1973. In view of the fact that the national patent laws of only two of the contracting states and the case law of a third contracting state provided a basis for refusing a patent application on the grounds of double patenting, there was no principle of law generally recognised in the contracting states which justified refusing a European patent application on the ground of double patenting.

### **3.10. Entry into force of a decision to grant a European patent**

Under Art. 97(3) EPC (former Art. 97(4) EPC 1973) the decision to grant a European patent shall take effect on the date on which the mention of the grant is published in the European Patent Bulletin. New Art. 97(3) EPC is essentially identical to Art. 97(4), first sentence, EPC 1973. The provisions concerning the minimum period that must lapse before the grant can take effect have been deleted from the Article. With the other grant formalities being transferred to the Implementing Regulations (see R. 71 EPC), this

matter too was more appropriately regulated at a lower legislative level. Consequently, Art. 97(6) EPC 1973 was deleted as unnecessary.

Under the EPC 2000, Art. 98 EPC stipulates that the European Patent Office shall publish the specification of the European patent as soon as possible after the mention of the grant of the European patent has been published in the European Patent Bulletin. The contents of the specification are transferred to the Implementing Regulations (see R. 73(1) EPC). Art. 98 EPC now contains the words "as soon as possible" in order to indicate that it is not always technically possible to publish the specification on the same day as the mention of the grant.

In **J 7/96** (OJ 1999, 443) the board did not share the view of the department of first instance and the applicant that the proceedings for grant were concluded on the date the examining division reaches its decision to grant a European patent under Art. 97(2) EPC 1973. The board noted that it was true that this date represented the date on which the process of reaching a decision on the application within the examining division was concluded; both the EPO and the applicant were bound by the decision as far as the text of the patent to be granted, the claims, description and drawings were concerned, and the subject-matter of the text of the patent became *res judicata* at that date. Thereafter, the EPO could no longer amend its decision and had to disregard any fresh matter the parties might submit (see **G 12/91**, OJ 1994, 285). Only linguistic errors, errors of transcription and obvious mistakes could be corrected later under R. 89 EPC 1973. The date on which the decision to grant the European patent was reached was thus clearly decisive as regards the EPO and the applicant.

The board noted that under Art. 97(4) EPC 1973, the decision to grant a European patent referred to in Art. 97(2) EPC 1973 does not take effect until the date on which the European Patent Bulletin mentions the grant. It is from this date of mention that, in accordance with Art. 64(1) EPC 1973, a European patent confers on its proprietor the same rights in respect of each Contracting State in respect of which it is granted as would be conferred by a national patent granted in that State. The mention also marks the time when the responsibility of the EPO comes to an end and the national patent systems take over, the granted patent becoming a bundle of national patents. It also marks the start of the period during which a notice of opposition may be filed (Art. 99(1) EPC 1973). Thus, the date of publication of the mention of the grant of the patent is the date on which the grant of the patent takes legal effect with respect to third parties, and on which the extent of protection conferred on the applicant is determined once and for all by means of the accompanying publication of the specification of the patent pursuant to Art. 98 EPC 1973. During the period between the decision to grant the patent (Art. 97(2) EPC 1973) and the publication of the mention of the grant (Art. 97(4) EPC 1973), the application is deemed to be **still pending** before the EPO. As the department of first instance itself admits in its decision, and as is also not disputed by the applicant, according to established EPO practice it is still possible during this **interim period** to take some limited action in respect of the application, which may, for example, be withdrawn or transferred. Applicants may even withdraw individual designations if they so wish. For its part, the EPO continues to have certain rights or obligations

concerning the patent during this period; for example, the annual fees fall due and transfers of rights in the patent must be registered by the EPO.

In **J 23/03** the appellant requested that the designation country GR incorrectly marked with a cross be corrected to GB. After a considerable exchange of correspondence, the examining division refused the request for correction on the ground that, from the date of publication of the patent, public interest in the reliability of the published information overrode the patent proprietor's interest in a correction, especially as he had had several opportunities to check the designation information in the course of the proceedings, namely after the notification of forms 2004 and 2005.

The board stated that R. 88 EPC 1973 did not contain an explicit reference to a time limit and that a request for correction could therefore be submitted at any stage of the patent grant procedure (see also **J 6/02**). This also applied to the correction of incorrect designation information in the application documents as requested by the appellant. The board nevertheless found that the appellant's request for correction of the designation information in the application documents had been submitted to the EPO only on 29.4.2002. Mention of the grant of his patent had appeared in the Patent Bulletin over a month before that date. Under Art. 97(4) EPC 1973, mention of the patent grant led to the grant of the patent taking effect and to the patent grant proceedings being concluded. At the time that the appellant submitted his request for correction, therefore, the proceedings were no longer pending (see **J 7/96**, OJ 1999, 433 and **J 42/92**).

The board held that the pendency of patent grant proceedings was, however, a requirement for the submission of an admissible request for correction because after that date the bundle of European patents granted under a single system divides into national patents which are then no longer administered by the EPO but by the appropriate national offices.

### **3.11. Errors in the Patent Bulletin**

Art. 97(3) EPC (former Art. 97(4) EPC 1973) stipulates that the decision to grant a European patent shall take effect on the date on which the mention of the grant is published in the European Patent Bulletin.

In decision **J 14/87** (OJ 1988, 295) the question arose to what extent a deficiency in the publication of the mention of grant of a European patent, i.e. the omission of important particulars relating to the grant, might render the patent ineffective. The board held that in principle deficiencies in the publication of the mention of grant in the European Patent Bulletin did not necessarily render the decision to grant within the meaning of Art. 97(4) EPC 1973 ineffective. Nevertheless, this matter could be decided only in the light of the case in question and the fact that the purpose of the publication was to draw the attention of interested parties to the grant of the patent, and also that any decision to file an opposition had, under normal circumstances, to be based on a careful examination of the extent of the protection conferred by the patent and not solely on the particulars given in the European Patent Bulletin. Such an examination could be carried



out satisfactorily only if the patent specification was published at the same time as the mention of grant of the patent.

#### 4. Additional searches during examination

An additional search will sometimes be required either at the first stage of amendment or subsequently. This may arise for a number of reasons (for more details, see Guidelines C-IV, 7.2 – November 2015 version).

##### 4.1. Rule 63 EPC governing incomplete search

###### 4.1.1 Introduction

R. 63(1) and (2) EPC (Incomplete search) (former R. 63 EPC; R. 45 EPC 1973) have been amended by decision of the Administrative Council CA/D 3/09 of 25 March 2009 (OJ 2009, 299), which entered into force on 1 April 2010.

Under R. 63(1) EPC if the EPO considers that the European patent application fails to such an extent to comply with the EPC that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed, it shall invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched.

According to R. 63(2) EPC if the statement under paragraph 1 is not filed in due time, or if it is not sufficient to overcome the deficiency noted under paragraph 1, the EPO shall either issue a reasoned declaration stating that the European patent application fails to such an extent to comply with the EPC that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed or, as far as is practicable, draw up a partial search report. The reasoned declaration or the partial search report shall be considered, for the purposes of subsequent proceedings, as the European search report.

In the ideal case, the applicant's statement removes completely the deficiencies under Art. 84 EPC and a **complete search report** can be drawn up. Alternatively, the **partial search report** will be drawn up in the light of the applicant's submissions, so that it will be up to the applicant to delimit the subject-matter to be searched.

R. 63 EPC enables the applicant to submit statements more clearly defining the subject-matter to be searched in cases where a normal search cannot be carried out. However, because the search report should, as a rule, be drawn up in time for publication together with the application further processing in respect of the period referred to in proposed R. 63(1) EPC will be excluded. This implies that re-establishment of rights will be possible.

In **T 1242/04** (OJ 2007, 421) the board held that R. 63 EPC applies to cases which do not comply with the provisions of the EPC to such an extent that it is not "possible" to carry out a "meaningful search" into the state of the art on the basis of all or some of the

claims. Thus a R. 45 EPC declaration is allowed only where a search is not possible. In other cases the search division draws up a partial search report, "so far as is practicable". R. 45 EPC relates only to the practicability of a search and not to the potential relevance of its results in subsequent substantive examination.

#### 4.1.2 Additional search necessary: limited discretion of the examining division

In **T 1515/07** the board stated that in normal circumstances an additional search had to be carried out if a search under R. 63 EPC is missing. It was true that the case law allowed discretion in this respect, but this discretion was limited to the special cases of notoriously known features or those explicitly accepted by the applicant as known. In all other cases, an additional search had to be performed. In particular, as long as no search had been performed an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contained at least one technical feature which was not notorious. The examining division considered that it was not "necessary" to carry out a search because a decision could be reached anyway. The examining division was held to have committed a substantial procedural violation within the meaning of R. 103(1)(a) EPC by not performing an additional search that was manifestly necessary. It was therefore equitable to reimburse the appeal fee.

In **T 1242/04** it was held that only when a search is not at all possible can it be denied under R. 45 EPC 1973. Whether or not the search division believes that the result of a search will be of use for the substantive examination is irrelevant. If nevertheless the situation occurs that no search has been performed although it could (and should) have been, an examining division is not obliged to perform an additional search for purely formal reasons if it considers a refusal of the application to be justified on the basis of prior art which is either so well known that it clearly does not require written proof or is accepted by the applicant as known. In all other cases an additional search should be performed.

In **T 690/06** regarding the procedure before the examining division the board was of the opinion that the examining division should have performed an additional search since the database partitioning and access control features were neither non-technical nor notorious. Following the principles set out in decision **T 1242/04** (OJ 2007, 421), the board considered that, as long as no search has been performed, an examining division should normally not refuse an application for lack of inventive step if the invention as claimed contained at least one technical feature which was not notorious. The term "notorious" had to be interpreted narrowly.

In **T 1411/08** the board understood "notorious" as implying that technical detail was not significant. The board stated that where a search division has decided that no search was to be performed, it is not always necessary for the examining division to carry out an "additional search" before raising an inventive-step objection. According to the established case law of the boards of appeal it is possible to raise an objection of lack of inventive step without documented prior art. That should be allowable where the objection is based on 'notorious knowledge' or indisputably forms part of the common general knowledge (**T 1242/04**, OJ 2007, 421). Such cases, however, are exceptional,

and a search is otherwise essential. In the case at issue, the examining division could and should have ensured that a search was performed before refusing the application for lack of inventive step. The board considered that the failure to carry out an "additional search" constituted a substantial procedural violation and that the reimbursement of the appeal fee must be ordered.

In **T 1924/07** the board held that the applicant's acknowledgement in the original application that certain prior art is known is, in general, not a sufficient reason for not carrying out an additional search. The only condition under which an additional search can be dispensed with is where all the technical features of a claim correspond to "notorious" prior art.

In **T 2299/10** the decision under appeal was, *inter alia*, based on the objection that the subject-matter of claim 1 lacked an inventive step. The EPO acting as International Searching Authority issued a declaration of non-establishment of the international search report under Art. 17(2)(a) PCT. No supplementary European search report was established either. The examining division examined the application despite the fact that no search had been carried out. However, this is only possible in exceptional cases and, according to the jurisprudence of the boards of appeal, an additional search for pertinent prior art may be dispensed with only if the technical features of the claims are considered to be "notorious", i.e. generic and so well known that they cannot reasonably be refuted (see **T 1411/08**). In the board's judgment, the technical features went beyond the mere common general knowledge and could not be considered "notorious". An applicant's acknowledgement in the original application that certain prior art was known is in general not a sufficient reason for not carrying out an additional search since such statements may be – and indeed frequently are – withdrawn or qualified. Moreover, this could only apply in cases where all the technical features in the claim would be acknowledged as known (see **T 1924/07**). In the case at issue, however, the appellant did not acknowledge the relevant features of claim 1 mentioned as being known. Thus, claim 1 could not be definitively assessed with respect to novelty and inventive step without knowledge of the relevant documented prior art. Thus the request required a search for relevant prior art. Hence the matter had to be remitted for an additional search and further examination.

In **T 2249/13** the appellant doubted the legitimacy of the Notice from the European Patent Office dated 1 October 2007 concerning business methods (OJ 2007, 592), which announced a no-search policy for claims pertaining to business methods. Such discrimination was not justified. It considered that the EPO had enriched itself unfairly by receiving the search fee without performing a search. Furthermore, the no-search declaration of the search division could not be deemed to be a European search report under R. 63(2) EPC as the search division had ignored R. 63(1) EPC by failing to invite the appellant to file a statement indicating the subject-matter to be searched. The board pointed out that the board was applying the EPC and associated provisions as they stand. The Rules Relating to Fees did not provide for a refund of the search fee in case of a no-search declaration under R. 63 EPC. R. 63(2) EPC states that such a no-search declaration shall be considered as the European search report. Further, the fact that the search division did not comply with R. 63(1) EPC (failure to communicate with the

appellant) did not alter the legal situation. The search division's actions were not open for review by the board (Art. 106(1) EPC) and, for the same reason, neither was the search division's reliance on the Notice from the EPO dated 1 October 2007 concerning business methods. Therefore, the board considered that the request for a (partial) refund of the search fee was inadmissible.

#### 4.1.3 Declaration under Rule 63(2) EPC

##### a) Notoriously well-known technical features

According to the case law of the boards of appeal an examining division need not carry out an additional search if the technical features of the claims are notoriously well known. In particular, it is possible to raise an objection of lack of inventive step without documented prior art (see e.g. **T 939/92**, point 2.3 of the Reasons, OJ 1996, 309; **T 1242/04**, OJ 2007, 421, **T 1411/08**). That should be allowable where the objection was based on "notorious knowledge" or indisputably forms part of the common general knowledge. In such cases it would be inappropriate to carry out an additional search for documented prior art on purely formal grounds (**T 1242/04**, OJ 2007, 421; see also **T 690/06**, **T 698/11**).

In **T 359/11** the board held that where the relevant search authority has stated, either in a search report or in a declaration that no search report will be established, that it is not necessary to cite any documentary evidence of the prior art on the grounds that all of the technical features of the claimed invention are notorious, it is always incumbent upon the examining division to consider whether an additional search is necessary. The criterion to be applied is that if the invention as claimed contains at least one technical feature which is not notorious, the application should normally not be refused for lack of inventive step without performing an additional search (see point 3.9 of the Reasons and **T 690/06**). In the case at issue, the choice of the examining division to decide on the issue of inventive step without performing an additional search could only be considered justifiable if the claimed subject-matter comprises no technical features which are non-notorious.

In **T 2467/09** the examining division refused the application for lack of inventive step without making reference to documentary evidence. In fact, no prior art search was carried out in either the international phase or the European phase. The board noted that according to the established case law of the boards of appeal, an application should normally not be refused for lack of inventive step as long as no search has been performed. An exception may however be made in cases where the objection is based on knowledge that is "notorious" or indisputably forms part of the common general knowledge.

The board pointed out that while it could not be reasonably disputed that server systems providing web pages were known at the priority date of the application, in the board's view this was less evident for "technologies for the dynamic building of web pages". While such technologies were probably well-known in 2008, which was when the examining division for the first time explicitly relied on their existence, it had to be kept in

mind that the field of web technology had evolved considerably in the eight years following the filing of the priority application in April 2000. The board noted that the argument that certain knowledge is notorious is only a sufficiently cogent reason if it satisfies any reasonable addressee, i.e. if, at the time the argument is to be assessed by the applicant and, in case of an appeal, by a board of appeal, it cannot be reasonably disputed that that knowledge formed part of the common general knowledge of the skilled person at the effective filing date. In the present case, the board did not consider it to be indisputable that "technologies for the dynamic building of web pages", let alone specific technologies that could take away the novelty or inventive step of the invention as claimed, were generally known in April 2000. It followed that, without documentary evidence, the examining division's reasoning failed to convince in this respect. The board remitted the case to the department of first instance for further prosecution. The examining division was to carry out an additional search on the basis of the claims, including the dependent claims.

#### b) Subject-matter not having technical character

In **T 1242/04** (OJ 2007, 421) the board noted that R. 45 EPC 1973 applied to cases which did not comply with the provisions of the Convention to such an extent that it was not "possible" to carry out a "meaningful search" into the state of the art on the basis of all or some of the claims. Thus a R. 45 EPC 1973 declaration was allowed only where a search was not possible. In other cases the search division would draw up a partial search report, "so far as is practicable". In the board's view, R. 45 EPC 1973 related only to the practicability of a search and not to the potential relevance of its results in subsequent substantive examination. The board noted that it was not evident that claims directed only to technical features that the search division deemed "trivial" could prevent a meaningful search into the state of the art, which in fact ought to be particularly simple in such a case. The board held that where the application's subject-matter had **non-technical** aspects, a declaration under R. 45 EPC 1973 might be issued only in exceptional cases in which the claimed subject matter clearly had no technical character. In the board's view, however, it was not always necessary in such circumstances to carry out an additional search in the documented prior art.

#### 4.1.4 Invitation to restrict the claims under Rule 63(3) EPC

R. 63(3) EPC is based on the same reasoning as former R. 62a(2) EPC. It states that when a partial search report has been drawn up, the examining division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified.

R. 63(3) EPC in conjunction with proposed R. 137(5), second sentence, EPC, ensures that no patent will be granted with claims directed to unsearched subject-matter. Whereas proposed R. 137(5), second sentence, EPC, relates to amendments made during the grant procedure which are under the control of the examining division, R. 63(3) EPC is necessary to avoid originally filed claims relating to the unsearched subject-matter remaining in the application. If the applicant does not comply with the invitation under R. 63(3) EPC, the application will not meet all requirements of the EPC

and may be refused under Art. 97(2) EPC (Guidelines C-III, 3.3 – November 2015 version) (CA/29/09, points 7 and 15).

#### **4.2. Non-payment of further search fees under Rule 64 EPC**

R. 64(1) EPC (former R. 46 EPC 1973) was amended by decision of the Administrative Council (OJ 2009, 299), and entered into force on 01.04.2010.

Under R. 64(1) EPC if the EPO considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial search report on those parts of the application which relate to the invention, or the group of inventions within the meaning of Art. 82 EPC, first mentioned in the claims. It shall inform the applicant that, for the European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within a period of two months. The European search report shall be drawn up for the parts of the application relating to inventions in respect of which search fees have been paid.

In **G 2/92** (OJ 1993, 591) the Enlarged Board of Appeal stated that an applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division cannot pursue that application for the subject-matter in respect of which no search fees have been paid. Such an applicant must file a divisional application in respect of such subject-matter if he wishes to seek protection for it (CA/29/09). It also stated that if the applicant has not availed himself of the opportunity to have the search results on the other inventions included in the search report because he has paid no additional search fees in response to the invitation under R. 46(1) EPC 1973, he will be taken to have elected that the application should proceed on the basis of the invention which has been searched (see **G 2/92**). However, non-payment is not to be equated with the abandonment of parts of the application.

In **T 998/14**, however, the board noted that decision **G 2/92** does not necessarily apply for **features** which are disclosed in the original application documents in connection with an invention or group of inventions in respect of which a search has been made.

### **5. Amendments relating to unsearched subject-matter - Rule 137(5) EPC**

#### **5.1. General issues**

R. 137(5) EPC as in force from 01.04.2010 (OJ 2009, 299) (former R. 137(4) EPC and R. 86 (4) EPC 1973) relates to amendments made during the grant procedure which are under the control of the examining division. It stipulates that amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. Nor may they relate to subject-matter not searched in accordance with R. 62a or R. 63 EPC.

In **T 2459/12** what was at issue was whether the invention is "unsearched" within the meaning of R. 137(5) EPC, which limits the choice of subject-matter which may be put forward by way of amendment for examination in the European procedure. The board

stated that it was clear that the only interpretation of R. 137(5) EPC was that, within the meaning of R. 137(5) EPC, "unsearched" means "unsearched by the EPO". It was consequently the view of the board that where, following the drawing up of a supplementary European search report by the EPO, an applicant files amended claims seeking protection for subject-matter not covered by the supplementary European search as a result of the application of R. 164(1) EPC as then in force, an objection under R. 137(5) EPC should be raised.

## 5.2. The purpose of Rule 137(5) EPC

The wording of R. 137(5) EPC is the same as that of R. 86(4) EPC 1973. R. 86(4) EPC 1973 (with effect from 1 June 1995), was intended to prevent amendments of the application which circumvent this principle that a search fee must always be paid for an invention presented for examination (**T 274/03**). This rule was introduced to give the EPO the means to react appropriately when the applicant dropped existing claims and replaced them with originally non-unitary subject-matter extracted from the description (see **T 1285/11**).

In **T 274/03** the board stated, with regard to R. 86(4) EPC 1973 (now R. 137(5) EPC), which was introduced with effect from 1.6.1995, that it was intended to prevent amendments of the application which circumvent the principle that a search fee must always be paid for an invention presented for examination. R. 86(4) EPC 1973 stops applicants switching to unsearched subject-matter in the reply to a communication from the examining division and makes means available for the EPO to react when different subject-matter is claimed not simultaneously but in sequence as is the case when the applicant drops the existing claims and replaces them with originally non-unitary subject-matter extracted from the description (**T 2334/11**).

In **T 443/97** the board stated that R. 86(4) EPC 1973 (now R. 137(5) EPC) concerned examination proceedings, and particularly those cases in which no further search fees requested by the search division for non-unitary subject-matter had been paid by the applicant. The purpose of R. 86(4) EPC 1973 was to exclude any amendment which circumvented the principle according to which a search fee must always be paid for an invention presented for examination. The board noted that unity of invention was a requirement of an administrative nature and that the administrative purposes of this requirement were fulfilled when the examination procedure had been concluded, i.e. when the patent had been granted (see **G 1/91**, OJ 1992, 253). Therefore, R. 86(4) EPC 1973 was not relevant for the opposition case at issue.

### 5.3. Applicability of Rule 137(5) EPC

#### 5.3.1 General issues

R. 137(5) EPC provides that amended claims are not admissible in the following two cases:

(1) the amended claims may not relate to unsearched subject-matter "which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept" and

(2) the amended claims lack unity of invention with the originally claimed invention or group of inventions.

See also Guidelines H-II, 6.2 – November 2015 version (Amendments directed to unsearched matter).

According to well-established case law, R. 137(5) EPC does not apply when the applicant has not paid the search fee in respect of a non-unitary invention relating to the originally filed claims (see **T 708/00**, OJ 2004, 160, **T 1285/11**).

In **T 613/99** the board stated that R. 86(4) EPC 1973 referred to a particular situation, i.e. where subject-matter was described but not claimed in the original application and was therefore not searched; where that subject-matter failed to meet the requirement for unity of invention with the matter claimed in the application; and where, following the search report, the applicants had filed fresh claims relating only to this unsearched matter. In this situation, the patentability of these fresh claims could not be examined in the context of the original application, since this would have amounted to a derogation from the principle endorsed in **G 2/92** (OJ 1993, 591), according to which the invention to be examined had to be an invention for which a search fee had been paid. In the case at issue, the situation was entirely different. The claimed subject-matter in the application under consideration had been claimed in the original application and had therefore been searched, even if it had not been possible to carry out a **meaningful search**. Moreover, the invention forming the subject of claims 1 and 2 of the application at issue was substantially the same as that which formed the subject of claims 1 and 2 of the original application. In such a situation, if the examining division rejected a finding of the search division regarding matter excluded from the search, a so-called additional European search could be carried out at the request of the examining division.

#### 5.3.2 Extent of the European search report

The extent of the search for prior art to be conducted for the purposes of the European search report is defined in Art. 92 EPC, which states that the EPO shall be drawn "on the basis of the claims, with due regard to the description and any drawings". In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to



be directed after they have been amended (Guidelines B-III, 3.5 – November 2015 version).

In **T 708/00** (OJ 2004, 160) the application was refused by the examining division, principally on the grounds that the new claims were not allowable under R. 86(4) EPC 1973. The board stated that the provisions of Art. 92(1) EPC 1973 must not have the effect of limiting the search solely to the subject-matter of the claims, even if this would simplify matters for the search division. Nor does this imply that the sole purpose of the description and drawings is to help interpret the claims. It does, however, mean that the search division has to be discerning in the use of its discretionary power so as to ensure that the search is in complete accordance with the subject-matter of the patent application (see R. 44(1) EPC 1973), i.e. the invention, even if the essential features are not all defined in the claims at the time of search but are disclosed for example in the description or drawings. In the case at issue, the applicants were never informed of exactly what subject-matter is searched, which means that the examining division and board of appeal were also without any information in this regard. It was therefore impossible - since negative proof is out of the question - to establish what subject-matter went "unsearched" under R. 86(4) EPC 1973. This rule therefore had to be interpreted using alternative means such as the preparatory documents or the documents published regarding the adoption of the rule. The board came to the conclusion that amended claims may only be refused on the basis of R. 86(4) EPC 1973 if the subject-matter of the claims filed originally and that of the amended claims is such that, had all claims originally been filed together, a further search fee would have been payable - on top of the search fee payable in respect of the claims actually filed at the outset - in respect of the amended claims, relating to a different invention within the meaning of R. 46(1) EPC 1973.

The board noted that R. 86(4) EPC 1973 must be interpreted so as to fairly balance the objective of this rule, namely the EPO's interest in collecting, in return for services rendered, search and examination fees, and the fundamental right conferred by the EPC on the applicant to make amendments at least once to the description, claims and drawings that prove necessary during the grant procedure. The board pointed out that the intention and purpose of R. 86(4) EPC 1973 and the interference with the applicant's fundamental right to amend the application at least once called for a strict interpretation of R. 86(4) EPC 1973 (**T 141/04**). It held that R. 86(4) EPC 1973 did not apply when the applicant had not paid the search fee in respect of a non-unitary invention relating to the originally filed claims in spite of being invited to do so under R. 46(1) EPC 1973. In that case, the application could not be examined further, and a divisional application would have to be filed if protection were sought (see **G 2/92**, OJ 1993, 591). The boards in **T 319/96** and **T 631/97** (OJ 2001, 13) made a clear distinction between applying the provisions of R. 86(4) EPC 1973 and a situation where search fees were not paid in spite of an invitation to do so under R. 46(1) EPC 1973.

In **T 789/07** the board held that in order to search a claimed feature completely – as required by Art. 92 EPC and in line with the Guidelines – the search division must as a rule ascertain how the **feature is to be interpreted in the light of the description** and drawings. Only then can it arrive at a reasoned assessment about the amendments likely

to be made to the claims during examination proceedings and within the framework of the original disclosure. This interpretation also forms the basis for comparison, with a view to R. 86(4) EPC 1973, with the originally claimed invention or group of inventions. The board also took the view that a claimed feature falling within the scope of the search must be regarded for R. 86(4) EPC 1973 purposes as searched, even if it was not in fact searched in a specific case (see also **T 2334/11**).

In **T 2334/11**, the examining division had taken the view that the amendment to claim 1 did not meet the requirements of R. 137(5) EPC and so refused the amended set of claims according to the main request. The board observed that the first requirement for applicability of R. 137(5) EPC (formerly R. 137(4) EPC and, before that, R. 86(4) EPC 1973) was that the amended claims related to unsearched subject-matter. It stressed that it did not necessarily follow from the mere fact that a feature was not included in the searched set of claims that it had not been searched (see **T 708/00**, OJ 2004, 160, **T 377/01** and **T 789/07**). Thus, Art. 92(1) EPC, as worded in the EPC 1973 in force **at the time of the search** at issue, required that the search report be drawn up "on the basis of the claims, with due regard to the description", while the Guidelines stated that "in principle, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended". In the board's view, the **subject-matter of the amended claim had to be deemed searched** for the purposes of R. 137(5) EPC, even if the search had not actually covered the added feature (see **T 789/07**) (see also **T 345/13**).

In **T 345/13** the board noted that the search should be made on the basis of the claims, with due regard to the description and any drawings (Art. 92 EPC), and with particular emphasis on the inventive concept. In principle, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (Guidelines, B-III, 3.5). It followed from these principles that in the present case the subject-matter of the amended claims should have been covered by the search, and is thus deemed to be searched for the purpose of applying R. 137(4) EPC as in force before 1 April 2010. The board therefore did not follow the examining division's application of R. 137(5) EPC [R. 137(4) EPC as in force before 1 April 2010], since a prerequisite for applying this Rule, ie that the amended claims relate to unsearched subject-matter, was not fulfilled. For this reason alone the impugned decision had to be set aside.

In **T 264/09** the board stated that if a feature which has not been searched and which further defines an element which was already part of a claim which had been searched, is taken from the description and added to this claim in order to overcome an objection under the EPC, e.g. lack of inventive step, this does not result in a claim which has been amended such that it relates to unsearched subject-matter which does not combine with the originally claimed invention to form a single general inventive concept. The board thereby followed the well-established case law on the interpretation of R. 86(4) EPC 1973 (see e.g. **T 708/00** (OJ 2004, 160), **T 274/03**, and **T 141/04**), it being noted that R. 86(4) EPC 1973 has the same wording as R. 137(4) EPC (as in force at the date the examining division took its decision), which, as from 1 April 2010, is included in R. 137(5) EPC. The board noted that the Guidelines were drafted accordingly; these

explicitly mention the possibility of carrying out an additional search in connection with the examination of amended claims (**T 2334/11**).

### 5.3.3 Subject-matter of amendment not combining with the originally claimed invention

In **T 442/11**, the board noted that, under R. 137(4) EPC, as in force before 1 April 2010, amended patent claims could not relate to unsearched subject-matter which did not combine with the originally claimed invention or group of inventions to form a single general inventive concept. It observed that R. 137(4) EPC (having the same wording as R. 86(4) EPC 1973) had entered into force on 1 June 1995 and been incorporated in the Implementing Regulations to prevent applicants from switching, during the examination proceedings, the protection sought to unsearched parts of the application **which had not yet been claimed when the search was performed** (see "travaux préparatoires" on R. 86(4) EPC 1973, OJ 1995, 409; and **T 509/11**, **T 2334/11**).

In **T 442/95** the appellants submitted new claims, based on subject-matter which did not appear in the claims as filed. They submitted that the description of this newly claimed subject-matter was to be found in the description. In the board's judgment, the subject-matter claimed had not been searched and did not combine with the originally claimed and searched groups of inventions to form a single general inventive concept. There was no need at this stage to investigate whether the application as filed provided support for such a claim, because under R. 86(4) EPC 1973 the claim was not admissible. The only path open to the appellants was to pursue the subject-matter of said claim in the form of a divisional application.

In **T 353/03** the examining division had stated in its decision of refusal that the new feature in claim 1 had not been searched and that, for that reason, the application was refused according to Art. 97(1) in conjunction with R. 86(4) EPC 1973. The board found that in its decision the examining division did not take into account the fact that R. 86(4) EPC 1973 mentioned another condition which also had to be fulfilled for amended claims to be rejected, namely that the unsearched subject-matter did not combine with the originally claimed invention to form a single general inventive concept (lack of unity). There was no discussion in the appealed decision as to why the subject-matter of new claim 1 was not in unity with original claim 1. The board came to the conclusion that the appealed decision was not reasoned within the meaning of R. 68(2) EPC 1973.

In **T 333/10** the board found that the subject-matter of amended claim 1 could not be considered to have been searched and it did not combine with any of the originally claimed inventions to form a single general inventive concept. The appellant referred to decision **T 2334/11** and argued that, in a case like the one before it, no "a posteriori" unity judgment was to be made; rather, it was to be generally examined if the added feature taken from the description combined with the originally claimed invention to form a single general inventive concept focused on in the claims and description as originally filed.

The board noted that the claims as originally filed had been found to lack unity by the search division. It also stated that the instant case concerned the replacement of some of the features from the combination of features on which the search was based by features which might not be considered as corresponding special technical features within the meaning of R. 44(1) EPC and which could not be expected to constitute a pure limitation of one of the searched inventions. In contrast, decision **T 2334/11** concerned a factual situation in which added features restricted the scope of the searched subject-matter. This difference had also been addressed in decision **T 2334/11**, which essentially stated that the jurisprudence concerning R. 137(5) EPC (version of 1 April 2010) distinguished between cases in which the claimed subject-matter was substantially changed, in particular by replacement or omission of a feature in a claim, and which could give rise to an objection under R. 137(5) EPC, and cases which concerned the pure limitation or concretisation of a claim by adding a feature disclosed in the application as originally filed, and which did not normally cause lack of unity with the originally claimed invention within the meaning of R. 137(5) EPC. In the case before it, the board did not see a limitation or concretisation of any of the four inventions which had initially been searched and which could have been pursued by the appellant. The board noted that decision **T 2334/11** could not be understood to the effect that the amendment of an independent claim by a feature extracted from the description is generally admissible under R. 137(4) EPC if the subject-matter of the independent claim has been searched and lacks novelty with respect to a prior-art document. Instead, the board in decision **T 2334/11** emphasised that – in such cases – it always has to be examined whether the added feature is linked to the general inventive idea that can be deduced from the claims and description as originally filed. Hence, the amended set of claims was not admissible.

#### **5.4. Criteria for consent to amendments under R. 137(5) EPC**

The question concerning the criteria to be used for the proper application of R. 137(5) EPC has been dealt with in various decisions of the boards of appeal.

##### **5.4.1 Amendment not affecting the notion of unity of invention**

A claim may be limited by inclusion of additional features, provided the resulting combination was originally disclosed and does not relate to an invention which was not searched (Guidelines H-V, 3.2 – November 2015 version).

In **T 708/00** (OJ 2004, 160) the board held that under R. 86(4) EPC 1973, amended claims could only be refused if the subject-matter of the claims filed originally and that of the amended claims was such that, had all the claims originally been filed together, a further search fee would have been payable - on top of the search fees payable in respect of the claims actually filed at the outset - in respect of the amended claims, relating to a different invention within the meaning of R. 46(1) EPC 1973 (see also **T 319/96** and **T 631/97**, OJ 2001, 13). It noted that "a subsequent amendment to limit the subject-matter of the main claim by additional features disclosed in the application as filed did not generally affect the notion of unity of invention under either R. 86 (4) or 46 (1) EPC 1973" and that "it is normal for an applicant to make such an amendment in

respect of an objection to the patentability of the subject-matter in unlimited form" (T 2334/11).

In T 274/03 it was however made clear that certain conditions have to be satisfied for an amendment not to generally affect the notion of unity of invention. Thus, this notion is not affected, and therefore no post-search switching of subject-matter is involved by the amendment, if for instance features are added from the description to further define an element that was already a feature of the original main claim, to further specify an essential aspect of the original main claim (see T 1394/04).

In T 2334/11, the board held that what generally had to be ascertained for the purposes of applying R. 137(5) EPC where an original claim was amended by adding a feature was whether the added feature could be regarded as falling under the original general inventive concept as established in the light of the claims and description as filed (see T 1640/07), and not whether the originally claimed subject-matter and the subject-matter defined in the amended claim withstood an assessment of unity *a posteriori*. It found that one of the ideas underlying the case law on application of R. 137(5) EPC was that, while amendments to claimed subject-matter which considerably altered the essence or nature of the invention - especially through replacement or omission of features in a claim (see T 442/95 and T 274/07) - might occasion an objection under R. 137(5) EPC, the mere limitation or the more specific drafting or supplementing of a claim by inclusion of a feature disclosed in the application as filed, in order, for example, to overcome an objection of lack of clarity, novelty or inventive step, generally did not result in a lack of unity with the originally claimed invention for the purposes of R. 137(5) EPC.

In T 1394/04 the board noted that careful consideration of the very nature of the added feature is necessary in order to determine whether the amendment leads to a situation where lack of unity of inventive concept between the original main claim and the later claimed subject-matter arises. Such a situation in the context at issue would necessarily entail an implicit finding of lack of unity "a posteriori" (T 274/03, point 6 of the Reasons) and according to the Guidelines this form of objection to lack of unity should be the exception. The board also noted that it could not be excluded that such a situation could arise as a consequence of later amendments supported solely by the description. In fact, it may occur that the description of the application contains a further general inventive concept, distinct from that underlying the main claim and its dependent claims, if any, but not clearly identified or declared as such in the description. In such a case, if the subject-matter of the main claim based on the first inventive concept had to be amended, on account of a lack of novelty resulting from too broad terms used in the wording, any amendment of the claim pertaining exclusively to said further inventive concept could justify an objection of lack of unity "a posteriori". This example elucidates that situations may actually occur where the amendment of the main claim, whose subject-matter lacks novelty, based on features supported exclusively by the description, may affect the notion of unity of the invention. Although such situations occur very rarely in practice, as already noted above, in such cases R. 86 (4) EPC would have to be applied in order to **avoid a possible circumvention** of Art. 82 EPC. In the case at issue however it was clear that, much the same way as in the decision T 274/03, the introduced amendment feature merely constituted a further specification of original features of the claim which

are essential to the invention. This constituted an essential aspect of the invention. Therefore, no lack of unity pursuant to R. 86 (4) EPC 1973 in conjunction with Art. 82 EPC 1973 could be found.

#### 5.4.2 Amendments filed to meet an objection

In **T 141/04** the board held that R. 86(4) EPC 1973 does not apply if a feature originally disclosed in the description is added to an originally-filed claim **in order to meet an objection** raised. It noted that the Guidelines were in line with the jurisprudence of the boards of appeal. The board noted that, notwithstanding the applicant's right to introduce subject-matter from the description into the claims, the exercise of such a right is not without restrictions, as indicated by Art. 123(1) EPC 1973 and R. 86(3) EPC 1973. Therefore, the examining division could possibly have exercised its discretion under R. 86(3) EPC 1973, last sentence, to refuse to admit this request, as it was filed for the first time during the oral proceedings before the examining division and apparently comprised unsearched subject matter. As such, the request could not reasonably be considered as clearly allowable, this latter being a usually applied requirement for admissibility of a request at such a late stage of the proceedings. On the contrary, the potential requirement for an additional search would have represented an unreasonable protraction of the examination procedure.

In **T 274/03** the board noted that it was clear that post-search "switching" of subject-matter clearly implied a significant change in the nature of the subject-matter being claimed which was not normally comparable to the addition of features taken from the description to further define an element that was already a feature of the original main claim. The board was of the opinion that an amendment amounting to the restriction of an original main claim by including complementary features from the original description into the claim represented an admissible reaction of an applicant vis-à-vis an objection against the patentability of the unamended claim and did not constitute an abuse of the system of the nature which R. 86(4) EPC 1973 was introduced to prevent (**T 377/01** and **T 708/00**). This type of amendment should not therefore in general be judged as contravening the requirements of the rule, **even though an additional search could be required**. In this context it was to be observed that the implicit finding of lack of unity between the originally claimed and later claimed subject-matter, which was a prerequisite for an objection under R. 86(4) EPC 1973, had to, with amendments of the type under consideration here, be a posteriori. The Guidelines made it clear however that this form of objection to lack of unity should be the exception, with benefit of the doubt being given to the applicant (see also **T 2334/11**).

#### 5.5. Non-compliance with Rule 137(5) EPC: a ground for refusing an application

In **T 2459/12** (see point 5.3 of the Reasons) the board noted that in decision **T 1981/12** doubt was also expressed whether R. 137(5) EPC could be an appropriate basis for refusing an application. The deciding board in **T 1981/12** concluded that, by reference to decisions **T 708/00** and **T 442/95**, an amendment not complying with this rule was inadmissible. According to Art. 97(2) EPC, a European patent application which does not meet the requirements of the EPC is refused unless "this Convention provides for a

different legal consequence". R. 137(5) EPC sets out a requirement to be met by amended claims of a European patent application, and neither in the Rule itself nor elsewhere in the EPC is any "different legal consequence" provided for the case where this requirement is not met. The board therefore judged that a failure to meet the requirements of R. 137(5) EPC is a ground for refusal of the application under Art. 97(2) EPC. This was also entirely consistent with the view taken in decision **T 708/00**. R. 86(4) EPC 1973 was regarded as having "the status of an administrative provision in the context of the search and grant procedures", as is "the case for the unity of invention requirement in general".

### C. Special features of opposition and appeal proceedings

1.	Late submission	930
1.1.	General principles	930
1.1.1	Interpretation of Art. 114 EPC	930
1.1.2	Legal basis	931
1.1.3	Historical development	931
1.1.4	Examination as to relevance	933
1.1.5	Documents cited in the patent specification or search report	933
1.2.	Late-filed facts, arguments and evidence in opposition proceedings	934
1.2.1	Late submissions	934
1.2.2	Opposition divisions' exercise of discretion	935
	a) General principles	935
	b) Reasons for the decision	936
	c) Proper exercise of discretion	936
	d) Improper exercise of discretion	937
1.2.3	Late submission of new arguments	938
	a) New arguments – definition	938
	b) Late submission of new arguments	938
1.3.	Late-filed facts, arguments and evidence in appeal proceedings	939
1.3.1	General	939
1.3.2	Rules of Procedure of the Boards of Appeal	939
1.3.3	The boards' discretion	940
1.3.4	Procedural economy	941
1.3.5	Complexity of new subject-matter	941
1.3.6	Legitimate reaction to the first-instance decision	942
	a) General	942
	b) Documents admitted	943
	c) Evidence of common general knowledge	944
1.3.7	Relevance	944
1.3.8	Complete case	945
1.3.9	Communication of a board of appeal	945
1.3.10	Reinforcement of arguments	945
1.3.11	Submission of new arguments on appeal	945
	a) General	945
	b) New arguments admitted	946
	c) New arguments not admitted	947
1.3.12	Adjournment of oral proceedings	948
1.3.13	Absence of a party from oral proceedings (Art. 15(3) RPBA)	948
1.3.14	Article 12(4) RPBA	949
	a) Documents and evidence withheld at first instance	949
	b) Documents and evidence not admitted by the opposition division	950
	c) Documents and evidence admitted under Art. 12(4) RPBA	951
1.3.15	Cases of abuse of procedure	952
	a) No abuse of procedure	952
	b) Abuse of procedure (yes)	953
1.3.16	Late submission of experimental data	954



a)	Test reports admitted into the proceedings	954
b)	Test reports not admitted into the proceedings	954
1.3.17	Public prior use	955
a)	No consideration of late-filed evidence of public prior use	955
b)	Consideration of late-filed evidence of public prior use	957
1.3.18	Change of representative	957
1.3.19	New submissions in proceedings resumed before the boards	958
2.	Transfer of party status	958
2.1.	Party status as patent proprietor	958
2.2.	Party status as opponent	959
2.2.1	General principles	959
2.2.2	Universal succession	960
2.2.3	Transfer together with the business assets to which the opposition relates	961
2.2.4	No transfer: sale of opponent's subsidiary company	962
2.2.5	Legal uncertainty as to who is the correct party	963
2.2.6	Evidence for and effect of a transfer	964
a)	Date of effective transfer	964
b)	What kind of evidence suffices	966
c)	Natural heir	966
2.2.7	Effect of finding that no transfer took place	966
3.	Intervention	967
3.1.	Admissibility	967
3.1.1	Any third party	967
3.1.2	Relevant patent	968
3.1.3	National infringement proceedings	968
3.1.4	Proceedings pending before the EPO	970
a)	Intervention in opposition proceedings	970
b)	Intervention in appeal proceedings	970
3.1.5	Time limit for intervention	971
3.1.6	Fees	971
3.1.7	Substantiation requirement	972
3.2.	Legal status of intervener	972
3.2.1	In opposition proceedings	972
3.2.2	In appeal proceedings	972
3.2.3	Time limits in pending proceedings	973
4.	Continuation of the opposition proceedings by the EPO	973
4.1.	Surrender and lapse of the patent	973
4.1.1	Surrender of patent	973
4.1.2	Continuation of the opposition proceedings after lapse or surrender (Rule 84(1) EPC)	974
a)	Request for continuation of the proceedings made by the opponent	975
b)	Request for continuation of the proceedings made by the patent proprietor	976
4.2.	Death or legal incapacity of an opponent	976
4.3.	Withdrawal of opposition	976
4.3.1	Form and effect of withdrawal on party status	977

4.3.2	Effect of withdrawal on opposition proceedings before the departments of first instance	977
4.3.3	Effect of withdrawal on opposition appeal proceedings	978
5.	Limitation/revocation	979
5.1.	Limitation/revocation - Article 105a-105c EPC	979
5.2.	Requests for revocation during opposition and opposition appeal proceedings	979
6.	Apportionment of costs	981
6.1.	Principle that each party must bear its own costs	981
6.2.	Equity of a different apportionment of costs – case groups	982
6.2.1	Late submission of documents and/or requests	983
	a) Late submission was unjustified	983
	b) Late submission was justified	987
6.2.2	Acts or omissions prejudicing the timely and efficient conduct of oral proceedings	990
	a) Failure of a party to appear at oral proceedings	990
	b) Request for scheduling or postponement of oral proceedings; withdrawal of request for oral proceedings	994
	c) Other cases	996
6.2.3	Filing of opposition or appeal	997
6.2.4	Withdrawal of opposition or appeal at short notice	998
6.2.5	Other cases	999
6.3.	Procedural aspects	1000
6.3.1	Filing a request for apportionment of costs	1000
6.3.2	Competence issues	1001
6.3.3	Apportionment of costs	1001
	a) Future costs	1002
	b) Procedure for fixing costs	1002
6.3.4	Appeal solely against the decision on costs inadmissible	1003

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## 1. Late submission

### 1.1. General principles

#### 1.1.1 Interpretation of Art. 114 EPC

Under Art. 114(1) EPC, the EPO is obliged to examine the facts of its own motion, and in doing so, it is not restricted to the facts, evidence and arguments provided by the parties and the relief sought. According to Art. 114(2) EPC, however, the EPO may disregard facts or evidence which are not submitted in due time by the parties concerned. Interpretation of Art. 114 EPC therefore requires an analysis of the inter-relationship between its paragraphs Art. 114(1) and (2). In **T 122/84** (OJ 1987, 177) the board summarised the historical development of the principle of ex officio examination with regard to late submission on the basis of the "travaux préparatoires" to the EPC 1973. A solution it found compatible with this principle was to leave it to the discretion of the

department concerned whether or not to examine facts or evidence not submitted in due time, rather than, as had also been considered, ruling out such examination altogether.

A rigid rule excluding all new evidence on appeal might lead to injustice and unfairness in some cases and would not be compatible with the principles of procedural law generally recognised in the Contracting States (**J 5/11**, **J 6/14**).

The discretionary power under Art. 114(2) EPC is clearly conferred on the EPO departments only to ensure that proceedings run smoothly and to forestall tactical abuse (**T 273/84**, OJ 1986, 346).

### 1.1.2 Legal basis

What is meant by "in due time" for the purposes of Art. 114(2) EPC requires interpretation. The parties in inter partes cases are subject to a particular duty to facilitate due and swift conduct of the proceedings, in particular by submitting all relevant facts, evidence, arguments and requests as early and completely as possible. This duty is reflected in the EPC provisions governing the handling of late submissions: Art. 114(2) EPC as a general provision; R. 137 EPC for the grant procedure; and R. 76(2)(c) and R. 80 EPC for the opposition procedure. For procedures at first instance, R. 116(1) EPC additionally provides that, when issuing the summons to oral proceedings, the EPO must fix a final date for making written submissions in preparation for those proceedings. Precise rules governing appeal proceedings are also laid down in the Rules of Procedure of the Boards of Appeal, which were comprehensively amended in 2003 (RPBA 2003), and revised again in 2007, when the provisions on subsequent amendments were renumbered but left unchanged in substance (see, in particular, Art. 12 and 13 RPBA).

### 1.1.3 Historical development

The boards of appeal have developed different approaches to the consideration of late submissions. According to one of these, the principle of examination by the EPO of its own motion (Art. 114(1) EPC) takes precedence over the possibility of disregarding facts or evidence not submitted in due time. This follows from the EPO's duty towards the public not to grant or maintain patents which it is convinced are legally invalid (**T 156/84**, OJ 1988, 372). Accordingly, the main criterion for deciding on the admissibility of late-filed documents and evidence is their **relevance**, i.e. their evidential weight in relation to other documents already in the case (see e.g. **T 322/95**, **T 475/96**, **T 864/97**, **T 892/98**, **T 605/99**, **T 100/07**).

In addition, the principles set out by the Enlarged Board in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) with regard to the admissibility of fresh grounds of opposition are also generally applicable to late-filed new facts and evidence in support of grounds of opposition already presented in the notice of opposition, in proceedings before both the opposition divisions and the boards of appeal (see in particular **T 1002/92** OJ 1995, 605).

In the landmark decision **T 1002/92**, the board reached the following conclusion: **in proceedings before the opposition divisions**, late-filed facts, evidence and related arguments which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55(c) EPC 1973 in support of the grounds of opposition on which the opposition is based should only exceptionally be admitted into the proceedings if, *prima facie*, there are clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent in suit.

The criteria governing the admission of late-filed facts, evidence and arguments are more restrictive and stringent in proceedings before the boards of appeal than in opposition proceedings at first instance.

In **T 1002/92** the board held that in contrast to the first-instance proceedings, the appeal procedure is a judicial procedure and therefore "less investigative". Therefore, as regards **proceedings before the boards of appeal**, new facts, evidence and related arguments which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55(c) EPC 1973 in support of the grounds of opposition on which the opposition is based should only very exceptionally be admitted into the proceedings in the appropriate exercise of the board's discretion and if such new material was *prima facie* highly relevant in the sense that it could reasonably be expected to change the eventual result and was thus highly likely to prejudice maintenance of the European patent in suit. In addition other factors relevant to the case, in particular whether the patentee objected to the admissibility of the new material and the reasons for any such objection, and the degree of procedural complication that its admission was likely to cause, should be taken into account. In general the later such new material was filed, the greater the degree of procedural complication it was likely to cause.

Many decisions have affirmed **T 1002/92** (see, among others, **T 267/92**, **T 255/93**, **T 463/95**, **T 481/00**, **T 982/02**, **T 671/03**, **T 874/03**, **T 1027/03**, **T 151/05**, **T 1600/06**, **T 1883/12**).

In many earlier decisions, too, 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, why they had been submitted late 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; **T 1019/92**, **T 1182/01**, **T 927/04**).

With regard to how the various criteria are applied in opposition and appeal proceedings, see in this chapter, IV.C.1.2 "Late-filed facts, arguments and evidence in opposition proceedings" and IV.C.1.3 "Late-filed facts, arguments and evidence in appeal proceedings" below.

#### 1.1.4 Examination as to relevance

According to established case law of the boards of appeal, a decisive criterion for admitting late-filed documents is their prima facie relevance, see **T 1002/92**, OJ 1995, 605; **T 212/91**, **T 931/06** and **T 1883/12**. Also the Guidelines (E-V, 2 – November 2015 version) mention prima facie relevance as the most important (albeit not exclusive) criterion. The approach outlined there follows from the principles set out in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420).

The admission of a citation which could have been submitted earlier and was therefore late filed depends on whether it is decisive (relevant) for the outcome of the case (see **T 258/84**, OJ 1987, 119). If it is relevant - i.e. if it might cause the patent to be revoked or its scope to be limited - it must be admitted into the case and taken into account (**T 164/89**, **T 1016/93**).

Regarding examination as to relevance, the board explained in **T 560/89** (OJ 1992, 725) that Art. 114(2) EPC 1973 allowed the EPO to disregard documents which contained no more information than the documents filed on time and did not disclose matter which could change the outcome of the decision. Late-filed evidence is admissible only if it is more relevant than the evidence already on file (**T 1557/05**). According to the decision in **T 611/90** (OJ 1993, 50), the boards could reject late-filed evidence, documents and other submissions on the ground that they were irrelevant, i.e. no more "weighty" or "cogent" than those already on file (**T 237/03**). Prima facie relevance is ascertained on the face of the facts, i.e. with little investigative effort, which reflects the need for procedural expediency in considering and admitting late-filed facts and evidence (**T 1883/12**). The interest in procedural expediency is also expressed in the common approach of **T 1557/05** not to admit late documents which, prima facie, are no more relevant than what is already on file. In this regard the board added in **T 1883/12** that relevance is decided in relation to facts to be proven, and if late documents, on the face of it, are not more relevant to those facts than admitted evidence and thus appear to add nothing, it is perfectly reasonable in the interest of procedural economy not to admit them.

#### 1.1.5 Documents cited in the patent specification or search report

A document considered during the examination procedure is not automatically scrutinised in opposition or opposition appeal proceedings, even if it is quoted and acknowledged in the contested European patent (**T 155/87**, **T 198/88**, OJ 1991, 254; **T 484/89**, **T 652/99**). According to **T 291/89** this also applied to a document cited in the search report. In **T 111/04** the board agreed with the case law and considered that this applied also to evidence filed during the grant proceedings.

In **T 536/88** (OJ 1992, 638) the board pointed out, however, that the document cited and acknowledged in the description of the contested patent itself as the closest prior art and on the basis of which the technical problem in the description was formulated remains an exception. Such a document also forms part of the opposition or opposition appeal proceedings even if it is not expressly cited within the opposition period (**T 541/98**, **T 652/99**, **T 454/02**, **T 86/03**).

In **T 140/00** although document (7) had been cited in the specification of the patent in suit, it had merely been acknowledged as conventional background art; it was not considered therein as essential or as the closest prior art and starting point of the claimed invention. Therefore, that document did not automatically form part of the appeal proceedings and, thus, was late-filed evidence subject to a discretionary decision of the board.

In **T 234/90**, **T 300/90** and **T 501/94** (OJ 1997, 193) the board held that a document indicated in a citation as the closest prior art for the purpose of elucidating the technical problem set out in the citation did not automatically form part of the opposition or opposition appeal proceedings if not expressly cited within the opposition period.

In the board's view in **T 387/89** (OJ 1992, 583), neither an opposition division nor a board of appeal had any duty to reconsider the relevance of documents cited in the European search report if such documents had not been relied upon by the opponents to support their grounds of opposition. Under Art. 114(1) EPC 1973, however, an opposition division or appeal board could introduce new documents into the opposition proceedings if it had good reason to suppose that the documents could affect the outcome of the decision (**T 420/93**, **T 530/00**). In **T 588/89** the board similarly introduced a document into the appeal proceedings under Art. 114(1) EPC 1973, because, in its view, the document reflected the closest prior art and raised doubts as to whether an inventive step had taken place.

## **1.2. Late-filed facts, arguments and evidence in opposition proceedings**

### **1.2.1 Late submissions**

The boards have stressed that opponents are required to submit all their objections during the opposition period, setting each out in full (**T 117/86**, OJ 1989, 401). Under R. 76(2)(c) EPC, the notice of opposition must 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 and evidence presented in support of these grounds. R. 116(1) EPC provides that, when the summons to oral proceedings is issued, a final date for making written submissions in preparation for the oral proceedings must be fixed. New facts and evidence submitted after this date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed. The rule confers scope for discretion (**T 798/05**, **T 2102/08**, **T 1253/09**).

An example of a change in the subject of the proceedings is where, in timely response to the points raised in the note annexed to the summons, the patent proprietor files amendments which have the result that a new document becomes relevant; in such a case the opponent should be allowed to present this document and must be given a chance to comment on the amendments (Art. 113(1) EPC; see also Guidelines E-II, 8.6 – November 2015 version). In **T 117/02** the board stated that in the case of a request to introduce late-filed submissions (here: a new ground of opposition and new arguments and evidence) the right to be heard should be granted before those late-filed submissions were rejected. In summary, an opponent must be given an opportunity to

respond in an appropriate way when the subject of the proceedings has changed, for example due to amendment. Depending on the nature of the amendment this may involve the filing of further documents (**T 366/11**).

Filing "on time" refers not only to facts and evidence submitted by the opponent within the nine-month opposition period but also to those that the patent proprietor may advance in his response to the grounds for opposition within the four-month time limit. New facts, documents and/or evidence would be regarded as having been filed on time if their filing was occasioned by an argument or a point raised by another party or in the appealed decision so that, under the circumstances of the case, they could not have been filed earlier. The submission of facts and evidence within successive time limits could then also be "on time", if the principle of procedural economy has been duly observed, i.e. the submitting party has taken due care in the proceedings (**T 156/84**, OJ 1988, 372; **T 201/92**, **T 238/92**, **T 389/95**, **T 532/95**, **T 502/98**, **T 468/99**, **T 574/02**, **T 320/08**).

### 1.2.2 Opposition divisions' exercise of discretion

#### a) General principles

It is at the opposition division's discretion whether to admit late-filed documents (Art. 114(2) EPC). According to settled case law, it must first examine them as to their relevance. Late-filed facts and evidence and supporting arguments should only exceptionally be admitted into the proceedings if, *prima facie*, there are reasons to suspect that such late-filed documents prejudice the maintenance of the European patent in suit (see, in particular, **T 1002/92**, OJ 1995, 605; **T 1643/11**; Guidelines E-V, 2 and 2.1 – November 2015 version; and in this chapter IV.C.1.1.4 "Examination as to relevance").

The discretionary power conferred by Art. 114 EPC necessarily implies that the EPO department of first instance must have a certain degree of freedom in exercising its power. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion when deciding on a particular case if it concludes that it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way, and has thus exceeded the proper limits of its discretion (**T 640/91**, OJ 1994, 918, **G 7/93**, OJ 1994, 775, **T 1485/08**, **T 2513/11**, **T 544/12**). This rule also applies with respect to opposition division decisions on the admission of late-filed submissions (**T 1209/05**, **T 1652/08**, **T 1253/09**). 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 such discretion in the same way (**T 75/11**). This power has to be exercised reasonably after hearing the parties, including in oral proceedings if requested (**T 281/00**).

In **T 467/08** the board refused the request to disregard on appeal comparative test results submitted in the opposition proceedings, on the basis that neither the EPC itself nor the RPBA provided for such a decision. The boards merely had competence to

review a decision taken by the opposition division on whether or not to admit late-filed submissions, documents and requests filed in those earlier proceedings, or to decide themselves whether or not to admit submissions, documents and requests filed on appeal.

In **T 1652/08**, the appellant argued that the late-filed documents, which the opposition division had admitted - wrongly in its view - to the proceedings, were no more relevant than those previously introduced. The board, however, held that, in establishing whether a document was prima facie relevant, the decisive factor was not whether it was even more relevant than a previously filed document, but rather whether it was prima facie relevant for the outcome of the case. Where documents had been properly admitted into the first-instance proceedings and the contested decision was based on them, they had to be admitted on appeal too (see also **T 1568/12**).

b) Reasons for the decision

According to the consistent case law of the boards of appeal, although Art. 114(2) EPC gives an opposition division discretion not to consider facts and evidence not submitted in due time, the division is obliged to give reasons for its decision; it is not enough merely to cite their late submission (**T 705/90**, **T 214/01**, **T 1855/13**). Even if submissions are late-filed, their admission remains a procedural aspect over which the opposition division can exercise discretion. As a consequence, the decision needs to show the reasoning why the discretion was exercised one way or the other (**T 1855/13**).

In **T 2097/10**, the board found that the brief statement of reasons given by the opposition division - to the effect that documents D18 and D19 were relevant and not especially voluminous - was sufficient. Indeed, it was not apparent from the minutes that the patentee's representative had been denied an opportunity to comment on those documents, or that he had asked for more time to prepare such comments but his request had been refused.

c) Proper exercise of discretion

In **T 267/03** the board decided that a late submission not admitted by the opposition division was not to be admitted on appeal if the opposition division had correctly exercised its discretionary power under Art. 114(2) EPC 1973 (see also **T 927/04**).

In **T 2165/10**, applying the criteria of prima facie relevance, documents E1-E10, which related to an alleged public prior use, had not been admitted into the proceedings by the opposition division. The board shared the opposition division's conclusion that E1-E10 had been filed late without good reason. The reason mentioned by the appellant for their late submission was that the public prior use had taken place more than 20 years ago in a foreign country. Since the legal time limit for keeping documents had long elapsed, many of the relevant documents had been destroyed. The board, however, shared the respondent's view that the appellant should have included an indication of the alleged public prior use in its notice of opposition and indicated/filed all evidence in its possession at that time.



In **T 1643/11** the board had no doubt that the opposition division had considered the correct criterion, prima facie relevance, and had done so in detail and in a reasoned manner in deciding not to admit D9 and D13 into the proceedings (see also **T 782/13**, **T 2513/11**).

d) Improper exercise of discretion

In **T 1194/08** the opposition division indicated that E15, a late filed document, was accepted as a belated submission. In the oral proceedings, however, the opposition division decided to reject the document as having been filed late. In the opinion of the board, the opposition division was not entitled to reverse its admittance of the document during the oral proceedings. The opponent was entitled to rely on the earlier decision of the opposition division to admit the document into the proceedings. The board therefore considered that E15 was already in the proceedings so that there was no need to take a decision regarding its admittance into the appeal proceedings.

In **T 68/02** document D16 was discussed extensively by the respondent without objecting to its admission into the proceedings. At the start of the oral proceedings before the Opposition Division the respondent requested that the document not be admitted into the proceedings. The Opposition Division as a consequence did not admit the document. The board could not agree with the action of the Opposition Division in this respect. The discussion of the document by the respondent and the Opposition Division before the oral proceedings took place led to the normal expectation that the document was already in the proceedings and that the oral proceedings could be prepared on this basis.

In **T 1485/08**, the opposition division had decided not to admit the late filing (i.e. on the day of the oral proceedings) of an English translation of a Korean patent which had been filed in a timely fashion with the grounds of opposition. The appellant maintained that the document was highly relevant to the issue of novelty. The board noted that the document (Korean patent) had been filed with the notice of opposition against novelty of the patent in suit. Although not in one of the official languages of the EPO, from the use of various English terms in the description of the document it was already discernible that its subject-matter was related to the claimed subject-matter. The board was of the opinion that the opposition division in not admitting the English translation for the sole reason that it was late-filed, without having examined its relevance or considered any other criteria, did not properly exercise its discretion.

In **T 544/12** the board pointed out that a bare assertion of a lack of prima facie relevance was not by itself sufficient reasoning. Without any sufficient reasons being given by the opposition division for not admitting the late-filed documents, the board was not in a position to decide whether or not the opposition division had exercised its discretion in an appropriate way. In such a situation, it was first necessary for the board to put itself in the place of the opposition division and to decide whether or not it would have exercised such discretion in the same way as the opposition division did. If the board came to the conclusion that, in the position of the opposition division, it would not have exercised its discretion to admit these documents, the separate question would then arise whether the board should exercise its discretion to admit the documents as documents (late-)filed in

the appeal proceedings). In the event, the board considered that the documents had been *prima facie* relevant and should have been admitted.

### 1.2.3 Late submission of new arguments

#### a) New arguments – definition

The Enlarged Board of Appeal defined "new arguments" in opinion **G 4/92** (OJ 1994, 149) not as new grounds or evidence, but as reasons based on the facts and evidence which have already been put forward (**T 131/01**, OJ 2003, 115). In **T 604/01**, facts in the legal sense are to be understood as the circumstances and incidents of a case, looked at apart from their legal bearing. In **T 926/07** the board stated that facts are claimed subject-matter which must, where applicable, be substantiated by evidence. Arguments, by contrast, are the expositions generated when the law is applied to facts and evidence filed on time. Arguments based on facts filed on time are therefore to be admitted at every stage of the opposition and opposition appeal proceedings.

Taking a similar line in **T 861/93**, the board ruled that decisions referred to by a party in support of its arguments were never citations which, under Art. 114(2) EPC 1973, could be rejected as being late. 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.

#### b) Late submission of new arguments

According to the case law of the boards of appeal, Art. 114(2) EPC provides no legal basis for disregarding late-filed arguments. Art. 114(2) EPC refers to late-filed facts and evidence ("Tatsachen und Beweismittel" in German; "faits et preuves" in French), but not legal submissions and arguments (**T 861/93**, **T 386/01**). Late-filed arguments cannot therefore be disregarded on the grounds that they were submitted for the first time at the oral proceedings (**T 92/92**, **T 704/06**).

In **T 92/92**, the board held that the EPC in the English version made a clear distinction between "facts and evidence" on the one hand and "arguments" on the other in Art. 114(1) EPC 1973 and that Art. 114(2) EPC 1973 did not refer to arguments. Art. 114(2) EPC 1973 was to be interpreted such that the parties' right to argue their case was not unduly restricted.

Under R. 71a EPC 1973 (R. 116 EPC) new facts and evidence do not need to be considered after the time stated in the summons, unless they are admitted on the grounds that the subject of the proceedings has changed. R. 71a EPC 1973, and Art. 114(2) EPC 1973 on which it is based, refer to late-filed facts and evidence but not to new arguments, which can be made at any stage in the proceedings. In accordance with the jurisprudence, therefore, new arguments in support of facts already adduced have to be considered in accordance with R. 71a(1) EPC 1973, even if presented after the date specified in the summons, and equally cannot be rejected by citing Art. 114(2) EPC 1973 (**T 131/01**, OJ 2003, 115; **T 926/07**, **T 1553/07**).

According to **T 1553/07** arguments also included statements intended to rebut facts which had already been put forward (including evidence). In oral proceedings before the opposition division, the patent proprietor explained why in its opinion the public prior use claimed by the opponent had not been established beyond all doubt by the evidence which had been submitted late. The board did not regard the disputing of the prior use claimed by the opponent as constituting the presentation of new facts. Instead, the statements in question constituted a presentation of arguments concerning facts which had already been put forward and evidence submitted with respect to them.

### 1.3. Late-filed facts, arguments and evidence in appeal proceedings

#### 1.3.1 General

Further information on the filing of amended claims in appeal procedures is contained in Chapter IV.E.4.

In earlier case law it has been pointed out that the wording of Art. 114(1) EPC 1973 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) and Art. 111(1) EPC 1973 set a clear limit to the scope of any new matter that can be introduced into an appeal by the parties so that cases on appeal have to be, and remain, identical or closely similar to those on which decisions at first instance have been rendered (**T 97/90**, OJ 1993, 719; see also **T 26/88**, OJ 1991, 30, where it was stated that the essential function of the appeal procedure was to determine whether the decision issued by a department of first instance was correct on its merits; **T 326/87**, OJ 1992, 522; **T 229/90**; **T 611/90**, OJ 1993, 50; **T 339/06** and **T 931/06**).

Facts and evidence submitted for the first time in appeal proceedings may be disregarded by the boards of appeal as a matter of discretion under Article 114(2) EPC 1973, which limits the boards' inquisitorial duties under Article 114(1) EPC 1973 (**T 326/87**, OJ 1992, 522).

#### 1.3.2 Rules of Procedure of the Boards of Appeal

The Rules of Procedure of the Boards of Appeal give general directions on how the boards of appeal should exercise their power to admit or disregard material filed at different stages of the appeal proceedings. Account must be taken of Art. 12 and 13 RPBA in particular. Under Art. 12(2) RPBA, the statement of grounds of appeal and the reply must contain a party's complete case.

Under Art. 13(1) RPBA any amendment to a party's submissions after it has filed its statement of grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion is exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy (for more details, see CA/133/02).

Art. 13(3) RPBA adds that amendments sought to be made after oral proceedings have been arranged may not be admitted "if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings". Art. 12(4) RPBA points out that in exercising this discretion the board can also disregard late submissions which were not admitted as late filed in the first-instance proceedings. Art. 12(4) RPBA also instructs us that consideration is unlikely to be given to new submissions that should have been presented in the first-instance proceedings.

The criteria laid down in the RPBA for the admission of new submissions take account of the other parties' right to fair proceedings, and are aimed at having proceedings conducted more pragmatically and reliably. The parties' should concentrate their filing of submissions at an early stage of the proceedings and so help the board reach an appropriate decision within a reasonable period. The RPBA provisions on amendments to a party's case essentially codify the boards' comprehensive case law (on this point, see **T 87/05**).

### 1.3.3 The boards' discretion

Under Art. 13(1) RPBA any amendment to a party's submissions after it has filed its statement of grounds of appeal or reply may be admitted and considered at the board's discretion.

According to established case law, discretion has to be exercised equitably, i.e. all relevant factors which arise in the particular circumstances of the case have to be considered (see **G 7/93**, OJ 1994, 775; **R 11/11**, **T 931/06**, **T 936/09**, **T 23/10**).

In **T 188/05** the board did not share the appellant (opponent's) view that it was obliged to admit relevant evidence irrespective of how late it had been filed, provided that it cast doubt on the patent's validity. The case law of the boards of appeal establishes quite clearly that the first instance and the boards of appeal have a discretion to admit late-filed submissions and that the exercise of this discretion depends on the facts of each case but pertinent matters may include the relevance of the new material, whether it could have been produced before and if so why it was not, whether other parties and/or the board itself are taken by surprise, and how easily they can and whether they have adequate time to deal with it (see also **T 1774/07**, **T 424/11**).

In **T 874/03** the board, considering a prior-art document, which was first filed at the oral proceedings before the board, acknowledged that it was immediately apparent that this fresh material might represent the closest prior art. In accordance with Art. 10b(3) RPBA 2003 (Art. 13(3) RPBA), such facts and evidence might not in principle be admitted into the proceedings because their admission would lead to an adjournment of the proceedings. However, an exception to the above principle was justified if the patent proprietor agreed to the admission of the fresh material. The board stipulated that, as emphasised by the Enlarged Board in **G 9/91** (OJ 1993, 409), it might in some cases be in the patent proprietor's own interest that such facts and evidence were not excluded from consideration in the centralised procedure before the EPO. It pointed out that such

fresh material had to be prima facie highly relevant in order to be admitted into the proceedings exceptionally with the agreement of the patent proprietor (**T 369/08**).

In exercising its discretion the board takes account of the circumstances of the specific case, in particular the interests of the parties and the procedural economy of the appeal proceedings, having in mind the purpose of these proceedings (**T 123/08**).

#### 1.3.4 Procedural economy

Under Art. 13(1) RPBA any amendment to a party's submissions after it has filed its statement of grounds of appeal or reply may be admitted and considered at the board's discretion. The discretion is exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.

As early as **T 117/86** (OJ 1989, 401), it was pointed out that facts and evidence in support of an opposition which were presented after the nine-month period had expired were out of time and late, and might or might not be admitted into the proceedings as a matter of discretion under Art. 114(2) EPC 1973. Boards had to ensure that proceedings were conducted expeditiously, and other parties fairly treated. The parties should submit all the facts, evidence and arguments relevant to their case as early and completely as possible, particularly when such an evidence was already known to the party concerned (see **T 101/87**, **T 237/89**, **T 951/91**, OJ 1995, 202, **T 34/01**, **T 1182/01**, **T 927/04**, **T 1029/05**).

There are restrictions on the admission of new submissions because parties cannot be given complete freedom in their conduct of proceedings given, in particular, the need in inter partes (adversarial) procedures to act fairly towards the other party and, more generally, the requirements of due process (**T 1685/07**).

In **T 1488/08** the patent had been opposed under Art. 100(a) and (c) EPC 1973. In their written statement setting out the grounds of appeal, however, the appellants had only invoked lack of inventive step. The board found that the new objections of added subject-matter and lack of novelty had only been raised after the respondents had submitted their reply and were therefore late filed. Their attempt to re-introduce them could therefore only be regarded as a change of position determined by procedural tactics ("salami" tactics). On that basis alone, the board considered, in view of procedural economy, that it should exercise its discretion not to admit the late filed objections.

#### 1.3.5 Complexity of new subject-matter

Some boards have held that new submissions should normally be disregarded if the **complexity of the technical or legal issues** raised is such that clearly neither the board nor the other party can be expected to deal with them without adjournment of the oral proceedings. Complex fresh subject-matter filed at short notice before or during oral proceedings runs the risk of being not admitted to the proceedings without any consideration of its relevance or allowability (see **T 633/97**, **T 1050/00**, **T 1213/05**).

In **T 1044/04** the board stated that the late-filed document was a relatively short document which did not raise further complex substantive questions with regard to technical or legal issues complicating the appeal proceedings. Thus the board decided to admit the late-filed document D6 into the appeal proceedings (see **T 633/97**, **T 787/00**).

In **T 609/99** the board stated that despite the proprietor's objection to the admission of evidence which had been disregarded in the opposition procedure pursuant to Art. 114(2) EPC 1973, the board might, in certain circumstances, take account of this evidence without any implication that it was prima facie highly relevant. This exercise of discretion was not inconsistent with the criteria set out in **T 1002/92**. In the circumstances of the case at issue the board's admission of evidence had not extended the legal and factual framework.

### 1.3.6 Legitimate reaction to the first-instance decision

#### a) General

According to the established case law of the boards of appeal, filing new facts, documents and evidence would be considered to be in due time, if the filing was occasioned by an argument or a point raised by another party or in the appealed decision and could not have been filed before under the circumstances of the case. However, in order not to deprive the other parties of their right to verify the new evidence or to prevent the board from ensuring that the proceedings are conducted expeditiously, such facts and evidence have to be submitted once they are available and once it has become clear that they were relevant (**T 201/92**, **T 951/91**, OJ 1995, 202; **T 502/98**, **T 730/07**, **T 320/08**, **T 976/10**). Late filing is justifiable if it is an appropriate and immediate reaction to developments in the previous proceedings (**T 855/96**). Late filing is also admissible in order to support the reasoning to date (**T 561/89**) and to prove claimed common general knowledge, if challenged (**T 106/97**, **T 1076/00**).

The delay is of less importance if the party was reacting to a finding in the contested decision (**T 101/87**, **T 1511/06**). An appellant who has lost the opposition proceedings should be given the opportunity to fill the gaps in its arguments by presenting further evidence in the second instance (**T 406/09**).

In **T 49/85** the board stated that a reference filed by an opponent for the first time with its statement of grounds was not submitted in due time unless representing the effective counter evidence to a newly emphasised reason given in the decision (see also **T 172/85** and **T 561/89**). It is however within the discretion of a board of appeal pursuant to Art. 114(1) EPC to admit such a document into the proceedings in view of its relevance (**T 339/08**). The same applied if the party reacted to its opponent's submission, e.g. in **T 705/90**, where documents I to N were cited by the appellant in its observations in support of an argument presented in response to the respondent's statement of grounds.

In **T 1045/08** the board stated that where a party files new requests in appeal proceedings the other party must have the possibility of responding to these including the filing of new prior art documents, particularly when some of the amendments to the

claims of the requests are based on features taken from the description of the patent. In this situation the concept of "late filed" must be considered relatively since the documents could not have been filed earlier because the party could not know the content of the future requests of the other party.

b) Documents admitted

Similarly, in **T 238/92** the board of appeal did not consider a document presented for the first time with the statement of grounds of appeal as "late-filed", since it served as the first evidence of a feature considered in the contested decision as essential for the assessment of inventive step (see also **T 117/92**). In **T 1380/04** the submission of D16 along with the statement of grounds was a justified reaction to the opposition division's decision. The document also appeared *prima facie* more relevant to inventive step than any other document already in the proceedings (see also **T 1146/06**).

In **T 666/09**, the board agreed with the appellants that the comparative study filed with the statement of grounds of appeal was a direct response to the opposition division's decision.

In **T 101/87** the board drew a distinction between (a) the case of an opponent attempting to find further prior art when the opposition division had decided that the original citations did not warrant revoking or restricting the patent, and (b) the case of an opponent making a further search in response to substantial amendments of a claim or to comments from the opposition division regarding a missing link in a chain of argument. In the latter case, new documents could be admitted into the proceedings, instead of being regarded as late-filed.

In **T 927/04** the board stated that it was legitimate for a party who had lost in opposition proceedings to try to improve its position in appeal by filling a presumed missing link, as in the case in point, with respect to the issue of prior use.

In **T 259/94** the appellants submitted new evidence two years after filing the appeal. The respondent did not object to their introduction into the appeal proceedings. The board held that in such circumstances the principle of "*volenti non fit iniuria*" empowered it to admit the late-filed evidence.

In **T 828/14** the board, citing Art. 12(4) RPBA, said a party to appeal proceedings was not entitled to expect that evidence it could have produced in the first-instance proceedings but had actually only produced in the statement of grounds of appeal would be admitted into the proceedings. Hence an appellant-opponent could challenge the patent in suit on the basis of such evidence only if it had been admitted by the board in the due exercise of its discretion. One of the things that needed to be considered in that respect was whether the change in the line of attack was justified as a direct and objectively appropriate response to developments in the first-instance proceedings, and in particular to findings in the contested decision. The document was admitted into the proceedings.

In **T 241/10** the board stated that the board has no power under Art. 12(4) RPBA to hold a document filed with the statement of grounds of appeal inadmissible if the filing of that document was a legitimate reaction to the submission of amended claims by the patent proprietor shortly before the first-instance oral proceedings and the opponent could not have been reasonably expected to present that document in the proceedings before the opposition division.

c) Evidence of common general knowledge

Belated submissions may be taken into account as evidence of alleged common general knowledge, where such knowledge has been disputed (**T 106/97**, **T 1076/00**).

In **T 85/93** (OJ 1998, 183) the board pointed out that evidence of common general knowledge, like any other evidence in support of an opponent's submissions, should be filed at an early stage in the proceedings before the opposition division, and might be rejected as inadmissible at the board's discretion if filed for the first time during appeal proceedings. In **T 274/99** the board considered the late-filed textbook under Art. 114(1) EPC 1973 – although late-filed documents, including those that prove common general knowledge, could be disregarded under the boards' case law – because it provided a better understanding of the state of the art, it was obviously relevant, its submission could be seen as reasonable as far as the respondent was concerned, and its consideration did not delay the proceedings in any way.

### 1.3.7 Relevance

According to the established jurisprudence of the boards of appeal a crucial criterion to be taken into account is whether a late-filed document is prima facie highly relevant and whether there is proper justification for its late filing to forestall tactical abuse. Such material should be prima facie highly relevant in the sense that it can reasonably be expected to change the eventual result and is thus highly likely to prejudice the maintenance of the European patent (see **T 1002/92**, OJ 1995, 605; **T 212/91**, **T 931/06**, **T 501/09**, **T 1306/09** and **T 2542/10**). In **T 887/11** the board admitted the (new) evidence as well as the offered witness testimony submitted with the appeal grounds into the proceedings because of its high relevance. In **T 182/09** likewise the board admitted a highly relevant document into the proceedings (see also **T 1404/10**, **T 605/11**). See also under chapter IV.C.1.1.4 "Examination as to relevance".

In **T 931/06** the board stated that when assessing inventive step, a late filed document may be considered if it belongs to the same or a closely related technical field and discloses subject-matter conceived for the same or a similar purpose as the contested patent. In the light of **T 1002/92** such a document would then be prima facie relevant in the sense that it might prejudice the maintenance of the patent, at least in unamended form.

In **T 1105/04** the board referred to **T 736/99** and admitted a late-filed document into the proceedings, because it was considered by both parties as the closest prior art document.



### 1.3.8 Complete case

According to Art. 12(2) RPBA, the statement of grounds of appeal and the reply must contain a party's complete case. They must set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, and should specify expressly all the facts, arguments and evidence. This provision provides a cut-off point after which any further submission is ipso facto late and subjected to the discretionary power of the board. The intended overall effect of this article is to require the parties to present a complete case at the outset of the proceedings in order to provide the board with an appeal file containing comprehensive submissions from each party and to prevent procedural tactical abuses (**T 1488/08**).

In **T 1544/08** the board stated in its catchword that the wish to avoid giving commercially valuable information to competitors was not necessarily a valid reason for not complying with the requirement of Art. 12(2) RPBA that the grounds of appeal should contain the appellant's complete case.

### 1.3.9 Communication of a board of appeal

The purpose of a communication of a board of appeal pursuant to Art. 15(1) RPBA is to prepare the oral proceedings; it is not an invitation to the parties to make further submissions or to file further requests (**T 1459/11**).

### 1.3.10 Reinforcement of arguments

Filing with the statement setting out the grounds of appeal new documents reinforcing the line of attack already taken before the department of first instance had to be considered as the normal behaviour of a losing party and did not constitute an abuse of procedure (**T 113/96**, **T 1034/01**, **T 1177/04**, **T 1267/05**).

In **T 875/06** the board found that the additional evidence D14 and D15 did not change the appellant's case but simply backed up the arguments made previously because these documents were more relevant with regard to the cited aspects of the invention than the documents already entered into the proceedings. Since the consideration of D14 and D15 did not significantly alter the legal framework and facts of the case in respect of the first-instance proceedings, the board admitted these documents into the proceedings under Art. 13(1) RPBA. In **T 113/96** and **T 426/97**, involving similar cases, the boards admitted new prior-art documents.

### 1.3.11 Submission of new arguments on appeal

#### a) General

Further information on "new arguments" is contained in chapter IV.C.1.2.3 a).

Art. 12(2) RPBA provides that the statement of grounds of appeal should specify expressly all the facts, **arguments** and evidence relied on by the party. To the extent

that the decision of the Enlarged Board of Appeal in **G 4/92** (OJ 1994, 149) deals with the general admissibility of new arguments in appeal proceedings, it must be taken to have been modified by the amendments to the RPBA introduced with effect from 1 May 2003 (**T 1621/09**).

In **T 1621/09** the board examined whether or not new arguments first brought forward during oral proceedings but based on citations already in the proceedings could constitute an amendment to a party's complete case within the meaning of Art. 13(1) RPBA. The board said they could, and concluded that the admissibility of such arguments was therefore prima facie a matter for the board's discretion. The boards in **T 232/08**, **T 1069/08**, **T 1732/10**, **T 1761/10** and **T 433/11** came to similar conclusions.

b) New arguments admitted

In **T 607/10** the board considered that, in deciding whether a new argument has the effect of amending a party's case within the meaning of Art. 13(1) RPBA, it must be established on a case-by-case basis whether the new argument is a departure from, or just a development of, the original arguments filed with the grounds of appeal or the reply thereto. In the case at hand, the new argument could not be seen as merely a further development or elaboration of the opponent's previous position. The new analysis was based on a different choice of the closest prior art. This new argument had therefore to be seen as constituting an amendment to the opponent's case within the meaning of Art. 13(1) RPBA, which might be admitted and considered only at the discretion of the board. In the case at hand, the board, in the exercise of its discretion, decided to admit the new arguments put forward by the opponent. See also **T 1941/10**, **T 216/10** and **T 174/12**, where the late-filed arguments were also admitted into the proceedings.

In the ex parte case **T 704/06**, the applicant (appellant) raised a new inventive step argument during the oral proceedings which the board admitted into the proceedings.

In **T 161/09** the board decided to use its discretionary power to admit the appellants' first line of argument to the proceedings, in support of their objection of lack of inventive step, despite these submissions having been made only during the oral proceedings and having been contested as being inadmissible by the respondent. In the view of the board these submissions did not alter the legal and factual framework of the proceedings.

Likewise in **T 671/08** the late filed argument was exceptionally admitted despite causing adjournment of the oral proceedings. The board considered the appellant's (opponent's) objection of insufficient disclosure to be a fundamental one that could not be ignored. The board stated that the fundamental nature of the new objection would render any discussions on novelty and inventive step meaningless, had it been left unresolved. This case was an exception to the principles set out in Art. 13(3) RPBA where amendments to a party's case should not be admitted into the proceedings when their admission would lead to an adjournment of the oral proceedings.

In **T 524/12** the case made by the appellant (opponent) was an extension of the case it had made before the opposition division. Since, in essence, similar features were

discussed, and the lines of argument put forward were largely those that had already been discussed, the appellant (opponent) was not making a substantially new case, but was simply basing the case it had made in support of its objection before the opposition division partly on new arguments. Art. 12(4) RPBA did not provide for not admitting mere arguments.

c) New arguments not admitted

In some decisions it has been observed that new arguments first put forward at the oral proceedings without any reasonable explanation or justification are to be regarded as late filed and not admitted into the proceedings (**T 1069/08**, **T 775/09**, **T 1621/09**).

In **T 1621/09** the board held that a new argument brought forward in appeal proceedings by a party which would have the effect of amending its case, even if the argument is based on evidence and facts already in the proceedings, can only be introduced into the proceedings at the discretion of the board of appeal by way of an amendment under Art. 13 RPBA. The board, in the exercise of this discretion, decided however not to allow the appellant to amend its case, inter alia because the new argument amounted to a new way of putting the appellant's case on novelty and was raised at the last stage of the appeal, namely during oral proceedings.

In **T 1761/10** the board also decided not to admit the new inventive step attack submitted at oral proceedings. The appellant's attack raised complex new issues and oral proceedings would have had to have been adjourned in order to give the board and the respondent sufficient time to address these issues.

In **T 1069/08** it was only at the oral proceedings that the appellant (opponent) asked the board to be allowed to present its arguments on the lack of obviousness of the claimed subject-matter. This request was refused by the board for the following reasons: The appellant's statement of grounds of appeal did not include any argument regarding the obviousness of the claimed subject-matter. Hence, the introduction of this new argument at oral proceedings represented an amendment to the appellant's case (Art. 13(1) RPBA). The appellant's failure to submit the new argument in reply to the board's communication deprived the respondents of the opportunity to present their comments thereon and/or of the opportunity to reconsider their intention not to attend the oral proceedings.

In **T 775/09**, the party as of right's second line of argument was based on a number of citations first referred to at the oral proceedings on appeal. The board observed that such an amendment to the party's case at this stage gave rise to combinations and facts of a complex nature which had not previously been addressed during the written proceedings. Therefore the board exercised its discretion under Art. 13(1) RPBA and refused to admit the new argument at such a late stage of the appeal proceedings.

### 1.3.12 Adjournment of oral proceedings

Strict criteria are applied to amendments sought to be made after oral proceedings have been arranged. According to Art. 13(3) RPBA these amendments "shall not be admitted if they raise issues which the board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings." Thus, the parties' right to be heard and/or procedural economy take precedence over other considerations (**T 232/08**).

In **T 188/05** the board held that the admission of the appellant's new submission would alter his case in a way that would raise issues which the board and the respondent could not reasonably be expected to deal with without adjournment of the oral proceedings. The material was therefore not admitted to the proceedings.

In **T 1774/07** the introduction of the new documents into the proceedings without adjourning oral proceedings would have been contrary to the principle of equal treatment of the parties. The board thus concluded that the documents, independently on their relevance, were not to be introduced into the proceedings.

In **T 232/08** the objection of lack of novelty based on document D11 was raised for the first time during appeal proceedings at the oral proceedings. In the board's view, the respondent had every reason to believe that novelty was no longer pursued as a ground of opposition in the appeal. The board considered that the respondent's right to be heard with regard to the novelty-objection based on document D11 would have been respected only if the oral proceedings had been adjourned or the case had been remitted to the department of first instance in order to allow the respondent adequate consideration of the appellant's objection. Consequently the board had decided not to allow the appellant to present its novelty objection based on document D11.

### 1.3.13 Absence of a party from oral proceedings (Art. 15(3) RPBA)

In **T 1949/09** the board refused to admit test results filed by the proprietor (appellant) before the oral proceedings. Apart from the unjustified, late filing, the tests raised in the board's view a number of questions about their significance, which could not be answered without an adjournment of the proceedings. Art. 15(3) RPBA, which provides that the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party, does not go so far as to nullify Art. 113(1) EPC. On that basis, the respondent, who chose not to attend the oral proceedings, could rely on the procedural provisions, namely that the decision would be made on the basis of the written case within the meaning of Art. 12 RPBA and that no significant amendment of the case would be admitted which would go beyond what is provided by Art. 13 RPBA.

In **T 1621/09** the board likewise dealt with the following question: where a new argument is put forward for the first time at oral proceedings, how is the exercise of the board's discretion to admit the amendment affected if the party prejudiced is not present at the oral proceedings? The board stated that Art. 13(2) RPBA must be read subject to

Art. 15(3) RPBA, with the result that the absence of a duly summoned party does not prevent a board from allowing an amendment to another party's case and reaching a decision on the basis of the amended case. The absence of the party is nevertheless a factor to be taken into account in the exercise of the discretion. In the case at issue the board decided however not to allow the appellant to amend its case.

In **T 607/10** the board referred to **T 1621/09**, according to which a party's absence from oral proceedings had to be taken into account in the exercise of discretion, but did not prevent the board from allowing an amendment and reaching a decision on the basis of the amended case.

#### 1.3.14 Article 12(4) RPBA

According to Art. 12(2) RPBA, the statement of grounds of appeal shall contain a party's complete case. Art. 12(4) RPBA requires the board to take into account everything presented by the parties under Art. 12(1) RPBA if and to the extent that it relates to the case under appeal and meets the requirements in Art. 12(2) RPBA. However, according to Art. 12(4) RPBA, the board has the discretionary power to hold inadmissible facts, evidence and requests which could have been presented or were not admitted in the first instance proceedings.

Art. 12(4) RPBA enables the boards to penalise an infringement of the duty to facilitate the first-instance proceedings, i.e. a failure to display due co-operation through the submission of facts, evidence and requests in the manner required up to a certain point in the proceedings, and so serves to ensure compliance with the requirement of a fair procedure and to expedite processing of the case. Moreover, it does not entail any arbitrary different treatment of similar cases of belated submissions which is incompatible with the procedural scheme. The duty to facilitate proceedings applies equally to opponents (with respect to the submission of their objections) and patentees (with respect to their means of defence) (**T 2102/08**).

In **T 432/12** the decisive issue was whether the documents could have been presented before the opposition division, i.e. whether there was a sound and plausible reason in this specific case for filing them only in the appeal proceedings. In principle, documents could be admitted in the case of e.g. a normal reaction to a late turn of events in the opposition (oral) proceedings, an exceptional interpretation by the opposition division at a late stage or in the decision, or evident non-allowability in view of the newly cited documents and/or objections, (see also **T 169/12**). However, none of these exceptions applied to the case at hand.

#### a) Documents and evidence withheld at first instance

In **J 5/11** the Legal Board stated that the Office's duty to examine evidence of its own motion is more stringent in relation to evidence that is in the public domain, and the case for admitting such evidence when it is filed out of time by the parties is correspondingly stronger. The Office's duty to examine of its own motion evidence that is in the private sphere of the party concerned is obviously limited. Such evidence can only be taken into

consideration by the Office if it is brought to the Office's notice by the party concerned. If evidence of that type is not put forward in the proceedings before the first-instance department of the Office, it is difficult to see any compelling reason why the Board of Appeal should exercise its discretionary power under Art. 114(2) EPC and Art. 12(4) RPBA in such a way as to admit the evidence when it is filed with the grounds of appeal or a fortiori at a later stage of the appeal proceedings. That is particularly true when, as in the present case, the first-instance department has expressly drawn the appellant's attention to the need for supporting evidence, indicated precisely what type of evidence is needed and given the appellant an adequate time limit within which to file the evidence.

In **T 724/08** the board observed that it had the power under Art. 12(4) RPBA to refuse to admit into the proceedings documents D10/D10a and D11/D11a, which the appellant (opponent) had cited as novelty-destroying for the first time in the statement setting out the grounds of appeal, if that evidence could have been presented in the first-instance proceedings. The appellant had already raised a novelty objection in its opposition and therefore could have submitted these documents during the first-instance proceedings or even during the period for opposition. It was immaterial whether the appellant had indeed only come across these Japanese patent specifications or the corresponding Patent Abstracts of Japan by chance later or whether said documents had genuinely been difficult to find, because it was not permissible to use these issues to slow down proceedings or gain an unfair advantage over the other party. In exercising this power, the board could make admitting a citation into appeal proceedings dependent on whether it is prima facie relevant but the board was not obliged to do so, because otherwise an opponent could easily submit a (highly) relevant citation for the first time in the statement setting out the grounds of appeal and expect the citation to be admitted into the appeal proceedings on grounds of relevance.

In **T 1314/12** the board added that this would mean that a proprietor could be obliged to repeatedly defend its patent against new attacks throughout the entire opposition and opposition appeal procedure. However, this was clearly incompatible with the requirement under the EPC and the RPBA that all relevant information be presented within certain time limits.

In **T 910/11** the appellant (opponent) raised a new line of attack under Art. 123(2) EPC against claim 4, which had been held to be allowable by the department of first instance. An objection could therefore clearly have been raised at first instance. Nor was any explanation offered as to why this objection had not been raised earlier. In view of the absence of justification for the late filing of this new attack the board decided not to admit it into the proceedings (see also **T 169/12**).

b) Documents and evidence not admitted by the opposition division

In **T 876/05** the board rejected the opponent's argument that filing new documents a few days before the oral proceedings before the department of first instance was destined for failure and that it was therefore preferable for him not to file those documents until the appeal stage. The board held that Art. 10a(4) RPBA 2003 (Art. 12(4) RPBA) put

documents that could have been submitted before the department of first instance and documents which had been submitted but had not been admitted on an equal footing. Had these documents been filed in the opposition proceedings, the worst that could have happened was that they would have been regarded as inadmissible by the opposition division, so the consequences would have been no different than if they had not been filed. The board decided, when examining the patentability of the filed requests, to consider only the documents that appeared immediately relevant (**T 624/04**).

In **T 229/08** the opposition division had disregarded evidence designated as M12 because it was late-filed and because prima facie availability to the public could not be established. M12 had been filed on the last working day before the oral proceedings. The board considered that it was primarily charged with reviewing the opposition division's exercise of its discretion. The provision of Art. 12(4) RPBA related to evidence which not only was not admitted but which also "could have been presented" in first instance proceedings. It was therefore evident that in both cases the board would have equal power to hold late-filed evidence inadmissible, whereby the party filing the evidence during appeal would have to overcome the additional hurdle of satisfying the board that its action in first presenting it in the statement setting out the grounds of appeal did not amount to tactical abuse.

In **T 305/07** the appellant filed the experimental evidence which had not been admitted by the opposition division with its statement of the grounds of appeal and requested its admission. The board stated that the claims at issue differed from those dealt with by the opposition division and in relation to which it considered the experimental evidence as irrelevant. The board came to the conclusion that none of the experimental evidence submitted with the statement of the grounds of appeal was relevant to the present case. Hence, in accordance with Art. 12(4) RPBA, second half-sentence the board decided not to admit the experimental evidence filed with the statement of the grounds of appeal.

c) Documents and evidence admitted under Art. 12(4) RPBA

In **T 1830/11** the board admitted evidence produced with the statement of grounds of appeal. It found that there were no provisions in the EPC which obliged the opponent to provide evidence against every possible fallback position defined in the dependent claims. Thus when amendments were made to the claims during oral proceedings before the opposition division (as in the case at issue, claim 1 having been amended to include the features of a dependent claim in the patent as granted), the requirement under Art. 114(2) EPC that evidence be submitted "in due time" might, depending on the circumstances, arise only when the statement of grounds of appeal was filed.

In **T 79/11**, various sets of experimental data were submitted with the statement of grounds of appeal, clearly in response to the decision under appeal and with a view to supporting the appellant's (patentee's) arguments on inventive step. Although the data could already have been submitted at first instance, their later submission was not an unreasonable response to the reasons given for the decision under appeal.

### 1.3.15 Cases of abuse of procedure

#### a) No abuse of procedure

In some decisions, the boards of appeal have held that there has been no tactical abuse and taken late-filed documents into account under the principle of examination by the EPO of its own motion, since these might have put maintenance of the patent at risk (see **T 110/89**, **T 315/92**). An abuse of procedure presumes a deliberate withholding of information (see **T 534/89**). In **T 1029/05** the board stated that the issue of admissibility of the late-filed document boiled down to the following questions: (i) whether the late filing is to be seen as an abuse of proceedings, and, if question (i) is answered in the negative, (ii) whether the relevance of the document is prima facie such as to justify its introduction into the proceedings (see also **T 2020/09**).

In **T 1019/92** the board reached the conclusion that the fact that an opponent, after the end of the opposition period, subsequently submitted prior art material originating from itself, did not constitute an abuse of the proceedings in the absence of evidence that this was done deliberately for tactical reasons. The board admitted the late-filed document into the proceedings.

In **T 330/88** the board held that the right to be heard (Art. 113(1) EPC 1973) had not been contravened by virtue of a relevant document being submitted late during oral proceedings. The representative was given sufficient time during the oral proceedings held on two consecutive days to consider this document, consisting of only seven pages including the claim page and two figure sheets. He could be expected to be able to react to this new situation either by rejecting the document as irrelevant or by filing amended claims.

In **T 671/03** the opposition division did not admit documents D6 to D16 into the proceedings, stating that they had been filed more than two years after the expiry of the opposition period and were prima facie not so complete as to substantiate the alleged prior use. Three more documents were filed during the appeal proceedings. The board regarded all these documents as late-filed, and it was at its discretion to admit them. However, it was not apparent to the board that the submission of documents D6 to D19 had been deliberately delayed for tactical reasons. It therefore held that the late filing was not an abuse of procedure. Documents D6 to D19 could therefore not be disregarded without considering their relevance. Following a detailed examination of the relevance of the various documents, the board concluded that only D18 could be admitted into the proceedings under Art. 114(2) EPC 1973 because it was prima facie highly relevant, i.e. most likely prejudiced the maintenance of the European patent (**T 1182/01**, **T 1029/05**).

In **T 151/05** the fact that the appellant relied first on prior use 2 and then, after having realised that this argument was not sufficiently substantiated, on other evidence for demonstrating the common general knowledge was seen by the board as a misjudgement but not as an abuse of the proceedings. Consequently, the board considered the relevance of the documents.



In **T 1757/06** the opponent (Dow chemical) submitted a patent publication filed by Dow Italia two months before the oral proceedings before the board of appeal. The board held that the opponent and the applicant were separate corporate entities, but nevertheless it would be expected that companies of the same commercial group would have knowledge of their own patent documents. Normally the attempt of a party to file at a late stage one of its own publications will fail, as this is considered to be an abuse of procedure. Although in this case the board did not find that there had been an abuse, it pointed out that the filing at a very late stage of a document that the opponent should have been aware of from the outset of the proceedings could not be condoned.

b) Abuse of procedure (yes)

In some cases the boards of appeal have disregarded late-filed material on the grounds of abuse of procedure.

In **T 951/91** (OJ 1995, 202) the board refused to take account of late-filed evidence **even before it was actually submitted** and pointed out that the discretionary power given to the departments of the EPO pursuant to Art. 114(2) EPC 1973 served to ensure that proceedings could be concluded swiftly in the interests of the parties, the general public and the EPO, and to forestall tactical abuse. Parties had to take into account the possibility that late-filed material would be disregarded and do their best to submit the facts, evidence and arguments relevant to their case as early and completely as possible. If a party failed to do so without adequate excuse, and admitting the evidence would lead to an excessive delay in the proceedings, the boards of appeal were fully justified in refusing to admit it in exercise of the discretion provided by Art. 114(2) EPC 1973. The board held that the submission of further fresh experimental data proposed to be filed by the appellant (opponent) some 20 months after the statement of grounds of appeal had been filed as an abuse of procedure.

In **T 496/89** the board pointed out that the late introduction of documents and of other matter into the appeal proceedings is inimical and contrary to the public interest, quite apart from being unfair to the other party. Attempts by either party to spring a surprise on the other by deliberate late-filing, as well as inadvertent omissions to present arguments and the evidence needed to support them, ran counter to the spirit and intent of the Convention (see also **T 430/89**, **T 270/90**, **T 741/91**, **T 135/98**).

The board in **T 718/98** decided that a party's introduction, at a very late stage of the proceedings, of evidence which could have been filed much earlier, as a strategic measure to improve its own case against the opposing party, amounted to an abuse of procedural rights and was therefore rejected independently of the possible relevance of the evidence (see also **T 169/04**).

In **T 446/00**, the board identified various forms of behaviour as abuses of procedure, including non-compliance with a procedural direction of the board requiring a party to take a certain step or steps. It was also an abuse of procedure for a party to adopt an unequivocal position on an issue and subsequently to depart from that position without explanation. That applied particularly, but not solely, in contested inter partes

proceedings, in which another party was entitled to rely on that position as part of the case it had to meet (see also **T 762/07**).

In **T 215/03** the appellant (opponent) sought to rely on a document (D24) filed approximately one year after commencing the appeal proceedings together with 25 other documents (in total about 450 pages of technical literature). The board stated that under the particular circumstances of the case, that the belated submission of evidence was not justified. To submerge, at such a late stage of proceedings, the other party and the board under a deluge of paper amounted to an abuse of procedure. The board thus decided not to admit this evidence into the proceedings regardless of its possible technical relevance.

#### 1.3.16 Late submission of experimental data

##### a) Test reports admitted into the proceedings

In **T 192/09** the late filing of the additional experimental report could not be seen as an abuse of procedure. The new results had been submitted one month before the oral proceedings, in accordance with the instructions of the board. This had provided the respondent with adequate time to examine the data, decide if counterexperiments were necessary and assess whether it was feasible to provide these within the available time.

In **T 317/10** the board admitted into the proceedings a late-filed test report which had been filed shortly before the scheduled oral proceedings, finding that its late submission did not raise issues which the board or the respondent could not reasonably be expected to deal with without adjournment of the oral proceedings. Similarly, in **T 596/11**, in view of the prima facie highly relevant nature of the results in a test report, and the fact that no objections to their lateness, correctness or admittance had been raised by the respondent, the board admitted them into the proceedings.

##### b) Test reports not admitted into the proceedings

In some cases, experimental data submitted shortly before the oral proceedings before the boards of appeal was found to be late filed and so inadmissible under Art. 114(2) EPC. The reason invoked was that the handling of such data was more cumbersome and time-consuming than that of scientific publications, since it usually called for counter-experiments (**T 342/98**, **T 120/00**, **T 157/03**, **T 311/10**). In **T 760/05** the board confirmed that filing an experimental report shortly before the date indicated by the board as the ultimate date for filing submissions ran counter to the principle that sufficient time should remain for the adversary to study it and perform counter-experiments. Similarly, in **T 569/02**, the board held that comparative experiments normally required careful consideration by the other party, including discussions with technical experts, who could not be expected to be immediately available. It might also be necessary for the other party to repeat the tests or perform other tests themselves. The board did not consider that the **relevance of the tests** played a role, since even relevant evidence of this type should not be filed at such a late stage in the proceedings.

The comparative tests filed one month before the oral proceedings were found inadmissible regardless of their possible relevance.

Moreover, if oral proceedings have been arranged in inter partes proceedings, experiment results must be submitted sufficiently well in advance for the other party to have the opportunity to perform counter-experiments (e.g. **T 270/90**, OJ 1993, 725; **T 939/90**, **T 375/91**, **T 685/91**, **T 305/94**, **T 245/10**). Very late submission of experiment results (seven weeks before the oral proceedings) is contrary to a fair and expedient procedure (**T 375/91**, **T 1008/05**). In **T 832/08**, the board found that, where comparative experiments were submitted, the other parties had to be afforded sufficient time, so as not to breach their right to equal treatment.

In **T 356/94** the board pointed out that any late-filed facts or evidence could be admitted in the opposition proceedings in so far as such facts or evidence were subsequently discussed by the parties concerned in accordance with Art. 113(1) EPC 1973, which meant allowing the parties sufficient time, depending on the nature of the facts or evidence submitted, to provide explanations. Taking into consideration comparative tests presented on the same day as oral proceedings were held could constitute an infringement of the other party's right to be heard, since the latter had had no material opportunity to check them (see also **T 481/00**, **T 567/02**).

#### 1.3.17 Public prior use

##### a) No consideration of late-filed evidence of public prior use

The boards began early on in their case law to set strict standards for the admissibility of late-filed evidence of public prior use by the opponent. On the basis of Art. 114(2) EPC 1973, they refused to include late-filed evidence in the proceedings where, in the specific circumstances, there had been an abuse of procedure and a breach of the principle of good faith. In such cases they chose to refrain from examining the **potential relevance** of the submission (see **T 17/91**, **T 534/89**, OJ 1994, 464 and **T 211/90**). In **T 985/91** the board took the view, with reference to **T 17/91**, that late-filed documents should only be admitted into the proceedings under certain circumstances if they related to alleged prior use.

In **T 17/91** an allegation of prior use based on the opponents' own activities had been filed two years after the expiry of the opposition period, with no good reason for the delay. This, in the board's view, constituted an abuse of the proceedings and a breach of the principle of good faith. Irrespective of its potential relevance, the allegation was therefore to be disregarded under Art. 114(2) EPC 1973.

Taking a similar line, the board ruled in **T 534/89** (OJ 1994, 464) that an objection based on prior use by the opponents themselves which was raised only after the expiry of the opposition period, although the factual circumstances were known to the opponents and there was nothing to prevent the objection being raised during that period, constituted an abuse of procedure. From this, the board concluded that when abuse of procedure was manifest, in view of the fact that a party deliberately refrained from raising an issue even

though the necessary supporting evidence was available, it would be contrary to the principle of good faith to admit such evidence by applying Art. 114(2) EPC 1973 in that party's favour.

Four weeks before the oral proceedings in **T 211/90** the appellant alleged public prior use for the first time. However, the evidence was already familiar to the appellant before expiry of the opposition period. The board held that the fact that the appellant was unaware of the relevance of this evidence, even though familiar with it at the time of filing the opposition, did not justify its introducing the evidence into the proceedings for the first time at such a late stage - irrespective of the reasons why it did not become aware of the potential relevance of this material until then. The board therefore decided not to consider this material in the further proceedings, without examining its potential relevance.

In **T 481/99** the board said that the principle that late-filed facts, evidence and related arguments should only exceptionally be admitted into the proceedings by the opposition division (see e.g. **G 9/91**, OJ 1993, 408 and **T 1002/92**, OJ 1995, 605) did not imply that a late-filed allegation of prior use, which would be relevant if proven, was to be automatically disregarded on the ground that the new facts first needed to be established by taking evidence. However, if the submissions and/or documents relating to the late allegation of prior use showed inconsistencies or even contradictions, the deciding body was entitled to disregard the alleged prior use pursuant to Art. 114(2) EPC 1973 without further enquiries.

In **T 380/00** the appellant (opponent) relied for the first time in the statement of the grounds of appeal on the non-confidential disclosure of technical features of the invention by an engineer during a job interview. The board considered that the alleged public prior use by the engineer was too poorly substantiated to justify further investigation of the matter.

On the issue of documents relating to prior use submitted during appeal proceedings, the board in **T 508/00** ruled that poor communications within a company or a group of subsidiary companies did not constitute adequate and acceptable grounds for allowing the late submission of evidence concerning alleged prior use (see also **T 443/09**).

In **T 1914/08**, justifying why these documents had not been submitted until more than two years later and only shortly before the date set for oral proceedings, the respondent stated that it had been experiencing financial difficulties in the interim period. The board exercised its discretion in this regard and considered that, given the documents had been referred to and therefore available to the respondent from early on, their late filing without a justification which was causally linked to the proceedings was not in keeping with a proper conduct of the procedure. The late-filed documents were thus not admitted into the proceedings.

In **T 691/12** the board observed that a prior-use allegation first submitted in the appeal proceedings could not be admitted and considered as prior art unless it met at least the following three conditions: (a) it did not involve an evident abuse of procedure; (b) the

prior use as alleged had prima facie to be so relevant that it cast doubt on the validity of the patent; and (c) the prior use had to be fully proven, requiring no further investigation to establish its nature or context. In the case in point these conditions were not met. Therefore, exercising its discretion under Art. 114(2) EPC and Art. 12(4) RPBA, the board concluded that the new challenge, being based on public prior use first alleged in the statement of grounds of appeal, should not be considered.

In **T 1835/11**, in its statement of grounds the appellant submitted new prior art - an alleged public prior use - without explaining why it had not filed it earlier. As the claims had not been amended in substance and the alleged prior use concerned sales of the appellant's own products, the board took the view that the appellant should have been able to file this prior art during the opposition proceedings. It therefore decided under Art. 12(4) RPBA not to admit it in to the proceedings.

In **T 450/13** the board stated that not substantiating a public prior use in opposition proceedings but attempting to substantiate it in the statement of grounds of appeal could lead to the inadmissibility of such a line of attack under Art. 12(4) RPBA.

Likewise in **T 444/09**, **T 12/11** and **T 1295/12** no account was taken of a public prior use alleged for the first time in appeal proceedings.

#### b) Consideration of late-filed evidence of public prior use

In **T 628/90** an allegation of public prior use, which was filed for the first time in appeal proceedings and was adequately substantiated, was taken into account because of its possible relevance to enable thorough consideration to be given to the patentability of the subject-matter of the contested patent (see also **T 150/93**, **T 947/99**).

In **T 947/99** the appellant submitted with regard to the circumstances of the late claim concerning public prior use that he had only become aware of the possibility that there might have been public prior use in the course of proceedings conducted in parallel before the Patents Court in London at a meeting on 17 May 1999. In the board's opinion, the appellant had given a very clear explanation and sound reasons as to why the claim of public prior use had been made and why it could not have been made any earlier.

In **T 571/08**, the board held that documents submitted by the appellant to support a new prior use, as part of a challenge to one of a set of new auxiliary requests filed shortly before the oral proceedings before the opposition division, had not been filed belatedly. The appellant had, in response to the opposition division's decision to allow the auxiliary request with the additional feature in question, filed the documents at the earliest possible opportunity, namely with its notice of appeal.

#### 1.3.18 Change of representative

In **T 430/89** the explanation for the late submission of arguments and a document was that the representative had only recently taken over the case. The board held that this could not be accepted as a justification for tardiness (see also **T 736/99**).

In **T 785/96**, under cover of a letter sent just one month before the oral proceedings before the board, the appellant filed additional experiments. The appellant stated that the reason for this late filing was a change of representative, after which the necessity of the experiments had appeared. The board confirmed the decision **T 97/94** (OJ 1998, 467) and stated that a change of representative did not form an acceptable ground for late filing unless it was due to force majeure. The new representative was obliged to continue the proceedings from the point they had reached when he took over from his predecessor (see also **T 552/98**).

### 1.3.19 New submissions in proceedings resumed before the boards

In review case **R 16/13** the Enlarged Board set the contested decision aside and ordered that the proceedings (in **T 379/10**) be resumed. On doing so, the board held that such resumptions of appeal proceedings were confined to rectifying the defect identified on review. The appellant took the view that filing comparative tests was an essential part of the comments that **R 16/13** had allowed it to make. But the newly filed tests raised an admissibility issue: whether they merely helped the appellant to overcome the board's objection – which **R 16/13** had said it could comment on – or whether they went further and would thus extend the subject-matter of the resumed proceedings beyond that specified in the petition for review decided on in **R 16/13**. The board held that the new tests and line of argument would indeed extend the subject matter, and therefore declined to admit them into the resumed proceedings.

## 2. Transfer of party status

### 2.1. Party status as patent proprietor

Where the European patent is transferred during opposition proceedings the new patent proprietor entered in the Register of Patents takes the place of the previous patent proprietor both in the opposition and in the appeal proceedings. His entitlement may not be questioned in these proceedings (**T 553/90**, OJ 1993, 666).

For a transferee of a patent to be entitled to appeal, the necessary documents establishing the transfer, the transfer application and the transfer fee pursuant to R. 22 EPC must be filed **before** expiry of the period for appeal under Art. 108 EPC. Later recordal of the transfer does not retroactively validate the appeal (**T 656/98**, OJ 2003, 385). In appeal proceedings, substitution of another party for the patent proprietor is possible only once the relevant department of first instance has made the entry in the register or where there is clear cut evidence of a transfer (**J 26/95**, OJ 1999, 668, **T 593/04**). The procedural requirements to be fulfilled for recording the transfer of a European Patent in the register (filing of a request, providing evidence, payment of a fee) need not be fulfilled at the same time. If they are met at different times, the transfer takes effect vis-à-vis the EPO from the date on which all of these requirements are fulfilled (**T 128/10**). The original party remains, as long as the transfer has not been proven, a party to the proceedings, with all its rights and obligations (see **T 870/92** of 8 August 1997). A name change does not result in a change of legal identity (see **T 19/97**).

In **T 15/01** (OJ 2006, 153) the board distinguished between the situation where a party acquired a patent through a transfer, as in **T 656/98** and through a merger, as in the case before the board. It held that R. 20(3) EPC 1973 (now R. 22(3) EPC) did not apply in the latter case, where the change of proprietor status was caused by universal succession of law. The universal successor of a patent applicant or patentee automatically acquired party status in proceedings pending before the EPO.

The transfer of party status as patent proprietor must be distinguished from a "transfer" of the legal entity from one jurisdiction to another. In **T 786/11** the patent proprietor (respondent) had requested that the address of the "applicant (patentee)" be changed from one in the British Virgin Islands to one in Mauritius and submitted a "certificate of discontinuance" and a "certificate of registration by continuation" from the authorities of the British Virgin Islands and the Republic of Mauritius, respectively, as evidence that it had merely changed its address.

The board studied the applicable legal provisions of the British Virgin Islands and of the Republic of Mauritius. These jurisdictions – unlike many others – allow a legal entity to be transferred from one jurisdiction to the other without any effect on its identity. The board therefore concluded that the respondent had not changed its legal identity and, in particular, had not ceased to exist at any time. Rather, it had been "transferred" from the British Virgin Islands to Mauritius and had continued as a legal entity under Mauritian law (see also **T 2330/10** and **T 1458/12**).

## **2.2. Party status as opponent**

### **2.2.1 General principles**

The status as an opponent cannot be freely transferred (**G 2/04**, OJ 2005, 549). The opponent does not have a right of disposition over his status as a party. If he has met the requirements for an admissible opposition, he is an opponent and remains such until the end of the proceedings or his involvement in them. He cannot offload his status onto a third party (**G 3/97**, OJ 1999, 245, **T 298/97**, OJ 2002, 83).

However, in the following two circumstances the status as an opponent may be transferred:

- in the case of universal succession of the opponent (**G 4/88**, OJ 1989, 480, **T 475/88**, **T 1091/02**, OJ 2005,14); or

- when a relevant part of the opponent's business has been transferred (**G 2/04**, **T 670/95**). The transfer or assignment of the opposition to a third party has to be made as part of the transfer or assignment of the opponent's business assets together with the assets in the interests of which the opposition was filed (**G 4/88**, OJ 1989, 480).

Opponent status may also be transferred in opposition appeal proceedings (**T 659/92**, OJ 1995, 519, **T 670/95**, **T 19/97**). In **T 563/89** the board held that the right to lodge an

appeal may also be transferred to a third party, based on the same reasons as developed in case **G 4/88**.

A transfer of an opposition has to be requested at the EPO together with supporting evidence before it can take effect (**T 1137/97**, **T 19/97**, **T 1911/09**). This does not apply to cases of universal succession where the opponent status is automatically acquired from the date of the effective succession (**T 6/05**, **T 425/05**, **T 2382/10**).

The EPO has a duty to examine, *ex officio*, the status of the opponent at all stages of the proceedings. This duty not only extends to the admissibility of the original opposition, but also to the validity of any purported transfer of the status of opponent as a new party (**T 1178/04**, OJ 2008, 80).

### 2.2.2 Universal succession

In **T 349/86** of 29 April 1988 (OJ 1988, 345) the board referred to R. 60(2) EPC 1973, which stated that in the event of the death of the opponent the opposition proceedings could be continued by the EPO of its own motion, even without the participation of the heirs. According to the board this may be read as definitely stating that an opposition may be transferred to a deceased opponent's heirs and, by analogy, to a company absorbing the opposing company by merger or takeover (see also **T 1091/02**, OJ 2005,14). In **G 4/88** the Enlarged Board confirmed that the opposition may be transferred to the opponent's universal successor in law (point 4 of the Reasons). In **T 475/88**, the board held that the appeal filed in the name of Hoechst AG was admissible, as opponent status had been transferred to that company on its merger with Ruhrchemie AG.

In **T 2357/12** the board was concerned with a situation in which the transfer of all assets of an enterprise had been made whose legal entity had subsequently been dissolved. In its assessment of this situation, the board noted that "universal succession" as an exception to R. 22(3) EPC was a concept of procedural law under the EPC and was to be construed autonomously by the EPO, independent from national law. Under the case law of the boards of appeal, the main considerations for acknowledging that a universal succession has taken place were legal certainty as to the person of the successor and the need to avoid a legal vacuum. Under that case law, the transfer of all assets of an enterprise, immediately followed by its dissolution as a legal entity, could constitute universal succession.

The board applied these principles to the facts of the case and concluded that although there was no genuine concept of "universal succession" under the national law in question (State of Delaware), the case at hand was to be considered one of universal succession under EPC case law.

In **T 659/92** (OJ 1995, 519), there had been no universal succession. There was nothing to indicate that the opponent's business assets had been contractually transferred. The board concluded that a unilateral declaration by the owner of rights that he had transferred industrial property rights and opponent status in proceedings relating to a



particular right could not of itself effect universal succession by transfer of business assets.

An excerpt from a purchase contract stating that a company has been acquired "through sale of individual business assets" shows that under the terms of the contract there has been no universal succession (**T 531/11**).

### 2.2.3 Transfer together with the business assets to which the opposition relates

In **T 349/86** of 29 April 1988 the board considered a request filed by the universal successor in title of the original opponent for transfer of opponent status to the singular successor of part of its industrial and commercial activity (operations in the commercial vehicle field) to which the opposition related. The board asked the Enlarged Board to decide whether an opposition instituted before the EPO is transferable only to the opponent's heirs or whether it may 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 **G 4/88** the Enlarge Board examined the situation in which the opposition has been instituted in the interest of the opponent's business or part of that business. The term "business" was understood in a broad sense as describing the an economic activity which is or could be carried on by the opponent and which constituted a specific part of his business assets. In such a situation, the opposition constituted an inseparable part of those business assets. Insofar as those assets were assignable under applicable national laws, the opposition which was part of them had also to be regarded as transferable. The Enlarged Board answered the referred question by stating that an opposition pending before the EPO may be transferred or assigned to a third party as part of the opponent's business assets together with the assets in the interests of which the opposition was filed. Applying **G 4/88** to the facts of the case the board in **T 349/86** thus held in its decision of 30 November 1989 that the universal successor in title of the original opponent had transferred its opponent status to the singular successor of part of its industrial and commercial activity (operations in the commercial vehicle field) to which the opposition related.

In **T 9/00** (OJ 2002, 275), the board found as follows: If, as in the present case, the subject of an opposition is assigned to two different parts of the opponent's company, the status of opponent can pass to a third party only if both parts or the entire company are transferred to it. In **T 1982/09** the board concluded that the declaration submitted by the purported transferee in support of the transfer of opposition did not constitute sufficient evidence in order to conclude that the transferred business part comprised all of the technology to which the patent in suit related.

In **T 298/97** (OJ 2002, 83) the board held that to preserve admissibility the transfer of an opposition, or opposition appeal, must be subject not only to a number of conditions including the condition that it is accompanied by the transfer of the relevant related business assets of the opponent, but also to the condition that such transfer is to one, and one only, successor party or transferee.

In **T 799/97**, the opponent had gone bankrupt during the first-instance opposition proceedings. The board held that the opponent's entire business, and so the activities to which the opposition related, had been transferred to the company with which the administrator had concluded a contract of sale. Not all receivables and liabilities had been acquired, but that had not been established as an essential prerequisite for the transfer of opponent status in **G 4/88** and **T 659/92**. In **T 384/08** the board confirmed that the mere fact that certain assets were explicitly excluded in an assignment contract was as such not sufficient for concluding that the contract did not result in the transfer of a business or a specific part of it.

In **T 423/11** the board was concerned with the validity of the transfer of the opposition from SAGEM SA to SAGEM Défense Sécurité. According to the board it resulted sufficiently from the "reiterative agreement" that the assets transferred to SAGEM Défense Sécurité were those in whose interest the opposition had been filed. The opposed patent related to the field of aircraft flight data systems. This meant that the field of the opposed patent fell within the assets transferred, namely in the "navigation and aeronautical systems" division. The objection that not all the corresponding assets had been transferred, because exceptions had been made for some patents, had no bearing. It was true that some patents had not been transferred and only a licence had been given. However a licence conferred on the licensee the necessary rights to undertake any action to defend the patent under licence. Therefore those exceptions did not deprive the transferee of the general rights conferred on it by the transfer of the other assets.

In **T 1421/05** the board held that where the business assets in relation to which an opposition was filed have been transferred and at the same time the transferor has contractually agreed to transfer the opposition to the transferee, the status of opponent remains with the transferor in the absence of there being filed with the Office (a) evidence sufficiently evidencing the transfer and (b) a request to recognise the transfer of opponent status. Where in such a case the transferor subsequently ceases to exist but has a universal successor, the status of opponent is capable of passing to that successor.

#### 2.2.4 No transfer: sale of opponent's subsidiary company

In **T 711/99** (OJ 2004, 550) the board emphasised that the exception stated in **G 4/88** to the general principle that an opposition was not freely transferable should be construed narrowly. In **G 4/88** the Enlarged Board had considered a situation where the commercial vehicles department, which was subsequently sold, was without legal personality. The company which filed the opposition was the only one entitled to do so. In **T 711/99**, by contrast, the issue was whether the opponent parent company should be recognised, in the event of the sale of a subsidiary that has always been entitled itself to file oppositions, as having the right to transfer its opponent status. The board denied this and held that the opponent status could only be transferred together with the assignment of part of the commercial activity of an opponent with sole legal authority where the transferred company division or department did not have that status and therefore lacked legal personality. It added that the notion of legitimate interest in the proceedings, which

was irrelevant for the admissibility of an opposition at the time of its filing, likewise had no bearing on the opponent's status at any subsequent stage.

In **T 1091/02** (OJ 2005, 14) the board challenged the case law subsequent to **G 4/88** which required, for a transfer of opponent status outside universal succession, a transfer of the relevant business or part of it (**T 659/92**, **T 670/95**, **T 298/97**, **T 711/99**). It referred to the Enlarged Board questions which included the following: Can a legal person who was a wholly owned subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates acquire opponent status if all its shares are assigned by the opponent to another company and if the persons involved in the transaction agree to the transfer of the opposition? The board noted that this factual situation was rather similar to the situation in which **G 4/88** accepted a transfer of opponent status, but that the conditions for a transfer of opponent status according to the case law following **G 4/88** were not met. The application of this case law would make the transferability of opponent status dependent on the corporate structure of the opponent.

In **G 2/04** (OJ 2005, 549) the Enlarged Board decided that there was no convincing reason, in particular not any overriding interest of the parties or the public, to extend the application of the rationale of **G 4/88** to the case where a subsidiary company was sold in whose interest the opposition had been filed by the parent company. Thus, a legal person who was a subsidiary of the opponent at the time when the opposition was filed and who carries on the business to which the opposed patent relates cannot acquire the status as opponent if all its shares are assigned to another company.

In its reasoning, the Enlarged Board emphasised that in **G 4/88** the Enlarged Board was faced with a situation in which, for legal reasons, it was not possible from the outset to attribute the procedural status of opponent to the business in whose interest the opposition was filed, whereas the Enlarged Board in **G 2/04** was concerned with the situation in which the holding company did not want to attribute the procedural status of opponent to the entity in whose interest the opposition was filed. The opponent could easily have made provision for a future eventuality that its subsidiary should take over the responsibility for the opposition. If the holding company and subsidiary had filed the opposition as common opponents, the holding company could have withdrawn from the opposition at any time, leaving the subsidiary as the sole opponent.

The Enlarged Board noted that a liberal admission of transfers could often result in the need to examine contested questions of fact or difficult questions of company law. This would broaden the possible procedural battle-fields for the parties and give rise to complications and delays in opposition proceedings.

### 2.2.5 Legal uncertainty as to who is the correct party

In **G 2/04** the Enlarged Board also considered the issue of what could be done if there was a justifiable legal uncertainty as to how the law was to be interpreted in respect of the question of who the correct party to the proceedings is. It decided that in such a situation it was legitimate that the appeal was filed in the name of the person whom the person acting considers, according to his interpretation, to be the correct party, and at

the same time, as an auxiliary request, in the name of a different person who might, according to another possible interpretation, also be considered the correct party to the proceedings.

For an example of a case where a justifiable legal uncertainty as to the person entitled to appeal existed, see **T 1091/02** of 28 June 2006.

#### 2.2.6 Evidence for and effect of a transfer

The EPC does not contain any explicit provisions regarding the formal requirements for the transfer of opponent status. Nevertheless, the boards of appeal have consistently held that formal requirements have to be fulfilled for the opponent status to be considered as transferred (see **T 960/08** with reference to case law, see also **T 261/03** of 24 November 2005).

A transfer of an opposition is something that has to be requested at the EPO together with supporting evidence before it can take effect. The effective date of the transfer of an opposition must be taken as the date when the transfer has been requested at the EPO and adequate evidence provided (**T 1137/97**, **T 19/97**, **T 1421/05**, **T 1032/10**). Pursuant to **T 261/03** (of 24 November 2005) such a request may also be an implicit one.

Until evidence of the transfer has been provided, the original party to the proceedings continues to have the relevant rights and obligations (**T 870/92**, **T 1137/97**, **T 413/02**). In case of a universal succession, however, there is necessarily and automatically a continuation of the existing legal status as opponent from the date of merger (**T 6/05**, see further below).

##### a) Date of effective transfer

The board in **T 19/97** emphasised that there was a clear distinction between the substantive transfer of opponent status as a business asset and its procedural validity in the case at issue. As a formal requirement, the procedural validity of a transfer of opponent status was dependent on the submission of a duly substantiated request within the proceedings. On grounds of procedural certainty, a change of party based on an assignment could not take place outside the proceedings without the formal cognisance of the board and also could not have retroactive effect, as otherwise procedural acts or decisions could be respectively performed or taken without the involvement of the new opponent as the only legitimate party.

In **T 956/03** the board considered the question of the time limit for filing evidence of a transfer. According to the board, the case law showed a definite balance in favour of the view that a transfer could only be acknowledged from, at the earliest, the date when adequate evidence to prove the transfer had been filed. This was desirable in the interest of legal certainty and, within that principle, to ensure that the identity of an opposing party was known. If the transfer took place before the appeal period expired, then the entitlement of the transferee to replace the opponent had to be established by filing the necessary evidence before the appeal period expired. In **T 428/08** the appellant had

argued that it ought to be admissible to submit evidence of legal succession after the appeal period had expired, as evidence of prior use could also be submitted after the opposition period had expired without being rejected as grounds for opposition. The board did not follow this argument and relied on case law which made the date when the transfer became valid explicitly dependent on the date when evidence of it was supplied, in keeping with the procedural certainty requirement for the identities of the parties to the proceedings to be clear at all times.

In **T 184/11** the board could not share the appellant's view that, following **T 956/03**, any transfer occurring before the appeal period expired also had to be substantiated by the end of that period. In **T 956/03** the board had had to rule on the admissibility of an appeal filed by a party which maintained that it was successor in title to one of the opponents in the first-instance proceedings but failed to provide evidence of that within the appeal period. It was in that light that the principle set out in **T 956/03** – that if a transfer occurred before expiry of the appeal period, then the evidence showing that the transferee was entitled to take the opponent's place also had to be submitted by the end of that period – was to be understood.

In the case at issue, however, a party that had been opponent in the first-instance proceedings had initially been respondent in the appeal proceedings, and only during the latter was transfer of party status requested. This request was granted during the oral proceedings before the board, once the requisite evidence of the transfer of opposition had been provided.

The board in **T 6/05** drew a distinction between those cases where the opponent status is transferred together with the assignment of business assets and the cases of universal succession via merger - like the case at issue. Whereas in the former cases, the party status might either remain with the original opponent or be transferred to the new one, the universal successor of a patent proprietor automatically acquired party status in proceedings pending before the EPO, since R. 20(3) EPC 1973 did not apply in the context of universal succession in law. The successor acquired party status from the date on which the merger became effective and not only once sufficient evidence to this effect had been produced. The principles for transferring a European patent were to be applied *mutatis mutandis* to the transfer of opponent status. In the case of the universal succession of the opponent, there could only be one (legal) person who had rights and obligations, with the consequence that there was necessarily and automatically a continuation of the existing legal status as opponent from the date of merger. It could thus be established unambiguously and without any legal uncertainty, at any point in time in the proceedings who in fact was the opponent having party status, regardless of the date when sufficient evidence to this effect was filed (see also **T 425/05** and **T 2382/10**).

In **T 1514/06**, the board considered it established that opponent status had been transferred from JB TEC (A) to JB TEC (C), as it was clear from the draft demerger agreement that JB TEC (A) had divested its business activities relating to conventional sealed mechanical transmission agitators to AGITEC SAS and those relating to magnetic drive agitators for mainly pharmaceutical and biological use to JB TEC (C).

Nevertheless, the board observed that the change in party to the appeal proceedings could not take effect unless it were brought to its attention (see **T 19/97**). Having been dissolved on 16 September 2010, JB TEC (A) had ceased to have legal personality and the authorisation issued to its representative had therefore lapsed. The representative had been designated as JB TEC (C)'s representative in an authorisation dated 8 September 2011, i.e. issued a year later, but the board had not been notified of this or of the request for a transfer of opponent status to JB TEC (C) until 14 September 2011. Consequently, the documents in question sent on 5 August 2011 were removed from the proceedings on the ground that they had not been duly filed. Nevertheless, at JB TEC (C)'s request, their content was readmitted at the oral proceedings as an integral part of its oral submissions.

b) What kind of evidence suffices

If no evidence of legal succession is produced, the mere declaration by a company designated as legal successor to the original opponent that it is the original opponent's legal successor is not sufficient to substantiate the transfer of the status of opponent and of party to the appeal proceedings (**T 670/95**).

In **T 261/03** (of 24 November 2005) the board of appeal considered what kind of evidence was required to establish a valid transfer. The board made a parallel to the requirements of R. 20 EPC 1973 and noted that it was not aware of any appeal decision that had held that the documents to be submitted according to this provision have to prove the alleged transfer "up to the hilt". Such a yardstick of full and absolute proof would indeed be overly strict since in many situations documentary evidence alone could then hardly suffice. As the wording of R. 20(1) EPC 1973 suggested, something less was required. The board took the view that the requirements of R. 20 EPC 1973 were complied with if the documents submitted were such as to render it credible to the competent organ of the EPO, evaluating the documents in a reasonable way and in the light of all the circumstances, that the alleged facts are true. The mere fact that another document might have been a more direct piece of evidence than the one submitted by the appellant does not invalidate the proof actually offered (see **T 273/02**, applied in **T 1178/04**).

c) Natural heir

In the case of a transfer of an opposition from a deceased natural opponent to his or her heir, the heir can only be ascertained by reference to the particular national laws of succession applicable to the estate of the deceased opponent. It follows that the person seeking to establish that they have the right to succeed to an opposition must produce satisfactory evidence that he, she or they have done so under the relevant national law (**T 74/00**).

### 2.2.7 Effect of finding that no transfer took place

In **T 1178/04** (OJ 2008, 80) the opposition division had decided, among other issues, that the transfer of opponent status in the course of the opposition proceedings was valid.

The board held that even if the transfer of the opponent status during the opposition proceedings was invalid, the appeal by the opponent was nevertheless admissible. The board explained that "party" simply meant someone who takes part in the proceedings before the EPO. If it was decided by the department of first instance that he was entitled to take part in the proceedings he remained a party even though this decision was later reversed on appeal; such a decision on appeal had the effect that he was no longer entitled to take part in the proceedings, but not that he had never been a party to the proceedings. His position could not change retrospectively from that of having been a party to that of never having been a party.

After reviewing the evidence the board held that no valid transfer of the status of opponent had taken place. The only means of correcting this error was to set aside the decision of the opposition division as a whole. The opposition division was thus not bound by its previous decision. It was only bound by the ratio decidendi of the board's decision as regards the transfer of opposition status (see also **T 1081/06**).

### **3. Intervention**

Under Art. 105 EPC, to intervene admissibly in opposition proceedings a party must show either that proceedings for infringement of the same patent have been instituted against him, or that following a request of the proprietor of the patent to cease alleged infringement, the third party has instituted proceedings for a ruling that he is not infringing the patent. Under Art. 105(2) EPC, an admissible intervention shall be treated as an opposition.

In the course of the revision of the EPC, Art. 105 EPC was redrafted to clarify its meaning. The word 'court' has been deleted entirely, since an action for declaration of non-infringement need not be instituted before a court in all states. The details relating to intervention are now contained in R. 89 EPC; under R. 89(2) EPC, the filing requirements for oppositions, as laid down in R. 76 and 77 EPC, apply *mutatis mutandis*.

#### **3.1. Admissibility**

##### **3.1.1 Any third party**

In the case before the board in **T 305/08**, the appellant (opponent I) had filed an appeal against the decision of the opposition division to reject the opposition. Two separate interventions were subsequently filed (by opponents II and III), which also raised fresh grounds of opposition under Art. 100(c) EPC 1973. The board stated that the term 'any third party' in Art. 105(1) EPC could not be given an interpretation other than that each party had to be a separate legal entity and that it was irrelevant whether they belonged to the same group of companies. Nor was allowing the interventions tantamount to allowing the appellant to late-file oppositions via opponents II and III under its control and thus introduce new evidence. The interventions were therefore admissible.

### 3.1.2 Relevant patent

In **T 446/95**, in which an infringement action had been based on a French **national patent**, the board held that the intention and purpose of an intervention in accordance with Art. 105 EPC 1973 was to enable the assumed infringer to defend himself against the action by the patentee based on the opposed **European patent**, in order to prevent the EPO and the national courts handing down contradictory decisions on the validity of European patents. In the case in question, the fact that the European patent had claimed priority from the French patent and that France had been designated was irrelevant, as there was no legal basis for intervening in the European patent on the basis of an infringement action relating to the French patent. The admissibility of an intervention before the EPO could not depend on a provision of national law. The intervention was therefore inadmissible.

In **T 7/07** the board held that the patent in suit was not granted for Lithuania under the EPC, as Lithuania was an extension state and therefore could not be designated for a European patent. The national law of the extension state governs the extension proceedings and the legal effects of the extension. The infringement proceedings were based on a patent which had been granted for a number of EPC contracting states and which, under Lithuanian law, also took effect in Lithuania, but exclusively on the basis of Lithuanian national law, which conferred the same effect on this patent as on a national patent. As a result, the infringement proceedings were not based on the European patent in suit in the opposition proceedings. The board agreed with the findings in **T 1196/08** that an intervention based on proceedings for infringement of a patent that has effect in a particular state solely on the basis of national law is inadmissible because it fails to meet one of the requirements under Art. 105(1)(a) EPC. It therefore regarded the intervener's submissions as third-party observations under Art. 115 EPC.

### 3.1.3 National infringement proceedings

Under Art. 105 EPC, third parties may intervene only if they prove either that proceedings for infringement of the opposed European patent have been instituted against them or that, following a request by that patent's proprietor that they cease the alleged infringement, they have instituted proceedings for a ruling that they are not infringing the patent (**G 4/91**, OJ 1993, 707 in conjunction with Art. 105 EPC). The principle that the assessment of the nature of a procedural act taken by a party before the EPO is to be made with consideration of its actual substance rather than with consideration of its form or name applies equally when deciding whether national infringement proceedings have been commenced (**T 188/97**).

In **T 195/93** the board held that if a patentee simply sent a legal warning letter asking the intervener to stop production and sale of a product covered by the patent, this could not be regarded as institution of proceedings for a court ruling even if under national law the addressee became liable for damages 30 days after receiving the letter. The intervention was therefore rejected as inadmissible.



In **T 898/07**, the board found the intervention admissible. It was apparent from the documents submitted by the opponent that the respondent had repeatedly informed it that it considered its actions to infringe the patent and, with reference to infringement proceedings already pending against third parties, invited it to enter licensing negotiations. The board considered this a request to cease patent infringement by concluding a licensing agreement which would render the allegedly unlawful conduct (patent infringement) lawful (licensed use). This met the first requirement under Art. 105(1)(b) EPC, the wording of which related not only to a request to refrain from using the invention altogether, but also generally to a request to cease the alleged patent infringement. Since, in addition, the opponent had instituted proceedings against the respondent for a declaration of non-infringement of the patent before the Rome Court, the board found the intervention admissible.

Similarly, according to **T 392/97**, Art. 105 EPC 1973 required that an intervener should prove both that the patentee had requested that he cease alleged infringement of the patent **and** that he had instituted proceedings for a court ruling that he was not infringing the patent. Thus where the letter was sent not to the allegedly infringing company, but to an unrelated one which it was assumed was about to acquire it, the first requirement was not fulfilled and their interventions were inadmissible. The first requirement was also not fulfilled in **T 446/95**, where the letter merely set out a position adopted in response to a letter from the purported intervener, and did not give notice to cease infringement. According to **T 887/04** of 14.11.06, it was for the assumed infringer to prove, first, that he had received a "request" to cease the infringement, i.e. that he had been expressly asked to do so, and, second, that he had been required to "cease", i.e. put an end to, the infringement. Proof of mere warnings or threats of legal action had therefore to be considered insufficient.

In **T 223/11** the board held that it is internationally a widely accepted principle that the submission of a request on the national level for a marketing authorisation for a pharmaceutical product by a generic company does not constitute patent infringement (the so-called Bolar exemption). Such proceedings, no matter how obstructive these may have been to a future market entry of the intervener's product, cannot be considered as equivalent to infringement proceedings, irrespective of whether the Bolar exemption has been codified in the relevant national law or not.

In **T 1713/11** the board stated that the EPC can give no specific definition of what constitutes proceedings for infringement. Furthermore, it is clear that intervention was conceived as a procedurally exceptional situation, which is justified only by a substantial legitimate interest of the assumed infringer to enter the opposition proceedings. Therefore it does not appear likely that there was a legislative intent to create an elaborate and intricate system of procedural provisions for the admissibility of interventions, and the boards too should refrain from creating such a system through their case law, and focus instead on whether the substantive conditions for admitting an intervention are fulfilled. Nullity proceedings concerning the patent at issue would not qualify and neither would *saisie contrefaçon* proceedings (see also **T 305/08**). However, the definition of "proceedings for infringement" is not limited to civil proceedings, to proceedings that allow for certain remedies to be claimed, or two party proceedings. The

board therefore concluded that as long as a patent proprietor or any other party entitled to do so initiates proceedings which aim to establish whether a third party is commercially active in an area that falls within the patent proprietor's right to exclude, such proceedings are "proceedings for infringement" within the meaning of Art. 105 EPC.

### 3.1.4 Proceedings pending before the EPO

#### a) Intervention in opposition proceedings

In **G 4/91** (OJ 1993, 707) the Enlarged Board held that the intervention under Art. 105 EPC 1973 of an assumed infringer in the opposition proceedings presupposed that opposition proceedings were pending at the time he gave notice of intervention. Moreover, a decision of the opposition division on the relief sought had to be regarded as conclusive in the sense that the opposition division no longer had the power thereafter to amend its decision. The Enlarged Board further held that proceedings before an opposition division were terminated when such a conclusive decision was issued, irrespective of when this decision became final. Thus, if, after an opposition division had issued a decision terminating the proceedings, and none of the parties to the opposition proceedings filed an appeal, any notice of intervention filed during the two-month period for appeal under Art. 108 EPC 1973 was invalidated. See also **T 791/06**, where an intervention was filed after the oral proceedings before the opposition division when the decision was pronounced but before notification of the written decision. The board held that it had not been filed during pending opposition proceedings but considered the intervention to have been filed during the appeal proceedings.

In **T 631/94** (OJ 1996, 67) the board noted that when a decision to terminate opposition proceedings, taken in written proceedings, was handed over to the EPO postal service, it became public and effective and had therefore been issued. If the parties to the proceedings leading to that decision did not appeal, the opposition proceedings were completed at that point in time and thereafter intervention based on Art. 105 EPC 1973 was no longer possible.

#### b) Intervention in appeal proceedings

In **G 1/94** (OJ 1994, 787) the Enlarged Board concluded that Art. 105 EPC 1973 should apply to appeal proceedings. The term "opposition proceedings" was not restricted to the department of first instance, but could also refer to such proceedings at second instance. Intervention during appeal proceedings was therefore admissible (see also **T 694/01**). A notice of intervention filed during the two-month period for appeal has no legal effect if no appeal is filed (**G 4/91**, OJ 1993, 707; see also 3.1.4 a) above).

In **T 694/01** the board found that intervention depended on how far the opposition or appeal was still pending. An intervener could not challenge issues on which a final decision had already been taken (in earlier appeal proceedings).

In **T 1961/09** the board held in the catchword that while an intervention under Art. 105 EPC shortly before oral proceedings in an appeal, raising new issues, will

normally require the oral proceedings to be adjourned if not the remittal of the case altogether (**G 1/94**, OJ 1994, 787), the oral proceedings may be continued if and so far as this can be done without unfairness to the other parties, in particular the proprietor.

### 3.1.5 Time limit for intervention

Under R. 89 EPC, intervention is not possible until the opposition period has expired (this was previously laid down in Art. 105 EPC 1973), but notice of it must be filed within three months of the date on which proceedings referred to in Art. 105 EPC were instituted.

In **T 452/05**, the board considered three dates which could possibly have triggered the three month period: the date on which the request for an interim injunction was made, the date on which the request was granted, or the date when the injunction order was served upon the opponent. In the board's view, only the last date should be regarded as the decisive point in time, as only from that date onwards could the opponent provide evidence of the proceedings that entitled it to intervene.

If multiple proceedings are under way, the three-month time limit for intervening is always triggered by the date on which the **first** proceedings were instituted (**T 296/93**, **T 1143/00**).

The two alternative starting points under Art. 105(1) EPC 1973 for calculating the three-month period for intervention were mutually exclusive (**T 296/93**, OJ 1995, 627). See also **T 144/95**. Art. 105 EPC 1973 could not be used to give an opponent who failed to file an appeal in time a second chance, as the opponent does not fulfil the requirement of being a third party (**T 1038/00**).

### 3.1.6 Fees

Under Art. 105(2) EPC in conjunction with Art. 2(1) No. 10 RFees, interveners must pay the opposition fee (**T 27/92**). Where a party intervenes only at the appeal stage, several decisions have stated that no appeal fee need be paid if the party is not seeking appellant status in his own right (see **T 27/92**, **T 684/92**, **T 467/93**, **T 471/93**, **T 590/94**, **T 144/95**, **T 886/96** and **T 989/96**). In **T 1011/92** and **T 517/97** (OJ 2000, 515) the board ruled that an intervener must pay the fee if he wants to have his own right to appeal proceedings, in the sense that he can continue them if the original appellant withdraws his appeal. However, in **T 144/95**, where an intervention was filed during appeal proceedings and an appeal fee paid, the board ordered the appeal fee to be refunded (at the request of the intervener) - under Art. 107 EPC 1973, an admissible appeal could only be filed by a party who was already a party to the proceedings leading to the decision and who was adversely affected by it. Where the intervention was filed during appeal proceedings, the intervener could not satisfy these conditions, and, (referring to **G 1/94**, OJ 1994, 787), could not be considered as an appellant. Whilst Art. 105 EPC 1973 provided an exception to the time limit for payment of the opposition fee under Art. 99 EPC 1973, no such exception was made concerning the appeal fee.

### 3.1.7 Substantiation requirement

Under R. 89 in conjunction with R. 76 EPC, the notice of intervention must give the grounds for the intervention, and the facts and evidence submitted to substantiate them.

In **T 1659/07**, the board found that the substantiation requirement under R. 89(2) EPC in conjunction with R. 76(2)(c) EPC was met by a reference to an existing statement of grounds for appeal or notice of opposition. The purpose of the requirement was to ensure that the intervener's arguments could be objectively understood, i.e. that the intervener's position was set out clearly enough that both the patentee and the opposition division or board of appeal could identify the reasons for the intervention. Reference to the arguments of another opponent already on file was sufficient to that end. Accordingly, an intervener need not repeat those arguments in detail or contest the patent on the basis of new, independent reasoning or facts.

## 3.2. Legal status of intervener

### 3.2.1 In opposition proceedings

In **G 3/04** (OJ 2006, 118), the Enlarged Board concluded, inter alia, that the valid intervener acquired the status of an opponent, irrespective of whether the intervention occurred during the proceedings before the opposition division or at the appeal stage. In either case his rights and obligations were the same as those of other opponents. An intervener in proceedings before the opposition division has a right of appeal under Art. 107 EPC. For the appeal to be validly filed, he must pay the appeal fee under Art. 108, second sentence, EPC. Furthermore, the board held that an intervener in proceedings before the opposition division, where all the opponents have withdrawn their oppositions, can continue the proceedings alone and, if need be, file an appeal, since he has the same status as an opponent under Art. 99 EPC 1973.

In **T 614/13**, the board had to rule on the admissibility of an intervener's appeal against the opposition division's decision to reject its opposition because it had not shown that it had intervened in the opposition proceedings in time. The board held that, even if it upheld the opposition division's decision, that would not mean the intervener had never been a party to the proceedings, but only that as from the date on which decision on appeal took effect it would no longer be entitled to take part in the (further) proceedings. Until that point in time its procedural status would be confined to obtaining clarification as to whether it was entitled to take part.

### 3.2.2 In appeal proceedings

Also in **G 3/04** (OJ 2006, 118; see in this chapter IV.C.3.2.1), the Enlarged Board ruled that an intervener, if the appeal is filed by someone other than him, is a party as of right according to Art. 107, second sentence, EPC. If the intervention is filed during the appeal proceedings, the intervener, again because he can only acquire the status of an opponent, has the same rights and obligations – apart from the right to raise new grounds of opposition – as any opponent who has not filed an appeal. If in this case the

sole, or each, appeal has been withdrawn, the appeal proceedings are terminated in respect of all the substantive issues, including the new grounds for opposition raised by the intervener, for all the parties (see also **T 694/01**, OJ 2003, 250).

In **G 1/94** (see in this chapter IV.C.3.1.4 b)), the Enlarged Board also examined the question of whether an intervener during appeal proceedings could raise any of the grounds for opposition under Art. 100 EPC 1973 even if they had not yet been examined by the opposition division, and found in the affirmative. If a fresh ground for opposition was raised, the case should be remitted to the department of first instance unless the patent proprietor wished the board to rule on it there and then. In **T 694/01** (OJ 2003, 250), it was made clear that where a board has decided to maintain a patent on the basis of a given set of claims and a description to be added to them, in subsequent appeal proceedings confined to the issue of the adaptation of the description the previous decision is *res judicata* and the intervener cannot therefore challenge this decision by introducing a new ground of opposition.

### 3.2.3 Time limits in pending proceedings

In **T 392/97** the would-be interveners requested that the date for the appointed oral proceedings be postponed and submitted that they had not been duly summoned to the oral proceedings in accordance with R. 71(1), second sentence, EPC 1973 which stipulated at least two months' notice. In the board's view, R. 71(1) EPC 1973 did not stipulate that the requirement of a two-month period also applied if, subsequent to a duly effected summons, there was an intervention by a third party. As a general principle, an intervener entered the proceedings at the stage they were at on the date of intervention, including **pending time limits**. Issuing a further summons or adjourning the date in this case was therefore rejected.

## 4. Continuation of the opposition proceedings by the EPO

R. 84 EPC provides for the continuation of opposition proceedings by the EPO of its own motion. This may happen in the following circumstances: where the patent has lapsed or been surrendered and the opponent requests continuation of the opposition proceedings (R. 84(1) EPC); in the event of the death or legal incapacity of an opponent and where the opposition has been withdrawn (R. 84(2) EPC). In the case of a withdrawal of the opposition during the opposition appeal proceedings, there are a number of procedural consequences which depend on the party status of the opponent and which do not permit the exercise of discretion as to whether or not opposition appeal proceedings are continued (see in this chapter IV.C.4.3.3).

### 4.1. Surrender and lapse of the patent

#### 4.1.1 Surrender of patent

Under the provisions of the EPC 1973, the patent proprietor was unable to terminate the proceedings by informing the EPO of his surrender of the European patent, since this was not provided for in the EPC 1973; at this stage in the proceedings, notices of

surrender had to be addressed, as far as national law permitted, to the national authorities of the designated contracting states (**T 73/84**, OJ 1985, 241; **G 1/90**, OJ 1991, 275; see **T 123/85**, OJ 1989, 336 and **T 196/91**). Under the provisions of the EPC 2000 the patent proprietor may request that the European patent be revoked pursuant to Art. 105a EPC. The existence of this procedure does however not preclude patent proprietors from giving notices of surrender to national authorities.

Neither the surrender of a patent nor its lapse has retroactive effect. Both therefore have to be distinguished from revocation, which takes effect from the outset (Art. 68 EPC).

#### 4.1.2 Continuation of the opposition proceedings after lapse or surrender (Rule 84(1) EPC)

If a European patent has lapsed or been surrendered in all the designated states, the opposition proceedings may, under R. 84(1) EPC (R. 60(1) EPC 1973), be continued at the request of the opponent, provided the request is filed within two months of a communication from the EPO informing the opponent of the surrender or lapse. R. 84(1) EPC is limited to the situation where the opposed patent has been surrendered or has lapsed during ongoing opposition proceedings. Where the patent had already lapsed prior to the filing of the opposition R. 75 EPC applies, which states that an opposition may be filed even if the opposed patent has been surrendered or has lapsed in all the designated contracting states (**T 606/10**).

R. 84(1) EPC also applies, pursuant to R. 100(1) EPC, to opposition appeal proceedings and the boards have applied it regularly.

The board in **T 740/15** interpreted R. 84(1) EPC to mean that if the opponent files a request for continuation of the opposition proceedings within the given time limit, the scope of discretion of the opposition division provided in R. 84(1) EPC was thereby limited to only one possible lawful decision and this was the continuation of the opposition proceedings. The board noted that this understanding found support in the Travaux Préparatoires of the EPC 1973.

Where the European patent expires during ongoing appeal proceedings in all the contracting states and the appellant (opponent) does **not** request continuation of the proceedings, the proceedings are terminated without any decision on the issues (**T 329/88**, followed by numerous decisions, including **T 762/89**, **T 749/01**, **T 289/06**, **T 949/09**, **T 480/13** and **T 977/14**).

R. 84(1) EPC establishes no legal obligation on the EPO to ascertain of its own motion the legal status of a European patent and does not apply in the event of an alleged surrender or lapse of a European patent, unless confirmation thereof has been received by the EPO from the appropriate authorities of all the designated contracting states (**T 194/88**, **T 809/96**, **T 201/04**). However, in some exceptional circumstances, the proceedings have been terminated where such evidence was missing. In **T 762/89** the respondent (patent proprietor) had submitted that the patent had lapsed following non-payment of the national renewal fees in the designated contracting states (AT, BE,

DE, FR, GB, IT, LU, NL und SE). EPO records showed that the European patent had lapsed in 1990 in all the designated contracting states except Italy and Luxembourg, and the respondent provided confirmation that the patent had lapsed in Italy with a letter of 7 January 1992. Since the respondent had expressly declared on a number of occasions that the patent had lapsed in all the designated states, the board held that, with a view to procedural economy, there was no valid reason why the respondent should be required to show that it had lapsed in Luxembourg as well. In **T 607/00** the board accepted the respondent's statement, which was not challenged by the appellant, that the patent had lapsed in Italy.

If the appellant (opponent) expressed doubts concerning a respondent's (patent proprietor's) claim that a patent had lapsed or been surrendered, then the lapse had to be registered with the EPO or properly proved. Otherwise, R. 60(1) EPC 1973 was not applicable and the appeal procedure continued (**T 194/88**, **T 682/91**, **T 833/94**, **T 201/04**).

a) Request for continuation of the proceedings made by the opponent

In **T 1213/97** the patent had expired for all designated contracting states during the opposition appeal proceedings. The appellant (opponent) requested a decision on the state of the file which implied a request for the continuation of the appeal proceedings for the purpose of issuing a decision. The board exercised its power under R. 60(1) EPC 1973 to continue the appeal proceedings.

In **T 598/98** too the patent had lapsed for all designated contracting states since a time subsequent to the opponent's filing of the appeal, and the appellant (opponent) had requested continuation of the proceedings. The request was allowed. The board maintained that the opponent's legitimate interest in retroactive revocation was one of the elements that could be a factor in the board's decision to terminate or continue the proceedings under R. 60 EPC 1973. It also stated that the general interest in a central ruling on the patentability of an invention claimed in a patent did at any rate justify continuing the proceedings until a final decision was taken if the case was essentially ready for decision at the time when the patent lapsed and if it also made a significant difference to the patent's fate whether a decision was taken on the merits or the proceedings were simply terminated.

In **T 500/12** the board granted the request filed by the appellant (opponent) for continuation of the appeal proceedings. The appellant had provided evidence from several national patent registers showing that the opposed patent had not lapsed in all contracting states and was still in force. The appellant further submitted that the annuity fees could be paid not only by the patentees but also by a third party. Furthermore, annuity fees could still be validly paid with a surcharge in many of the contracting states and, even if they were not paid with a surcharge in due time, reinstatement periods also had to be considered.

b) Request for continuation of the proceedings made by the patent proprietor

In contrast to the case law cited above, **T 708/01** concerns the situation where the patent proprietor had appealed against the decision of the opposition division to revoke the patent. The patent had expired in all the designated contracting states. The board decided that R. 60(1) EPC 1973 only applied, if at all, to the extent that the appellants were required to state whether they wished to maintain the appeal. The proprietors could also apply to have the patent maintained in amended form with effect only for the past. In the case in point the appellants stated that they wished to maintain the appeal. The board decided to continue the proceedings.

In **T 520/10** the board noted that if a European patent has lapsed in all designated contracting states, opposition proceedings may be continued at the request of the opponent. However, if - as in the present case - the patent proprietor was the appellant, it would be inappropriate to allow one or more of the opponents (respondents) to decide whether the appeal proceedings should be continued. For this reason, R. 84(1) EPC had to be applied mutatis mutandis in such opposition appeal proceedings so that it was the patent proprietor who could request that the appeal proceedings be continued (see also **T 2536/10**). As no such request had been made, the appeal proceedings were terminated.

A mere statement confirming that the patent had been allowed to lapse in all designated states in response to the board's communication asking the appellant (patent proprietor) whether it requested continuation of the appeal proceedings was interpreted by the board to mean that the appellant did not wish to request continuation. The appeal proceedings were terminated (**T 2536/10**).

#### **4.2. Death or legal incapacity of an opponent**

R. 84(2), first sentence, EPC provides that in the event of the death or legal incapacity of an opponent the opposition proceedings may be continued by the EPO of its own motion. This means that, with a view to ensuring expeditious handling of the case, they can be continued even without the participation of the opponent's heirs or legal representatives. There is therefore no need to wait for the heirs to be identified and the inheritance to be accepted or for a legal representative to be appointed (**T 1533/07**).

The appointment by the courts of an insolvency administrator under German law does not mean that the opponent is legally incapacitated within the meaning of R. 84(2), first sentence, EPC. Rather, under German insolvency law the administrator is an ex officio party. By way of a change of party by operation of law, he thus becomes a party to the proceedings, and takes the place of the opponent (**T 1533/07**, **T 917/01**).

#### **4.3. Withdrawal of opposition**

R. 84(2), second sentence, EPC provides that the opposition proceedings may be continued by the EPO of its own motion if the opposition is withdrawn.



#### 4.3.1 Form and effect of withdrawal on party status

A withdrawal requires an unambiguous statement. An opponent's statement explaining his lack of interest in the fate of the European patent to which his opposition relates cannot be construed as a withdrawal of the opposition (**T 798/93**, OJ 1997, 363). A declaration by the opponent that he has decided to "discontinue the opposition" clearly indicates that he wants to cease his opposition and is to be interpreted in the sense that the opposition has been withdrawn (**T 789/89**, OJ 1994, 482).

An opponent who withdraws his opposition ceases to be a party to the proceedings (**T 283/02**). Where the proceedings continue and there are questions concerning the apportionment of costs, the opponent ceases to be a party with respect to the substantive issues, but remains a party as regards apportionment of costs (**T 789/89**, see also recent decisions **T 1397/10**, **T 2350/10** and **T 2061/11**).

It is not possible to request that a withdrawal of an opposition be cancelled. The withdrawal is a procedural declaration by a party which takes effect on receipt by the EPO. An opponent who withdraws his opposition and as a result ceases to be an active party to the proceedings can no longer take procedural steps himself (**T 283/02**).

In **T 558/95** the board noted that the main request had been refused by the opposition division before the opposition was withdrawn. The decision concerning this request was thus final; even after the withdrawal of the opposition, it could no longer be reviewed by the department of first instance. The continuation of the proceedings by the EPO of its own motion under R. 60(2), second sentence EPC 1973 (R. 84(2) EPC) therefore applied only to the auxiliary request, which had not been the subject of a final decision.

#### 4.3.2 Effect of withdrawal on opposition proceedings before the departments of first instance

After withdrawal of an opposition, the opposition proceedings should be continued if they have reached such a stage that they are likely to result in a limitation or revocation of the European patent without further assistance from the opponent and without the opposition division itself having to undertake extensive investigations (**T 197/88**, OJ 1989, 412; see also the more recent decision **T 36/11** and Guidelines D-VII, 5.3 – November 2015 version). The continuation of the opposition proceedings under these circumstances follows from the EPO's general duty towards the public not to maintain patents which it is convinced are not legally valid at all or would be legally valid only with the necessary limitations (**T 156/84**, OJ 1988, 372; **T 197/88**).

In **T 1668/08** the respondent (opponent) withdrew its opposition during the appeal proceedings and was hence no longer a party to those proceedings. The board decided to remit the case to the department of first instance for further prosecution. The board emphasised that during that further prosecution the opposition division would first need to decide, in accordance with R. 84(2) EPC, whether or not to continue the opposition proceedings of its own motion in view of the withdrawal of the opposition. It warned that

its decision to remit should not be taken as indicative of the conclusion to be reached in this respect.

In **T 36/11** the board held that an appeal by the patent proprietor against the decision of the opposition division to discontinue opposition proceedings after the withdrawal of the opposition was inadmissible because the patent proprietor had not been adversely affected by that decision.

#### 4.3.3 Effect of withdrawal on opposition appeal proceedings

The discretionary nature of an opposition division's decision whether or not to continue the proceedings pursuant to R. 84(2) EPC has to be distinguished from the much more narrow framework within which the boards of appeal decide on the effect of a withdrawal of an opposition. The effect of a withdrawal on the opposition appeal proceedings depends on whether or not the opponent is the sole appellant.

In **G 8/93** (OJ 1994, 887) the Enlarged Board held that if the **opponent as sole appellant** filed a statement withdrawing his opposition, this could only be regarded as a withdrawal of the appeal which immediately and automatically terminated the appeal proceedings as far as all substantive issues were concerned (**G 7/91**, **G 8/91**, OJ 1993, 356 and 346). This was irrespective of the patentee's consent. The proceedings were terminated even if in the board's view the requirements under the EPC for maintaining the patent were not met. The Enlarged Board emphasised the distinction between the power to initiate and continue proceedings and the power to clarify the facts in pending proceedings. According to its case law, in appeal proceedings the former was **exclusively** the province of the appellant, whereas the latter might be exercised by the board subject to Art. 114 EPC 1973 provided proceedings were pending.

In contrast, according to established case law the withdrawal of an opposition has no direct procedural consequences for the appeal proceedings if the opponent was the **respondent** and the contested patent was revoked by the contested decision (**T 629/90**, OJ 1992, 654; followed by numerous other decisions, including **T 789/89**, OJ 1994, 482, **T 194/90** and **T 627/92**, as well as, more recently, **T 46/10** and **T 2061/11**). In such cases, the board must carry out a substantive examination of the opposition division's decision, and can only set aside this decision and reject the opposition if the grounds for opposition do not prejudice the maintenance of the granted patent. The board's examination can include the examination of evidence submitted by the respondent prior to the withdrawal of the opposition (**T 629/90**, OJ 1992, 654; see also **T 900/03**, **T 340/05** and **T 46/10**).

The opposition appeal proceedings are also continued if both the patent proprietor and the opponent have appealed but the opponent withdraws his opposition in the course of the appeal proceedings. The effect of the withdrawal of the opposition is that the appeal is regarded as withdrawn and the opponent ceases to be a party to the appeal proceedings as regards the substantive issues (**T 922/01**, **T 1346/10**).

## 5. Limitation/revocation

### 5.1. Limitation/revocation - Article 105a-105c EPC

With the entry into force of the EPC 2000, Art. 105a EPC has been introduced, pursuant to which a European patent may be revoked or limited at the request of the proprietor. Limitation can be achieved by an amendment of the claims. The effect of a successful limitation or revocation is that the patent is limited or revoked ab initio (Art. 68 EPC) and in respect of all the Contracting States in which it has been granted. It takes effect on the date on which the mention of the decision to limit or revoke is published in the European Patent Bulletin (Art. 105b(3) EPC, **T 646/08**, **T 2177/12**). The nature of this procedure, which is ex parte, lies somewhere between the examination and opposition proceedings (**G 3/14**, OJ 2015, A102).

There is no time limit as to when the request for limitation/revocation can be made. However, it is a precondition that no opposition proceedings (including opposition appeal proceedings) in respect of the patent are pending (Art. 105a(2) EPC). If they are, then the request is deemed not to have been filed (R. 93(1) EPC). If limitation proceedings are pending at the time of the filing of an opposition, the limitation proceedings are terminated (R. 93(2) EPC). If a patentee wishes to revoke his patent whilst opposition proceedings are ongoing, he may do so but not by using the procedure set out in Art. 105a-105c EPC (see in this chapter IV.C.5.2). If he wishes to limit his patent, he may be able to do so by amending it in the course of the opposition and opposition appeal procedure.

The decision as to whether a request for limitation or revocation under Art. 105a EPC is granted is taken by the examining division (R. 91 EPC). If the request is admissible, the examining division examines whether the amended claims constitute a limitation of the claims of the European patent as granted or amended, and whether they comply with Art. 84, 123(2) and 123(3) EPC (R. 95(2) EPC). No examination of the claims with regard to Art. 52-57 EPC is foreseen. The decision of the examining division is appealable before the technical boards of appeal. As at 31.03.2016 no decision of the boards of appeal concerns an appeal against such a decision of the examining division.

### 5.2. Requests for revocation during opposition and opposition appeal proceedings

The procedure for limitation/revocation pursuant to Art. 105a-105c EPC is not available during opposition and opposition appeal proceedings. However, a patent may still be revoked during such proceedings at the request of the patent proprietor (see e.g. **T 2177/12**).

If the patent proprietor states in opposition or appeal proceedings that he no longer approves the text in which the patent was granted and will not be submitting an amended text, the patent is to be revoked. This is supported by Art. 113(2) EPC, which provides that a patent may be maintained only in a version approved by the patent proprietor. If there is no such version, one of the requirements for maintaining the patent is lacking

(**T 73/84**, OJ 1985, 241, followed by numerous decisions, see e.g. recent decisions **T 307/13** and **T 1536/14**).

If the patent proprietor himself requests that the patent be revoked, the decision to revoke the patent is given without substantive examination as to patentability. The examination as to whether the grounds for opposition laid down in Art. 100 EPC prejudice the maintenance of the patent becomes impossible since the absence of a valid text of the patent precludes any substantive examination of the alleged impediments to patentability (**T 186/84**, OJ 1986, 79; see also **T 157/85**, **T 1659/07**, **T 124/08**, **T 1287/08**, **T 1111/10**).

In **T 237/86** (OJ 1988, 261) the board stated that a direct request for revocation sufficed, whatever the form of the words, when it was made clear to the boards that appellant and respondent agreed that the patent should be revoked. In **T 459/88** (OJ 1990, 425) the board stated that if, in proceedings before the EPO, the patent proprietor himself requested that his patent be revoked, there could scarcely be any more cogent reason for revoking it since it could not be in the public interest to maintain a patent against its proprietor's will. The patent was thus revoked by the board exercising its powers under Art. 111(1) EPC 1973 (see also the more recent decisions **T 655/01**, **T 1187/05**, **T 1526/06**, **T 1610/07**, **T 1541/09**).

There must be no doubt that the proprietor applying to have the patent revoked is requesting revocation with the consequences specified in Art. 68 EPC 1973 (Art. 68 EPC), namely the cancelling of the effects of the European patent application and the resulting patent as from the outset (**T 186/84**, **T 347/90**, **T 386/01**). Where the respondent (patent proprietor) states that the patent has been abandoned 'since' a particular date, this cannot be considered to be a request for revocation, as it does not indicate that the patent has been abandoned ab initio. The case law on requests for revocation therefore does not apply and the appeal must be examined as to its merits (**T 973/92**).

In **T 237/86** (OJ 1988, 261), the statement "We herewith abandon the above patent" was held to be equivalent to a request for revocation to which the board could accede under Art. 111(1) EPC 1973 (see also **T 347/90**). In **T 92/88** the words "the patent has been allowed to lapse in all designated states" were held to amount to a request for revocation. In a number of cases the boards have decided that a request by a patent proprietor to withdraw "the application" amounted to a request to revoke the patent (**T 264/84**, **T 415/87**, **T 68/90** and **T 322/91**).

In **T 646/08** the appellant, in a letter, withdrew its appeal and at the same time withdrew its approval of the text of the patent as maintained by the opposition division in its interlocutory decision. The board held that the letter did not contain an unequivocal statement of the proprietor that he accepted the revocation of the patent with all the consequences specified in Art. 68 EPC. The appeal proceedings were terminated.

In **T 2573/12** the proprietor had stated during proceedings before the opposition division that it wished to abandon the patent. The board held that the **wish** to abandon the patent

did not constitute a clear and unambiguous request for abandonment, which would be construed as equivalent to a request for revocation (see **T 237/86**, OJ 1988, 261).

A number of cases concern the situation in which the opposition division revoked the patent, and the patent proprietor appealed, and then, in the course of the appeal proceedings, requested revocation of the patent. In **T 347/90** the board dismissed the appeal without going into the substantive issues, so that the revocation of the patent by the department of first instance was confirmed. In **T 18/92**, by contrast, the request by the patent proprietor (appellant) for revocation of the patent was interpreted by the board as a withdrawal of the appeal. Withdrawal of the appeal meant that the first-instance decision revoking the patent took effect. In **T 481/96** the board examined the two solutions and endorsed **T 18/92**. In **T 1244/08** the board confirmed that according to established case law (see also **T 1003/01** and **T 53/03**), if an appellant holding a patent revoked by an opposition division states clearly and unambiguously that it is no longer interested in pursuing the appeal proceedings, that is tantamount to a statement withdrawing the appeal. The withdrawal had the effect of immediately terminating the appeal proceedings, such that the opposition division's revocation decision became final. Any later request to retract the withdrawal and continue appeal proceedings was inadmissible.

## **6. Apportionment of costs**

### **6.1. Principle that each party must bear its own costs**

Under Art. 104(1) EPC, each party to opposition proceedings must, as a rule, meet the costs it has incurred. However, the opposition division or board of appeal may, for reasons of equity, order a different apportionment of the costs incurred during taking of evidence or in oral proceedings. At the appeal stage Art. 16(1) RPBA also applies, allowing the board, subject to Art. 104(1) EPC, to order a different apportionment. It lists typical cases where costs arise as a result of: (a) amendments pursuant to Art. 13 RPBA to a party's case as filed pursuant to Art. 12(1) RPBA; (b) extension of a time limit; (c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings; (d) failure to comply with a direction of the board; or (e) abuse of procedure.

As part of the revision process, Art. 104(1) EPC was slightly redrafted and together with Art. 104(2) EPC was amended such that the details of a decision ordering a different apportionment of costs and the procedure for fixing them were transferred to the Implementing Regulations (see R. 88 EPC, formerly R. 63 EPC 1973).

In its decision of 28 June 2001 the Administrative Council established transitional provisions *inter alia* for Art. 104 EPC (see OJ SE 1/2007, 197), according to which the revised Art. 104 EPC applies to:

- European patents already granted at the time of the EPC 2000's entry into force
- European patents granted in respect of European patent applications pending at that time.

In **T 133/06** the board added that Art. 104 EPC belonged to the procedural provisions and so was subject to the general principle of law that a new procedural law was immediately applicable but had no retrospective effect unless otherwise provided. Hence when deciding whether the new Art. 104 EPC is applicable in appeal proceedings initiated under EPC 1973, the board must take into consideration not only the fact that, according to the transitional provisions, the new Art. 104 EPC is applicable to granted patents, but also the date of the event which gives rise to the application of this article. This is the only way to give the new procedural provision an immediate application without giving it a retrospective effect.

The phrase "taking of evidence" used in Art. 104(1) EPC 1973 referred generally to the receiving of evidence by an opposition division or a board of appeal (**T 117/86**, OJ 1989, 401; **T 101/87**, **T 416/87**, **T 323/89**, OJ 1992, 169; **T 596/89** and **T 719/93**). The boards' case law refers to Art. 117(1) EPC (unchanged in substance), according to which "taking of evidence" covers the giving or obtaining of evidence generally in proceedings before departments of the EPO, whatever the form of such evidence, and includes, in particular, the production of documents and sworn statements in writing. The EPC revision transferred the details of the procedure for taking evidence to the Implementing Regulations (R. 118-120 EPC; see Chapter III.G "Law of evidence").

## **6.2. Equity of a different apportionment of costs – case groups**

There is no definition of equity in the EPC. The boards of appeal therefore had to develop the criteria determining whether costs were to be apportioned on a case-by-case basis. In a number of decisions it has generally been stated that apportionment of costs is justified if the conduct of one party is not in keeping with the care required, that is if costs arise from culpable actions of an irresponsible or even malicious nature (see, for example, **T 765/89**, **T 26/92** and **T 432/92**). The boards' case law identifies instances of such actions, the board in **T 1771/08** for example finding that an apportionment of costs under Art. 104(1) EPC could be ruled out from the outset for lack of equity if the representative of the party requesting a different apportionment owing to postponement of the oral proceedings had unreservedly agreed to their postponement.

A thorough examination of the decisions of the boards of appeal reveals that requests for a different apportionment of costs are often filed in various scenarios in which costs are incurred for:

- late submission of documents and/or requests (see in this chapter IV.C.6.2.1);
- acts or omissions prejudicing the timely and efficient conduct of oral proceedings (see in this chapter IV.C.6.2.2);
- filing of opposition or appeal (see in this chapter IV.C.6.2.3);
- withdrawal of opposition or appeal at short notice (see in this chapter IV.C.6.2.4);
- other cases (see in this chapter IV.C.6.2.5).

### 6.2.1 Late submission of documents and/or requests

Fresh grounds for opposition submitted in appeal proceedings may be considered only with the approval of the patentee (**G 10/91**, OJ 1993, 420). In **T 1002/92** (OJ 1995, 605), however, the board focused on the issue of the late submission of facts and evidence to substantiate the original grounds for opposition cited in the proceedings before the opposition division. In interpreting Art. 114(2) EPC 1973, the board applied the principles laid down in **G 10/91** and held that late-filed facts, evidence and related arguments should only exceptionally be admitted into the proceedings if, prima facie, there were clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent (see chapter IV.C.1).

Where facts and evidence supporting the opposition are submitted at a late stage in the proceedings and another party incurs considerably higher costs as a result, a different apportionment of the costs may be ordered for reasons of equity (see **T 10/82**, OJ 1983, 407; **T 117/86**, OJ 1989, 401; **T 101/87**, **T 326/87**, OJ 1992, 522; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169; **T 596/89**, **T 622/89**, **T 503/90**, **T 611/90**, OJ 1993, 50; **T 755/90**, **T 110/91**, **T 867/92**, OJ 1995, 126; **T 719/93** and **T 970/93**). The relevant factor in deciding on the costs is whether or not there are cogent reasons justifying the late submission; it is regarded as irrelevant whether the material in question has any bearing on the merits of the decision. However, it should be pointed out that, in several cases, requests for apportionment of costs have been refused, despite an unjustified delay, because there was no proof that higher costs had been incurred (see, for example, **T 212/88**, OJ 1992, 28; **T 582/90**, **T 267/92**, **T 9/95** and **T 207/03**).

According to board of appeal case law, if a party introduces important facts or evidence at a late stage of the proceedings, without cogent reasons for the delay, this may be taken into account in the apportionment of costs (see **T 117/86**, OJ 1989, 401; **T 326/87**, OJ 1992, 522; **T 97/90**, **T 611/90**, OJ 1993, 50; **T 847/93**, **T 1016/93** and **T 574/02**). If the reasons for the late citing of a document do not point towards negligence or other circumstances that would amount to an abuse of procedure, there is no reason of equity which would justify an apportionment of costs in the other party's favour (**T 1016/93**).

#### a) Late submission was unjustified

In principle, submissions at a late stage in the proceedings justify a different apportionment of the costs for reasons of equity if there is no justification for the late filing. In the absence of cogent reasons to justify the late submission, a different apportionment of costs will usually be ordered unless the late submission is shown not to have been disadvantageous to the other party. As a rule, though, late submission will cause the other party to incur additional expenses which would not have arisen if the submission had been made on time.

#### (i) Different apportionment of costs ordered

In **T 117/86** (OJ 1989, 401) the appellants had produced, together with their statement of grounds, two new documents and an affidavit in support of the contention that the

opposed patent lacked an inventive step. The board concluded that the fact that new documents were presented after the nine-month period for filing opposition could itself give rise to additional expenditure for the other party, and that the costs should be apportioned differently for reasons of equity.

The board in **T 416/87**, expressly referring to **T 117/86**, regarded it as an abuse of the opposition procedure that the appellant had in its statement of grounds of appeal relied exclusively on three new documents and had even raised for the first time the **issue of novelty** on the basis of a document already discussed in the patent in suit. By introducing arguments and documents which bore little relation to the content of those filed in the original opposition, the appellant had produced virtually a new opposition at the appeal stage. This could not, by definition, be the purpose of an appeal. 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.

The board in **T 83/93** held that it was also an abuse of the appeal procedure to submit **five new documents** as evidence 40 months after the end of the opposition period (without giving reasons) and to revive an objection under Art. 100(c) EPC 1973 on the basis of new facts and evidence 51 months after the end of the opposition period.

In **T 493/11** the respondent introduced important evidence at a late stage of the proceedings, namely only two months before the date of the scheduled oral proceedings, without cogent reasons for the delay and without submitting all the necessary information. The board found that the respondent could have come forward with the above-mentioned supporting submissions at an earlier stage of the proceedings and it was evident that the purpose of postponing the oral proceedings was to follow the respondent's submissions. Consequently, the fact that the appellant itself had submitted new requests quite late in the appeal proceedings obviously was not the decisive factor. The board stressed that the responsibility for stating its complete case lies exclusively within the respondent's own sphere. As a consequence, any delay causing the incurring of additional costs by the other party remains within the respondent's sphere and liability and in this case justified an apportionment of costs.

In **T 867/92** (OJ 1995, 126) the claims had been amended during the opposition proceedings. Eighteen months after the claims had been amended the appellant (opponent) cited in the statement of grounds of appeal a **new prior art** document. The board held that the EPC does not impose a time limit for citing new prior art in response to an amendment of the claims. However, an opponent who cites new prior art with a considerable delay with no special reason justifying the delay runs the risk of having to bear the proprietor's costs incurred in attending oral proceedings which cannot bring the case to an end because of the new citation. However, as there was no suggestion that the appellant (opponent) wilfully abused the procedure in the case at issue, the board considered that it would be equitable to order the appellant to pay only half those costs.

In **T 514/01**, the board found that the late allegation of **public prior use** during the first oral proceedings before the opposition division had given rise to additional costs



because second oral proceedings before the opposition division had been needed to investigate the alleged prior public use.

In **T 416/00** the appellant (opponent) submitted a document which had been cited in the patent in suit and mentioned in the opposition proceedings but **had never been discussed between the parties** until the appeal proceedings, and had even been expressly excluded before the opposition division. The board found that the opponent's attempt to make surprising use of a document that it had disregarded in the oral opposition proceedings ran counter to the speedy conclusion of the proceedings before the two departments. Even if this was not a deliberate tactic on the opponent's part, the result was the same in terms of the principle of fairness governing proceedings. The respondent's request for a different apportionment of costs was granted.

In **T 671/03** document D18 was first filed in the appeal proceedings and deemed to constitute an **amendment to the appellant's submissions** pursuant to Art. 10b RPBA 2003 (now Art. 13 RPBA). If it had been filed within the opposition period, there would have been no need to discuss its admission during the oral proceedings in the appeal. The costs for preparing and attending the oral proceedings before the board, which mainly discussed the admission of D18, could have been avoided. For reasons of equity the board ordered a suitably modified apportionment of costs.

In **T 1033/09**, the oral proceedings had been adjourned following the admission of an auxiliary request submitted by the respondent during those proceedings. For the board, there was no doubt that this auxiliary request constituted an amendment to the respondent's case after it had filed its reply to the statement of the grounds of appeal, and so one within the meaning of Art. 13(1) RPBA. The board therefore found it equitable to apportion the costs in the appellant's favour.

Similarly, in **T 1071/06**, the appellant (patent proprietor) filed its auxiliary requests 1 to 3 one month before the oral proceedings and further supporting documents even closer to the oral proceedings. The board stated that it would always be unacceptable for a party to produce evidence without any explanation - unless conceivably its relevance was self-evident. But to produce evidence at the virtual end of the proceedings accompanied only by a statement that the explanation would be provided even later was not only discourteous but a clear, and apparently deliberate, attempt to frustrate the respondent's preparation for the oral proceedings. That was both an act prejudicing the efficient conduct of oral proceedings and an abuse of procedure, which merited an apportionment of costs.

Remittal to the department of first instance does not mean that the late filing of documents by the respondent gives rise to a disproportionate cost burden in relation to the appeal at issue (**T 1182/01**). Where a document successfully introduced at a late stage is of such relevance that the board decides to remit the case to the department of first instance in order to allow the patentee to have his case decided by two instances of jurisdiction, then in the absence of any convincing explanation for the late introduction of that document, the costs between the parties should be apportioned in such a way that the late-filing party should bear all the additional costs caused by his tardiness. Costs

should only be shared between the parties if there exist strong mitigating circumstances for the late filing of facts, evidence or other matter, for example, where the document introduced was obscure and therefore difficult to get hold of (**T 326/87**, OJ 1992, 522 and **T 611/90**, OJ 1993, 50).

The board in **T 874/03** ruled that when late filing of facts and evidence necessitated remitting the case to the department of first instance, the costs of any oral proceedings in the appeal proceedings were normally to be borne by the party responsible for the late filing.

In **T 2233/09** the board concluded that it would have been possible for the appellant to submit the evidence necessary to prove transfer of appellant status well ahead of the oral proceedings and that it was its conduct that had caused the adjourning of the oral proceedings. Therefore, for reasons of equity, the respondent's costs for the new oral proceedings had to be borne by the appellant.

(ii) No different apportionment of costs ordered - no disadvantage

In a number of cases the boards have refused a different apportionment of costs despite unjustified late submission because they were of the opinion that the belated introduction of new documents was not disadvantageous to the other party.

In **T 28/91** three documents which had already been submitted to the opposition division were re-submitted at a later stage in the appeal proceedings. The board ruled that the late submission was not disadvantageous as no new arguments had been introduced, and therefore no additional work had been necessary (see also **T 133/06**).

In **T 525/88**, the late filing was unjustified, but the request for apportionment of costs was rejected because the documents were of **no relevance** and did not affect the decision. The same applied in **T 534/89** (OJ 1994, 464) and **T 876/90**. In **T 882/91**, the board did not look into whether the unjustified late submission had led to higher costs because it was of the opinion that the other party had not had to spend very **much additional time and energy** on the documents which had been submitted late and that there was therefore no reason to apportion costs (see the decisions on similar cases in **T 737/89**, **T 685/91**, **T 556/90**, **T 231/90** and **T 875/91**).

In **T 330/88** the respondents filed a new document two days prior to the oral proceedings. The board took the view that the late filing was unjustified but that an apportionment of costs would not be equitable as the appellants had had **sufficient time** to deal with the document, especially since the decision was not taken until four months after the oral proceedings and following the opportunity to present comments.

In **T 336/86** the appellants submitted a prior patent belonging to the respondents for the first time in the appeal proceedings, which destroyed the novelty of the patent in suit. The respondents requested an apportionment of costs as the oral proceedings would not have been necessary had the patent been presented earlier. The board agreed that the late submission was not justified and that higher costs had been incurred as a result.

However, as the respondents either had - or should have - been aware of the **existence of their own patent**, it took the view that an apportionment of costs was not justified.

In **T 931/97**, the opponent had submitted new evidence in appeal proceedings, which was already **known** to the patentee from earlier proceedings before the German Patent Office. The board held that where the patentee knew the documents and could assess their prospects a different apportionment of costs was not justified.

In **T 633/05**, the appellant referred for the first time in the statement of grounds of appeal to a document which had been cited in the European search report but not considered in the opposition proceedings. In the board's view, the appellant sought to provide new evidence in support of a line of argument already put forward in the opposition proceedings, namely the fact that certain features of the present invention were known in the art. As the said document was cited in the statement of grounds of appeal and was anyway part of the examination file, the respondent had had ample time to study the content of this fairly short document and prepare a rebuttal against the appellant's allegation that it disclosed some key features of the contested patent. Thus, the board had no reason to suspect that the appellant's late filing might have been aimed at delaying the appeal proceedings, or that it resulted in the respondent being burdened with unreasonable additional costs.

In **T 273/10**, the board found that the opponent had abusively withheld the document in question, which ought to have been submitted for adversarial scrutiny in good time. However, it also observed that this had not been the only reason why further oral proceedings had been necessary. At the stage when the initial proceedings had been adjourned, it would anyway have been impossible to close them the same day. The board noted that a full day had been needed for the second set of proceedings and, moreover, that continuation of the proceedings had given the proprietor an opportunity to put forward new auxiliary requests. It followed that, since both parties had benefited from the holding of further oral proceedings, it would not be equitable to order the opponent to bear the costs alone.

b) Late submission was justified

In principle, costs are not apportioned differently if the late submission of facts and evidence appears justified. The boards have assumed in particular that belated submission is justified or that no abuse of procedure has taken place if new documents are filed for the first time at a later stage in the proceedings as a reaction to communications from the board, comments from the other party or amendments of the patent or decisions of the department of first instance which make such documents necessary in the first place (see **T 582/88**, **T 638/89**, **T 765/89**, **T 472/90**, **T 556/90**, **T 334/91**, **T 875/91**, **T 81/92** and **T 585/95**).

(i) No different apportionment of costs ordered

In **T 712/94** the board allowed the appellant (opponent) to introduce facts and evidence on alleged prior use at the appeal stage, whilst refusing the respondent's (patentee's)

request for apportionment of costs. The patentee had been made aware of the prior-use documents during negotiations conducted well before the first-instance decision was taken; so they had not taken him by surprise when submitted after the failure of those negotiations.

In **T 1167/06** the board did not consider it an abuse of procedure that two weeks before the oral proceedings the appellant filed three further auxiliary requests, additional arguments and four short documents, the latter illustrating common general knowledge on issues that had already been discussed. The need to **translate the requests and documents** and the resultant costs were in the nature of the European procedure with three official languages and affected all parties in equal measure. As the language of the proceedings for the patent was German, the respondent had to expect many submissions to be made in that language. The respondent stated that an additional representative had had to deal with the late filing and travel to the oral proceedings because the **representative assigned the case had been on leave** at the time in question. In the board's view, however, the representative's absence on leave was not the fault of the other party. Moreover, the respondent (opponent) had been represented by the same two representatives before the opposition division, so the additional representative had not needed much time to familiarise himself with the latest dossier updates.

Similarly, in **T 29/96** the request for a different apportionment of costs was refused. A new document which was fairly simple and straightforward in content had been filed together with the statement of grounds of appeal. The board ruled that this was the earliest possible moment that the document could have been submitted. In any event, the introduction of the new document could not be regarded as having given rise to a new opposition; it had not introduced new closest prior art, but was merely a new secondary information source. In the case before the board, it was logical for the appellant, as the losing party in the opposition proceedings, to introduce the document into the appeal proceedings in an effort to **improve his position** by **filling a gap** referred to in the impugned decision.

In **T 554/01**, the applicant submitted a number of documents following the negative decision taken by the opposition division. The board held that the mere fact that certain documents had been submitted at a late stage did not justify a finding that there had been an abuse on the part of the applicant, especially where they had been submitted as a result of a legitimate desire **to supplement the line of argument** which had been unsuccessful before the department of first instance. Moreover, the respondents had not shown that they had incurred additional costs as a result of the documents' introduction into the proceedings.

In **T 1171/97** the board rejected a request for apportionment of costs because it was satisfied that the new documents which had become known to the appellants (opponents) in the course of another search had not been filed in order to obstruct the proceedings, but because they contained aspects which, **according to the statement of the opposition division**, had not been found in the previously available references.

In **T 507/03** the opposition division had regarded the claimed invention as being patentable over the documents cited by the opponent. As a reaction to the reasons given in the impugned decision, the opponent (appellant) filed a new set of documents in the appeal proceedings, after the nine-month period for filing opposition. Refusing the request for a different apportionment of costs due to the late filing, the board argued that, according to Art. 108 EPC 1973 (minor editorial changes only) and R. 65 EPC 1973 (now R. 101 EPC), a statement of grounds of appeal had to identify the extent to which amendment or cancellation of the decision was requested. This, however, did not forbid a losing opponent from filing new pieces of prior art if it was felt that they could counter the reasons given in the appealed decision. Further, the new documents were all **easily understandable** and had not caused **an unreasonable amount of extra work** such as to justify departure from the normal rule that each party meets its own costs pursuant to Art. 104 EPC 1973.

In case **T 242/04**, the board held that the respondent's late filing was made **in response to a communication of the opposition division** for making written submissions and took place roughly one month before expiry of the final date accorded in the communication as well as roughly two months before the date for oral proceedings. The circumstances were therefore not such that there was no justification for the late filing or that it could be held that the respondent acted in bad faith. In addition, the appellant who requested an apportionment of costs and, in particular, reimbursement of the travel costs of a technical expert, neither gave any reasons let alone any evidence for the necessity of the technical expert's presence at the hearing before the opposition division, nor provided any evidence that the respective trip was caused only by the said late filing. Therefore, a different apportionment of costs was not regarded as justified.

The board in **T 333/06** found that the appellant's maintenance of his request for admission of the fresh ground for opposition - lack of inventive step - and of the new supporting documents after being notified of the board's preliminary negative opinion did not constitute abuse, as that opinion was not a final decision. Furthermore, while the appellant might have acknowledged that the new documents were not relevant to novelty, objectively he could not be censured for having maintained them in the hope that his oral presentation would result in the admission of lack of inventive step as a fresh ground for opposition and hence of the new documents relevant to inventive step. Thus while this had admittedly made the respondent's preparations for oral proceedings more difficult than they would have been if the appellant had withdrawn the new documents, the procedural conduct on the part of the appellant which had necessitated those preparations was not abusive but one of the appellant's legitimate prerogatives.

(ii) Different apportionment of costs ordered for reasons of equity

In **T 847/93**, the board admitted a statement of grounds of appeal documenting new prior art. Mitigating circumstances for the late filing of new facts and evidence were put forward by the appellants and were held to be credible by the board. On the other hand, the board was also of the opinion that it was credible that the costs incurred by the respondents were higher as a result of the introduction of an entirely fresh case than if the facts and evidence had not been filed at a late stage. It therefore decided to order an

apportionment of costs under Art. 104(1) EPC 1973 according to which the appellant had to pay the respondents 50% of the costs incurred by the respondents - after remittal to the department of first instance - in respect of the subsequent oral proceedings and the taking of evidence as well as in any subsequent appeal. In **T 1137/97**, a belatedly submitted document was likewise admitted into the proceedings and a different apportionment of costs was ordered. In determining the costs, the board itself, exercising its discretion under Art. 111(1) EPC 1973, awarded a fixed sum of EUR 2 500 to avoid the need for an exact investigation of the amount, which would have been more burdensome for the parties.

In **T 937/00**, the board found that all the requests presented by the appellant in writing in advance of the oral proceedings were clearly inadmissible and their filing could hardly be considered appropriate in the circumstances of the case, in which the appellant had chosen to file an exceptionally high number of independent claims in response to the notice of opposition. At the very end of the oral proceedings, he had even filed a third auxiliary request according to which all the claims which had been contested in the appeal procedure were simply abandoned. In these circumstances, the board felt compelled to admit the belated auxiliary request, as had the board rejected the appellant's third auxiliary request, the appeal would have been dismissed and the revocation of the patent would have become final. The board also remitted the case to the department of first instance, none of the remaining claims having ever been considered by the opposition division. However, the board ordered for reasons of equity an apportionment of the costs of the oral proceedings such that the appellant bore 50% of the costs incurred by the respondent in travel expenses and remuneration for his representative for the purpose of attending the oral proceedings.

#### 6.2.2 Acts or omissions prejudicing the timely and efficient conduct of oral proceedings

##### a) Failure of a party to appear at oral proceedings

A party requesting oral proceedings is not obliged to be represented at them. Its duly announced absence could not be considered as improper behaviour (**T 1071/06**).

However, the boards consider it highly undesirable for summoned parties to announce too late, unclearly or not at all that they will not be attending. Such conduct is inconsistent both with the responsible exercise of rights and with the basic rules of courtesy (see for example **T 434/95**, **T 65/05**).

There is an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as he knows that he will not be attending as summoned (**T 212/07**), regardless of whether he himself or another party requested the oral proceedings and of whether or not a communication accompanied the summons to oral proceedings. If a party who has been summoned to oral proceedings fails to attend as summoned without notifying the EPO in advance, an apportionment of costs in favour of another party, who has attended as summoned, may be justified for reasons of equity in accordance with Art. 104(1) EPC 1973 (established case law, see for example **T 930/92**, OJ 1996, 191; **T 123/05**, **T 972/13**). As one party's non-attendance does not automatically put the other

party at a disadvantage (**T 273/07**, **T 544/94** and **T 507/89**), one essential question here is whether the appellant's failure to attend rendered the oral proceedings unnecessary (**T 10/82**, OJ 1983, 407; **T 275/89**, OJ 1992, 126).

(i) Different apportionment of costs ordered

In **T 909/90** oral proceedings had been appointed at the appellants' request. Without giving the board or opponents any advance notice, the appellants did not attend the oral proceedings. Nor did they comment on the board's communication. For this reason in particular the oral proceedings contributed nothing new to the case. The board ordered the apportionment of costs without examining whether higher costs had been incurred as a result of the appellants' failure to appear. The appellants' failure to advise the board **in time or at all** that they would not be appearing at the oral proceedings was likewise the reason for ordering them to bear the costs in **T 434/95**, **T 641/94** and **T 123/05**.

In **T 937/04** the appellant (patent proprietor), by fax sent only to the EPO after its business hours on Friday, 17 February 2006, informed the board, without giving reasons, that it would not be attending the oral proceedings on 21 February 2006. The board stated that the appellant, in informing only the EPO and not the other parties, had failed to exercise all due care required and concluded that, for reasons of equity, an apportionment of costs should be accorded in favour of the respondent.

In **T 91/99**, the board stated that, where an appellant failed to give notice that he would not be attending the oral proceedings until two working days before the date set for the proceedings, this could constitute negligent or wilful conduct; however, in the case at issue, there was no culpable conduct on the part of the appellant which could justify an apportionment of costs under Art. 104(1) EPC 1973. In **T 693/95** and **T 338/90** costs were awarded because notice of the appellant's absence had been given, in the former case, only an hour before the oral proceedings and, in the latter, at the time when the oral proceedings were due to start.

According to the board in **T 1079/07**, to inform the EPO and any other party to the proceedings about the intention not to attend oral proceedings in due time is a matter of courtesy and respect rather than a procedural obligation to be met (see also **T 69/07**). In cases where a party **delays** his decision not to attend oral proceedings or the communication of this decision to the board, an apportionment of costs in favour of the other party may be justified.

In **T 53/06** the appellant requested oral proceedings "in case the board considers not to set the decision aside". As soon as it received the board's summons to oral proceedings and communication, the appellant knew not only that oral proceedings would take place but also that the condition it had itself placed on its own request for oral proceedings had been fulfilled, since the communication clearly indicated that the board's provisional opinion was that the decision under appeal would not be set aside. However, the appellant neither replied to the communication nor indicated at all, let alone as soon as it knew, that it would not attend oral proceedings. Since the respondent had, in the absence of any submissions from the appellant additional to those in the grounds of

appeal, nothing to add to its own case in its reply to the grounds of appeal, the **oral proceedings proved to be unnecessary**. In those circumstances, an apportionment of costs in favour of the respondent was held to be appropriate under Art. 16(1)(c) RPBA as well as under Art. 16(1)(e) RPBA (see also **T 212/07**, **T 2179/09**).

(ii) Refusal of a request for apportionment of costs

The non-appearance of a party generally does not adversely affect the party which did attend. As a rule, a different apportionment of costs will not be ordered if the parties which are affected have neither shown nor claimed that they incurred additional costs because the other party was not present (**T 544/94**, **T 632/88** and **T 507/89**).

In **T 591/88** both parties had requested that oral proceedings be held - both in fact filing an "**unconditional**" request. Without giving any advance notice, the respondents failed to appear. The appellants requested apportionment of costs on the grounds that the oral proceedings would not have been necessary had they known that the respondents would not be attending. The board rejected a different apportionment of costs because the appellants had made an "unconditional" request for oral proceedings, i.e. also covering the eventuality that the other party would not appear.

In **T 1441/06**, the respondents had not asked for oral proceedings. They had not reacted to the board's communication, nor had they apparently had the intention to come or to notify the EPO of their intended absence at all. It was the appellant who had requested oral proceedings, albeit conditionally. In addition, the oral proceedings were not only arranged at the request of the appellants, but also because the board itself wished to be in a position to give a decision on the case. The oral proceedings would therefore not have been cancelled by the board even if the respondents had at an early time indicated that they would not attend. In these circumstances the board saw no sufficient reason to depart from the ordinary rule that each party bears its own costs.

In **T 65/05** the respondent maintained that, like the appellant, it would not have attended the oral proceedings if it had been informed in time that the opposing party would not be appearing. In the case in point the board considered it doubtful that the oral proceedings could therefore have been waived or that the respondent would then at any rate not have attended them or would have withdrawn its request for oral proceedings. Both parties had submitted auxiliary requests for oral proceedings. The board had issued the summons without an opinion on the merits, in particular without any announcement or intimation that it was likely to decide in the respondent's favour. Therefore the respondent could not rely on a favourable decision purely on the basis of its written submissions if it stayed away from the oral proceedings. In these specific circumstances the board deemed it likely that that respondent (patent proprietor) would have appeared at the oral proceedings to defend its interests even if it had known that the opposing party would not be there. The request for a different apportionment of costs was therefore rejected (see also **T 190/06** and **T 1361/09**).

In **T 435/02**, both the appellant and the respondent had filed an **auxiliary request** for oral proceedings. When filing its request, the respondent had wanted to attend the oral



proceedings to ensure that the board would not overturn the decision under appeal without its having the opportunity to present its case orally. In response to the appellant's decision not to attend the proceedings, the respondent gave notice that it too would not be attending and commented that it had wished to attend "merely to rebut statements/arguments made by the patentee during these proceedings". Although the board expressly informed the parties that the oral proceedings would be held as planned, the respondent failed to attend. The respondent requested a different apportionment of costs because the appellant had withdrawn its request for oral proceedings so late that the respondent had incurred costs which no longer could be recovered. The board refused the request on the grounds that, contrary to the respondent's claim, its failure to appear was not a response to the appellant's decision not to attend but the result of a choice not to take the opportunity which it had requested to present its case orally.

In **T 275/89** (OJ 1992, 126) the appellant's representative filed a request that the oral proceedings scheduled for 09.00 on 3 May be adjourned, on the grounds that the appellant was unable to attend the oral proceedings owing to illness. The request was submitted so late, i.e. in the afternoon of 30 April, that it was **impossible** in view of the public holiday the following day to notify the respondents **in time**: they had already set out during the afternoon of 1 May. The request for adjournment was refused however and the oral proceedings took place without the appellant. The respondents requested a different apportionment of costs on the grounds that they would not have attended either had they known that the appellant would not be appearing. The board, however, took the view that the appellant could not be made responsible for the fact that the respondents had chosen to make an early start to the journey. Furthermore, the only matter of importance was whether the appellant's absence rendered the oral proceedings unnecessary. This question had to be answered in the negative. The request for costs was therefore rejected. The same decision was reached in **T 1856/10**, where a medically certified, sudden and unexpected illness of the appellant's representative had made him unable to attend. Here it was deemed acceptable that the board and the other party had not been informed of the first signs of his illness on the morning of the day before the oral proceedings, but only on the afternoon of that day, after he had seen a doctor. The request for costs was therefore rejected.

In **T 849/95** the respondent submitted a request for apportionment of costs, as the appellant had not informed the EPO in good time that he would not be taking part in the oral proceedings which he too had requested. The board rejected the request, as the oral proceedings were arranged not only at the request of both parties, but also because the board itself required further airing of facts on the part of the respondent. The oral proceedings would not have been cancelled even if the appellant had informed the EPO in good time.

In **T 838/92** too, the appellants stayed away from the oral proceedings. The respondents requested a different apportionment of costs as they had appeared with **seven witnesses**. The board rejected the request because the witnesses had been summoned at the respondents' instigation in order to prove the prior uses alleged by the latter. There was therefore no reason to impose the costs on the appellant (cf. also **T 273/07**).

- b) Request for scheduling or postponement of oral proceedings; withdrawal of request for oral proceedings

Nothing in the EPC prevents a party from **withdrawing a request for oral proceedings** at any stage of the procedure. The withdrawal of such a request is not culpable conduct as such and cannot be a factor in assessing whether reasons of equity exist in accordance with Art. 104(1) EPC 1973 (**T 91/99**).

On the basis of Art. 116(1) EPC 1973 any party has the exclusive right to request oral proceedings if it considers them to be necessary. The fact that one of the parties has to travel a longer distance than the other does not make the request for oral proceedings abusive. Furthermore, an objection of abuse based on the fact that the problems to be discussed in oral proceedings are simple ones and could easily be presented in writing cannot be sustained (**T 79/88**).

In **T 297/91** it had, for a number of reasons, not been possible to decide all the issues during the first oral proceedings, with the result that the respondent (patent proprietor) had requested that oral proceedings be held for the second time and that the costs incurred be borne by the appellant. The board rejected the request for apportionment of costs because the further oral proceedings had become necessary for reasons beyond the patent proprietor's control.

In **T 432/92 postponement** of the oral proceedings was requested two days prior to the agreed date as the father of the respondents' representative had died on the previous day. The appellants requested a different apportionment of costs because their representative had already travelled from America to the EPO, thereby incurring unnecessary costs. They argued that the respondents could have been represented by someone else from their patent attorney's firm. The board refused the request because there had been no recognisably wrongful or irresponsible conduct on the part of the other party. The board was of the opinion in particular that the respondents could not be expected to be represented by a different patent attorney, who would have had to prepare two oral proceedings in one day (one for an ongoing parallel case) and to travel as well.

In **T 154/90** (OJ 1993, 505) the opponents had initially insisted on oral proceedings, although the opposition division did not consider that they were necessary. However, **eight days** before the arranged date the opponents informed the opposition division that they wished to cancel the oral proceedings. For reasons of internal organisation at the EPO, the opposition division did not receive this letter until after the date of the oral proceedings. The board of appeal ruled that eight days was a sufficient period of time for the oral proceedings to be cancelled, since no evaluation of new facts or arguments was needed (the case was different in **T 10/82**, OJ 1983, 407). Since the letter was received too late for purely internal reasons, the opponents were not at fault. They were not obliged to bear a part of the costs of the other party. A change of opinion regarding the necessity of oral proceedings could not be regarded as culpable conduct either (see also **T 383/05**).

In **T 29/96** the respondent informed the board and appellant, **four working days** before the date set for oral proceedings, that it was abandoning the patent and no longer requesting oral proceedings. However, the declaration abandoning the patent was not completely unambiguous. The board refused the appellant's request that costs be awarded against the respondent; it had been clear that the oral proceedings would probably be superfluous and the appellant could have contacted the DG 3 Registry to find out about the course the proceedings would be taking.

In **T 490/05**, on the day before oral proceedings, the proprietor had withdrawn both his request for oral proceedings and his request to have the impugned decision set aside. Thus, even before oral proceedings it was clear that the impugned decision revoking the patent was sure to be made final. This gave him the advantage of being able to focus his preparations for the oral proceedings on the proprietor's request for apportionment of costs. Thus there were no reasons of equity for sharing the costs incurred by the opponent.

In **T 42/99**, appellant I announced, as early as one month prior to oral proceedings, that experts would attend those proceedings. Only shortly before the appointed date for the proceedings, appellant II submitted a request that statements by an expert be admitted at the oral proceedings. Appellant II also requested the postponement of the oral proceedings so that its expert would have enough time to prepare. The board decided to postpone the appointed date, however, in doing so, the board also regarded it as equitable to order a different apportionment of costs. In its reasons the board took the view that, although a reply from appellant II to the announcement by appellant I that experts would attend the oral proceedings would not have been possible within the time limit set by the board, a "response" to the aforementioned announcement should have followed immediately and not shortly before the appointed date for oral proceedings. At this late stage, it was plausible that the representative of appellant I had made arrangements for the trip to Munich and a hotel reservation, which could not be cancelled without a financial loss.

In **T 99/05**, the appellant submitted, 13 days before the oral proceedings, a new experimental report in view of which the respondent asked for postponement of the oral proceedings. The appellant strongly objected to such a postponement. Since, in the board's view, the question of postponing the oral proceedings was linked to the question of whether the late-filed experimental report should be introduced into the proceedings, the board deemed it appropriate to maintain the oral proceedings in order to hear the arguments of the parties concerning the relevance of the late-filed experimental report of the appellant, and hence to decide on the introduction or not of this report into the proceedings. However, the oral proceedings did not result in a final decision with regard to patentability and second oral proceedings were scheduled in order for the respondent to be allowed sufficient time to file counter-experiments. Whilst the late filing did not represent an abuse of proceedings, it was evident that the final outcome of the proceedings had been delayed. Therefore, the board found it appropriate for reasons of equity to order a different apportionment of costs.

In **T 556/96**, the appellant withdrew his request for oral proceedings **early in the afternoon preceding** the oral proceeding. By that time, the opposing party's representative had already set off. The board ruled that the appellant had withdrawn his request too late. The fact that the other party had also unconditionally requested oral proceedings was irrelevant; it too could have withdrawn the request, had it known in time that the appellant would not be attending. The board therefore ordered the appellant to pay the costs incurred by the respondent in preparing and attending the oral proceedings.

c) Other cases

An apportionment of costs is justified if excessive costs are incurred for the oral proceedings and caused mainly by one party (see **T 49/86**). The right to oral proceedings is absolute and therefore not subject to any conditions (**T 614/89**, **T 26/92**, **T 81/92** and **T 408/02**). If the party that requested oral proceedings fails to produce new arguments during them, that does not constitute abuse of procedure and is not a reason for awarding of costs, as consistently ruled in **T 303/86**, **T 305/86**, **T 383/87**, **T 125/89** and **T 918/92** (but not in **T 167/84**, OJ 1987, 369).

In **T 1022/93** the oral proceedings, which only the appellant had requested, were superfluous. Even in the written appeal procedure the appellant had refrained from communicating why, in its opinion, the amended process claims should be considered inventive and from specifying that the additional example described a process according to the amended set of claims. This made it impossible either to remit the case without oral proceedings or to deal with the substance of the case at the oral proceedings. For reasons of equity, therefore, the appellant was required pursuant to Art. 104(1) EPC 1973 to reimburse to the respondent the costs incurred as a result of the participation at the oral proceedings before the board.

In **T 905/91** the respondents had requested a different apportionment of costs on the grounds that the appellants had not brought prepared auxiliary requests to the oral proceedings, which had therefore continued into the afternoon. The board rejected the request for the following reasons. Firstly, the appellants had endeavoured to take account of the reservations expressed by the board and had filed new documents. Secondly, oral proceedings served specifically to clarify the situation completely through the direct exchange of arguments and, if necessary, to rephrase the patent application in the light of the outcome of the discussion. The duration of oral proceedings depended on the particular case; at any rate it was not unusual for such proceedings to continue into the afternoon, and the parties should be prepared for this.

In **T 210/98**, the respondent requested an apportionment of costs on the ground that the appellant had withdrawn three auxiliary requests at the beginning of the oral proceedings for which the preparation had been time-consuming. The board refused the request, stating that it was normal for parties to prepare themselves thoroughly for oral proceedings. A change of view was one of the situations with which a professional representative could be confronted during oral proceedings. As it was not exceptional for requests to be changed or withdrawn during oral proceedings as a result of the

discussion held, no abuse of procedure could be seen in the withdrawal of requests at the beginning of the oral proceedings, which had apparently been a reaction to convincing written arguments.

In **T 461/88** (OJ 1993, 295) the board decided that the appellants' insistence on hearing witnesses was clearly compatible with the principle of the responsible exercise of rights, as this may well have been the only means of proving the alleged public nature of the prior use. The board refused the request for apportionment of costs.

In **T 668/03** the appellant requested an apportionment of costs in view of the fact that oral proceedings had to be held for a second time. As a matter of fact, the former oral proceedings had to be adjourned because the identity of one of the opponents had been drawn into doubt by the appellant during the first oral proceedings. The board pointed out that it was the duty of the respondent to make it clear throughout the procedure who belonged to the group of common opponents. However, had the appellant raised this issue before the first oral proceedings, it could have been dealt with in writing and thus the costs for further oral proceedings could have been avoided. Therefore, the board could not detect any reasons of equity which could be used to order a different apportionment of costs (likewise **T 1404/10**).

### 6.2.3 Filing of opposition or appeal

Exceptions to the principle that each party must bear its own costs may also be made in cases of abusive conduct in which it is equitable to make an award of costs against one of the parties. An apportionment of costs is often requested on the grounds that the notice of opposition or appeal has been incorrectly filed. The fact that an appeal proves clearly inadmissible does not justify an award of costs if the appellant evidently has the subjective impression that he is adversely affected. A party which is of the opinion that the first-instance department has not acceded to its request may consider that it is adversely affected by the decision and may consequently decide to file an appeal. This is no more than its legitimate right to make use of the appeal procedure provided for in the EPC and to have the decision reviewed. Occasionally having to seek defence against unfounded or even inadmissible appeals is just one of the general risks of life and thus, in the absence of any further circumstances, does not justify a different apportionment of costs. The EPC makes no distinction between successful and unsuccessful appeals for the purposes of cost apportionment; so it cannot be argued that apportionment is justified if an appeal appears to be clearly inadmissible (**T 964/14**, **T 2177/12**, **T 614/89**, **T 772/95**).

In **T 170/83** the opponents had used an incorrect form for payment of the opposition fee, thereby giving rise to a decision by formalities to reject the opposition; the opponents thereupon filed an appeal against this decision. The patent proprietors (respondents) requested that the appeal costs be awarded against the appellants, since it was their error which had rendered the proceedings necessary. The board rejected the request, taking the view that the appeal proceedings were not improper. An abuse justifying the apportionment of costs could only be rooted in the party's conduct **during the proceedings**.

In a number of cases the boards took the admissibility or allowability of an opposition or an appeal to be an indication that no abuse had taken place (e.g. **T 7/88** and **T 525/88**). Similarly, in **T 506/89**, the board found that the opponent's filing of an appeal did not constitute an abuse of procedure and therefore rejected the request for a different apportionment of costs, since it had decided, in the oral proceedings, to maintain the patent as amended. Nor was there an abuse of procedure where the appeal was filed without new arguments (**T 605/92**) or where the appellant's chances of success were considered to be low (**T 318/91**). According to **T 717/95** no abuse has taken place if a party to the proceedings misinterpreted the content of a citation when comparing it with the subject-matter claimed in the disputed patent.

In **J 22/12**, it was disputed whether an appeal against a communication issued on behalf of the examining division could be admissible. The board found that this was not the case. It considered that the filing of an opposition and of a subsequent appeal in the matter could not be considered as an abuse of procedure as they were actions which used the provisions of the EPC for the ends envisaged by those provisions. Thus the board found it appropriate that each party should bear its own costs.

#### 6.2.4 Withdrawal of opposition or appeal at short notice

An appellant is entitled to withdraw his appeal at any time. Based on the principle of free party disposition, this right may not be restricted, even implicitly by the threat of cost apportionment, on the grounds that oral proceedings have been scheduled and the opposing party cannot be notified in time. As a rule, the benefits that respondents derive from the withdrawal of the appeal will offset the costs that they incur, even if they are avoidable. That is the case even if the appeal is only formally pending on account of the request for cost apportionment (**T 490/05**).

In **T 85/84** the appellants withdrew the appeal in a telex to the EPO and the respondents' representative **48 hours** before the date of the oral proceedings. By the time the respondents' representative found out, he had already departed in order to prepare for the oral proceedings in Munich. The board conceded that the appeal had been withdrawn at extremely short notice but did not order apportionment of the costs, as the respondents' representative had still been informed in due time that the oral proceedings would not be taking place. Internal delays in forwarding the communication were not the fault of the appellants. The representative's departure for Munich a day before the oral proceedings was not warranted by the distance and therefore not necessary from the point of view of the oral proceedings.

In **T 614/89** and **T 772/95**, in which the appeals were withdrawn respectively four and three days before the date set for oral proceedings, the boards ruled that the short notice alone did not constitute an abuse of procedure. The same decision was reached in **T 674/03**, where the opponent withdrew its appeal **nine days** before the date set for the oral proceedings. The board held that the exercise of an absolute procedural right did not, in principle, constitute abuse and that there was no evidence of improper or negligent conduct.

### 6.2.5 Other cases

In **T 952/00**, the board found that the wrongful act, whether intentional or simply the result of culpable negligence, had to be judged in the light of the normal behaviour of an ordinarily diligent party. It also had to be the direct cause of the costs in suit. In the case in point, it transpired that the proprietor had culpably made inaccurate statements in the course of the proceedings. The board concluded that without those false statements the opponent (appellant) would not have been required to go to the expense of gathering further evidence. Its request for an apportionment of the costs it had incurred during taking of evidence after notification of the decision at first instance was therefore granted.

In **T 269/02** the appellant had been given sufficient opportunity during the protracted written proceedings and at the oral proceedings before the opposition division to amend its claims to alleviate the problem under Art. 123(2) EPC 1973. However, the appellant had chosen not to do this, with the result that the patent was revoked on the ground of Art. 123(2) EPC 1973, rendering necessary the present appeal proceedings which dealt solely with the issue of amendment. In view of this, the respondent argued that the appellant's conduct had been far from exemplary and, if the appeal were to be allowed, and the case remitted to the opposition division, the appellant should be made to bear the costs incurred as a result of the present appeal proceedings. Contrary to the respondent's assertions, the board stated that in cases such as the present, where the patent had been revoked in opposition proceedings, the appellant must be given the opportunity to study the decision of the opposition division duly substantiated in writing in order to enable it to decide on the **formulation of appropriate requests** for the appeal proceedings. In these circumstances, the board did not find that the appellant had abused or exceeded its legitimate rights, thereby arbitrarily causing the respondents to incur costs which, in all fairness, ought to be reimbursed. The request for an apportionment of costs was therefore refused.

Similarly, the circumstances underlying **T 916/05** did not, according to the board, justify a different apportionment of costs. The fact that some of the arguments had not been presented before and could have been filed in oral proceedings before the opposition division, had such proceedings taken place, was in the board's opinion irrelevant and could not be regarded as an abuse of procedure. In fact, an appellant could not be prevented from choosing a **different line of arguments** when making its case before a board of appeal.

In **T 162/04** the respondent requested a different apportionment of costs because it had had to invest a considerable amount of time and effort in considering the numerous requests submitted by the appellant during the appeal proceedings. However, the appellant's requests were later **withdrawn** rendering the time and effort of the respondent, in its view, useless. In the board's judgment, such conduct did not amount to an abuse of procedure. Indeed, the conduct of the appellant, who by withdrawing the contested requests and by **replacing** them with other requests was apparently trying to overcome the objections which had been raised, was not as such objectionable but had

to be considered as a legitimate defence of its case. The request for an apportionment of costs was therefore refused (likewise **T 967/12**).

The request for apportionment of costs made by the respondent in case **T 248/05** was mainly based on the alleged **lack of clarity** of the category of claim 1 as granted and the vagueness in this respect of the appellant's submissions in the statement setting out the grounds of appeal. The board held, however, that the alleged lack of clarity of the category of the claimed subject-matter and the possible associated additional costs which could be incurred by a clarification of this subject-matter would not justify an apportionment of the respondent's costs on the appellant. Firstly, the criticised elements of claim 1 and the alleged vagueness of the statement setting out the grounds of appeal were entirely irrelevant for the subject-matter of the appeal in point, i.e. the findings of the opposition division on added subject-matter. Secondly, lack of clarity of a claim or of a submission could hardly be regarded as an abuse of procedure unless this were intentional. The board therefore saw no legal basis for any apportionment of costs.

### 6.3. Procedural aspects

#### 6.3.1 Filing a request for apportionment of costs

The practice before the boards of appeal is that all requests by parties, including any requests as to costs, should be made before any decision is announced in oral proceedings, as the decision on apportionment is part of the final decision (see R. 88(1) EPC re opposition proceedings). In **T 212/88** (OJ 1992, 28), though, **by way of exception** the request for apportionment was also considered later, because at that time this practice had not been published and the parties were therefore unaware of it.

The decision on costs may also be taken in isolation if the opposition and the appeal have been withdrawn (**T 85/84**, **T 765/89**).

There is no basis for deciding on a different apportionment of costs if the party which would benefit from the decision did not request apportionment and even made it known that it would not enforce any such decision (**T 408/91**, **T 125/93**).

A request for apportionment of costs submitted by the respondent merely as a party to the appeal proceedings as of right (Art. 107, second sentence, EPC 1973) must be rejected as inadmissible as it would otherwise contravene the principle of equal treatment (**T 753/92**, **T 514/01**, **T 1237/05**).

In several decisions, the boards of appeal have stressed the importance of submitting evidence to support a request for a different apportionment of costs (e.g. **T 49/86**, **T 193/87**, **T 212/88**, OJ 1992, 28; **T 404/89**, **T 523/89**, **T 705/90**, **T 776/90**, **T 306/93**). Thus 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 193/87** (OJ 1993, 207) the board likewise refused to apportion costs because the respondents had provided no evidence and it was unable to see any reasons of equity that might have justified such an apportionment.



### 6.3.2 Competence issues

In **T 765/89** it was stressed that the board was still responsible for deciding on the request that costs be awarded against the appellants even if the latter had withdrawn their appeal. Where an opponent (respondent) withdraws his opposition during appeal proceedings, he ceases to be a party to the appeal proceedings as far as the substantive issues are concerned but retains his party status in so far as the question of apportionment of costs is still at issue (**T 789/89**, OJ 1994, 482).

According to the board in **T 1059/98**, apportionment of the costs of proceedings before the opposition division could not be requested for the first time on appeal, because the boards of appeal could only review decisions taken by a department of first instance and so had no competence to decide on such requests (see also **T 1273/11**). As a matter of principle costs are not apportioned in transfer proceedings (**J 38/92**, OJ 1995, 8).

### 6.3.3 Apportionment of costs

Under R. 88(1) EPC (R. 63(1) EPC 1973) the decision on **apportionment of costs in opposition proceedings** may consider only the expenses necessary to ensure proper protection of the rights involved (**T 167/84**, OJ 1987, 369; **T 117/86**, OJ 1989, 401; **T 416/87**, OJ 1990, 415; **T 323/89**, OJ 1992, 169). The order for apportionment of costs should be such as to compensate the other party for the unnecessary costs which it has incurred as the direct result of the appellant's failure in its duty (**T 212/07**, **T 952/00**). On the costs of interpreting at oral proceedings, see Chapter III.C.5.2.

Under R. 88(1), third sentence, EPC, the costs include the remuneration of the parties' representatives. In **T 854/09** the board stated that the costs concerned were those reasonably incurred by the opponent. In this case, where an adjournment of oral proceedings was necessary, this included the expense of a single representative preparing for and attending the second proceedings, including travel and accommodation. Under R. 88(2), last sentence, EPC, costs may be fixed once they have been established as credible. The request must be accompanied by a bill of costs and supporting evidence. The board in **T 475/07** exceptionally took the view that a detailed cost calculation was superfluous. It worked on the assumption that the representative could calculate on the basis of one day for preparing the additional oral proceedings and one day for attending them. The cost estimate of EUR 2 300 thus seemed credible.

In **T 930/92** (OJ 1996, 191) the board held that, when fixing the amount of costs to be paid to a party, in addition to the remuneration of the professional representative of that party, the expenses incurred by an employee of that party in order to instruct the professional representative before and during oral proceedings could be taken into consideration under R. 63(1) EPC 1973, if such instruction was necessary to assure proper protection of the rights involved. In **T 326/87** (OJ 1992, 522), all the costs incurred as a result of the remittal to the department of first instance were deemed to be apportionable.

According to Art. 16 RPBA, **the costs ordered to be paid in appeal proceedings** may be all or part of those incurred by the receiving party and may inter alia be expressed as a percentage or as a specific sum. In the latter event, the board's decision is a final decision for the purposes of Art. 104(3) EPC. The costs ordered may include costs charged to a party by its professional representative, costs incurred by a party itself whether or not acting through a professional representative, and the costs of witnesses or experts paid by a party but shall be limited to costs necessarily and reasonably incurred.

a) Future costs

The prevailing view in the boards' case law is that they should not take a decision on the apportionment of future costs because they have no basis for assessing them and lack jurisdiction (**T 1178/04**, OJ 2008, 80). Thus the board in **T 758/99** held that a decision on the apportionment of **future** costs in appeal proceedings caused by the late filing of documents depended on the course of the subsequent procedure and, in the absence of the necessary facts, could not be decided at that stage (see also **T 133/06**). For these reasons the board deviated from the judgment given in **T 611/90**, in which the legitimately incurred future costs had been apportioned. The board remitted the case to the department of first instance and ordered that a decision on the request for apportionment of costs would be taken at a later stage (see also **T 223/95**, **T 758/99**, **T 890/00**, **T 1182/01**, **T 48/00** and **T 758/99**).

In **T 369/08** the board also stated that it was apparent that the costs arising would depend on the course of the future proceedings. According to the board, the consequence of this is that the board necessarily is not in possession of the necessary facts to decide upon an apportionment of costs. Consequently the Board considered it appropriate not to make an open-ended order of apportionment of costs as had been done in the aforementioned **T 611/90**.

In **T 1282/08** the board noted that in some cases some boards of appeal ordered the apportionment of future costs (see **T 847/93**, **T 715/95**) and the scenarios facing these other boards might have been different in the above-cited cases. Nevertheless, the board had difficulty seeing how it could make a decision, at the remittal stage, on the apportionment of costs yet to be incurred in subsequent proceedings, the course and outcome of which were still open to speculation. Hence the possible apportionment of opposition costs was to be decided by the opposition division at the end of the opposition proceedings.

b) Procedure for fixing costs

Under R. 88(2) EPC, costs will be fixed by an apportionment decision under Art. 104(1) EPC only at the written request of the entitled party. The request must be filed with the registry of the opposition division and is not subject to a time limit. Under R. 88(3) EPC, a request for a decision by the opposition division on the amount fixed by the registry must be filed within one month of the **communication** on the fixing of costs. It must be filed in writing and state the grounds on which it is based. It is not deemed to

be filed until the fee prescribed in Art. 2(16) RFEes has been paid. Thus the requirements are largely the same as for appeals.

In **T 668/99**, the question was raised as to whether the prohibition of *reformatio in peius* also applies if the proceedings are not referred to a higher level of jurisdiction but are continued within the same level of jurisdiction, as is the case with a **legal remedy against the fixing of the costs** by the opposition division registry. The board recalled that an appeal and a request for an opposition division decision have far more similarities (suspensive and devolutive effect) than differences, and so the position of the sole requester is comparable to that of the sole appellant. The board was therefore satisfied that the prohibition of *reformatio in peius* also had to apply to a request under Art. 104(2), second sentence, EPC 1973.

Where the **boards of appeal** have to rule on the apportionment of costs, they have the power under Art. 104 EPC (Art. 111(1) EPC 1973) and having due regard to Art. 113(1) EPC 1973, not only to apportion but also to fix the costs (see e.g. **T 934/91**, OJ 1994, 184; **T 323/89**, OJ 1992, 169; **T 930/92**, OJ 1996, 191). The scope of the apportionment depends on the specific circumstances of the individual case. The party to the proceedings who caused the additional costs may be ordered to pay all or a part of those costs (**T 323/89**, OJ 1992, 169).

Since the filing of new material after expiry of the opposition period may cause the other party to incur additional costs, the board, in **T 117/86** (OJ 1989, 401), ordered that the appellant should pay the respondent 50% of his representative's costs in preparing and filing the response to the appeal (see also **T 83/93**).

In **T 715/95**, new documents were submitted only in the appeal proceedings, and the delay was not justified. However, the board admitted the documents, remitted the case to the department of first instance and ordered the late-filing party to bear 50% of the cost of the oral proceedings. Similarly, in **T 45/98**, the appellant submitted new documents only in the appeal proceedings, and they were admitted. The case was not remitted to the department of first instance, but the appellant was ordered to pay 45% of the costs incurred in the appeal proceedings by the respondent's representative.

#### 6.3.4 Appeal solely against the decision on costs inadmissible

R. 97(1) EPC (Art. 106(4) EPC 1973) states that the apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. As a rule, therefore, an appeal relating to apportionment of costs must be regarded as inadmissible if the appeal relating to the revocation of a patent is rejected as inadmissible for lack of merit and there is no other admissible request. However, if the impugned decision did not take into account the withdrawal of the request for oral proceedings and is thus based on a substantial procedural violation, the part of the impugned decision relating to apportionment of costs must be set aside (see e.g. **T 154/90**, OJ 1993, 505).

In **T 1237/05** the board found that the opponent, not being adversely affected by the patent's revocation, was not entitled to appeal solely against the apportionment of costs.

The opponent's appeal, in view of Art. 106(4) EPC 1973, was inadmissible on that count alone. The mere fact that an appeal, in this case the proprietor's, was admissible did not in itself make the opponent's appeal admissible (the opponent in any case not being adversely affected by the first-instance decision on the merits) because it related only to cost apportionment. A distinction had to be drawn between appeal proceedings (initiated by at least one admissible appeal) and an appeal lodged by a party; the wording of Art. 106(4) EPC 1973 clearly referred to an appeal lodged by one of the parties to the proceedings, regardless of the existence of other appeals lodged by the other parties.

In **T 753/92** respondents I were adversely affected by the decision under appeal only in so far as their request for apportionment of costs was rejected. If respondents I had lodged an appeal against this decision, the appeal, with the apportionment of costs as its sole subject, would have been inadmissible under Art. 106(4) EPC 1973.

In **T 668/99**, the board took the view that, since no appeal had been lodged against the opposition division's decision on costs, that decision had become final upon expiry of the time limit for filing a notice of appeal. It found that the decision on costs mentioned in the request had not been submitted with the appeal, nor was there any indication of an implicit challenge to that decision. The board held that, unlike general procedural requirements, which - as had been consistently held - had to be reviewed at all times, including in the appeal procedure, the issuance of a decision on costs by the EPO did not necessarily mean that a decision had also to be reviewed by the EPO. The review of a decision at a higher level of jurisdiction required an appeal by one of the parties.

In **T 420/03** the question arose whether the "additional decision" concerning the apportionment of costs fell within the scope of appeal. While the notice of appeal remained completely silent as regards the decision on the apportionment of costs, the request for cancellation of this decision was contained in the statement setting out the grounds of appeal. In the case before it, the board found that the notice of appeal did not contain any explicit statement concerning the apportionment of costs, and there was no other statement in the notice of appeal which could be interpreted - at least indirectly - that this was also the subject of the appeal.

**D. Opposition procedure**

1.	Legal character of opposition proceedings and applicable principles	1006
2.	Filing and admissibility requirements	1008
2.1.	Entitlement to file an opposition	1008
2.1.1	General	1008
2.1.2	Examination at any stage in the proceedings of entitlement to oppose	1009
2.1.3	Filing of opposition by patent proprietor or inventor	1009
2.1.4	Filing of opposition on behalf of a third party - straw man	1010
2.1.5	Repeated filing of an opposition by the same person	1011
2.1.6	Filing of multiple oppositions by different persons	1012
2.1.7	Filing a joint opposition - multiple opponents	1012
	a) Payment of a single opposition fee	1012
	b) Representation, legal status and composition of a multiple opponent	1012
2.2.	Formal requirements for opposition and filing in due time	1014
2.2.1	Introduction	1014
2.2.2	Start of opposition period	1014
2.2.3	Payment of opposition fee	1014
2.2.4	Identity of opponent and correction of opponent's name	1015
2.2.5	Title of invention	1017
2.2.6	Statement of extent of opposition	1017
2.2.7	Statement of grounds for opposition	1018
2.2.8	Indication of facts, evidence and arguments – substantiation of grounds for opposition	1019
2.2.9	Groups of cases	1022
	a) Sufficient substantiation of grounds for opposition	1022
	b) Insufficient substantiation of grounds for opposition	1022
	c) Alleged public prior use	1023
2.2.10	Other requirements for notice of opposition	1025
2.3.	Procedural aspects of examination of admissibility	1026
2.3.1	Formalities officers' powers in opposition proceedings	1026
2.3.2	Admissibility of opposition to be checked at every stage	1026
2.3.3	Rejection of opposition as inadmissible	1027
3.	Substantive examination of opposition	1027
3.1.	Introduction	1027
3.2.	Extent of opposition	1028
3.3.	Scope of examination of grounds for opposition	1028
3.4.	Fresh grounds for opposition	1030
3.4.1	General	1030
3.4.2	Objections of lack of novelty and lack of inventive step	1031
3.4.3	Grounds raised against amended claims	1033
3.4.4	Scope of examination of new grounds for opposition by opposition division	1033
3.4.5	Examination of fresh facts and evidence	1035
3.4.6	Opportunity to comment on new grounds for opposition	1035
4.	Amendments in opposition proceedings	1037

4.1.	Admissibility of amendments	1037
4.1.1	General	1037
4.1.2	Amendments occasioned by national prior rights	1040
4.1.3	Time frame for filing amendments	1040
4.1.4	Filing amendments	1042
	a) Filing new dependent claims (sub-claims)	1042
	b) Filing new independent claims	1043
	c) Applicability of Rule 43(2) EPC in opposition proceedings	1044
4.1.5	Amendments intended to remedy a lack of clarity	1045
4.2.	Scope of examination of amendments	1046
4.2.1	General	1046
4.2.2	Extent of power to examine amended claims for compliance with Article 84 EPC	1047
4.3.	Removal of error (in claim) in opposition proceedings	1049
5.	Right to be heard in opposition proceedings	1050
5.1.	Principle of equal treatment	1050
5.2.	Invitation to file observations under Article 101(1) EPC	1050
5.3.	Invitation to file observations under Rule 82(1) EPC	1052
5.4.	EPO communication concerning submissions by the other party - adequate opportunity to reply	1052
5.5.	Opportunity to present comments	1054
6.	Acceleration of opposition proceedings in the case of pending infringement proceedings	1055
7.	Decisions of opposition division	1056
7.1.	Revocation of a European patent by way of decision	1056
7.2.	Interlocutory decisions	1056
7.2.1	General	1056
7.2.2	Maintenance of European patent as amended	1057

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## 1. Legal character of opposition proceedings and applicable principles

According to Art. 99(1) EPC, within nine months of the publication of the mention of grant of the European patent any person may give notice to the EPO of opposition to that patent. Opposition proceedings (see Art. 99 to 105 and R. 75 to 89 EPC) constitute an exception to the general rule under the EPC that after grant a European patent is no longer within the competence of the EPO but becomes a bundle of patents within the jurisdiction of the designated contracting states. They allow, during a limited period of time, a centralised action for revocation of a European patent to be brought before and decided by the EPO.

Opposition is an independent procedure following the grant procedure (T 198/88, OJ 1991, 254). It is not designed to be an extension of the examination procedure (G 1/84, OJ 1985, 299). As explained in G 9/91 and G 10/91 (OJ 1993, 408 and 420), it takes place at a point in time when the proprietor is enjoying in each designated contracting state the same rights as would be conferred by a national patent granted in that state

(Art. 64 EPC). The relief sought by the opponent is 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 EPC). Furthermore, the grounds for opposition (Art. 100 EPC) being limited to and essentially the same as the grounds for revocation under national law (Art. 138 EPC), the concept of post-grant opposition under the EPC differs considerably from that of pre-grant opposition. The opposition procedure before the EPO thus has several important features more in common with the concept of the traditional revocation procedure and its effect is more similar to that of such a procedure. This characteristic is further emphasised by the addition at a late stage in the preparation of the EPC of the possibility to oppose a European patent even if it has been surrendered or has lapsed for all contracting states (Art. 99(3) EPC 1973; see now R. 75 EPC and also **T 606/10**).

Post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties who normally represent opposing interests and who should be treated equally fairly (**G 9/91** and **G 10/91**, OJ 1993, 408 and 420). As soon as the notice of opposition has been filed, the procedure automatically becomes bilateral, no matter whether the opposition is valid, admissible or allowable. The Convention does not provide for a decision by an opposition division "to end the *ex parte* proceedings" (**T 263/00**). R. 79(1) EPC (cf. R. 57(1) EPC 1973) requires the opposition division to communicate the opposition to the proprietor of the patent, and the Guidelines D-IV, 1.5 (November 2015 version) provide that communications and decisions about whether the opposition is deemed to have been filed and is admissible are also to be notified to the patent proprietor. Concerning the contentious nature of opposition proceedings, see also parallel cases **T 1553/06** and **T 2/09** in this chapter IV.D.2.1.4.

The opposition procedure is a purely administrative procedure. It differs fundamentally from the appeal procedure, which must be regarded as a judicial procedure and is, by its very nature, less investigative (see **G 7/91** and **G 8/91**, OJ 1993, 356 and 346; **G 9/91**, OJ 1993, 408). Unlike an appeal, opposition has neither suspensive effect nor the effect of transferring the case to a superior instance (see **T 695/89**, OJ 1993, 152).

According to the principle of party disposition (cf. **G 2/92** and **G 4/93**, OJ 1994, 875), the request of the opponent determines the extent to which the patented subject-matter may be examined in opposition.

In opposition proceedings, the EPO must investigate the facts of its own motion (Art. 114(1) EPC). However, certain restrictions have been placed on this 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 (**G 2/92** and **G 4/93**, OJ 1994, 875).

Under the EPC, there is no legal obligation for the patent proprietor to take an active part in opposition proceedings. However, the patent proprietor is not free to present or complete his case at any time that he wishes during the opposition or opposition appeal proceedings (**T 936/09** – see also summary in Chapter IV.E.4.3.2c) and decision **T 167/11**).

As opposition is an independent procedure which takes place after the grant procedure, a document considered in examination proceedings is not automatically scrutinised in opposition or opposition appeal proceedings, even if quoted and acknowledged in the contested European patent (**T 198/88**, OJ 1991, 254).

## 2. Filing and admissibility requirements

### 2.1. Entitlement to file an opposition

#### 2.1.1 General

In **G 3/97** and **G 4/97** (OJ 1999, 245 and 270) it was held that the legislator explicitly designed the opposition procedure as a legal remedy in the public interest which, according to Art. 99(1) EPC, is open to "any person".

According to the Enlarged Board, an opponent's status is a procedural status, and the basis on which it is obtained is a matter of procedural law. This is addressed in Art. 99(1) EPC in conjunction with Art. 100, R. 76 and R. 77(1) EPC (cf. R. 55 and R. 56(1) EPC 1973). The opponent is the person who fulfils the requirements set out therein for filing an opposition; in particular the person must be identifiable (R. 76(2)(a), R. 41(2)(c) EPC; cf. R. 55(a) EPC 1973; see also in this Chapter IV.D.2.2.4). The EPC does not specify any further formal conditions to be met by the opponent. A person who fulfils the said requirements becomes a party to the opposition proceedings (Art. 99(3) EPC; cf. Art. 99(4) EPC 1973).

Thus, the EPC does not require that the opponent have his own interest in the outcome of the opposition proceedings. As early as in **G 1/84** (OJ 1985, 299) the Enlarged Board held that the motives of the opponent were in principle irrelevant (otherwise, no doubt, the phrase "any person" would have been rendered as "any person interested"), whilst his identity was primarily of procedural importance (similarly in **T 635/88**, OJ 1993, 608; **T 590/93**, OJ 1995, 337). Following that case law, the board in **T 798/93** (OJ 1997, 363) found that the EPC and its attendant provisions contained no requirements as to the opponent's personal circumstances or motives for acting. Requests for the opposition to be declared inadmissible therefore had to be refused if, as in the case under consideration, they were based on either an objection regarding a particular aspect of the opponent's status, such as his profession (professional representative before the EPO) or his field of technical expertise (different from that of the opposed patent), or on his lack of motives for acting (statement by the opponent saying that his only reason for acting was to complete his training).

According to **T 353/95**, only an existing natural or legal person can be a party to opposition proceedings and this applies also at the appeal stage since Art. 107, first sentence, EPC makes no different provision (R. 66(1) EPC 1973; cf. R. 100(1) EPC).



### 2.1.2 Examination at any stage in the proceedings of entitlement to oppose

An objection that an opposition is inadmissible because the opponent was not entitled to file it may be raised at any stage of the proceedings, i.e. even at a late stage before the board of appeal, because the admissibility of the opposition is an indispensable procedural requirement for any substantive examination of the opposition submissions and is therefore to be examined *ex officio* (see **T 289/91**, OJ 1994, 649; **T 590/94**, **T 522/94**, OJ 1998, 421; **T 1178/04**, **T 384/08**). Following the principle established by board of appeal case law that the admissibility of an opposition is examined by the EPO of its own motion, if the board has good reasons for examining the admissibility of an opposition (**T 199/92**), it may and is obliged to do so, even if the patent proprietor has not challenged admissibility during either opposition or appeal proceedings (**T 541/92**). In **G 3/97** and **G 4/97** (OJ 1999, 245 and 270), the Enlarged Board of Appeal reaffirmed that the admissibility of an opposition could be challenged during the appeal proceedings on grounds relating to the identity of an opponent, even if no such objection had been raised before the opposition division.

During the appeal underlying **G 1/13** (OJ 2015, A42), the proprietor had challenged the admissibility of the opposition because the opponent company had ceased to exist during the proceedings before the opposition division. By court order, the company was then restored with retrospective effect. The Enlarged Board held that where an opposition is filed by a company which subsequently, under the relevant national law, ceases to exist, but is subsequently restored to existence under a provision of that national law, by virtue of which the company is deemed to have continued in existence as if it had not ceased to exist, all these events taking place before a decision of the opposition division maintaining the opposed patent in amended form becomes final, the EPO must recognise the retroactive effect of that provision of national law and allow the opposition proceedings to be continued by the restored company (see also Chapter IV.E.2.4.3c) "Retrospective restoration of a company").

For decisions concerning **transfer of opponent status**, see Chapter IV.C.2.2.

The status of opponent can also be acquired by an **assumed infringer** who has **intervened** in pending opposition proceedings (see Chapter IV.C.3 "Intervention").

### 2.1.3 Filing of opposition by patent proprietor or inventor

Given the purpose and special nature of the opposition procedure, patent proprietors may not oppose their own patent. In **G 9/93** (OJ 1994, 891), the Enlarged Board of Appeal departed from the view taken in **G 1/84** (OJ 1985, 299) and held that patent proprietors were not covered by the expression "any person" used in Art. 99(1) EPC 1973. The provisions of Part V of the EPC and the corresponding Implementing Regulations were clearly based on the assumption that the opponent was a person other than the patent proprietor and that the opposition proceedings were always *inter partes*. The case law established in **G 1/84** on this point is thus obsolete.

In **T 3/06** the patentee argued, with reference to **G 9/93** (OJ 1994, 891), that opponent 2 as the inventor of the patent in suit, being a shareholder of the patent proprietor, could not validly file an opposition even if the plain language definition of "any person" in Art. 99(1) EPC did not prevent inventors from filing an opposition. The board held the patent proprietor and the opposing inventor to be different persons. The inventor, although a shareholder in the patent proprietor, was not an executive of the company, nor did he have any substantial influence on commercial and judicial decisions concerning the business of the patent proprietor. In particular, the patent assignment contracts constituted evidence that this right lay exclusively with the patent proprietor.

A procedure for limitation or revocation of a European patent at the request of the patent proprietor is now provided for under Art. 105a to 105c EPC (see also Chapter IV.C.5).

#### 2.1.4 Filing of opposition on behalf of a third party - straw man

With regard to the question whether an opposition is inadmissible if the opponent is a "straw man" acting for some other person, the Enlarged Board of Appeal clarified in **G 3/97** and **G 4/97** (OJ 1999, 245 and 270) that the opponent is the person who fulfils the requirements of Art. 99(1) in conjunction with Art. 100 EPC, R. 55 and 56(1) EPC 1973 (now R. 76 and 77(1) EPC). Filing the opposition renders this person formally the legitimate opponent. The fact that the opponent is acting on behalf of a third party does not render the opposition inadmissible. It is however inadmissible if the opponent's involvement is to be regarded as circumventing the law by abuse of due process. Such circumvention of the law arises, **in particular**, if:

- the opponent is acting on behalf of the patent proprietor. According to **G 9/93** (OJ 1994, 891), a proprietor cannot oppose his own patent; opposition is an inter partes procedure, so the patentee and opponent must be different persons.

- if the opponent is acting on behalf of a client in the context of activities which, taken as a whole, are typically associated with professional representatives, without possessing the necessary qualifications (Art. 134 EPC 1973). This would be the case if a person not entitled to act as a professional representative were acting on a client's behalf and carrying out all the activities typically carried out by professional representatives, while himself assuming the role of a party in order to circumvent the prohibition on his acting as a professional representative.

However, circumvention of the law by abuse of process **does not arise merely** because a professional representative files an opposition in his own name on behalf of a client. In any case, the principle of the free evaluation of evidence applies. The burden of proof lies with the person alleging that the opposition is inadmissible. The deciding body has to be satisfied, on the basis of clear and convincing evidence, that such abuse is occurring.

Previously relevant case law (see **T 10/82**, OJ 1983, 407; **T 635/88**, OJ 1993, 608; **T 25/85**, OJ 1996, 81; **T 582/90**, **T 289/91**, OJ 1994, 649; **T 548/91**, **T 339/93**, **T 590/93**, OJ 1995, 337; **T 798/93**, OJ 1997, 363) has been superseded by **G 3/97** and **G 4/97**.

Parallel cases **T 1553/06** and **T 2/09**, involving the same parties but different patents, were heard by the same board. Considering the admissibility of the respective oppositions, the board examined in particular whether the parties and their representatives had worked together on a test case in order to obtain answers from the EPO to specific legal questions regarding prior art. Following the principles set out in **G 9/93** and **G 3/97**, the board emphasised the contentious nature of opposition proceedings as a necessary condition for the admissibility of the opposition and examined whether an abuse of procedure, i.e. because the opponent acted on behalf of the patent proprietor ("straw man"), rendered the opposition inadmissible. The board could not find a circumvention of the law by abuse of process as it saw no reason to doubt the parties' submissions that the opponent was not bound by any instructions from the patentee or the study committee. Nor did the board see any reason to question that the proceedings were contentious in nature. An opposition filed within the framework of a test case was not inadmissible for that sole reason, provided that the prosecution of the proceedings thereby instituted was contentious because the parties defended mainly opposing positions. The respective oppositions were therefore deemed admissible.

#### 2.1.5 Repeated filing of an opposition by the same person

According to **T 9/00** (OJ 2002, 275), the repeated filing of an opposition by the same person could be objected to for lack of legitimate interest. A (legal) person who filed two different notices of opposition against the same patent acquired party status as an opponent only once, even if both notices complied with the requirements of Art. 99(1) EPC and R. 55 EPC 1973 (now R. 76 EPC). Both oppositions in question gave lack of novelty and lack of inventive step as grounds. Since the later opposition did not entail any change in the legal situation in the opposition proceedings compared to the earlier one, the board dismissed it as inadmissible for lack of a general legitimate interest. Nor could such an interest be inferred from the fact that the later opposition was assigned to a different part of the company and only that part of the company had been transferred to a third party. The status of opponent could pass to a third party only if both parts or the entire company were transferred to it.

In **T 774/05**, a notice of opposition was filed on one day, enclosing a cheque for the opposition fee but no reasoned statement. On the following day further documents were filed which included patent documents and a reasoned statement referring to a notice of opposition. According to the board, the opponent's intention was to maintain a single opposition, as evidenced by the statement in the faxes that the cheque for the opposition fee presented the day before should be used for the opposition. The only indication of separate oppositions was the fact that both the document filed initially and the faxes of the following day each stated that they were an opposition. This was not an indication, however, of an intention on the part of the opponent to file two oppositions but rather an indication of their content. Taking all these documents together, the board considered that the opponent had filed only one opposition, for which the requirements for a valid filing were completed within the opposition period. The opposition was therefore admissible.

In **T 966/02**, the same opponent had filed two oppositions, the second of which cited document D1, on which the opposition division based its decision. The main issue was whether the opposition division had been competent to use the document cited in the second opposition. The board stated that, irrespective of whether or not the second opposition filed had to be regarded as admissible, the first opposition had been filed in due form and time and was therefore admissible. Hence there was no need to decide whether the second opposition was admissible, since the department of first instance was, in any event, competent to take account of both document D1 and any other relevant material of its own motion (Art. 114 (1) EPC).

#### 2.1.6 Filing of multiple oppositions by different persons

According to Art. 99(3) EPC, opponents are parties to the opposition proceedings as well as the patent proprietor. It is clear from this provision that multiple admissible oppositions do not initiate a corresponding number of parallel opposition proceedings but only a single one. Each opponent can rely on an opposition ground duly submitted by other opponents and communicated to all parties in accordance with R. 79(2) EPC, both in the opposition proceedings and in any subsequent appeal proceedings (**T 270/94**, **T 620/99**, **T 774/05**).

#### 2.1.7 Filing a joint opposition - multiple opponents

##### a) Payment of a single opposition fee

In **G 3/99** (OJ 2002, 347), the Enlarged Board of Appeal held that an opposition filed in common by two or more persons, which otherwise met the requirements of Art. 99 EPC and R. 1 EPC 1973 (cf. R. 3 EPC) and R. 55 EPC 1973 (cf. R. 76 EPC), was admissible on payment of a single opposition fee. The payment of the opposition fee was linked to the filing of an opposition and not to the number of persons who filed the opposition. There was no procedural difference with respect to an opposition filed by a single natural person, by a single legal person or by a single body equivalent to a legal person by virtue of the law governing it. With respect to the wording "any person" in Art. 99(1) EPC and its interpretation in line with Art. 58 EPC, the Enlarged Board held that, as regards an opposition filed in common by a plurality of persons, the common opponents had to be either a natural person, a legal person, a body equivalent to a legal person by virtue of the law governing it or a combination thereof.

##### b) Representation, legal status and composition of a multiple opponent

In **G 3/99** (OJ 2002, 347), the Enlarged Board also held that, in an opposition filed in common, there had to be in all cases a **common representative** (Art. 133(4) and R. 100 EPC). Only that common representative is entitled to act in the opposition proceedings on behalf of all the common opponents taken as a whole and to sign the filed documents. Since the EPO treats a procedural act performed by a non-entitled person in the same way as a missing signature (see **T 665/89**), each common opponent or any other person acting on his behalf could perform such an act to avoid missing a deadline, provided the deficiency is remedied within an additional period set by the board

in the communication under R. 36(3) EPC 1973 (cf. R. 50(3) EPC), notified to the common representative and sent for information to the non-entitled person who performed the act. The deficiency is remedied once the procedural act is signed by the common representative.

According to the Enlarged Board, in order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it had to be clear throughout the proceedings who belonged to the group of common opponents or common appellants. If either a common opponent or appellant (including the common representative) intended to withdraw from the proceedings, the EPO had to be notified accordingly by the common representative or by a new common representative determined under R. 100(1) EPC in order for the withdrawal to take effect.

Referring to this case law in its interlocutory decision in **T 482/02** of 9.02.2005, the board stated that, where it was doubtful whether an opposition had been filed on behalf of a body which enjoyed legal personality in its own right or on behalf of several natural persons acting in common, the opponents (here a UK partnership) should be invited to establish that the body was a legal person or an equivalent thereto. If this was not established, the opposition was to be considered as having been filed on behalf of the several natural persons as common opponents (see also **T 866/01**). In that case the opponents still had to furnish the names and addresses of the partners in order to comply with R. 55(a) EPC 1973 (cf. R. 76(2)(a) EPC). If this information was not received within a period specified by the board, the opposition had to be rejected as inadmissible under R. 56(2) EPC 1973 (cf. R. 77(2) EPC), irrespective of whether or not such information would have been sufficient to prevent rejection under R. 56(1) EPC 1973 (cf. R. 77(1) EPC).

Similarly, in **T 315/03** (OJ 2005, 246), the board followed **G 3/99**, adding that, while the admissibility of an opposition by multiple opponents had to be kept under review throughout the proceedings, parties could not expect the opposition division or board to do this alone. It was clear that the board had neither the resources nor the knowledge of the relevant laws of all the contracting states necessary to police the composition of, and the legal status of all members of, multiple opponents. Once prima facie admissibility was acknowledged, it had to be up to the party or parties seeking to challenge admissibility to make a case of inadmissibility.

With regard to changes over time in the **composition** of a multiple opponent, the board agreed with the respondent that the absence over eleven and a half years of any notification concerning the 1200 members of opponent 6 ("opposition club") could in itself be considered an indication that the "clear throughout" condition had not been complied with. On the other hand, the fact that certain opponents only came into being for the purpose of filing opposition to one patent could not in itself be an objection to admissibility; an opponent's motive or lack of motive was irrelevant (see **G 3/97**, OJ 1999, 245). Similarly, it appeared to the board to be wholly irrelevant that an opponent, whether individual or multiple, might be supported by others (e.g. employees or shareholders of a company which was a party). Such supporters clearly could not take

any part in the proceedings and could not affect its outcome. Moreover, the support for a party could not per se be a reason to challenge admissibility.

## 2.2. Formal requirements for opposition and filing in due time

### 2.2.1 Introduction

According to Art. 99(1) EPC notice of opposition must be filed within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin. Notice of opposition is not deemed to have been filed until the opposition fee has been paid. In the interests of legal certainty, the Convention lays down certain further requirements that must be met before the opposition period expires, in particular that the notice of opposition is filed in a written reasoned statement (R. 76(1) EPC) and that it sufficiently identifies the opponent (R. 76(2)(a) EPC) and the patent opposed (R. 76(2)(b) EPC), that it states the extent to which the patent is opposed and the specific grounds, and that it indicates the facts and evidence presented in support of these grounds (R. 76(2)(c) EPC). Fulfilment of the requirements of R. 76(2)(c) EPC (cf. R. 55(c) EPC 1973) is not only essential for the admissibility of the opposition. They also establish the legal and factual framework of the opposition (see **G 9/91** and **G 10/91**, OJ 1993, 408 and 420).

### 2.2.2 Start of opposition period

In **T 438/87** the question addressed was whether a delay in **publication** of the European patent specification could affect the calculation of the nine-month period for filing an opposition. The board concluded that, since the mention of the grant of the patent in suit had been brought to the public's attention in the normal way, it was from this date that the opposition period had begun, irrespective of what problems may have affected publication of the patent specification and what consequences such untoward event might have for certain third parties owing to their geographical location.

According to **T 1644/10**, the opposition period is triggered solely by the grant of a European patent and publication of the mention of its grant in the European Patent Bulletin. The mention in the European Patent Bulletin that a correction of the patent specification has been issued does not trigger either a first or any "further" opposition period, even if the corrected specification confers a broader scope of protection than that conferred by the one originally published.

### 2.2.3 Payment of opposition fee

Art. 99(1), last sentence, EPC states that a notice of opposition is not deemed to have been filed until the opposition fee has been paid. According to the board in **T 152/85** (OJ 1987, 191), payment of an opposition fee is a factual requirement, which must be fulfilled within the nine-month opposition period if an opposition is to be admitted. Failure to pay an opposition fee within the required period where the filing of an opposition is intended is a factual mistake which cannot be rectified once the time limit for filing an opposition has passed. In the board's view, it could not be corrected under R. 88 EPC 1973

(cf. R. 139 EPC). It was apparent from the wording of that rule that the clear policy of the EPO was to distinguish between a mistake in a document and other kinds of mistakes, such as failure to pay a fee in time, and only to allow correction of mistakes in a document. Art. 99(1) EPC 1973 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 the opposition. Until the requirements of Art. 99(1) EPC 1973 were met, a potential opponent was not party to any proceedings before the EPO.

#### 2.2.4 Identity of opponent and correction of opponent's name

Under R. 76(2)(a) EPC and R. 41(2)(c) EPC, the notice of opposition must contain the name, address and nationality of the opponent and the state where his residence or principal place of business is located. R. 41(2)(c) EPC also gives precise particulars by which such identity needs to be established. If the **identity** of an opponent is not sufficiently established before expiry of the opposition period, the opposition is inadmissible (**T 25/85**, OJ 1986, 81). This defect cannot be remedied (**T 590/94**).

In **T 870/92** the board emphasised that, when indicating a legal entity, failure to use its exact official designation (R. 26(2)(c) and 61a EPC 1973; cf. R. 41(2)(c) and 86 EPC) did not necessarily mean that the opposition was inadmissible. An incorrect designation which nevertheless sufficed to indicate the party's identity had to be distinguished from the absence of such information. Errors in a designation could be corrected at any time (R. 88, first sentence, EPC 1973; cf. R. 139, first sentence, EPC; see also **T 828/98**).

In principle, the use of an abbreviation instead of the full name of a legal entity does not render an opposition inadmissible as long as the party's identity can be established. In **T 1034/08**, the board had no reasonable doubt that the abbreviation GSK stood for GlaxoSmithKline with regard to the identity of the Belgium-based opponent GSK Biologicals. Given that Belgian company law allows the co-existence of more than one company name and that GlaxoSmithKline Biologicals was the company's sole primary name, the board concluded that abbreviation GSK Biologicals did not constitute an incorrect designation of the opponent.

In **T 1165/03** the board regarded an identity card or passport as the best evidence of identity but with the same proviso as applies to all evidence, i.e. that its value could be offset or even negated by other evidence. In this case, two different photocopy identity cards had been filed: the first had been sent to the opposition division and, although even less legible than the copy later faxed to the board, it was clearly not a copy of the same document as that shown in the fax and subsequently filed during the oral proceedings. The letter signed in the opponent's name said his name had only been used accidentally in relation to the proceedings and that he was more often at his work address than the home address shown on the identity card. However, there was no legible address on the earlier photocopy card on file. Moreover, the work address in the letter was not that shown on the second photocopy card filed with the board. The board therefore held that the identity card evidence was inherently unreliable and inconclusive.

Questioning the identity of an opponent is not enough to render the opposition inadmissible; cogent evidence must be put forward. In **T 4/05** no such case was made. The appellant had not filed the extract from the commercial register which, it submitted during oral proceedings before the board, showed a different company name. This could therefore not be cited as evidence that the opponent's identity was unclear. The appellant's objection that two other companies were trading at the same address as the opponent also failed; this was merely an observation which could not affect the party status of an opponent who had been unambiguously identified.

In **T 1426/13** the opposition had been filed on behalf of "Isarpatent GbR". The board noted that the lack of public registration of a GbR ("Gesellschaft bürgerlichen Rechts") could contribute to uncertainty or even confusion about the name and/or identity of a GbR at specific points in time. However, the EPO had to accept that such unregistered legal entities may be a party in proceedings before the EPO. Any relevant evidence had to be evaluated according to the principle of free and unfettered consideration of evidence (e.g. **T 482/89**, OJ 1992, 646). From the documents submitted the board was satisfied that a name change had occurred before the opposition was filed and that no other entity than Isarpatent GbR could have been the opponent. Nor was the admissibility of the opposition affected by any changes in the composition of the GbR after the opposition had been filed. A GbR may be held liable for its obligations, including costs which may be awarded to another party in EPO opposition proceedings. Therefore it was not necessary to determine the individual members (**T 482/02** distinguished).

According to **T 1551/10**, for an opposition to be admissible, the opponent has to be identifiable by expiry of the opposition period (**T 25/85**, OJ 1986, 81), and provided this is the case, wrong information can be corrected (**T 219/86**, OJ 1988, 254; **T 870/92**). Extracts from the commercial register showed that Swisscom (Schweiz) AG was the (sole) universal successor in title to Swisscom Mobile AG, which was originally named as the opponent, although it had already been removed from the register before the opposition was filed. It was not apparent that any of Swisscom Mobile AG's business assets had been taken over by any other legal entity. Therefore, even though its predecessor in title had been wrongly named in the notice of opposition, Swisscom (Schweiz) AG was clearly and unambiguously identifiable as the opponent by the time the opposition period ended. Procedural statements mistakenly made in the name of a deceased party or of a legal person that no longer existed following a merger could be regarded as having been made in the name of their universal successor in title (**T 15/01**, OJ 2006, 153). The mistake in the opponent's name could therefore be corrected under R. 139 EPC. The public could not be misled because the register extracts showed only one successor in title at the time the opposition was filed, namely Swisscom (Schweiz) AG.

In **T 1269/11** the board held that both R. 77 and R. 139 EPC were available in principle to rectify errors in the name of the respondent (opponent) as given in the notice of opposition (by analogy with **G 1/12**, OJ 2014, A114, concerning correction of the wrong identification of the appellant and summarised in Chapter IV.E.2.5.2 a)). However, there was not sufficient evidence to allow a correction in this case.



The availability of R. 139 EPC to correct the name of the opponent was confirmed by **T 615/14** as follows. A request to correct the designation of the opponent in the notice of opposition is allowable under Rule 139, first sentence, EPC provided that it complies with the principles endorsed in **G 1/12** (OJ 2014, A114), in particular that it reflects what was originally intended when filing the notice of opposition, that it does not give effect to a change of mind or development of plans and that it represents the opponent's actual rather than ostensible intention. The original intention at the time of filing the opposition can also be established on the basis of evidence submitted after the expiry of the opposition period.

Further deficiencies such as a wrong postal code or lack of signature may be subsumed under R. 76(2)(a) and R. 50(3) EPC, respectively, and can thus be remedied within a time limit set by the opposition division in accordance with R. 77(2) EPC. The opposition division can extend this time limit or set a new time limit if deemed appropriate (**T 1632/06**).

#### 2.2.5 Title of invention

Under R. 76(2)(b) EPC, the notice of opposition must contain, inter alia, the number of the patent, the name of the proprietor and the title of the invention. If the patent is not sufficiently **identified**, the opposition must be rejected as inadmissible under R. 77(1) EPC, unless the deficiency has been remedied before expiry of the opposition period.

In **T 317/86** (OJ 1989, 378) the opponent had not indicated the title of the invention within the period specified under R. 56(2) EPC 1973 (R. 77(2) EPC) for remedying deficiencies other than those falling under R. 56(1) EPC 1973 (R. 77(1) EPC). The board decided that omission from the notice of opposition of the title of the invention - merely an item of bibliographical data identifying the contested patent - did not constitute a deficiency within the meaning of R. 56(2) EPC 1973, if the other particulars available to the EPO were together sufficient to identify easily and beyond doubt the patent being contested by means of an opposition.

In **T 335/00** and **T 336/00**, the R. 55(b) EPC 1973 (R. 76(2)(b) EPC) requirements were not strictly fulfilled. Among other things, the title of the invention was missing, and the opposition was directed to the application. The board nonetheless deemed the opposition admissible because the contested patent was identifiable uniquely and fairly easily on the basis of the specified publication number. Even the mistake of opposing an application and the omission of the title did not seem serious enough to the board to render the opposition inadmissible.

#### 2.2.6 Statement of extent of opposition

The Enlarged Board of Appeal remarked in **G 9/91** (OJ 1993, 408) that in practice it is rather unusual that the opposition is limited to only a certain part (subject-matter) of the patent. Normally, the whole of the patent is opposed. Addressing the situation where it was clear from the statement under R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC) that the

patent was opposed only to a certain extent, the Enlarged Board held that 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 Art. 101 and 102 EPC, nor are there any "proceedings" in the sense of Art. 114 and 115 EPC concerning such non-opposed subject-matters.

According to **T 114/95**, If an opponent requests revocation of the patent in its entirety, it is sufficient to substantiate the ground(s) of opposition in respect of **at least one claim** of the patent for the requirements of R. 76(2)(c) EPC (cf. R. 55(c) EPC 1973) to be met (**T 926/93**, OJ 1997, 447; **T 1180/97**, **T 1900/07**; see also in this chapter IV.D.3.2).

### 2.2.7 Statement of grounds for opposition

The notice of opposition must also state the grounds on which the opposition is based (R. 76(2)(c) EPC; cf. R. 55(c) EPC 1973). The grounds for opposition which can form the legal basis of an opposition are contained in an exhaustive list in Art. 100 EPC. Accordingly, an opposition may only be filed on the grounds that (a) the subject-matter of the European patent is not patentable, (b) the European patent does not sufficiently disclose the invention or (c) the subject-matter of the European patent goes beyond what was originally disclosed. Each ground for opposition listed in Art. 100 EPC corresponds to a requirement for grant laid down elsewhere in the EPC.

The Enlarged Board of Appeal set out a number of fundamental principles in **G 1/95** (OJ 1996, 615):

Whereas the grounds for opposition in Art. 100(b) and (c) EPC 1973 each relate to a single, separate and clearly delimited legal basis on which an opposition can be based, i.e. insufficient disclosure or unallowable amendment before grant, the same does not apply to Art. 100(a) EPC 1973. Art. 100(a) EPC 1973 not only refers to the general definition of patentable inventions under Art. 52(1) EPC 1973 and the exceptions to patentability under Art. 53 EPC 1973; it also refers to a number of definitions given in Art. 52(2) to (4) and 54 to 57 EPC 1973 for the terms "invention", "novelty", "inventive step" and "industrial application", which, when used in conjunction with Art. 52(1) EPC 1973, set specific requirements and therefore constitute separate grounds for opposition. Taken together, Art. 52 to 57 EPC 1973 therefore do not, for the purposes of Art. 100(a) EPC 1973, constitute a single objection to the maintenance of the patent, but a collection of different objections. Some of these are completely independent of each other (e.g. Art. 53 and 52(1) EPC 1973, Art. 54 EPC 1973) whereas others might be more closely related (e.g. Art. 52(1) and 54 EPC; Art. 52(1) and 56 EPC 1973). For an opposition to be admissible under Art. 100(a) EPC 1973, it has to be based on **at least one of the grounds for opposition** set out in Art. 52 to 57 EPC 1973.

Following the reasoning of **G 1/95**, one function of R. 55 and 56 EPC 1973 (cf. R. 76 and 77 EPC) is to establish what the notice of opposition has to contain in order to be

admissible. R. 76(2)(c) EPC specifies that the notice of opposition has to contain a statement of the extent to which the European patent was opposed and of the grounds (i.e. the legal reasons mentioned above) on which the opposition is based and an indication of the facts, evidence and arguments presented in support of these grounds, i.e. the substantiation. The wording of (c) shows clearly the distinction made between the grounds, meaning the legal reasons or legal bases such as those under Art. 100(a) EPC and the substantiation. Accordingly, in the context of Art. 99 and 100 EPC and of R. 76(2)(c) EPC, a "ground for opposition" has to be interpreted as meaning an individual legal basis for an objection to the maintenance of a patent. It follows in particular that Art. 100(a) EPC contained a collection of different legal objections (i.e. legal bases), or different grounds for opposition, and is not directed to a single ground for opposition.

Non-compliance with Art. 84 EPC is not a ground for opposition, but is a matter to be considered in the context of Art. 101(3) EPC (see also **G 3/14**, OJ 2015, A102 and in this chapter IV.D.4.2.

In **T 600/08** the board observed that the EPC did not provide for reviewing, as part of opposition proceedings, the legality of a decision by the Receiving Section to correct an applicant's name in a divisional application. The grounds for opposition were set out exhaustively in Art. 100 EPC. Objections to the text of a patent as granted could not be raised on other grounds. It made no difference that the text of the patent in suit had been amended.

#### 2.2.8 Indication of facts, evidence and arguments – substantiation of grounds for opposition

The third requirement of R. 76(2)(c) EPC for the admissibility of the opposition is the substantiation of the specified ground, i.e. an indication of the facts, evidence and arguments presented in support of it. The fulfilment of this latter requirement in respect of **one** of the grounds for opposition is enough to render admissible the opposition as a whole. Nowhere in the EPC is there any basis for the concept of partial admissibility of oppositions. The concept of "inadmissibility" is only applicable to the notice of opposition as a whole (**T 653/99**; see also **T 212/97** and **T 65/00**). If the third requirement of R. 76(2)(c) EPC is also met, the opposition is deemed to be sufficiently "substantiated" and thus admissible.

The question whether the requirements in R. 76(2)(c) EPC are met must be determined on expiry of the nine-month opposition period (R. 77(1) EPC). A notice objectively complying with the requirements **on the relevant date** is not rendered inadmissible where the opponent later cites prior art not mentioned in it to support his line of argument (**T 1019/92**; see also **T 104/06**).

In **T 222/85** (OJ 1988, 128) the board of appeal held that the third requirement was only satisfied if the contents of the notice of opposition were sufficient for the opponent's case to be **properly understood on an objective basis**. The board reasoned that the purpose of the third requirement of R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC), in combination with the first two requirements, was to ensure that the notice of opposition

set out the opponent's case sufficiently so that both the patentee and the opposition division knew what that case was. Whereas the requirements of R. 55(a) and (b) EPC 1973 (cf. R. 76(2)(a) and (b) EPC) and the requirements (1) and (2) of R. 55(c) EPC 1973 could be considered as **formal** in nature, requirement (3) of R. 55(c) EPC 1973, in combination with Art. 99(1) EPC, was **substantive** in nature, and called for reasoning which went to the merits of the opponent's case. A well-drafted opposition ought to contain reasoning that was full but concise. And in general, the less reasoning that a notice of opposition contained, the greater the risk that it would be rejected as inadmissible (similarly **T 925/91**, OJ 1995, 469; see also **T 2/89**, OJ 1991, 51; **T 448/89**, OJ 1992, 361; **T 545/91**, **T 204/91**). According to the board, the question whether a particular notice of opposition meets the minimum substantive requirements of Art. 99(1) EPC 1973 and R. 55(c) EPC 1973 could only be decided in the context of the particular case (since various relevant factors, such as the complexity of the issues raised, vary from case to case) – see also e.g. **T 534/98**, **T 1097/98**, **T 934/99**.

In **T 204/91** the board stated in particular that the term "indication" in R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC) 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 for opposition raised, without the need to make further investigations (see **T 453/87** and **T 279/88**; see further **T 1069/96**). The fact that a patentee must be able to understand, without undue burden, the case made against his patent in the notice of opposition does not, however, exclude the possibility that he may have to undertake a **certain amount of interpretation** (**T 199/92**).

In **T 934/99** the board stated that R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC) did not imply the requirement of a logical line of reasoning in the sense that the arguments brought forward in the notice of opposition had to be cogent or convincing. Rather, the criterion was whether the arguments presented were relevant and, where necessary as the result of a reasonable interpretative effort, specific enough to allow a person skilled in the art to form a reasoned opinion of whether the line of reasoning on which the opponent apparently relies was (logically) correct ("convincing") or not (i.e. wrong).

The sufficiency of the notice of opposition had to be distinguished from the **strength** of the opponent's case. On the one hand, an unconvincing ground for opposition might have been clearly presented and argued. Conversely, a deficient submission may be rejected as inadmissible even though, if properly drafted, it would have succeeded (**T 222/85**, OJ 1988, 128; **T 621/91**, **T 3/95**, **T 1069/96**). Assessing the evidence is part of

the process of ascertaining whether the opposition is well founded in substance (**T 234/86**, OJ 1989, 79). Thus, in **T 353/06** the board identified the appellants' arguments for the inadmissibility of the opposition as concerning the corroborative value of the facts and evidence, rather than a failure to indicate such facts and evidence in support of the grounds of opposition.

Similarly, the board in **T 1194/07** referred to the established case law, according to which the indication of facts, evidence and arguments need not be conclusive or correct. That is an issue of merit. However, the board also emphasised that the merits of a case can only be assessed in a meaningful manner if the case has been stated fully, by an adequate indication of the relevant facts, evidence and arguments. Key elements linking the cited prior art to the claim or relating to their validity as evidence, as well as crucial arguments informing the reader why the skilled person might have considered combining the features of such prior art with those of the accompanying evidence, should not be missing in the notice's chain of logic leading from the prior art to the invention. The omission of key facts and elements in the notice's reasoning may amount to little more than speculation or an outline of a possible case against the patent (see also **T 1856/11**).

In **T 344/88** the opponent had given the wrong number for a patent specification which it had cited against the patent in suit. The board considered whether R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC) was contravened if the mistake was not corrected until after expiry of the opposition period. While the patent cited bore no relation to the invention under consideration, the notice of opposition contained enough information to identify the actual patent intended and so the board 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. The error was recognisable within the period for opposition and the opposition division was able, on the basis of the description of the citation, to establish the latter's identity beyond all doubt.

In **T 426/08**, the respondent argued that, although **evidence** need not be produced but merely indicated by expiry of the opposition period, the admissibility of the opposition was not determined solely on the basis of the notice of opposition, but rather on the basis of the notice and the evidence indicated in it and produced either before or after the opposition deadline. The board drew a distinction between evidence produced before and after the deadline and between indication and proof. The content of evidence merely referred to within the opposition period but not produced until after it could not, for the purpose of examining admissibility, be taken into account either as an **indication** of facts or evidence or as **proof** of facts.

In **T 1022/09** the opposition division had confused the criteria for admissibility of late-filed documents with those for documents filed with and referred to in an admissible notice of opposition. According to the board, the content and publication date of the documents filed with the notice of opposition did not come into play for the question of admissibility. Since their filing was substantiated, they were automatically admitted to the opposition proceedings.

## 2.2.9 Groups of cases

### a) Sufficient substantiation of grounds for opposition

In **T 134/88** the opposition did not deal with all the features of the contested claim, but still satisfied the requirements of R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC). The board summed up by saying that an opposition directed against alleged lack of inventive step in the case of a combination invention was generally inadmissible if it related only to the assessment of one individual feature - to be admissible, it would have to deal with the invention as a whole, or at least with its **essential** content, so that when the facts on which the opposition was based were indicated, circumstances became recognisable which enabled the patent proprietor and the assessing body to pass conclusive judgment on the asserted grounds for opposition without having to make enquiries of their own. Allegations which could not be subsumed under one of the opposition grounds have to be left out of consideration (see also e.g. **T 1279/05**, **T 114/07**, **T 521/00**, **T 1074/05**). A detailed and exhaustive discussion of matters which were implicit to such skilled persons was not needed to understand the opponent's case and, therefore, not an admissibility requirement. (See also **T 534/98**, in which it was held, contrary to the patent proprietor's assertion, that evidence of the common general knowledge was not required to substantiate an opposition. In accordance with the prevailing view in the case law, proof that something belonged to the common general knowledge was only necessary if this was called into question by another party or by the EPO).

In **T 1014/09** the opposition was based on the inadmissibility of an amendment "because it was not covered by the original disclosure". The board had to establish to what extent this **general reference** to the original disclosure could be regarded as a due indication of the facts, evidence and arguments within the meaning of R. 55(c) EPC (cf. R. 76(2)(c) EPC), and to what extent the assessment of the amendment to the claims could be construed as an indication that the amendment had unlawfully changed or extended the technical information. The board concluded that the facts of the case at issue and the accompanying legal analysis set out in the notice of opposition had to be regarded as duly substantiating the ground for opposition under Art. 100(c) EPC.

In **T 185/88** (OJ 1990, 451) the board ruled that grounds for opposition are deemed to be in due form if the only document cited in support of the sole assertion of lack of inventive step (here: German patent specification), while itself published **after** the date of filing or priority, nevertheless contained a reference to a document published **before** the date of filing or priority (here: German unexamined application or "Offenlegungsschrift" – cf. the different circumstances in **T 864/04**).

### b) Insufficient substantiation of grounds for opposition

In **T 182/89** (OJ 1991, 391) the opposition contained formal allegations concerning Art. 100(b) EPC 1973. The board first observed 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 inadequate. On the question of substantiation, the

board took the view that, indeed, if a notice of opposition alleging insufficiency under Art. 100(b) EPC 1973 as the sole ground for opposition contained such a statement as the only indication of "facts, evidence and arguments" in support of this ground, then the notice of opposition should be regarded as inadmissible even if the alleged facts were subsequently proved.

In **T 550/88** (OJ 1992, 117) the board of appeal considered whether **national prior rights** could as a matter of law constitute "facts or evidence" relevant to the ground of lack of novelty under Art. 54(1) and (3) EPC. If not, such facts and evidence did not support the ground for opposition which had been alleged and therefore did not satisfy the requirement of R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC). In the board's judgment, on the proper interpretation of Art. 54(3) EPC, national prior rights were not comprised in the state of the art, and only prior European patent applications filed under the Convention could be considered as such under Art. 54(3) EPC. The board decided that the opposition was inadmissible because the only facts and evidence indicated in the notice of opposition were references to national prior rights.

According to **T 613/10**, the admissibility of the opposition has to be decided in the light of the circumstances of the case, especially if the requirements of R. 76(2)(c) EPC are not clearly and unambiguously met. Those circumstances include not just the technical complexity of the subject-matter in the opposed patent and the citations but also the number of claims and the number of citations – even if in principle an opposition can contain any number of attacks or citations. The patent proprietor should not have to try and work out the opponent's case for himself, from inadequate information given in the notice of opposition. In the case before the board, notice of opposition had been filed within the opposition period on the official form and two additional sheets. These listed 26 items of evidence, which however were filed, together with a detailed statement, only after the period expired. The notice had indicated the grounds of lack of novelty and lack of inventive step but did not say which citations related to which. None of the cited passages or drawings had been compared with the features of any of the 26 claims; nor had any technical connection been established between the citations and the claims. The board concluded that the notice of opposition did not properly indicate the facts presented in support of either of the two grounds, so that the requirements of R. 76(2)(c) EPC were not fulfilled.

c) Alleged public prior use

- Adequate substantiation of relevant circumstances

In accordance with **G 1/95** (OJ 1996, 615), alleged public prior use does not constitute a ground for opposition under Art. 100(a) EPC but is a fact cited to substantiate such a ground (**T 190/05**).

An allegation of public prior use will generally only be considered if it is sufficiently substantiated, i.e. where it can be readily seen how the public prior use took place (this was not the case in e.g. **T 6/86**, **T 329/86** and **T 78/90**). If an opponent wishes to rely upon prior use as being part of the state of the art for the purpose of Art. 54(2) EPC and

as part of the legal and factual framework within which the substantive examination of the opposition is to be conducted, the notice of opposition must indicate within the opposition period all the facts which make it possible to determine the date of prior use, what has been used, and the circumstances relating to the prior use. An abstract indication of the subject-matter of the prior use is generally insufficient. Statements made within the period for opposition regarding the time, subject-matter and circumstances of the alleged public prior use must be intelligible enough from the viewpoint of the skilled person to enable their substantive legal merits to be reviewed.

In cases of alleged public prior use, particular substantiation is required in the notice of opposition. However, a distinction must still be made between examining the admissibility of the opposition and its substantive merit. It is settled case law (see e.g. **T 194/86**, **T 328/87** (OJ 1992, 701), **T 93/89** (OJ 1992, 718), **T 232/89**, **T 538/89**, **T 754/89**, **T 78/90**, **T 600/90**, **T 877/90**, **T 441/91**, **T 602/91**, **T 988/91**, **T 541/92** and **T 927/98**) that to be able to determine whether an invention has been made available to the public by prior use, the following circumstances have to be clarified:

- (i) when the act of prior use occurred
- (ii) what was made available to the public through that use
- (iii) the circumstances of the act of use, i.e. where, how and by whom the subject-matter was made public through that use

The information relating to the "when", the "what" and the "how" of the circumstances surrounding prior use is all that the patent proprietor and the opposition division need in order to understand the case of the opponent and for the opposition to be admissible. The rest, i.e. whether the alleged facts were or would be sufficiently proven through additional filings in the course of the opposition proceedings, is a question of allowability in terms of substantive law. Thus, establishing that the alleged prior use is indeed public has little bearing on the **admissibility** of the opposition, but could be significant for assessing its **allowability** in terms of substantive law (see **T 406/92**, **T 786/95**, **T 1022/99**; cf. also **T 533/94**, **T 534/94**, **T 1553/07**, **T 25/08**, **T 1856/11**).

In **T 241/99**, for instance, the board considered it insufficient for the purposes of R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC) that, in the event of a purported **sale to a small, closed group of customers**, these were identified only by a coded indication (list of numbers). This was different from the sale of mass-produced goods to anonymous buyers and resembled rather the case of a single sale, for which the requirements of R. 76(2)(c) EPC were met only if the name and address of the sole buyer were indicated within the opposition period.

In **T 511/02**, concerning the opponent's duty of substantiation, it had not been indicated when and how fitting and installation instructions cited against the patent had been made available to the public. Since this factor was crucial to the establishment of whether they formed part of the prior art and thus whether they could actually be cited against the



patent, no adequate indication had been given of the relevant facts and evidence (see also **T 1271/06**).

In **T 538/89** the board stressed that the evidence offered in support of public prior use could be submitted after expiry of the period for opposition since R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC) only required that it be indicated (see also **T 752/95**, **T 249/98**).

According to the board, **nomination of a witness** for subsequent examination is deemed to constitute indication of evidence (see also **T 28/93**, **T 988/93** and **T 241/99**). Although a general offer of a witness testimony cannot compensate for an inadequate presentation of facts, for the opposition to be admissible it is only necessary to name the witnesses. The naming of a witness to be heard later is therefore to be regarded as a sufficient indication of evidence as long as it is clear for what assertions of facts the witness is being named. It is neither necessary to indicate a specific subject in connection with evidence nor to indicate what the witness could say about a given assertion (**T 1553/07**).

The evaluation of evidence in cases of alleged public prior use is dealt with in detail in Chapter III.G.4.3.2.

#### - Examination by the EPO of its own motion

Under Art. 114 EPC the EPO has a limited obligation to undertake an examination of its own motion with regard to public prior use.

In **T 129/88** (OJ 1993, 598) the board noted that although a board of appeal had an obligation under Art. 114(1) EPC to investigate matters of its own motion, that obligation did not extend as far as investigating an allegation of public prior use, where the party previously making that allegation had withdrawn from proceedings and it was difficult to establish all the relevant facts without that party's co-operation. The reason for this was that the obligation to investigate of its own motion imposed on the EPO by Art. 114(1) EPC was not unlimited in its scope, but was confined by considerations of reasonableness and expediency. Therefore, if the opponents withdrew the opposition, thereby indicating that they were no longer interested in the outcome of the opposition, then, although the EPO might have the power, depending on the state of residence of relevant witnesses, to compel them to give evidence, either before the EPO or before the court of a contracting state, in the interests of procedural economy it should not normally investigate the issue any further. It would be different if a relevant public prior use had already been substantiated by documents of undisputed authenticity, or if the material facts with respect to the alleged public prior use were undisputed (see **T 830/90**, OJ 1994, 713; **T 887/90**, **T 634/91**, **T 252/93** and **T 34/94**).

#### 2.2.10 Other requirements for notice of opposition

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 prescribed **translation** was not filed in due time (Art. 14(4) and (5) EPC 1973;

cf. Art. 14(4) EPC), the notice should be deemed not to have been received, and the opposition fee was to be refunded (following **T 323/87**, OJ 1989, 343). Since the opposition had not come into effect, there was no question of examining its admissibility under R. 56(1) EPC 1973 (cf. R. 77(1) EPC).

In **T 960/95** the notice of opposition was filed **without having been signed**. The board stated that a notice of opposition should be duly signed (R. 36(3), first sentence, EPC 1973, R. 61a EPC 1973; cf. R. 50(3), first sentence, EPC, R. 86 EPC). The omission of the signature was remedied within the time limit set by the opposition division, and the notice of opposition therefore retained its original date of receipt (R. 36(3), third sentence, EPC 1973; cf. R. 50(3), third sentence, EPC; see also **T 1165/03**).

### **2.3. Procedural aspects of examination of admissibility**

#### 2.3.1 Formalities officers' powers in opposition proceedings

In opinion **G 1/02** (OJ 2003, 165), the Enlarged Board of Appeal examined the powers and duties of formalities officers in opposition proceedings, the underlying question being their competence to decide on the consequences of late payment of the opposition fee. Taking the view that **T 295/01** (OJ 2002, 251) and **T 1062/99** were divergent, the President asked the Enlarged Board of Appeal to consider whether points 4 and 6 of the Notice of 28.04.1999 conflicted with provisions of a higher level (OJ 2002, 466). The Enlarged Board stated that the provisions of the Notices of the Vice-President DG 2 were valid on the basis of R. 9(3) EPC 1973 (cf. R. 11(3) EPC), under which formalities officers could be entrusted with duties falling to the examining and opposition divisions and involving no technical or legal difficulties. It therefore concluded that points 4 and 6 of the Notice of 28.04.1999 did not conflict with provisions of a higher level.

#### 2.3.2 Admissibility of opposition to be checked at every stage

The admissibility of the opposition must be checked *ex officio* in every phase of the opposition and ensuing appeal proceedings. It can and, where appropriate, must be raised by the board in appeal proceedings even if this is the first time this matter is addressed (**T 289/91**, OJ 1994, 649). On the other hand, the requirement of admissibility must not be circumvented by overemphasising the *ex officio* principle and shifting the burden of establishing the case from the opponent to the opposition division. In this context, the substantiation of the opposition is not a requirement *per se*, but has a clear purpose: that the opposition division can clearly set out the case just on the points at issue. The (minimum) requirements for substantiation of the opposition have their counter-part in the (minimum) requirements for the reasons to be given in the decision of the opposition division. There is insufficient reasoning in a decision if the "when, where and what" is not set out in detail, leaving the reader to guess what the facts underlying the decision are, why and on what evidence they were based, and how the evidence was evaluated (cf. **T 522/94**, OJ 1998, 421).

### 2.3.3 Rejection of opposition as inadmissible

In **T 222/85** (OJ 1988, 128) the board stated that a communication under R. 57(1) EPC 1973 (cf. R. 79(1) EPC) indicating the admissibility of an opposition was not a decision of the opposition division, and the sending of such a communication did not prevent the subsequent rejection of the notice of opposition as inadmissible under R. 56(1) EPC 1973 (cf. R. 77(1) EPC), for example if the admissibility was challenged by the patent proprietor (see also **T 621/91**).

As soon as an opposition had been rejected as inadmissible, the opposition procedure was regarded as legally terminated and substantive examination could no longer be initiated. The inadmissibility of an opposition, when finally decided, or an appeal, had the effect of transferring the European patent to the national jurisdiction of the designated states, which then assumed sole responsibility for assessing the patent's validity with reference to their own legislation. The board therefore came to the conclusion that it was inconsistent with the procedural principle referred to above for the decision rejecting the opposition as inadmissible to consider that opposition's merits. Remarks on substantive matters in a decision rejecting the opposition as inadmissible had no legal effect. However such remarks should, in principle, be avoided, as a procedural deficiency of this kind could result in legal uncertainty during the national phase and could disadvantage either the proprietor or the opponent (**T 925/91**, OJ 1995, 469; see also **T 328/87**, OJ 1992, 701).

## 3. Substantive examination of opposition

### 3.1. Introduction

In **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board held that R. 76(2)(c) EPC (cf. R. 55(c) EPC 1973) made sense only when interpreted as having the **double function** of governing (together with other provisions) the admissibility of the opposition and of simultaneously establishing the legal and factual framework within which the substantive examination of the opposition was in principle to be conducted.

The **legal framework** of an opposition case is defined solely by (i) the extent to which the patent is actually opposed and (ii) the grounds upon which it is opposed, whilst its **factual framework** is determined by the facts, evidence and arguments adduced and set out in the notice of opposition pursuant to R. 76(2)(c) EPC. 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**). Moreover, a distinction has to be made between the two main requirements of R. 76(2)(c) EPC, i.e. the indication of the **extent** to which the European patent is opposed and the **grounds** for opposition.

### 3.2. Extent of opposition

R. 76(1) EPC (cf. Art. 99(1) EPC 1973) provides, *inter alia*, that "notice of opposition shall be filed in a written reasoned statement". R. 76(2)(c) EPC (cf. R. 55(c) EPC 1973) requires the notice of opposition to contain, *inter alia*, "a statement of the extent to which the European patent is opposed" (see also in this chapter IV.D.2.2.6).

In **G 9/91** (OJ 1993, 408) the Enlarged Board clarified that the power of an opposition division or a board of appeal to examine and decide on the maintenance of a European patent under Art. 101 and 102 EPC 1973 (now merged in Art. 101 EPC) depends on the extent to which the patent is opposed in the notice of opposition (R. 55(c) EPC 1973; cf. R. 76(2)(c) EPC). However, this principle is subject to a restriction: even if the opposition is expressly directed only against the subject-matter of an independent claim in a European patent, claims which depend on any such independent claim can nonetheless also be examined as to their patentability if the independent claim is eliminated in opposition or appeal proceedings, provided that the validity of these dependent claims is put in doubt *prima facie* by the information which is already available (cf. also **T 443/93**, **T 31/08**; the principles set out in **G 9/91** have been followed by subsequent case law, e.g. **T 1019/92**, **T 1066/92**, **T 1350/09**; see also **T 525/96** and **T 907/03** in respect of claims of an auxiliary request).

The statements in the notice of opposition relevant to the extent to which the European patent is opposed should be interpreted in such a way that an addressee would understand them, taking into account the surrounding circumstances. However, the general practice of interpreting the absence of such statements as an indication of the opponent's intention to oppose the patent concerned in its entirety, has been subject to scrutiny in the light of **G 9/91**. In the extreme, where the extent to which a patent is opposed is in serious doubt, such a "liberal" practice may lead to a rejection of the opposition as inadmissible (**T 376/90**, OJ 1994, 906; see also **T 1/88**, in which the board based its interpretation of equivocal procedural acts on the "objective value of the explanation").

In **T 114/95** the board held that if an opponent requested revocation of the patent in its entirety, it was sufficient to substantiate the ground(s) for opposition in respect of **at least one claim** of the patent for the requirements of R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC) to be met. R. 55(c) EPC 1973 did not refer to claims but rather required that the notice of opposition should contain a statement of the extent to which the patent was opposed.

### 3.3. Scope of examination of grounds for opposition

According to the Enlarged Board in its opinion **G 10/91** (OJ 1993, 420; see also **G 9/91**, OJ 1993, 408), an opposition division or a board of appeal is not obliged to consider all the grounds for opposition referred to in Art. 100 EPC, going beyond the grounds covered by the statement under R. 55(c) EPC 1973 (R. 76(2)(c) EPC), but may exceptionally do so. In **opposition proceedings**, the opposition division may, in application of Art. 114(1) EPC, raise a ground for opposition not covered by the opposition statement or consider such a ground raised by the opponent (or referred to by

a third party under Art. 115 EPC) after the expiry of the time limit of Art. 99(1) EPC in cases where, prima facie, there are clear reasons to believe that it is relevant and would in whole or in part prejudice the maintenance of the European patent. However, in **opposition appeal proceedings** a more restrictive application of Art. 114(1) EPC is generally justified. It is not in conformity with the purpose of these proceedings, which is mainly to give the losing party the possibility of challenging the decision of the opposition division, to consider grounds for opposition on which that decision was not based. Furthermore, in contrast to the merely administrative character of the opposition procedure, the appeal procedure is to be considered a judicial procedure (**G 7/91** and **G 8/91**, OJ 1993, 356 and 346), which is by its very nature less investigative. Therefore, a fresh ground for opposition should only be raised by the board of appeal or admitted into the proceedings if the board considers it already prima facie highly relevant and the patentee agrees to its introduction.

The wording of Art. 101(1) EPC ("at least one ground for opposition") now makes it clear that the opposition division is not obliged to examine all the grounds for opposition. Reference is also made to this chapter IV.D.3.4 "Fresh grounds for opposition".

Following **G 10/91**, the board in **T 274/95** (OJ 1997, 99) held that, if a ground for opposition was substantiated in the notice of opposition but was subsequently not maintained during the opposition division proceedings (in the case in question, a statement to that effect had been made by the opponent during oral proceedings), the opposition division was under no obligation to consider this ground further or to deal with it in its decision, unless the ground was sufficiently relevant to be likely to prejudice maintenance of the patent.

In **T 223/95** the appellant had argued that the opposition division should take steps of its own motion to establish by investigation the level of knowledge of the person skilled in the art. The board observed that such an investigative approach would not be consistent with the character of the post-grant opposition proceedings under the EPC, which were in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment. In the board's opinion, it was unrealistic to suppose that the opposition division could seek, gather and select evidence in an entirely impartial fashion; herein lay an essential distinction between the functions of the examining divisions and the opposition divisions. It was the responsibility of the opponent himself to present to the opposition division the facts, evidence and arguments in support of the grounds on which the opposition was based.

As regards the investigative power of the **boards of appeal** under Art. 114(1) EPC, read in conjunction with in R. 66(1) EPC 1973 (R. 100(1) EPC), it is their judicial character that sets the limits to this power. To permit the shifting of the legal and factual framework of the opposition in appeal, in a mistaken reliance on the wording of Art. 114(1) EPC, read in isolation from the rest of the EPC, and in particular R. 66(1) EPC 1973, would offend the legal principles contained and expressed in the EPC and explained in the case law of the Enlarged Board (see e.g. **T 737/92**).

### 3.4. Fresh grounds for opposition

#### 3.4.1 General

In **G 1/95** and **G 7/95** ("Fresh grounds for opposition", OJ 1996, 615 and 626; consolidated proceedings), the Enlarged Board first defined the meaning of "grounds for opposition" within the framework of Art. 100 EPC, and paragraph (a) in particular, as well as in the light of **G 10/91** (OJ 1993, 408 and 420 – see also summary of **G 10/91** in this chapter IV.D.3.3). It noted that the function of Art. 100 EPC is to provide a limited number of legal bases i.e. a limited number of objections, on which an opposition can be based, all "grounds for opposition" in Art. 100 EPC having their counterparts in other articles of the EPC which have to be met during the procedure up to grant. Whereas the grounds in Art. 100(b) EPC and 100(c) EPC each relate to a separate and clearly delimited legal basis for an opposition, the totality of the articles (Art. 52 to 57 EPC) within the meaning of Art. 100(a) EPC constitute a collection of different objections to the maintenance of the patent.

The Enlarged Board had, in **G 10/91**, explained that, in application of Article 114(1) EPC, an opposition division may introduce a ground for opposition not covered by the notice for opposition, either of its own motion or upon application by an opponent, if such a ground is considered sufficiently relevant. If an opposition division does introduce such a ground into the proceedings before it, it will of course decide whether such ground prejudices the maintenance of the patent, in the decision that it issues. The Enlarged Board in **G 10/91** had first used the term "a fresh ground for opposition" in the context of considering the proper application of Art. 114(1) EPC during opposition appeal proceedings, and the term as used there must be interpreted as intended to refer to a new legal basis for objecting to the maintenance of the patent, which was neither raised and substantiated in the notice of opposition nor introduced by the opposition division.

In **G 1/95** (OJ 1996, 615), the Enlarged Board went on to hold that, in a case where a patent had been opposed on the grounds set out in Art. 100(a) EPC, but the opposition had only been substantiated on the grounds of lack of novelty and lack of inventive step, the ground of unpatentable subject-matter based on Art. 52(1) and (2) EPC was a fresh ground for opposition and accordingly could not be introduced into the appeal proceedings without the agreement of the patentee.

In **G 7/95** (OJ 1996, 626), it was held that in a case where a patent had been opposed under Art. 100(a) EPC on the ground that the claims lacked an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty vis-à-vis the said documents based on Art. 52(1) and 54 EPC was a fresh ground for opposition and accordingly could not be introduced into the appeal proceedings without the agreement of the patentee. However, the allegation that the claims lacked novelty in view of the closest prior art document could be considered in the context of deciding on the ground of lack of inventive step.

In **T 1549/07**, the ground for opposition under Art. 100(b) EPC had been raised after expiry of the opposition period. The opposition division had admitted this ground into the

proceedings without stating its reasons for doing so. It had then rejected the opposition and maintained the patent as granted. The patent proprietor (respondent) requested that the board refrain from examining this ground in the appeal proceedings. The board found that, while the opposition division's inadequately reasoned decision constituted a procedural error, the patent proprietor had not objected to it at any time during the oral proceedings. Nor had it led in the course of the opposition proceedings to any final decision adversely affecting the patent proprietor. The board thus deemed the patent proprietor's request inadmissible. There were no EPC provisions under which a ground for opposition admitted to and examined during the proceedings could be eliminated at the appeal stage. Since, in the case at issue, the opposition division had decided to admit said ground for opposition, it had become part of the contested decision and, as a result, was not "a fresh ground for opposition" introduced on appeal within the meaning of **G 10/91**. The board therefore had no need to obtain the patent proprietor's consent to its introduction and was entitled to consider it further.

In **T 2449/12**, the decision of the opposition division did not deal with the merits of a ground for opposition which had been both raised for the first time and withdrawn during the oral proceedings before it. According to the board, when neither the merits nor the admittance of a ground for opposition which was later raised and withdrawn during the opposition proceedings were addressed in the decision under appeal, this ground is considered a fresh ground for opposition which cannot be introduced into the appeal proceedings without the consent of the patent proprietor. The fact that the opposition division did not raise this ground of its own motion did not imply that it took a decision – subject to review of the board of appeal – to disregard it, as might have been the case if this late-filed ground had been maintained. Taking a different position on this point and accepting that all the grounds not introduced ex officio have been the subject of a discretionary decision to disregard them would open the possibility to circumvent the principle laid down in decision **G 9/91** that fresh grounds for opposition may not be introduced at the appeal stage without the consent of the patent proprietor.

#### 3.4.2 Objections of lack of novelty and lack of inventive step

In **T 135/01**, the board took the view that the mere observation in the course of an opposition procedure, whether by a party or the opposition division, that the subject-matter of a claim was new having regard to the prior art did not mean that **lack of novelty** was thereby introduced **as a ground for opposition**. Thus an assessment of inventive step generally began with a determination of the point of novelty, which implied a finding that the subject-matter of the claim was new. Treating such a routine affirmation of novelty as introducing the opposition ground of lack of novelty would be tantamount to including the latter ground as an invariant concomitant of the opposition ground of lack of inventive step, which would be contrary to decision **G 7/95** (OJ 1996, 626 – see in this chapter IV.D.3.4.1).

If a patent has been opposed on the grounds of lack of novelty and lack of inventive step and if only the ground of novelty has been substantiated, a specific substantiation of the ground of lack of inventive step is not necessary. Under such circumstances a specific substantiation of the ground of lack of inventive step is not even generally possible since

- given that novelty, i.e. the presence of a difference between the claimed subject-matter and a prior art, is a prerequisite for determining whether an invention involves an inventive step in view of that prior art - this would contradict the reasons in support of lack of novelty. Therefore, the objection of lack of inventive step does not constitute a fresh ground for opposition and can therefore be examined in the appeal proceedings without the agreement of the patentee (**T 597/07**; see also **T 131/01**, OJ 2003, 115).

In **T 635/06** the notice of opposition specified that the patent in suit was opposed for lack of novelty and lack of inventive step as the respective boxes of the standard EPO form had been crossed and as the notice explicitly indicated both grounds. In the circumstances of the case it was not possible for the opponent to substantiate the ground of lack of inventive step by any analysis going beyond its arguments against novelty. The opponent was thus limited to the position that a comparison of the disclosed composition and the claimed subject-matter revealed no distinguishing feature, the presence of which would, however, be necessary for a detailed objection to inventive step. Hence, the ground of lack of inventive step was considered by the board to be sufficiently addressed and, thus, properly raised in the notice of opposition.

According to the board in **T 514/04**, the lack of novelty objection originally raised against claim 5, relating to a process for the preparation of a product, **could not extend to the products obtained from this process**, including the products to claims 1 to 4, and that consequently the lack of novelty objection raised against claims 1 to 4 for the first time before the board was a fresh ground for opposition.

In **T 1959/09** the patentee (respondent) had requested the board to refer to the Enlarged Board of Appeal the question whether an existing ground for opposition raised in respect of a different independent claim amounts to a fresh ground of opposition as set out in **G 10/91**. In this respect, reference was made to **T 514/04** (see above), where the board had stated that the extent and ground for opposition mentioned in R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC) were connected in the sense that a specific claim(s) is/are objected to under a specific ground or grounds. The patentee argued that it was inadmissible without the approval of the patentee to extend the opposition over and above this basic concept which defined both the extent to which the patent was originally opposed (cf. **G 9/91**) and the grounds originally submitted with respect to subject-matter opposed under Art. 99 (1) EPC and R. 55(c) EPC (cf. **G 10/91**). The board did not recognise the necessity for such a referral since the ground for opposition pursuant to Art. 100(c) EPC as well as the question whether the requirements of Art. 123(2) EPC were clearly considered in the impugned decision. In addition, the board distinguished the present case, where claims 1 and 17 of the main request both belonged to the same category and virtually included the same subject-matter, from the case in **T 514/04**, where the question posed was whether a ground for opposition raised against a claim to a process applied equally to a claim to a product produced by said process. Hence, **T 514/04** had no bearing on the case at issue.

The board noted in passing that there was no basis in **G 10/91** for the general assumption that a ground for opposition raised against an independent claim may not subsequently be raised by the opponent against another independent claim, falling within



the scope of the opposition, since otherwise a new ground for opposition would thereby be introduced. According to the board, **T 514/04** neither mentioned nor elucidated the relevant passages in **G 10/91** which supported that assumption. Actually, **G 10/91** appeared to regard a new ground for opposition as being a "ground for opposition not covered by the statement pursuant to R. 55(c) EPC", no indication being given in that decision which would justify the inference that this should be construed far more broadly as meaning any ground for opposition in respect of a specific given claim which was not covered by the statement pursuant to R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC).

#### 3.4.3 Grounds raised against amended claims

Amendments must be examined fully for compatibility with the EPC (Art. 101(3) EPC; see also in this chapter IV.D.4.2). Thus, where the respondents (opponents) first raise an objection under Art. 100(b) EPC during the appeal proceedings to an amended claim, the appellants cannot refuse permission to discuss the new ground (**T 27/95**).

In **T 922/94**, the board recalled that Art. 102(3) EPC 1973, R. 66(1) EPC 1973 (cf. Art. 101(3)(a), R. 82, and R. 100(1) EPC) conferred wide powers upon the boards to consider all possible objections under the EPC, pleaded or not pleaded, that might arise from an amendment of the claims originally filed. In case objections concerning the requirements of Art. 123(2) EPC were not expressly pleaded under R. 55(c) EPC 1973 (cf. R. 76(2)(c) EPC), but formed part of the opposition division's decision, the objection under Art. 123(2) EPC formed part of the legal framework of the decision under appeal and the patentee (appellant) could not rely on **G 10/91** for its request not to admit this ground into the appeal proceedings (see **T 227/88**, OJ 1990, 292).

The fact that amendments have been made to a claim in the course of the opposition proceedings does not allow an opponent to raise an admissible objection under Art. 123(2) EPC at the appeal stage in the absence of the patentee's agreement, if such objection results from an amendment made before grant and has not been originally raised as a ground for opposition under Art. 100(c) EPC pursuant to R. 55(c) EPC (**T 693/98**).

The introduction of a feature into an independent claim, which feature was present in the claims and in the description as granted, could not be considered as an amendment which legitimated the admittance of Art. 100(b) EPC as a fresh ground of opposition, which required that a European patent as a whole had to disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (**T 1053/05**; cf. **T 739/08**).

#### 3.4.4 Scope of examination of new grounds for opposition by opposition division

In **T 736/95** (OJ 2001, 191) the ground referred to by the appellant under Art. 100(c) EPC had not been raised in the notice of opposition. The opposition division had decided not to admit the newly submitted ground, without giving the parties any indication that it considered it to be less pertinent. The question which then arose was whether the fresh ground could be examined at all under Art. 114(1) EPC. Having regard

to **G 10/91** (OJ 1993, 420) and **G 1/95** (OJ 1996, 615) and the Guidelines for Examination, the board concluded that the department of first instance at least had to examine whether a fresh ground was relevant and could therefore prejudice maintenance of the patent. Since it did not do so, but based its refusal to admit the ground only on the fact that it had been raised late, the opposition division deprived the appellants of the opportunity to have the relevance of this ground, and thus its admissibility, examined on appeal.

According to the board in **T 520/01**, where a ground was substantiated within the opposition period and the party which had raised the ground neither appeared at the opposition oral proceedings nor withdrew the ground, the ground had to be dealt with by the opposition division and could be taken up by other appellants in subsequent appeal proceedings.

In **T 433/93** the board held that, in all normal cases, if an opposition division decided to introduce a new ground for opposition into the proceedings in addition to the ground(s) for opposition raised and substantiated in the notice of opposition, this should be done in writing as early as possible in the proceedings. The written notification to the patent proprietor from the opposition division informing the proprietor that a new ground for opposition would be introduced into the proceedings should at the same time ensure that the proprietor was informed not only of the new ground for opposition (i.e. the new legal basis for the opposition), but also of the legal and factual reasons (i.e. its substantiation) that would in effect substantiate the new ground which would lead to a finding of invalidity and revocation, so that the proprietor was fully informed of the case which he had to meet, and had a proper opportunity to present comments in reply. If, in a very exceptional case, an opposition division decided for the first time during oral proceedings that a new ground for opposition should be introduced, it would in principle be appropriate, even during oral proceedings, for the opposition division to notify the proprietor in writing both of the introduction of the new ground and of the legal and factual reasons which substantiated such a new ground. In this way, possible misunderstandings would be avoided, and the notification would be part of the written file record of the case.

In **T 620/08** the opposition was originally based on the ground of lack of inventive step alone but, later in the opposition proceedings, the opponent submitted documents and arguments that the subject-matter of the patent lacked novelty. In its decision, the opposition division set out in detail under the point "Novelty" the reasons why it considered that the subject-matter of the patent was novel over these documents, which then led to its decision not to admit the late-filed ground for opposition. The patentee argued before the board of appeal that, since it had not been admitted into the proceedings by the opposition division, the objection of lack of novelty was a fresh ground for opposition which could not be introduced without the agreement of the patentee. Approval was not given. Citing **T 986/93** (OJ 1993, 215), the board took the view that the term "fresh ground of opposition" in **G 10/91** meant a ground which is relied upon for the first time in appeal proceedings. This, however, was not the case here. Novelty as a ground for opposition was relied upon and discussed during the opposition proceedings, thus forming a major part of the decision under appeal. Furthermore, a

board of appeal was at least not barred from considering a late-filed ground for opposition which had been disregarded by the opposition division pursuant to Art. 114(2) EPC, if it was of the opinion that the opposition division exercised its discretion wrongly in this respect. The procedural decision of an opposition division to disregard submissions formed an essential element of its decision-making process and belonged as such to the issues subject to review when the final decision of the opposition division was challenged on its merits.

#### 3.4.5 Examination of fresh facts and evidence

In **T 1002/92** (OJ 1995, 605) the board stated that, when considering the admissibility of a further ground for opposition not covered by the notice of opposition after expiry of the opposition period, both before an opposition division and before a board of appeal, the Enlarged Board was necessarily implicitly considering the admissibility of such a fresh ground in combination with at least an indication of the **fresh facts and evidence** intended to support it. The mere stating of a fresh ground without any indication of the fresh facts, evidence and argument supporting it would obviously be inadmissible, either within or after expiry of the opposition period. It would be illogical to have one criterion for the admissibility of late-filed new facts, evidence and arguments in combination with a fresh ground, and a different criterion for judging the admissibility of late-filed new facts, evidence and arguments in support of a ground for opposition already covered by the opposition statement. Hence, in the board's view, it followed that the principles set out by the Enlarged Board in the opinion **G 10/91** (OJ 1993, 420) as underlying the admissibility of fresh grounds for opposition, were also generally applicable to the admissibility of late-filed new facts, evidence and arguments intended to support grounds for opposition already covered by the opposition statement.

Likewise, where amended claims were introduced in the opposition proceedings there could be no objection to the opponent's submitting new citations and new arguments against the new claims (**T 623/93**). The examination by the opposition division of a new submission justified in this way was in keeping with **G 9/91** (OJ 1993, 408, point 19 of the Reasons).

In **T 154/95** the board ruled that in opposition or appeal proceedings it was basically irrelevant how an opponent came across documents or other evidence made available to the public. Thus there was nothing to stop an opponent from citing a prior use invoked in the same case by another opponent whose opposition was inadmissible because it had been filed after expiry of the opposition period.

#### 3.4.6 Opportunity to comment on new grounds for opposition

Art. 113(1) EPC, in which the requirement that the parties be heard is enshrined, provides that decisions of the EPO may only be based on grounds or evidence on which the parties have had an opportunity to present their comments. The term "grounds or evidence" in Art. 113(1) EPC should not be narrowly interpreted. In particular, in the context of the examination procedure the word "grounds" does not refer merely to a ground of objection to the application in the narrow sense of a requirement of the

Convention which is considered not to be met. The word "grounds" should rather be interpreted as referring to the essential reasoning, both legal and factual, which leads to a refusal of the application. In other words, before a decision is issued, an applicant must be informed of the case which he has to meet, and must have an opportunity of meeting it (see **T 951/92**, OJ 1996, 53; see also **T 105/93**). This interpretation of Art. 113(1) EPC is equally applicable in the context of opposition proceedings: thus the patent proprietor must be informed (normally in writing) not only of the new ground for opposition (i.e. the new legal basis for the opposition), but also of the **essential legal and factual reasons** (i.e. its substantiation) which could lead to a finding of invalidity and revocation. Thereafter the patent proprietor must have a proper opportunity to present comments in reply to the new ground and its substantiation (see **T 433/93**; also **T 1283/11**).

In **T 656/96**, the opponent had based his opposition solely on the invention's purported lack of inventive step. However, lack of novelty was advanced as a ground for opposition for the first time in the oral proceedings and in the absence of the patent proprietor, who had previously informed the division that he would not be attending oral proceedings. The opposition division revoked the contested patent, even though it had not originally raised a novelty objection in its communication under Art. 101(2) EPC 1973 (cf. Art. 101(1) EPC). In such circumstances, the board referred to the case law of the Enlarged Board of Appeal distinguishing between the opposition ground of lack of novelty and that of lack of inventive step (**G 7/95**, OJ 1996, 626) and recognising the opposition division's competence to consider, exceptionally under Art. 114(1) EPC, fresh grounds for opposition which, prima facie, appear, either in whole or in part, to prejudice maintenance of the European patent (**G 10/91**, OJ 1993, 420). In the case in hand, the board held that, particularly in the light of the opinion on novelty expressed in the communication from the opposition division, no prima facie case against maintenance of the patent could be gathered from the file, so that the appellant had been entitled to consider that the question of novelty would play no part before the opposition division. The appellant must therefore have been taken by surprise by the decision taken in his absence by the opposition division at the oral proceedings to revoke the patent on the grounds of lack of novelty, grounds on which he had not been asked, nor had any reason, to express an opinion.

In **T 270/94**, the board found that the opposition division had infringed Art. 113(1) EPC by preventing opponent 1, who had based its opposition solely on lack of novelty, from commenting on an opposition ground of lack of inventive step duly submitted by opponent 2 and communicated to all the parties in accordance with R. 57(2) EPC 1973 (cf. R. 79(2) EPC). Furthermore, the board observed that Art. 114(2) EPC, relied on by the opposition division, was not applicable to the case, because it indicated only that the EPO could disregard late-filed facts or evidence, whereas the case in hand involved arguments put forward by one of the parties to the proceedings in relation to a ground for opposition submitted in due time by another party.

In **T 1164/00**, the board held that the **opposition division** was in principle entitled to introduce a new ground for opposition even at the late stage of oral proceedings, since, in its view, it was apparent that the patent in suit did not comply with the requirements of Art. 83 EPC. However, in this case, the annex to the summons to oral proceedings did

not contain any indication of the opposition division's intention to introduce a new ground for opposition, which meant that the appellant was made aware of the factual and legal reasons supporting the introduction of this new ground for the first time during the oral proceedings. The board therefore concluded that the appellant had not been notified in writing as early as possible and, not having been informed beforehand of the factual and legal reasons, had been taken by surprise and had not had a fair opportunity during the oral proceedings to prepare a proper defence against this new objection. In those circumstances, the opposition division ought to have adjourned the oral proceedings in order to give the appellant sufficient time, in accordance with Art. 113 EPC, to prepare a suitable defence against the new objections (see also **T 433/93**, OJ 1997, 509 and **T 817/93**).

In **T 2362/08**, the board had to determine whether the patent proprietors' right to be heard according to Art. 113(1) EPC had been safeguarded with regard to the decision of the opposition division on insufficiency of disclosure. While the ground of insufficiency appeared in the notice of opposition, the objections of the opponents were merely based on two lines of argument. No further submission on insufficiency was filed by the opponents in writing and, before the oral proceedings took place, no further issue was raised by the opposition division. Specifically, in its communication accompanying the invitation to oral proceedings, the opposition division did not agree with the objections of the opponents, placed the burden of proof on them to establish that the skilled person would be unable to carry out the invention and noted that the opponents had not submitted any experimental evidence. In its decision on insufficiency, however, the opposition division developed a completely different line of argument on a substantive issue of insufficiency which was raised for the first time at the oral proceedings. Furthermore, the patent proprietors had to face an unexpected reversal of opinion from the opposition division, which discharged the opponents of the burden of proof, thereby shifting it to the patent proprietors. The board could not consider the simple formal hearing of the patent proprietors on the issue at the oral proceedings to have been a proper opportunity for them to present their comments. By presenting the new legal and factual framework only at the oral proceedings and by coming to a final decision on the issue without first having given the patent proprietors a proper opportunity to respond, the opposition division did not respect their right to be heard. Therefore a causal link existed between the non-observance of the right to be heard and the decision made, amounting to a substantial procedural violation.

## **4. Amendments in opposition proceedings**

### **4.1. Admissibility of amendments**

#### **4.1.1 General**

The extent to which amendments may be admissible in opposition proceedings was discussed in **T 1149/97** (OJ 2000, 259). Once a decision to grant has been issued, the European examination procedure is closed and its results become binding on the applicant and the EPO in that no further amendments may be made. However, if an opposition is filed, the patent in suit may be amended. Such amendments are not left to

the general discretion of the patent proprietor, since opposition proceedings are not a continuation of the examination proceedings (cf. **G 1/84**, OJ 1985, 299). However, the patent proprietor may, pursuant to R. 80 EPC (cf. R. 57a EPC 1973) – without prejudice to R. 138 EPC (cf. R. 87 EPC 1973) – react to the opponent's objections by amending the description, claims and drawings, provided that the amendments are occasioned by the grounds for opposition specified in Art. 100 EPC, even if the respective ground has not been invoked by the opponent. In addition, amendments occasioned by national rights of earlier date are admissible pursuant to R. 138 EPC (see also in this chapter IV.D.4.1.2).

According to the board, those regulations could be seen to reflect the formal aspects of a procedural cut-off effect associated with the grant of a patent in the opposition phase. Compliance with the restrictions imposed by R. 57a and 87 EPC 1973 (R. 80 and 138 EPC) was thus a prerequisite for any further considerations as to possible substantive cut-off effects for amendments after grant during opposition proceedings which, in the board's view, could only be based on Art. 123(3) EPC (see also Chapter II.E "Amendments").

According to **T 323/05**, which concerned a request to adapt the description, R. 80 EPC (cf. R. 57a EPC 1973) establishes a limit to the amendments which can be made to the patent in suit. Art. 84 EPC and R. 80 EPC are the two provisions which have to guide the patent proprietor when he is invited by the opposition division to adapt the description. In other words, the amendments have to be appropriate and necessary, and nothing more.

In **T 993/07** the board recalled that R. 80 EPC is *lex specialis* for amendments during opposition proceedings, analogous to R. 137 EPC for amendments during examination proceedings. The board interpreted the rule to mean that in opposition proceedings the proprietor's right to amend the patent, e.g. the claims as granted, is limited to making amendments in order to overcome an objection based on a ground for opposition as specified in Art. 100 EPC, thereby possibly avoiding revocation of the patent. In line with this interpretation, the board stated that opposition proceedings were not to be understood as an opportunity for the proprietor to fix any, from his perspective, shortcomings in the patent, such as an insufficient number of independent and/or dependent claims in order to define all commercially valuable embodiments. The fact that the addition of one or more independent and/or dependent claims may improve the fall-back positions in any future revocation proceedings before a national court was clearly not the scope and purpose of either R. 80 EPC or the opposition procedure. The board also observed that a limitation procedure pursuant to Art. 105a EPC is not subject to the same requirement as set out in R. 80 EPC.

The opposition division's decision to admit into the proceedings an auxiliary request (main request in the appeal proceedings) filed during the oral proceedings was challenged before the board in **T 491/09**. In its decision the board concluded that the opposition division had exercised its discretion according to R. 116(1) and (2) EPC by taking into account the following criteria:

a) prima facie allowability: contrary to the opponent's/appellant's argument that the opposition division should have examined the prima facie clarity of the claims, it was evident from the minutes of the oral proceedings that no such objections had been raised. Also, the board could not share the appellant's view that the opposition division should ex officio have examined the entire claim for clarity, following **T 1459/05** and **T 656/07** (on this issue, see now **G 3/14**, OJ 2015, A102, in this chapter IV.D.4.2.2). Apart from the fact that **T 656/07** was issued after the oral proceedings at the opposition stage and that, in general, the opposition division could hardly be expected to receive knowledge of any single decision immediately after its deliverance, the board could not find any fault with the opposition division not following a decision which expressly stated that it concerned a very particular case and thus warranted a departure from otherwise consistent case law.

b) procedural expediency/abuse of procedure: the board recognised that the respondent (patent owner) needed quite some prompting to finally come up with its late-filed request which addressed the point under discussion during the oral proceedings before the opposition division, but could not see an abuse of procedure therein, nor an unwarranted advantage for the respondent.

c) reasonable expectation that the opponents familiarise themselves with the proposed amendments in the time available: the minutes revealed that the oral proceedings had been conducted properly and towards the resolving of the outstanding issues, giving the opponent ample opportunity to familiarise itself with the amended subject-matter.

Since the EPC does not provide for surrender of the patent in opposition proceedings, so that - even if they issue an express statement to that effect - patent proprietors cannot surrender their patent either wholly or in part during such proceedings, they can merely request that the patent be amended. In requesting that the **patent be maintained in a limited form**, a patent proprietor is merely attempting to delimit it to meet objections raised by the EPO or the opponents and does not, by virtue of such limitation, irrevocably surrender subject-matter not covered by the request as limited. In principle, the patent proprietor is free to withdraw such a request at any time during opposition proceedings or to amend it subsequently and, in particular, to resume a defence of the patent as granted, unless this would constitute an abuse of procedural law or the proprietor is prevented from doing so by the prohibition of reformatio in peius (see **T 123/85**, OJ 1989, 336; **T 296/87**, OJ 1990, 195; **T 155/88**, **T 225/88**, **T 217/90**, **T 715/92**, **T 752/93**, **T 1037/96**, **T 445/97**, **T 473/99**, **T 880/01**, **T 794/02**, **T 934/02**, **T 1213/05**, **T 1394/05**).

According to the case law in **T 123/85** (OJ 1989, 336), there is nothing to stop patent proprietors who have defended only a limited version of their patent in opposition proceedings from seeking to reinstate the patent as granted in any subsequent appeal proceedings. However, this is subject to the conditions laid down in **G 9/92** and **G 4/93** (OJ 1994, 875; accordingly, the position taken in **T 369/91**, OJ 1993, 561, is obsolete).

In **G 1/10** (OJ 2013, 194), the Enlarged Board of Appeal held that R. 140 EPC is not available for correcting patents, including during opposition or limitation proceedings.

However, it is always open to a patent proprietor to seek to amend his patent during opposition or limitation proceedings and such an amendment could remove a perceived error. Such an amendment would have to satisfy all the legal requirements for amendments including those of Art. 123 EPC (see also full summary of **G 1/10** in Chapter III.L.1).

#### 4.1.2 Amendments occasioned by national prior rights

Amendments occasioned by national prior rights - which are not included in the grounds for opposition specified in Art. 100 EPC - are also admissible during opposition proceedings. The reference in R. 80 EPC to R. 138 EPC (former R. 87 EPC 1973), which as a general provision of the EPC 1973 also applies to opposition proceedings, makes this absolutely clear (see prior practice in **T 550/88**, OJ 1992, 117).

This was also confirmed by the board in **T 15/01** (OJ 2006, 153). In that case, the appellant had justified the filing of separate claims for Spain and Greece on the grounds that a number of claims as granted might be ineffective in Spain and Greece, since the reservations made by both contracting states under former Art. 167(2)(a) EPC 1973 (now deleted) were still in force on the date of filing of the application. The board held that, although the EPC 1973 did not contain an explicit provision for the corresponding situation where an applicant or proprietor wished to take into account the reservation made by an EPC contracting state under Art. 167(2)(a) EPC 1973, it had been the established practice of the EPO from the very beginning to accept the filing of separate sets of claims for such contracting states. This practice had also been confirmed in **G 7/93** (OJ 1994, 775), in which the Enlarged Board of Appeal regarded such situations as an exceptional case in which amendments might be appropriate at a very late stage of the examination procedure. The technical board further made it clear that the general purpose of R. 57a EPC 1973 (cf. R. 80 EPC) was to allow amendments only where they were made to overcome an objection against the validity of the European patent. It followed from the reference to R. 87 EPC 1973 (cf. R. 138 EPC) that, within the framework of the centralised opposition procedure before the EPO, amendments were also to be allowed where the patentee intended to overcome a possible ground of invalidity which only existed in respect of a particular contracting state. Thus, R. 57a EPC 1973 was not infringed by the formulation of a separate set of claims for a contracting state in which, due to a reservation made under Art. 167(2)(a) EPC 1973, certain product claims as granted would be considered invalid or ineffective.

#### 4.1.3 Time frame for filing amendments

R. 80 EPC (cf. R. 57a EPC 1973) does not specify the point in time up to which amendment is allowed; here existing practice remains unchanged. This restriction of the right to amend is in line with the object and purpose of opposition proceedings, and does away with the need for a discretionary provision like R. 137(3) EPC (former R. 86(3) EPC 1973) (see notes on introduction of R. 57a EPC 1973 in Notice dated 01.06.1995, OJ 1995, 409).



As already mentioned, the boards of appeal have derived, in particular from R. 79(1) EPC (cf. R. 57(1) EPC 1973), the principle that the proprietor has no right to have amendments admitted at any stage of opposition proceedings. At the discretion of the opposition division or the board of appeal, amendments can be refused if they are neither appropriate nor necessary. In particular, late-filed amendments can be refused if they are not a fair attempt to overcome an objection made. In general, the question whether an amendment is appropriate can only be answered on the basis of its content, i.e. after it has actually been submitted. To refuse any further amendment is only appropriate if it is evident after various unsuccessful amendments that the proprietor is not seriously trying to overcome the objections but is only delaying the proceedings (**T 132/92**).

In **T 648/96** the amendments requested during the oral proceedings before the opposition division were simply a response to arguments put forward. The board said EPO deciding instances have a discretion to consider documents (including claims) filed in particular during oral proceedings, if they respond to the instance's or the opponent's objections, or are clearly grantable. Undesirable delays in the proceedings should, however, be avoided.

In **T 382/97** the appellant (patentee) had submitted three auxiliary requests only at the beginning of oral proceedings. It tried to justify disregarding the time limit set by the opposition division under R. 71a EPC 1973 (cf. R. 116 EPC) by citing R. 57a EPC 1973 (cf. R. 80 EPC) which, it asserted, "was created as a *lex specialis* for amendments during opposition proceedings" and did not "specify the point in time up to which the amendment is allowed". Indeed, the board agreed that R. 57a EPC 1973 explicitly established the patent owner's right to amend its patent according to the criteria laid down in that rule, but it could not accept the argument that the absence of a time limit in R. 57a EPC 1973 entitled a patent proprietor to submit amendments to its patent at any time, i.e. also during oral proceedings, without good reason. In the board's judgment, R. 57a EPC 1973 and R. 71a EPC 1973 (cf. R. 116 EPC) together governed the procedural preconditions for amendments to a patent by its proprietor before the opposition division, which amendments of course had to comply with Art. 123(2) and (3) EPC 1973: R. 57a EPC 1973 created the legal basis for amendment, and R. 71a EPC 1973 governed the deadline for doing so. The board emphasised that amendments not complying with a time limit set under R. 71a EPC 1973 might nevertheless be admissible if there were good reasons for their late submission. Finally, the board noted that the patent owner's right to amend its patent under R. 57a EPC 1973 did not equate to an automatic right to file additional auxiliary requests. Any amendment had to be carried out in the most expedient manner, which had to be established by the opposition division, taking into due account the interests of all parties.

In **T 2415/13** the opposition division had admitted an auxiliary request filed only at the oral proceedings since, as stated in its decision, the amendment made in it was "neither unforeseeable nor difficult to grasp". In the board's view, this implied that, according to the opposition division, the opponent could be expected to deal with the amendment during the oral proceedings. This was an appropriate criterion to apply when deciding on

the admissibility of late-filed requests and the board has no reason to assume that the opposition division applied it in an unreasonable way.

#### 4.1.4 Filing amendments

The opposition division exercises a discretionary power in relation to requests for amendment. Consideration of a new or amended independent claim could reasonably be expected when such a new or amended claim results from a combination of features taken from granted claims which has been specifically opposed, since the opponents should already be familiar with the subject-matter (**T 463/95**). The principles for dealing with amendments to opposed patents developed by the boards of appeal also apply to the filing of additional dependent or independent claims in opposition or subsequent appeal proceedings.

##### a) Filing new dependent claims (sub-claims)

The addition of new dependent claims which do not correspond to any claims as granted is not appropriate or necessary to overcome a ground for opposition and therefore impermissible (see e.g. **T 794/94**, **T 674/96**, **T 24/96**). As explained in **T 829/93** and **T 317/90**, the addition of a dependent claim is not a response to an objection that the claimed subject-matter is not patentable because it neither limits nor amends the subject-matter claimed in the relevant independent claim. The fact that dependent claims can serve as an important safety net should the corresponding independent claim ultimately be refused does not render it legitimate to add them to a remaining, broader independent claim in opposition proceedings.

In **T 711/04**, the board took the view that the decision in **G 9/91** (OJ 1993, 408) did not answer the question to what extent a patent proprietor may amend a non-opposed claim in opposition or appeal proceedings. Rather, it merely set out the legal and factual framework for substantive examination of the patent in suit. In accordance with those principles, not even the patent proprietor could propose amendments because the subject-matter of a non-opposed claim was not the subject of an "opposition" within the meaning of Art. 101 and Art. 102 EPC 1973 (Art. 101 EPC combines Art. 101(1) and (2) with Art. 102(1) to (3) EPC 1973; R. 82 EPC) or "proceedings" within the meaning Art. 114 and Art. 115 EPC. The Enlarged Board of Appeal had also found, however, that this basic principle was not directly applicable where the only subject-matter outside the specified scope of the opposition were dependent claims which had to be regarded as implicitly covered. This exception for sub-claims was, the board found, entirely justified by the fact that a sub-claim combined with a main claim and requested as a new main claim had to be examined as to its form and substance in order to ascertain whether or not the combination of the claims had extended the protection sought. This also showed that the theoretical legal construct underlying the **G 9/91** decision, i.e. that there were no proceedings within the meaning of Art. 114 or Art. 115 EPC, was untenable in the case in hand. A patent proprietor wishing to limit the patent to the subject-matter of a non-opposed sub-claim had to combine that sub-claim with the corresponding main claim. The non-opposed sub-claim was inevitably amended as a result, even if the amendment might appear to be a mere technicality.

## b) Filing new independent claims

In **T 610/95** the appellant failed to provide a reasoned argument to show that the filing of new independent claim 5 was indeed necessitated by a ground for opposition. The board referred to **G 1/84** (OJ 1985, 299), which made it clear that the opposition procedure was not designed to be, and was not to be misused as, an extension of the examination procedure. It would, in the board's opinion, contravene the principles set out in **G 1/84** if it was considered admissible to amend the text of a granted patent during opposition proceedings, while maintaining the sole independent claim under opposition, by incorporating an additional new independent claim which as such had no counterpart in the granted patent and, accordingly, was neither the subject of substantive examination in the examination procedure nor open to opposition owing to its non-existence in the granted patent.

In **T 223/97** the board confirmed that the addition during opposition proceedings of one or more independent claims while maintaining the main claim in question could not be considered to be a restriction to the main claim in order to meet the ground for opposition raised against it. These new claims were therefore inadmissible because such amendments could not be said to meet a ground for opposition, even if they otherwise satisfied the dual conditions of Art. 123(2) and (3) EPC. However, the replacement of one independent claim as granted by several, for example two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted was admissible if the replacement was occasioned by grounds for opposition (see also **T 428/12**).

Referring to the above decision, the board held in **T 181/02** that only in exceptional cases could the replacement of a granted single independent claim by two or more independent claims be occasioned by a ground for opposition, for example where a granted independent claim covered two specific embodiments. Such a situation might also arise if two granted dependent claims (e.g. claims 2 and 3) were linked in parallel to a single independent claim (claim 1). Then the filing of two independent claims (e.g. including the features of claims 1 and 2, and 1 and 3) might be possible (moreover thereby decreasing the number of claims). However, it was normally sufficient for the patentee to remain with a single independent claim solely by modifying the granted claim once, i.e. by adding one or more features to the granted single independent claim. Adding a second independent claim was in normal cases not needed to avoid revocation of the patent on the basis of the unmodified or modified granted single independent claim, and furthermore did not do anything to help avoid revocation (see **T 610/95**).

Citing the above case law, the board in **T 263/05** (OJ 2008, 329) added that, when examining the amendments, it did not have to decide whether the ground for opposition would occasion the replacement of a granted single independent claim by two or more independent claims only in "exceptional cases". Rather, it had to be asked in each individual case whether the proposed amendments were an appropriate and necessary response designed to avoid revocation of the patent and could thus be regarded as occasioned by the grounds for opposition.

In **T 937/00** the board noted that the filing of multiple independent claims directed to **different inventions** might unduly complicate and delay the opposition procedure, in particular when this filing was followed by a series of further amendments. An efficient and possibly complete examination of the opposition might for instance become virtually impossible if subsequent amendments were proposed in a piecemeal way rather than addressing all the objections raised by the other party as soon as these objections arose, if they manifestly gave rise to new issues, in particular if they introduced new claims which did not result from any combination of the claims in the granted version, or if they introduced features for which there was no unambiguous support in the application documents as originally filed.

In **T 1/05** the board did not regard the introduction of product-by-process claims as an amendment occasioned by a ground for opposition. The submission of such claims demonstrated that these amendments were not directed addressing a ground for opposition but were intended to compensate for the effects of an amendment that had been made to address such a ground, namely deletion of the product claims.

c) Applicability of Rule 43(2) EPC in opposition proceedings

R. 43(2) EPC (cf. R. 29(2) EPC 1973) provides that a European patent application may not contain more than one independent claim in the same category unless they involve (i) a plurality of interrelated products, (ii) different uses of a product or apparatus or (iii) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

The scope and potential applicability of R. 43(2) EPC in opposition proceedings was addressed in **T 263/05** (OJ 2008, 329). Having considered the purpose and legislative history of the rule, the board concluded that it could not apply across the board to all amendments made during opposition proceedings. If it did, it would be impermissible to make any amendment introducing non-unitary claims, something which was not only permissible in opposition proceedings but also clearly appropriate given that the patent proprietor was no longer able to file a divisional application. To conclude that R. 43(2) EPC applied across the board in opposition proceedings would have watered down the decision in **G 1/91** (OJ 1992, 253). R. 43(2) EPC could not be applied in opposition proceedings to prohibit the amendment of a patent as granted where it would be unreasonable to demand that the amended claims comply with it. This was the case where, otherwise, R. 43(2) EPC would force the patent proprietor to abandon potentially valid subject-matter already contained in the claims as granted. The board could not envisage any circumstances in opposition proceedings in which R. 43(2) EPC would be of any application because, once it had been established that an amendment to the claims was necessary and appropriate having regard to grounds for opposition, it would inevitably be unreasonable to impose the additional requirement that the amendment complied with the purely administrative provisions of R. 43(2) EPC.

According to the board in **T 1416/04**, a request containing a plurality of independent product claims might be allowable under R. 57a EPC 1973 (cf. R. 80 EPC) in order to provide an amendment of a granted set of claims containing only one independent

product claim, if the amended independent claims arose from the deletion of previous claims. With regard to the form of the claims, the board did not consider it relevant for the case before it to decide whether R. 43(2) EPC applied to opposition cases or not: even if R. 43(2) EPC should be considered applicable, the subject-matter in the granted claims could not appropriately be covered by one independent claim so that the requirements of this rule would have been met anyway. If R. 43(2) EPC were not considered applicable to opposition cases at all, by virtue of its wording which relates to a European patent "application" and not to a granted patent, then there could be no objection under this rule against the form of the claims.

#### 4.1.5 Amendments intended to remedy a lack of clarity

Objections to the clarity of claims (here equivocality of the term "average particle size") or any consequent requests for amendment are only relevant to opposition proceedings in so far as they can influence the decisions on issues under Art. 100 EPC or arise in relation to the subject-matter to be amended as a consequence of such issues. This was the view taken by the board in **T 127/85** (OJ 1989, 271), to which it added that it would be an abuse of opposition proceedings if the patent proprietor were allowed merely to tidy up and improve the disclosure by amendments not specifically necessitated by the grounds advanced for the opposition, even if those amendments were to comply with Art. 123 EPC.

According to R. 81(3) EPC (R. 58(2) EPC 1973) limited consideration of amendments is intended to help expedite and streamline opposition proceedings (see e.g. **T 406/86**, OJ 1989, 302; see also **T 24/88**, **T 324/89** and **T 50/90**). According to the established case law of the boards of appeal, Art. 84 EPC is an EPC requirement that has to be taken into account in opposition proceedings whenever the patent proprietor files any amendments. However, Art. 84 EPC is not itself a ground for opposition under Art. 100 EPC. Irrespective of how the granted claims are formulated, and be they dependent or independent, an opposition cannot be lodged on the basis that they lack clarity. Consequently, merely formal, syntactical reformulations of the claims do not give rise to a new objection outside Art. 100 EPC, i.e. under Art. 84 EPC (**T 23/86**, OJ 1987, 316; see further **T 565/89**, **T 89/89**, **T 62/88**, **T 16/87**, OJ 1992, 212, **T 1835/08**, **T 1855/07**, **T 630/09**). In **T 792/95**, another board confirmed the principle that, in opposition proceedings and subsequent appeal proceedings, only such amendments could be made as were necessary in the light of the grounds for opposition under Art. 100 EPC.

In **T 113/86** the board of appeal followed this principle, ruling against the admissibility of amendments proposed by the patent proprietor which were not necessary to take account of the grounds for opposition invoked by the opponent under Art. 100 EPC or by the board under Art. 114 EPC, if there were the slightest possibility of a different interpretation being given to the patent specification before and after the amendments. The protection conferred by the patent would actually be extended if, as a result of amendments to clarify the granted claims, the claims could be more widely construed than a court would have construed them by the application of Art. 69 EPC. However, the board was of the opinion that the removal of an inconsistency between a claim and the

description should be allowed if the inconsistency arose from an error, provided that the error was so obvious to a skilled person in the light of the patent specification as a whole that an interested third party could have anticipated the extent of protection conferred by the amended claim. In these circumstances the request for the correction of an error did not represent an abuse of opposition proceedings. Moreover, the removal of the discrepancy was in the interests of legal certainty.

However, where a deficiency results from a discrepancy between the description and the claim, lack of clarity in the invention's disclosure can be objected to because that requirement comes under Art. 83 EPC, not Art. 84 EPC, and may therefore be taken into consideration in opposition proceedings (see e.g. **T 175/86**).

In **T 684/02** the board considered whether subject-matter which had been deleted during the examination procedure in order to avoid inconsistencies in the patent specification could be **reinstated** in subsequent opposition proceedings. Reference was made to the previous case law in **T 1149/97** (OJ 2000, 259) and **T 37/99**, where the boards had concluded that the reinstatement of subject-matter which, in view of Art. 84 and Art. 69 EPC, had been deleted or indicated as no longer relating to the invention before grant in order to avoid inconsistencies in the patent specification should as a rule not be admissible under Art. 123(3) EPC after grant. Based on the reasons and considerations set out in the above decisions, the board stated that the particulars deleted from the patent application before grant and considered in the case at issue could not be reinstated with regard to Art. 123(3) EPC.

## 4.2. Scope of examination of amendments

### 4.2.1 General

According to **T 472/88**, in all cases in which amendments are requested by a patentee which were compatible with Art. 123 EPC, Art. 102(3) EPC 1973 (now Art. 101(3)(a) and R. 82 EPC) conferred on the opposition division and the board of appeal jurisdiction, and thus the power, to decide on the amended patent in the light of the requirements of the EPC as a whole. This jurisdiction was thus wider than that conferred by Art. 102(1) and (2) EPC 1973 (both now Art. 101(2) EPC) which expressly limited jurisdiction to the grounds of opposition mentioned in Art. 100 EPC. When substantive amendments were made to a patent, both instances have the power to deal with grounds and issues arising from those amendments even if they were not (and could not be) specifically raised by an opponent pursuant to R. 55(c) EPC 1973 (now R. 76(2)(c) EPC) (**T 227/88**, OJ 1990, 292; **G 9/91**, OJ 1993, 408; **T 472/88** and **T 922/94**; also **T 459/09**).

In **T 503/96** the board considered the criteria for the need for an **additional search** in relation to restrictive amendments. It referred to the Guidelines B-III, 3.5, then applicable, which state, "In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended...". The board stated that whether or not to commission an additional search in a particular case was a matter for the administrative discretion of the opposition division, but if an inappropriate

criterion was invoked when exercising this discretion, doubt would inevitably be raised as to whether the discretion was reasonably exercised. Since, in the case of amendment of the claims in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (**G 9/91**, OJ 1993, 408), it was not inappropriate for an opponent to make observations on a possible need for an additional search to enable this full examination to be carried out (Guidelines D-VI, 5, then applicable). The judgment on whether an additional search was necessary and the obligation to perform this search if it was judged to be necessary were administrative matters for the EPO.

In **T 648/96** the board found that the opposition division's failure, in the contested decision, to address the substance of the opponent's "lack of clarity" objections to the amended documents was a substantial procedural violation; under Art. 102(3) EPC 1973 (now Art. 101(3)(a) and R. 82 EPC), it should have examined of its own motion whether the amendments complied with Art. 84 EPC and Art. 123(2) and (3) EPC 1973 (see also **T 740/94**).

#### 4.2.2 Extent of power to examine amended claims for compliance with Article 84 EPC

The extent to which the opposition division or a board of appeal may examine clarity for the purpose of Art. 101(3) EPC was the subject of questions put to the Enlarged Board of Appeal in referral **G 3/14** (OJ 2015, A102). In the case underlying the referral (**T 373/12**, OJ 2014, A115) claim 1 of auxiliary request 1, submitted during opposition proceedings, consisted of a combination of the features of claim 1 as granted and of dependent claim 3 as granted.

As a preliminary point, the Enlarged Board identified the following main types of case: amendments which encompass a literal insertion of elements of dependent claims as granted into an independent claim (type A); these include amendments in which a dependent claim contains within it alternative embodiments, one of which is then combined with its independent claim (Type A(i)), and amendments in which a feature is introduced into an independent claim from a dependent claim, being a feature which was previously connected with other features of that dependent claim from which it is now disconnected (Type A(ii)); furthermore, amendments which encompass a literal insertion of complete dependent claims as granted into an independent claim (Type B, this being the case with which the referring board was confronted).

The Enlarged Board first considered its previous jurisprudence, i.e. **G 1/91** (OJ 1992, 253), **G 9/91** (OJ 1993, 408) and **G 10/91** (OJ 1993, 420). Citing the statement in point 19 of the Reasons in **G 9/91** and **G 10/91** that "[...] in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC", it noted that if the Enlarged Board had at the time considered that the opposition division and the boards of appeal were given wide powers to examine amended claims, it would have said so. Therefore, the term "amendments" had to be understood in the sense that the subject-matter to be examined must have some direct nexus with the amendment.

The Enlarged Board identified three main lines in the jurisprudence of the technical boards: the "conventional" approach, based on the test whether the amendment introduces any contravention of Art. 84 EPC, and the principle that Art. 101(3) EPC does not allow objections to be based upon Art. 84 EPC if they do not arise out of the amendments made (see **T 301/87** and **T 227/88**, applied in many further cases, see e.g. **T 381/02**, **T 1855/07**, **T 367/96** and **T 326/02**). Secondly, there was a wider interpretation, according to which a lack of clarity could be examined if the amendment "highlights and focuses attention" on a previously existing ambiguity (**T 472/88**; see also **T 681/00** and **T 1484/07**). The third line of jurisprudence was considered "diverging". According to **T 1459/05** (see also **T 1440/08** and **T 656/07**), clarity may be examined on a case-by-case basis as a matter of discretion when the added feature is the only feature that distinguishes the subject-matter of the claim from the prior art. **T 459/09** was the most far-reaching of these diverging cases, stating that amended claims may generally be examined for clarity on a case-by-case basis irrespective of the kind of amendment.

On the interpretation of Art. 101(3) EPC, the Enlarged Board pointed out that the requirements of Art. 84 EPC are part of the "requirements of the Convention" for the purposes of Art. 101(3) EPC. There was, however, no indication that the object and purpose of Art. 101(3) EPC was to open up the patent to a complete re-examination, whether for clarity or the other requirements of the EPC. It was rather the amendment itself which was relevant, and its effect for the ground for opposition in question. Self-evidently, the amendment must not itself give rise to new objections.

As apparent from the travaux préparatoires to the EPC 1973, the legislator had deliberately chosen not to make Art. 84 EPC a ground for opposition. It would be unsatisfactory if an opponent could cause delays whenever an amendment was made, by raising all kinds of Art. 84 EPC objections. Moreover, a lack of clarity could still be relevant in opposition proceedings in that it could influence the decision on issues under Art. 100 EPC (sufficiency, novelty, inventive step), or impact on the grounds of invalidity alleged in national proceedings relating to a European patent. Furthermore, when the EPC 2000 was drafted, no suggestion was made for a change to reverse the effect of the then established case law, i.e. the conventional approach based on **T 301/87**. If the deletion of an independent claim with its dependent claims permitted examination of the remaining claims for lack of clarity, Art. 84 EPC would effectively become a ground for opposition in a large number of cases, which would be contrary to the legislator's intention. To conclude otherwise for a combination of claims which actually consists of striking out the original independent claim and then writing out the previously dependent claim in full, would be arbitrary and unjustified.

In conclusion, the Enlarged Board approved the conventional line of jurisprudence as exemplified by **T 301/87**, and answered the referred questions as follows:

"In considering whether, for the purposes of Art. 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Art. 84 EPC only when, and then only to the extent that, the amendment introduces non-compliance with Art. 84 EPC."



In **T 616/12** (issued before decision **G 3/14** above) the board held the appellant's objections to lack of clarity in amended claim 1 to be inadmissible. An objection to the clarity of granted claims was not foreseen in the opposition procedure, as lack of clarity was not a ground for opposition. Since claim 1 was a combination of granted claims 1 and 15, a clarity objection to it was tantamount to raising an objection of lack of clarity to the claims as granted. Furthermore, it was not apparent how a lack of clarity resulted from an amendment caused by combining the granted claims. In the granted patent, claim 15 was directly and truly dependent on claim 1 and thus, in accordance with e.g. R. 43(4) EPC, included all the features of that claim. Claim 15 as granted was thus nothing more than an abbreviated form of the combination of features defined in both claims 1 and 15. Since claim 15 was dependent on any of claims 1 to 14, the amendment of claim 1 to include the features of only claims 1 and 15 could not be understood as anything more than a deletion of claim 1 and its substitution by claim 15. The deletion of the back-reference to claim 1 in granted claim 15 could not be regarded as anything but an appropriate and indeed necessary adaptation for reasons of linguistic correctness when moving from the abbreviated form to the full text. The replacement of the words "characterised in that" by "wherein" and the deletion of reference numerals which were no longer applicable were not changes implying any amendment to the claim in a substantive sense, whereby the clarity of granted claim 15, dependent then on claim 1, also could not be affected. See also e.g. **T 1577/10**.

Considering the different types of amendment distinguished in **G 3/14**, the board in **T 1112/12** observed that a common theme underlying the Enlarged Board's ruling appeared to be that modifying a claim by merely deleting or excluding embodiments from the claimed subject-matter does not result in an amendment which is open to an objection under Art. 84 EPC (see also **T 1977/13** and **T 260/13**).

### **4.3. Removal of error (in claim) in opposition proceedings**

According to **T 657/11**, in opposition proceedings mistakes or errors concerning the claims, the description or the drawings of the patent as granted may be removed either by an amendment occasioned by a ground for opposition under Art. 100 EPC or, as far as the mistakes or errors concern texts or drawings which remain unamended, by way of a correction pursuant to R. 139 EPC.

The claims according to the main request before the opposition division and the appellant's initial request in the appeal proceedings differed from the granted claims only in that the wording "NF permeate" in the last process step of claim 6 was replaced by "NF concentrate". The board had communicated that R. 140 EPC was not available to correct the text of a granted patent (**G 1/10**, OJ 2013, 194). However, the claims according to the appellant's final (sole) request were, as compared to the claims as granted, amended beyond the mere removal of an error, namely by limiting them to those granted as (process) claims 6 to 11. Hence the basis for the decision on the appeal (and, thereby, on the opposition) was no longer that for the decision to grant, which would definitely lose its effect and be replaced by a new decision. In such a situation any (further) amendment of the claims, even if aimed at removing an obvious mistake in the claims as granted, did not constitute a correction of an error in a decision

of the EPO within the meaning of R. 140 EPC. As pointed out in **G 1/10**, it was always open to a patent proprietor to seek to amend his patent during opposition or limitation proceedings and such amendment could remove a perceived error. However, an amendment with the (sole) aim of removing a mistake or error in the claims, but also in the description and drawings of the patent as granted, could not be said to be "occasioned by a ground for opposition under Art. 100" (R. 80 EPC). It followed that such mistakes or errors – here the expression "[nanofiltration] permeate"- in the unamended part of the text could only be removed by a correction pursuant to R. 139 EPC, which provision and the specific requirements defined therein applied independently of R. 80 EPC. The proposed correction was in accordance with those requirements.

## **5. Right to be heard in opposition proceedings**

### **5.1. Principle of equal treatment**

In inter partes proceedings such as opposition proceedings the right to be heard is inextricably linked to the **principle of equal treatment**: 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. If the opposition division considers a multiple exchange of submissions expedient, it must give each party equal opportunity to comment. Thus, the opposition division may invite a party to submit a **rejoinder to the reply** to the notice of opposition, but in that case it is obliged to invite the other party to **respond to that rejoinder**, after which it must decide again whether a third exchange of submissions is expedient. The fact that R. 79(3) EPC (R. 57(3) EPC 1973) leaves it to the opposition division ("if it considers it expedient") to invite the opponents to reply cannot be interpreted as an authorisation to derogate from the fundamental principle of equal treatment (see **T 190/90**, **T 682/89** and **T 439/91**). According to **T 669/90**, (OJ 1992, 739), if the opposition division 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 an adverse party, and if such new facts and evidence then form the basis for a decision adversely affecting the misled party, the latter has not had "an opportunity to present its comments" within the meaning of Art. 113(1) EPC. Such a procedure is also not a fair procedure and is contrary to the principle of good faith governing relations between the EPO and parties to proceedings before it (cf. **T 532/91**, **T 678/06**). Such inequality of treatment constitutes a substantial procedural violation.

In addition to the cases that follow, see in this chapter IV.D.3.4.6 "Opportunity to comment on new grounds for opposition".

### **5.2. Invitation to file observations under Article 101(1) EPC**

Art. 101(1) EPC (Art. 101(2) EPC 1973) reinforces the right to be heard laid down in Art. 113 EPC by requiring the opposition division, when examining an opposition, to invite the parties **"as often as necessary"** to comment, within specified periods, on its own communications or those filed by other parties. Where necessary, any communication to the proprietor of the European patent must contain a reasoned

statement covering all the grounds against the maintenance of the European patent (R. 81(3) EPC; R. 58(3) EPC 1973).

Art. 101(1) EPC does not require as a rule that the grounds for not maintaining the patent invariably be set out in a communication, but only if this is "necessary". Such "necessity" can arise only in efforts to establish the facts or in view of Art. 113(1) EPC. So the opposition division **must issue a communication only** if it considers this necessary, e.g. to take up **new** substantive or legal arguments or draw attention to points still requiring clarification. R. 81(3) EPC, which merely contains instructions concerning the content of any communications that may have to be issued, adds nothing to the above consideration of principle. Accordingly, the provisions of Art. 101(1) EPC and R. 81(3) EPC cannot be interpreted as meaning that the opposition division is obliged in every case to issue at least one communication before giving its decision, unless it is necessary to do so on the basis of Art. 113(1) EPC (see e.g. **T 275/89**, OJ 1992, 126; **T 538/89**, **T 682/89** and **T 532/91**).

Not issuing at least one communication under Art. 101(1) EPC cannot in itself substantiate an allegation of infringement of the right to be heard under Art. 113 EPC (see e.g. **T 774/97** and **T 781/08**). In **T 165/93**, for example, the board saw no need under Art. 113(1) EPC for the opposition division, before revoking the patent, to announce its opinion in a communication or to give a further opportunity to the patentee to declare whether he was interested in a limited patent if, despite having been informed of an additional objection of the opponent, he did not react but maintained his sole request for maintenance of the patent with the amended claims. Nor is it necessary under Art. 113(1) EPC to give a party a **repeated opportunity** to comment on the argumentation of the EPO body, so long as the decisive objection against the contested procedural action remains the same (see e.g. **T 161/82**, OJ 1984, 551; **T 621/91**).

According to **T 295/87** (OJ 1990, 470), in opposition proceedings, under Art. 101(2) and R. 57(1) EPC 1973 (cf. Art. 101(1) and R. 79(1) EPC) the proprietor has a right to file observations upon a notice of opposition. Thereafter, observations from the parties are only admissible in the exercise of the discretion of the opposition division or a board of appeal, if such observations are necessary and expedient in the sense of Art. 101(2) and R. 57(3) EPC 1973 (cf. Art. 101(1), R. 79(3) EPC). The board specified that following communication of the patentee's observations (and any amendments), other parties are only to be invited by the opposition division to reply to such observations "if it considers it expedient". It was clearly desirable in the interest of the smooth and efficient conduct of opposition proceedings, and in the public interest, that observations by parties should be properly limited to what is necessary and expedient. This in turn required the exercise of a proper control by the opposition division (and by a board of appeal). Of course, the extent to which further observations are necessary or expedient depended upon various factors, including the complexity of the issues, and could only be decided in the context of each case. Nevertheless, in appropriate cases, 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 exercise of discretion under Art. 101(2) and 114(2) and R. 57(3) EPC 1973 (cf. Art. 101(1) and 114(2) and R. 79(3) EPC).

### 5.3. Invitation to file observations under Rule 82(1) EPC

R. 82(1) EPC (R. 58(4) EPC 1973) provides that the opposition division is to inform the parties of the text in which it intends to maintain the patent and invite them to state their observations **within two months** if they disapprove of that text. The boards of appeal have frequently addressed the issue of when it is necessary to send the parties such a communication.

In **T 219/83** (OJ 1986, 211) and **T 185/84** (OJ 1986, 373) the board stated that, after oral proceedings in an appeal from opposition proceedings, the parties had to be sent a communication pursuant to R. 58(4) EPC 1973 only if they could not reasonably be expected to state their observations concerning the maintenance of the European patent in the amended form definitively during the oral proceedings. This case law was confirmed in several decisions (e.g. **T 75/90**, **T 895/90** and **T 570/91**).

In **T 446/92** it was stated that, in a case where a duly summoned opponent was not represented at oral proceedings, the decision of the board to maintain the contested patent in amended form in accordance with a request of the patentee submitted during those proceedings could nevertheless be given orally (R. 68(1) EPC 1973; cf. R. 111(1) EPC) at the end of the proceedings, if no new facts or evidence were dealt with during the proceedings. Under these circumstances, the application of R. 58(4) EPC 1973 could be dispensed with because the patent in suit was maintained with an amended text emanating from and approved by the patentee (see, in this respect, **G 1/88**, OJ 1989, 189) and, furthermore, because the opponent's deliberate decision to refrain from being represented at oral proceedings before the board was to be regarded as being tantamount to a tacit abandoning of his right to present comments pursuant to Art. 113(1) and R. 58(4) EPC 1973. In the previous decisions **T 424/88**, **T 561/89** and **T 210/90** the board did not send the parties/participants a communication pursuant to R. 58(4) EPC 1973, even though the appellants (opponents) had not attended the oral proceedings.

### 5.4. EPO communication concerning submissions by the other party - adequate opportunity to reply

Communications signed by the formalities officer and inviting the appellants to "take note" of the opponents' submissions are not communications of the opposition division within the meaning of Art. 101(1) EPC (Art. 101(2) EPC 1973), which require a period to be fixed for reply (normally four months; see Guidelines E-VII, 1.2 - November 2015 version). It is at the discretion of the recipient to reply to this communication if he finds it necessary, having reviewed the significance of the material sent to him. If he intends to reply but for any reason is prevented from doing so within a reasonable period of time, then the appropriate action is to inform the opposition division of his difficulties (see **T 582/95**).

The boards of appeal have dealt in a series of decisions with the issue of fixing a reasonable period which provides the recipient of an EPO communication with an adequate opportunity to reply:

The right to be heard enshrined in Art. 113(1) EPC 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. The question regarding what period of time is sufficient for this purpose is a **question of fact** which has to be answered on the basis of the merits of each individual case. As a rule, the time limit set by the EPO should not be shorter than **two months** (see R. 132 EPC, former R. 84 EPC 1973).

Exceptional circumstances in which a shorter period of time was held to be acceptable were mentioned in **T 275/89** (OJ 1992, 126). In this case, the objection was made that the interval between the notification to the patentee of a submission from the opponents and the date the decision was issued was too short to allow the appellant (patentee) to file observations. The board noted that the opposition division had waited for somewhat longer than a month before taking its decision. In the board's view, in the case of a communication which was issued for information purposes only and which did not set a time limit for response, a period of **one month** (which in the present case was exceeded) sufficed as a rule to comply with the requirements of Art. 113 EPC. Moreover, the documents on which the decision under appeal was based had already been mentioned in the notice of opposition together with an assessment of their substantive and legal significance, so that the decision under appeal was not based on fresh matter.

In **T 494/95**, the board took the view that the interval of **more than one month** between the notification of the patent proprietor's reply to the opposition and the date of issuing the decision was sufficient to allow the appellant (opponent) a reasonable opportunity to present his comments, or at least to indicate an intention of so doing, or to request oral proceedings. In the board's view, it was clear from R. 57(3) EPC 1973 (cf. R. 79(3) EPC), from the EPO information "Opposition Procedure in the EPO" (OJ 1989, 417) and from previous decisions that, if oral proceedings did not take place and the decision was based solely on grounds on which the parties concerned had had an opportunity to present their comments, a decision could be taken without further notice upon expiry of the period allowed to the patent proprietor for submitting observations. Here, the board could not see that any procedural violation had occurred, as the decision was neither based on grounds unknown to the appellant (Art. 113(1) EPC), nor was the opposition division invariably obliged under the EPC to set a time limit for the appellant's response to the patent proprietor's observations or to suggest that any such response should be made.

By contrast, another board held in a case involving difficult technical questions that a period of about one month did not provide the appellant with a realistic opportunity to inform the opposition division of his intention to file a substantive reply and to ask for an appropriate time limit for this purpose, let alone to present substantive comments (**T 263/93**; see also **T 494/95**).

In **T 914/98** the board stated that the **seventeen-day** period which elapsed between the appellants receiving the reply of the respondents and the handing over of the decision to the EPO internal postal service was manifestly **too short** to give the appellants an

adequate opportunity for comment. According to the board, in view of the case law the appellants could not reasonably have expected a decision to be issued so quickly.

### 5.5. Opportunity to present comments

In **T 293/88** (OJ 1992, 220) the board found that the decision of the opposition division to revoke the patent without issuing any communication in advance disregarded the fact that the validity of the **uncontested claims** 7, 9 and 10 had not been challenged at all, and a further opportunity to fall back at least to such position was reasonably to be expected in such circumstances. The onus of raising such related additional matter with the parties was on the opposition division under Art. 113(1) EPC - which it had not done in this case (unlike **T 9/87**, OJ 1989, 438; here it was held that the opposition division had no obligation to examine uncontested claims in different categories which related to different inventions).

In **T 558/95** the opposition division had issued two written communications before the oral proceedings stating that, "in the **provisional opinion of the opposition division**", the subject-matter described in the public prior use did not prejudice the contested patent within the terms of Art. 100(a) EPC. The patent proprietor therefore found it "surprising" that detailed consideration was given to the public prior use during the oral proceedings. However, the board held that provisional opinions of this kind were not binding on the further proceedings. Especially in view of the fact that the opponent continued to elaborate his arguments against these comments by the opposition division, the possibility of a different assessment by the opposition division could not be ruled out from the start.

The opposition division that rejects an opposition as **inadmissible** without providing a reasoning prior to its decision prevents the opponent from responding with comments, thus violating the right to be heard (**T 1056/98**).

Normally, where a document has been sent to one of the parties, that party is given sufficient time to respond thereto before a department of the EPO takes a decision (**T 263/93**). If the case is to be **remitted to the department of first instance** for further prosecution, the recipient of a document still has, in view of the remittal, the opportunity to contest the arguments put forward by the other party (see **T 832/92**).

Under Art. 113(1) EPC, the opposition division must expressly give the parties an opportunity to present observations after remittal to it of a case by a board of appeal for further prosecution on the basis of new evidence, even if submissions with respect to this new evidence have already been made during the preceding appeal proceedings (see **T 892/92**, OJ 1994, 664; see also **T 769/91**). In **T 120/96** another board shared this view and added that the term "opportunity" in Art. 113(1) EPC could only be given effective meaning by applying the principles of good faith and the right to a fair hearing. For such an opportunity to exist, it is necessary that the parties be expressly asked whether or not they wish to present, within a fixed period of time, their comments, or if, as in the case at issue, the parties have already made detailed submissions during the previous appeal proceedings, whether or not these submissions should be regarded as complete. On

these grounds alone, the board found that the immediate termination of the opposition proceedings following the remittal, without any intervening communication announcing the resumption of proceedings, was inconsistent with Art. 113(1) EPC.

In **T 1027/13**, a case in which an accompanying person had not been allowed to speak in oral proceedings before the opposition division, the board held that an effective and efficient conduct of oral proceedings, although subject to the discretionary power exercised by the Chairman in oral proceedings with regard to specific issues, must nevertheless guarantee that the fundamental procedural rights of each party in adversarial proceedings, i.e. the right to fair and equal treatment, including the right to present comments in oral proceedings (Art. 113(1) and 116 EPC), are respected (see also Chapter III.R.5.2).

## **6. Acceleration of opposition proceedings in the case of pending infringement proceedings**

If the opposition division is unable to process an opposition speedily on account of the amount of work in hand, it should, in principle, process submissions in order of receipt (Guidelines D-VII, 1.1 – November 2015 version). One exceptional case in which an opposition must be given priority is where a party has submitted a reasoned request for accelerated processing because an infringement action is pending before a national court of a contracting state, or a national court or competent authority of a contracting state informs the EPO that infringement actions are pending (Notice of 17 March 2008, OJ 2008, 221; Guidelines, D-VII, 1.2(iii) and E-VII, 4 – November 2015 version).

The case underlying **T 290/90** (OJ 1992, 368) involved seven oppositions. One of these was deemed not filed, and the opponent appealed against the decision issued in respect of it under R. 69(2) EPC 1973 (R. 112(2) EPC). 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 to enforce the patent if maintained.

According to the board, a "raison d'être" for obtaining and maintaining a patent was to enforce it where appropriate. The timing of enforcement proceedings could be of real importance and delays could be prejudicial to the proprietor's interests and those of his competitors. In the case of infringement proceedings the speedy processing of opposition proceedings in respect of the relevant European patent became especially important. It was therefore important to decide quickly not only on the appeal but also on the complete substantive opposition. In the case of multiple oppositions, as here, the board considered, in view of the suspensive effect of the appeal, that the opponent (appellant) should be treated as having duly filed an opposition unless and until the board decided otherwise. With an appeal concerning the existence or admissibility of one of the oppositions, the examination stage of the opposition proceedings should be prepared and processed in parallel, with the participation of all the opponents, up to the point when it was ready to be decided: as soon as the appeal was decided, the opposition could also be decided (see Headnote II.).

See also Chapter IV.E.1.3 "Accelerated processing before the boards of appeal".

## 7. Decisions of opposition division

### 7.1. Revocation of a European patent by way of decision

It had been held in **T 26/88** (OJ 1991, 30) that the revocation of the patent for failure to fulfil the formal requirements of paying the printing fee and filing the translations of the amended claims (Art. 102(4) and (5) EPC 1973; cf. R. 82(3), second sentence, EPC) had occurred by operation of law ("automatically").

However, according to **G 1/90** (OJ 1991, 275), the revocation of a patent under Art. 102(4) and (5) EPC 1973 **required a decision**. The Enlarged Board compared the various procedural stages (grant, opposition and revocation, in connection with the future Community patent) and concluded that the wording of the regulations clearly indicated in each case whether a decision or a communication had to be issued concerning the loss of rights under R. 69(1) EPC 1973 (R. 112(1) EPC)). It also considered the issue of legal certainty and, in the light of the "travaux préparatoires", discussed the question of when a loss of rights noted in accordance with that provision became non-appealable. It found that the procedure of pronouncing revocation by way of a decision led neither to legal uncertainty nor to misunderstandings. Whereas, in the grant procedure, there was a clear basis for the deemed withdrawal of an application, no such possibility existed with oppositions because the patent proprietor was unable to abandon his granted patent by making a declaration to the EPO. The Enlarged Board confirmed that it was up to the legislator to decide when to issue a communication pursuant to R. 69(1) EPC 1973, which is followed on request by a decision (R. 69(2) EPC 1973), and when a decision was not preceded by such a communication. If the EPC had laid down different provisions for grant and opposition, that did not constitute an inherent contradiction.

### 7.2. Interlocutory decisions

#### 7.2.1 General

In case **T 376/90** (OJ 1994, 906) the opposition division had held that the opposition was **admissible** in an interlocutory decision within the meaning of Art. 106(3) EPC 1973 (Art. 106(2) EPC), i.e. a decision which did not terminate the proceedings as regards one of the parties, without, however, allowing separate appeal. In the board's view, according to the clear language of the 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. This discretion had been properly exercised by the opposition division with a view to enabling a decision on the substantive issues to be reached as soon as possible.



### 7.2.2 Maintenance of 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. 101(2) and (3)(a) EPC (former Art. 102(1) to (3) EPC 1973) 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 R. 82(2) EPC (former Art. 102(3)(b) EPC 1973) a prerequisite for maintenance of the patent as amended is that the fee for publishing (former printing fee) be paid. With these regulations in mind, the EPO very early on adopted the device of an interlocutory decision, for which there is no express provision, in order to establish in the first place the text of the amended specification. Only after this interlocutory decision has come into force are the fee for publishing (formerly printing) and a translation of the claims in the other official languages requested pursuant to R. 82(2) EPC (former R. 58(5) EPC 1973). Once these requirements have been fulfilled what is then a non-appealable final decision on maintenance of the patent as amended is given and the new patent specification is published.

A decision to maintain the European patent - even an interlocutory decision - can of course only be given if there is a text "submitted or agreed" by the patent proprietor pursuant to Art. 113(2) EPC 1973. In that connection R. 82(1) EPC (Art. 102(3)(a) EPC 1973) 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. 82(1) EPC (R. 58(4) EPC 1973) even where the text has already been "submitted or agreed" by the patent proprietor during the proceedings and rejected by the opponent.

Prior to that, it had been held in **T 390/86** (OJ 1989, 30) that Art. 102(3) EPC 1973 and R. 58(4) EPC 1973 did not preclude that an opposition division could, in the course of opposition proceedings, make a (final) interlocutory decision in respect of a substantive issue raised by the opposition, before sending any R. 58(4) EPC 1973 communication. What was precluded by R. 58(4) EPC 1973 was that the opposition division should "decide on the maintenance of the European patent" in an amended form without first informing the parties of the amended text in which it was intended to maintain the patent and inviting their observations. However, neither Art. 102(3) EPC 1973 (now Art. 101(3)(a) and R. 82 EPC) nor R. 58(4) EPC 1973 precluded an opposition division from giving **decisions on substantive issues** in the opposition before sending a communication under R. 58(4) EPC 1973, and before "deciding to maintain the patent in amended form". For example, an opposition division could during the course of an opposition make a (final) interlocutory decision (either orally or in writing) that a particular proposed amendment contravened Art. 123 EPC. Similarly, an opposition division could make a (final) interlocutory decision during an opposition that the main claim, for example, of the opposed patent could not be maintained. Such a **substantive**

**interlocutory decision** was not a decision actually to maintain the patent in amended form, but was preliminary to such a decision. The taking of such substantive interlocutory decisions during the course of opposition proceedings was desirable both in order to move the proceedings forward towards a conclusion, and, in appropriate cases as envisaged in Art. 106(3) EPC 1973 (cf. Art. 106(2) EPC), to allow a party to appeal such an interlocutory decision before the opposition proceedings were terminated. It was further held that where a final substantive decision had been given, an opposition division had no power thereafter to continue examination of the opposition in relation to the issues which were the subject of that decision, either under R. 58(5) EPC 1973 (cf. R. 82(2) EPC) or at all. Further submissions from the parties relating to such issues were inadmissible.

In **T 89/90** (OJ 1992, 456) the opponents had lodged objections to an interlocutory decision which maintained the patent as amended. The board observed that the EPC contained no general rules as to when an interlocutory decision could or should be delivered. The relevant department therefore had to use its discretion in judging whether an interlocutory decision was appropriate in an individual case or whether the matter could only be settled in a decision terminating proceedings. This involved weighing up various considerations such as whether an interlocutory decision would accelerate or simplify the proceedings as a whole (clarifying a disputed question of priority, for example, could be of key importance for the form and length of the subsequent proceedings) and clearly also included the issue of costs. In the board's view, it was clear that the established practice of delivering appealable interlocutory decisions under Art. 106(3) EPC 1973 (cf. Art. 106(2) EPC) where a patent was maintained as amended was based on the weighing up of such cost aspects. The board concluded that this practice was both formally and substantively acceptable.

In **G 9/92** (OJ 1994, 875), the Enlarged Board of Appeal set out the implications of an admissible appeal against an interlocutory decision of the opposition division maintaining the patent in amended form, first, where the sole appellant is the patent proprietor and, secondly, where the sole appellant is the opponent. In the first case, neither the board nor the non-appealing opponent as a party as of right may challenge the maintenance of the patent as amended in accordance with the interlocutory decision. In the second case, the patent proprietor is primarily restricted to defending the patent in the form in which it was maintained by the opposition division. The board may reject as inadmissible any amendments proposed by the patent proprietor as a party as of right if they are neither appropriate nor necessary. For further details of the prohibition on *reformatio in peius* and its application in board decisions, see Chapter IV.E.3.1.

**E. Appeal procedure**

1.	Legal character of appeal procedure	1065
1.1.	Suspensive effect of the appeal	1066
1.2.	Devolutive effect of the appeal	1067
1.3.	Accelerated processing before the boards of appeal	1068
2.	Filing and admissibility of the appeal	1069
2.1.	Transitional provisions	1069
2.2.	Appealable decisions	1070
2.2.1	Departments	1070
2.2.2	Decisions	1070
	a) Examples of appealable decisions	1071
	b) Examples where the communication was not an appealable decision	1071
2.2.3	Interlocutory decisions	1073
2.2.4	Appeals against decisions of the boards of appeal	1073
2.3.	Board competent to hear a case	1074
2.3.1	Technical or Legal Board of Appeal	1074
	a) General	1074
	b) Technical board of appeal competent	1075
	c) Legal Board of Appeal competent	1075
2.4.	Entitlement to appeal	1076
2.4.1	Formal aspects under Article 107 EPC	1076
	a) Appeal filed in name of representative	1076
	b) Appeal filed by wrong company	1076
	c) Party consisting of plurality of persons	1077
	d) Company in receivership	1078
2.4.2	Party adversely affected (Article 107 EPC)	1078
	a) General	1078
	b) Patent applicant	1079
	c) Patent proprietor	1080
	d) Opponent	1081
2.4.3	Procedural status of the parties	1083
	a) Parties to appeal proceedings	1083
	b) Rights of parties under Article 107 EPC	1084
	c) Retrospective restoration of a company	1086
2.5.	Form and time limit of appeal	1086
2.5.1	Electronic filing of appeal	1086
2.5.2	Form and content of notice of appeal (Rule 99(1) EPC)	1087
	a) Rule 99(1)(a) EPC	1088
	b) Rule 99(1)(b) EPC	1091
	c) Rule 99(1)(c) EPC	1092
	d) Rule 99(3) EPC	1093
2.5.3	Appeal filed within the time limit	1094
2.5.4	Payment of appeal fee	1095
2.6.	Statement of grounds of appeal	1095
2.6.1	Legal provisions	1095

2.6.2	Form of statement of grounds of appeal	1096
2.6.3	General principles	1096
	a) Legal or factual reasons to be specified	1097
	b) Grounds to be analysed vis-à-vis reasons in decision	1098
	c) Duty of board to be impartial	1101
2.6.4	References	1102
	a) References to earlier submissions	1102
	b) References to other documents	1103
2.6.5	New case raised	1103
	a) By opponent (appellant)	1103
	b) By patent proprietor or applicant and appellant	1105
2.6.6	Arguments need not be new or relevant	1107
2.6.7	Subsequent withdrawal of relevant objection	1107
2.6.8	Exceptional circumstances warranting admissibility of appeal	1107
	a) Immediately apparent the contested decision cannot be supported	1107
	b) Patent proprietor requests revocation	1108
	c) Substantial procedural violation	1108
2.6.9	No partial admissibility of appeal	1108
2.7.	Admissibility of appeal to be checked in every phase of appeal proceedings	1108
2.8.	Cases where admissibility of appeal need not be considered	1109
2.9.	Interlocutory revision	1109
2.9.1	General	1110
2.9.2	Reimbursement of appeal fee	1111
3.	Substantive examination of the appeal	1111
3.1.	Binding effect of requests - no reformatio in peius	1111
3.1.1	Reformatio in peius does not apply separately to each point	1112
3.1.2	Reformatio in peius and devolutive effect of appeal	1112
3.1.3	Cases where reformatio in peius does not apply	1113
3.1.4	Exceptions to reformatio in peius to be construed narrowly	1113
3.1.5	Patentee as sole appellant	1114
3.1.6	Opponent as sole appellant	1114
3.1.7	Revocation of patent	1115
3.1.8	Exceptions to the rule	1116
3.1.9	Reformatio in peius and lack of cross-appeal in the EPC	1118
3.2.	Subject-matter under examination	1118
3.2.1	Opposition appeal proceedings	1118
	a) Admissibility of opposition	1118
	b) The notice of appeal	1119
	c) Unopposed subject-matter not reviewed	1119
	d) Appeal by patentee against revocation	1120
	e) Removal of references in dependent claims	1120
	f) Abandonment of subject-matter	1120
	g) Withdrawal of request during opposition proceedings	1122
	h) Ground not properly substantiated by the patentee	1122
	i) Ground not properly substantiated by the opponent	1122
	j) Ambiguities in the claims	1123
3.3.	Patentability requirements under examination in ex parte proceedings	1123

---

3.3.1	Ex parte proceedings	1123
3.4.	Facts under examination - applying Article 114 EPC in appeal proceedings	1124
3.4.1	Boards to examine facts of own motion	1124
3.4.2	Circumstances where the board need not examine facts of its own motion	1125
3.5.	Arguments under examination	1126
3.6.	Review of first-instance discretionary decisions	1126
4.	Filing of amended claims in appeal proceedings	1127
4.1.	Introduction	1127
4.1.1	Legal basis	1127
4.1.2	Rules of Procedure of the Boards of Appeal (RPBA)	1127
4.1.3	Historical development	1128
4.1.4	Principles applicable to amended claims on appeal	1129
4.2.	State of proceedings	1130
4.2.1	General	1130
4.2.2	Procedural economy	1130
4.2.3	Parties' right to submit observations on amendments – Article 13(2) RPBA	1131
4.2.4	Unsubstantiated requests	1132
4.2.5	Amendments after arrangement of the oral proceedings	1133
4.2.6	Filing of requests during the oral proceedings	1134
	a) Efficient conduct of the proceedings	1134
	b) Amended claims not admitted	1135
	c) Amended claims admitted	1136
	d) Applicant (proprietor) absent from oral proceedings	1137
	e) Absence of opponent from oral proceedings	1138
4.3.	Article 12(4) RPBA - requests not examined at first instance	1139
4.3.1	General principles	1139
4.3.2	Inter partes appeal procedure	1140
	a) Admission of requests already refused by the opposition division	1140
	b) Broadening of claims considered by the opposition division	1141
	c) Requests not submitted by proprietor in opposition proceedings	1142
	d) Resubmission of requests withdrawn at opposition stage	1144
	e) Request admitted as a normal procedural development	1147
4.3.3	Ex parte appeal procedure	1148
	a) Admission of requests already refused by the examining division	1148
	b) Requests not submitted in examination proceedings	1148
	c) Resubmission of requests withdrawn during examination	1150
	d) Feature re-introduced on appeal	1151
	e) Interlocutory revision	1151
4.4.	Criteria for consideration of amended claims	1151
4.4.1	Introduction	1151
4.4.2	Clear allowability of amended claims	1152
	a) General	1152
	b) Examples	1153
4.4.3	Response to objections	1153
4.4.4	Converging or diverging versions of claims	1154

4.4.5	Discretion to admit amended claims at any stage of the appeal proceedings	1155
4.4.6	Last chance	1156
4.4.7	Change of subject-matter	1156
4.4.8	Need for additional search	1157
	a) General	1157
	b) Features taken from the description – Art. 13(3) RPBA	1157
	c) Carrying out an additional search	1158
4.4.9	Dependent claims	1158
4.4.10	Number of auxiliary requests	1159
4.4.11	Amended claims not admitted with divisional applications pending	1160
4.4.12	Board's communication	1160
4.5.	Reinstating broader claims in appeal proceedings	1160
4.5.1	General	1160
4.5.2	Patent revocation	1162
4.6.	Circumstances extraneous to proceedings	1163
4.6.1	Introduction	1163
4.6.2	Change of party or representative	1163
5.	Parallel proceedings	1164
6.	Termination of appeal proceedings	1164
6.1.	Closure of the substantive debate	1165
6.1.1	Decision taken as the file stands	1165
6.1.2	Proceedings after delivery of the decision	1165
6.2.	Interlocutory decisions of a board	1166
6.3.	Withdrawal of the appeal	1167
6.3.1	Article 114(1) EPC and withdrawal of the appeal	1167
6.3.2	Board's duty to issue decision when appeal is withdrawn after the decision is announced	1167
6.3.3	Board's powers to decide on issues after withdrawal of the appeal	1168
6.3.4	Withdrawal of appeal after filing of intervention	1168
6.3.5	Partial withdrawal of appeal by sole appellant and opponent	1168
6.3.6	No withdrawal of appeal with retrospective effect	1168
6.3.7	Request for withdrawal of appeal to be unambiguous	1169
6.3.8	Conditional withdrawal of appeal	1169
6.4.	Deemed withdrawal of patent application	1169
7.	Remittal to the department of first instance	1170
7.1.	General	1170
7.2.	Remittal following filing or late submission of relevant new document	1170
7.2.1	Opposition appeal proceedings	1170
7.2.2	Ex parte appeal proceedings	1171
7.2.3	Patent in jeopardy	1172
7.2.4	New facts or evidence	1172
7.3.	Remittal following substantial amendment to claims in the appeal proceedings	1174
7.4.	Remittal following a substantial procedural violation	1175
7.4.1	Legal basis	1175
7.4.2	Violation of right to be heard	1176

---

7.4.3	Violations of Article 19(2) EPC (composition of the opposition division)	1177
7.4.4	Unclear whether appellant adversely affected	1177
7.4.5	Special reasons not to remit under Article 11 RPBA	1177
a)	Circumstances held not to constitute special reasons under Article 11 RPBA	1177
b)	Circumstances held to constitute special reasons under Article 11 RPBA	1178
7.5.	Introduction of new arguments and amendment of the description	1180
7.6.	Exercise of discretion to remit	1180
7.6.1	No absolute right to have issue decided on by two instances	1180
7.6.2	Function of appeal	1180
7.6.3	Interests of procedural economy	1181
7.6.4	Final decision reached after expiry of patent	1181
7.6.5	Fresh case	1181
7.6.6	Article 32 TRIPS	1182
7.6.7	Circumstances to be taken into account	1182
7.7.	Binding effect of decision remitting case to department of first instance	1182
7.7.1	General	1182
7.7.2	Department of first instance bound by decision of board of appeal	1183
7.7.3	Opposition proceedings following remittal to examining division	1184
7.7.4	Board of appeal bound in subsequent appeal proceedings following remittal	1184
7.7.5	Type of remittal	1185
a)	Divisional applications	1185
b)	Remittal only for adaptation of the description	1185
c)	Board's silence on adaptation of description	1186
d)	Remittal for the continuation of proceedings	1186
8.	Reimbursement of appeal fees	1187
8.1.	Introduction	1187
8.2.	General issues	1187
8.2.1	Absence of request for reimbursement – examination ex officio	1187
8.2.2	Distinction between an appeal deemed not to have been filed and an inadmissible appeal	1188
a)	Appeal deemed not to have been filed due to late payment of the appeal fee	1188
b)	Notice of appeal not filed in due time	1188
c)	Appeal inadmissible	1188
d)	Translation of notice of appeal	1189
8.2.3	No legal ground for payment	1189
8.2.4	Reimbursement of the appeal fee in case of a request for re-establishment	1189
8.2.5	Appeal withdrawn	1189
8.2.6	Intervention in opposition appeal proceedings	1190
8.2.7	Several appellants	1190
8.3.	Allowability of the appeal	1190
8.4.	Substantial procedural violation	1191
8.4.1	Definition	1191

a)	Violation must be of procedural nature	1191
b)	Violation must be substantial and affect the entire proceedings	1191
c)	Procedural violation must be committed by the department whose decision is under appeal	1193
8.4.2	Oral proceedings	1193
a)	Request for oral proceedings	1193
b)	Submissions of parties as response to summons	1194
c)	Request for interview	1194
d)	No reasons for refusal of request for postponement	1194
e)	Minutes	1194
8.4.3	Right to be heard	1195
8.4.4	Inadequate reasons given in the decision at first instance	1196
8.4.5	Error of judgment by a department of first instance	1196
8.4.6	Cases concerning the decision-making process and the decision	1198
a)	Issuing of decision	1198
b)	Content of decision	1199
c)	Signature on decision and minutes	1200
d)	Composition of opposition division under Art. 19(2) EPC	1200
e)	Requests	1201
f)	Amendments	1202
g)	Partiality	1202
h)	Suspensive effect of appeal	1203
i)	Non-compliance with board order	1203
j)	Search	1203
k)	Guidelines	1204
l)	Third party observations not mentioned in decision	1204
m)	Referral pending before Enlarged Board	1204
n)	Refusal of application on one ground only	1204
8.4.7	Cases concerning documentation and communications passing between the EPO and the parties	1204
a)	Ambiguous communication or wrong form	1204
b)	No reply to communication under Article 101 EPC	1205
c)	Wrong type of communication	1205
d)	Period set for opponent to reply to patentee's response	1205
e)	Observations not forwarded to other party	1205
f)	Appointment of professional representative	1206
g)	Warning in relation to grace period	1206
8.5.	Reimbursement of appeal fee in case of interlocutory revision	1206
8.5.1	Requirements	1206
8.5.2	Competence to decide on reimbursement	1206
8.5.3	Examining division should have rectified decision	1207
8.5.4	Rectification decision maintaining earlier decision	1209
8.5.5	Re-opening examination after rectification	1209
8.6.	Reimbursement must be equitable	1209
8.6.1	Causal link between substantial procedural violation and filing of appeal	1209
8.6.2	Conduct of appellants	1212



a)	Reimbursement held not to be equitable	1212
b)	Reimbursement held to be equitable	1213
8.6.3	Violation of the principle of the protection of legitimate expectations	1213

## 1. Legal character of appeal procedure

The provisions governing the appeal procedure are set out in Art. 106 EPC to Art. 111 EPC and R. 99 EPC to R. 103 EPC and in the Rules of Procedure of the Boards of Appeal. R. 100(1) EPC plays an important role since it stipulates that, unless otherwise provided, the provisions relating to proceedings before the department which had taken the decision impugned shall apply to appeal proceedings. This application by analogy is, however, not automatically permissible in every case and for every provision (**G 1/94**, OJ 1994, 787). Criteria therefore had to be established for when such an analogy was permissible and when not. To this end it was necessary to analyse the legal nature of the appeal procedure.

Appeal proceedings are wholly separate and independent from the proceedings at first instance. Their function is to give a judicial decision upon the correctness of a separate earlier decision taken by a department (**T 34/90**, OJ 1992, 454; **G 9/91**, OJ 1993, 408; **G 10/91**, OJ 1993, 420; **T 534/89**, OJ 1994, 464; **T 506/91**). In **T 501/92** (OJ 1996, 261) the board deduced from this principle that any procedural request or statement made by a party during proceedings in the first instance was not applicable in any subsequent appeal proceedings, and had to be repeated during the latter if it was to remain procedurally effective.

In decision **G 1/99** (OJ 2001, 381) the Enlarged Board held that the appeal procedure is to be considered as a judicial procedure (see **G 9/91**, OJ 1993, 408, point 18 of the Reasons) proper to an administrative court (see **G 8/91**, OJ 1993, 346, point 7 of the Reasons; likewise **G 7/91**, OJ 1993, 356). In an older decision (**G 1/86**, OJ 1987, 447), the Enlarged Board also addressed this question. In **G 9/92** and **G 4/93** (both OJ 1994, 875) it was decided that the extent of appeal proceedings is determined by the appeal.

These characteristics of the appeals procedure not only serve as criteria when assessing whether a provision may be applied analogously in individual cases; they also have general legal consequences in many respects. It follows from the characteristics set out by the Enlarged Board that the general principles of court procedure, such as the entitlement of parties to direct the course of the proceedings themselves ("principle of party disposition"), also apply to appeals (see **G 2/91**, OJ 1992, 206; **G 8/91**, **G 8/93**, OJ 1994, 887; **G 9/92** and **G 4/93**), that a review of the decision taken by the department of first instance can, in principle, only be based on the reasons already submitted before that department (**G 9/91**, **G 10/91**), and that the proceedings are determined by the petition initiating them (ne ultra petita) (see **G 9/92** and **G 4/93**). The Enlarged Board has also made it clear that the decision-making powers of opposition divisions, and of the boards in opposition appeal proceedings, are circumscribed by the statement under

R. 55(c) EPC 1973 of the extent to which the European patent is opposed. They have no powers to decide and thus investigate anything extending beyond that statement (see **G 9/91**). This defined the sphere of application of Art. 114(1) EPC 1973, and clarified the distinction between the power to initiate and determine the object of proceedings, on the one hand, and the power to examine the facts then relevant, on the other. The individual procedural consequences and the Enlarged Board's decisions are discussed in greater detail below.

It is established jurisprudence that the boards of appeal and the Enlarged Board of Appeal respectively act as judicial bodies, which were established by law, and apply general principles of procedural law (see **G 3/08**, OJ 2011, 10 and **G 2/08**, OJ 2010, 456) (see **T 1676/08**).

In **T 1676/08** the board agreed and went on to say that one of these principles is laid down in Art. 6(1) ECHR, relying on principles of law common to the member states of the European Patent Organisation and applying to all EPO departments of the said organisation, which requires inter alia in "... the determination of his civil rights and obligations ... everyone is entitled to **a fair and public hearing** within a reasonable time by an independent and impartial tribunal established by law". It is also established jurisprudence that, for **inter partes** proceedings before a board of appeal to be fair, the board must be neutral (see for example decisions **R 12/09**, and **T 253/95**).

### **1.1. Suspensive effect of the appeal**

Under Art. 106(1) EPC, an appeal has suspensive effect. The Legal Board of Appeal defined this effect in **J 28/94** (OJ 1995, 742), in which a third party claimed entitlement to the grant of the patent and requested suspension of the proceedings for grant under R. 13(1) EPC 1973. The board took the view that the appeal's suspensive effect meant the contested decision had no legal effect until the appeal was resolved. Otherwise the 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).

According to **J 28/03** (OJ 2005, 597), suspensive effect means that the consequences following from an appealed decision do not immediately occur after the decision has been taken. Actions normally taking place after a decision are "frozen". Suspensive effect does not have the meaning of cancellation of the appealed decision. Even after an appeal the decision as such remains and can only be set aside or confirmed by the board of appeal. Moreover, the status of a divisional application filed while an appeal against the decision to grant a patent on the parent application is pending depends on the outcome of that appeal.

In **T 591/05**, the suspensive effect of an appeal was said to be a direct consequence of, and was subordinate to the appeal itself (Art. 106(1) EPC 1973) and, consequently, no circumstance directly arising from the suspensive effect of the appeal could be invoked in support of the admissibility of the appeal itself.

In **J 18/08** the applicant failed to appoint a professional representative (Art. 133(2) EPC) and the application was refused by the Receiving Section under Art. 90(5) EPC. A notice of appeal was filed by a professional representative, who notified the EPO at the same time that he had been appointed as the representative in this application. It was submitted that the deficiency on which the refusal was based had been rectified by the appointment. The board held that when the appeal was filed, the deficiency (on which the refusal was based) was corrected. Thus the underlying ground for the refusal had been overcome and the reasoning in the decision under appeal no longer applied. It was noted that this case was different from the situation where the non-observance of a time limit automatically leads to the application being deemed to be withdrawn. In such a case the legal consequence automatically ensues when an act required within a specific time limit is not performed, without any decision to be taken concerning the refusal of the application. By contrast, if the application is refused under Art. 90(5) EPC the deficiency on which the decision is based can be corrected at the appeal stage. Accordingly, the appeal was allowed.

The board in **T 1674/12** found that, in keeping with the spirit of Art. 106 EPC, suspensive effect applied to decisions which terminated proceedings before a particular department - to prevent the contested decision having legal effects (Art. 106(2), first sentence, EPC) - and to decisions for which the competent department itself allowed separate appeal (Art. 106(2), second sentence, EPC). This second sentence made clear that the department taking the decision remained in charge of the proceedings until a decision terminating them was taken or until it allowed a separate appeal. Otherwise the parties would be free to obstruct the efficient handling of cases by the competent department. Under Art. 106 EPC, in procedural situations like that at issue, it was up to the opposition division to decide whether to allow a separate appeal. The parties had no rights in that respect. If, as in the case in question, the opposition division had not expressly allowed a separate appeal in its decision, it was entitled to find that an appeal nevertheless filed did not meet any of the conditions of Art. 106(2) EPC, and in particular those of its second sentence.

## **1.2. Devolutive effect of the appeal**

On appeal, the department of first instance loses its competence for the further prosecution of the application for all contracting states - the appeal does not leave a part of the application pending in the first instance. Thus, deemed withdrawal of the application pursuant to Art. 110(3) EPC 1973 applied in the case of a failure to reply to a communication pursuant to Art. 110(2) EPC 1973 in ex parte appeal proceedings, even where the decision under appeal did not refuse the application, but only a particular request. The board reasoned that even if the appealed decision concerned only the designation of a state and not the application as a whole, according to the principle of

unity of the application and of the patent in the proceedings the suspensive effect of the appeal affected the application as a whole (**J 29/94**, OJ 1998, 147).

The devolutive effect of the appeal does not affect the competence of the department of first instance to decide on a request concerning the contents of the minutes of the oral proceedings held before it. What is devolved is the subject-matter decided by the appealed decision (**T 1198/97**).

According to **T 1382/08**, the devolutive effect of an appeal before a board extends only to that part of the impugned decision which is indicated in the statement of grounds for appeal and actually challenged by the appeal. For the board, therefore, the extent to which the impugned decision is to be amended, as defined under R. 99(2) EPC, is simultaneously the limit of the devolutive effect. This in turn implies that the impugned decision's part not covered by the statement of grounds of appeal also cannot be part of the appeal proceedings and consequently becomes final on expiry of the time limit for appeal. This approach was also adopted by the same board in **T 448/09**. However, the board in **T 689/09** noted that, whilst it was aware of case law, according to which the distinction between different legal effects of a decision also fell under the "extent to which the impugned decision is to be amended" pursuant to R. 99(2) EPC, (**T 1382/08**), this approach left the notion of the "subject of the appeal" even more diffuse and elusive.

See also in this chapter IV.E.3.2 "Subject-matter under examination".

### **1.3. Accelerated processing before the boards of appeal**

Parties with a legitimate interest may ask the boards of appeal to deal with their appeals rapidly (see Notice from the Vice-President Directorate-General 3 dated 17 March 2008 concerning accelerated processing before the boards of appeal (OJ 2008, 220)).

The appellant (patentee) in **T 734/12** requested acceleration of the appeal proceedings on the basis of three arguments: the possibility of remittal; the suggestion that the decision under appeal related to an important point of law the resolution of which might take additional time; and the commercial and medical importance of the patented and approved treatment. In the board's opinion these reasons did not in themselves justify acceleration. Whilst acceleration had been acknowledged as appropriate when infringement proceedings were threatened or pending, which was not the case here. However, it was clear there was a substantial measure of agreement between the parties and the public had an interest in the early resolution of disputes. The interests of the parties and of the public would therefore best be served by an expedited procedure.

In **T 895/13** the board confirmed that, under the Notice from the Vice-President Directorate-General 3 dated 17 March 2008 (OJ 2008, 220), acceleration is always a matter for the exercise of the board's discretion. While trivial reasons would clearly not warrant acceleration, there was no fixed standard of proof. Acceleration is not limited to the examples given in the Notice, but is a matter to be decided in the discretion of the board on the particular facts of the case before it. It was clear in the case at issue that the board could have accelerated the procedure ex officio under the notice, in view of the

disadvantage which could ensue before the Belgian courts from the suspensive effect of the appeal in question. (On application by patentees for preliminary measures, the Belgian courts do not consider the validity of patents even in cases where a revocation decision is suspended pending appeal.) If the board could allow acceleration on that basis of its own motion, it could clearly do so on the request of a party (in this case the respondent (opponent)). The board ordered the appeal proceedings to be accelerated. It added that its views related only to the particular facts of this case and the co-pending appeal in **T 1125/13** between the same parties and were not intended to set any precedent for application beyond those facts.

See also Chapter IV.D.6 "Acceleration of opposition proceedings in the case of pending infringement proceedings".

## **2. Filing and admissibility of the appeal**

According to Art. 108 EPC a notice of appeal shall be filed in accordance with the Implementing Regulations within two months after the date of notification of the decision. Notice of appeal shall not be deemed to have been filed until the fee for appeal has been paid. The content of the notice of appeal is set out in R. 99 EPC. In view of the future use of electronic means of communication, it was found useful to avoid references to 'in writing' or 'in written form' and leave such regulation to the Implementing Regulations.

The admissibility of an appeal can only be assessed as a whole (**T 382/96**, **T 1763/06**, **T 509/07**, **T 23/10**, **T 2001/14**). There is no support in the EPC for a notion of 'partial admissibility' of an appeal (**T 774/97**, **T 509/07**).

See also Chapter IV.E.8.2.2 "Distinction between an appeal deemed not to have been filed and an inadmissible appeal".

### **2.1. Transitional provisions**

If notice of appeal was filed before the revised EPC entered into force, the appeal's admissibility must be assessed under the provisions of the EPC 1973, in line with the principle (*tempus regit actum*) that entitlement to perform a procedural act is governed by the law in force when the act took place (**T 1366/04**).

The decision whether an appeal is admissible according to the relevant provisions, geared to the fulfilment of the requirements for admissibility within a certain legally defined period, depends entirely on the substantive and legal position at the time of expiry of the time limits. Since the belated fulfilment of admissibility requirements after the expiry of the time limit cannot be taken into account in the examination of admissibility, so too a change in the legal position occurring after the expiry of the time limit for fulfilling the admissibility requirements can have no impact, either to the appellant's advantage or to his detriment, on the assessment of admissibility (**J 10/07**; OJ 2008, 567). In **T 2052/08**, the board, citing the finding in **J 10/07** that R. 103 EPC should not be applied to appeal cases concerning patent applications filed before the entry into force of the EPC 2000, found that, as **J 10/07** concerned the reimbursement of

the appeal fee in situations where a substantial procedural violation had occurred at first instance, its conclusions should not be taken as implying a statement on the applicability of R. 103 EPC.

In **T 616/08**, the board found that, to the extent that it was relevant whether an aligned or the original version of a rule applied, there was a gap in the law which needed to be closed by case law as long as the legislator was not active. Art. 107, 109 and 111 EPC were not mentioned in the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Art. 7 of the Act revising the European Patent Convention of 29 November 2000 ("transitional provisions"), although Art. 106, 108 and 110 EPC were. The board took into account the purpose of the transitional provisions (namely, to avoid the use of different versions of the EPC over a prolonged period), and the fact that there was nothing to indicate any intention to use new and old versions of Articles covering appeal proceedings in parallel. It therefore decided to apply Art. 107, 109 and 111 EPC and the rules appertaining to them where Art. 106, 108 and 110 EPC were applicable.

The board referred to **J 10/07** (OJ 2008, 567), where the Legal Board had concluded that Art. 107 and 111 EPC 1973 should be applied to applications filed before the cut-off date, but considered that the continued application of all EPC 1973 articles which had not been addressed in the transitional provisions did not appear to be in line with the legislators' objectives that the revised provisions should quickly take effect in practice and that the use of different variations of the EPC over a prolonged period should be avoided.

## 2.2. Appealable decisions

Under Art. 106(1), first sentence, EPC appeals lie against decisions of the Receiving Section, examining divisions, opposition divisions and the Legal Division.

### 2.2.1 Departments

The boards can hear appeals only against the decisions taken by other EPO departments (**J 12/85**, OJ 1986, 155). There is thus no right of recourse to the boards of appeal in respect of extensions of patent applications and patents to the extension states. Instead, it is the respective national jurisdiction which is responsible (**J 14/00**, OJ 2002, 432; **J 19/00**, **J 9/04**, **J 2/05**, **J 4/05**, **J 22/10** and **J 9/11**). The board in **T 506/08** considered that it was not competent to hear a request for a (partial) refund of the international search fee where no search had been performed.

### 2.2.2 Decisions

Whether a document constitutes a 'decision' or not depends on the substance of its content and not on its form (**J 8/81**, OJ 1982, 10; see also **J 26/87**, OJ 1989, 329; **J 13/92**, **T 263/00** and **T 713/02**, OJ 2006, 267). It is, therefore, not relevant that the text in question is in the form of a mere letter, nor does it matter if it states "... it is decided" to allow the request. Nor is the fact decisive that the Notice of the Vice-President DG2 dated 28.4.99 uses the wording "Decisions concerning the correction of errors ..."

(**T 713/02**, OJ 2006, 267). A "decision" needs to involve a reasoned choice between legally viable alternatives (**T 934/91**, OJ 1994, 184).

Notification of the case number and the responsible board of appeal by the registry did not constitute a decision under R. 69(2) EPC 1973 recognising that an appeal was pending (**T 371/92**, OJ 1995, 324; see also **T 1100/97** and **T 266/97**). See now R. 112 EPC.

a) Examples of appealable decisions

(i) A formalities officer's letter rejecting the opposition as inadmissible was held to be an appealable decision in **T 1062/99**. (See **G 1/02**, OJ 2003, 165, a referral occasioned by diverging decisions **T 1062/99** and **T 295/01**, OJ 2002, 251) on a formalities officer's competence to decide on the admissibility of an opposition).

(ii) A document (EPO Form 2901) concerned with the applicant's request for re-establishment in respect of the period for payment of the third renewal fee plus additional fee was deemed to be a decision in **J 7/08**.

b) Examples where the communication was not an appealable decision

The case law of the boards of appeal has established that the following are **not** regarded as appealable decisions taken by other EPO departments:

(i) A request under R. 89 EPC 1973 for correction of a contested decision. Not until the request has been decided at first instance can the matter be referred to the board (**J 12/85**, OJ 1986, 155).

(ii) The preparatory steps referred to in Art. 96(2) EPC 1973 and R. 51(3) EPC 1973 (**T 5/81**, OJ 1982, 249).

(iii) A communication under R. 57(1) EPC 1973 (**T 222/85**, OJ 1988, 128), or R. 69(1) EPC 1973 (**J 13/83**). See also Chapter III.K "Formal aspects of decisions of EPO departments".

(iv) A communication from the opposition division finding that an opposition has been validly filed, and stating that the decision will be taken on that point at the oral proceedings (**T 263/00**).

(v) An order by a director of a department of first instance (such as an opposition division) rejecting an objection to a member of the division on the ground of suspected partiality. The composition of the division could, however, be challenged on such a ground in an appeal against its final decision or against a separately appealable interlocutory decision under Art. 106(3) EPC 1973 (**G 5/91**, OJ 1992, 617).

(vi) A "decision" by a director on a request for inspection of file. Only the examining division charged with the technical opinion (Art. 25 EPC 1973) or the formalities officer

pursuant to the Notice of the DG2 Vice-President (OJ 1984, 317, revised and supplemented in OJ 1989, 178 and OJ 1999, 504) has the competence to decide on a request for inspection of file. Such a 'decision' under appeal is therefore void ab initio and the appeal inadmissible (**J 38/97**; see also **T 382/92**).

(vii) A letter bearing the letterhead of an EPO Directorate-General and signed by an EPO Vice-President, if it is evident from its content that it does not constitute a decision and from its form that it does not emanate from any of the departments listed in Art. 21(1) EPC 1973 (**J 2/93**, OJ 1995, 675).

(viii) The minutes of oral proceedings (**T 838/92**). A correction to minutes of oral proceedings made on the initiative of the opposition division was held not directly appealable in **T 231/99**.

(ix) A communication from a formalities officer primarily dealing with the patentee's request to stay the opposition proceedings and to remit the case to the examination division for a decision on the request for correction under R. 89 EPC 1973 (**T 165/07**).

(x) A communication under R. 71(3) EPC. This is not intended to terminate the examination procedure but is rather a preparatory action and is therefore as such not appealable (**T 1182/04** and **T 1226/07**).

(xi) When not acceding to a request to hold oral proceedings in Munich instead of The Hague, the examining division does not take a decision but only expresses the way the EPO is managed. Consequently, that issue is not subject to appeal, nor can the board refer a question on the venue of oral proceedings to the Enlarged Board of Appeal (**T 1142/12**).

(xii) A communication of information by which the appellant was informed that, as the decision to grant had been rectified under Art. 109 EPC, the examination procedure was resumed, and it was not possible to file an opposition during this part of the procedure. The appeal was rejected as inadmissible under Art. 107 EPC (**J 22/12**).

The board in **T 1676/08** found that to comply with Art. 21(4)(b) EPC 1973, it was sufficient for the board to indicate in EPO Form 3303.15 that the complexity of the case was the reason for enlarging the board from three to five members; it was not obliged to give detailed reasoning why it considered the case at issue complex. A change in a board's composition with regard either to the number of its members under Art. 21(4)(b) EPC 1973 or to the replacement of a member under Art. 4 of the Business Distribution Scheme of the Technical Boards of Appeal was not a decision within the meaning of Art. 106 EPC and Art. 113(1) EPC 1973.

**T 26/88** (OJ 1991, 30), which held that a document stating that the patent was revoked under Art. 102(4) and (5) EPC 1973 did not constitute a decision, was overruled by **G 1/90** (OJ 1991, 275).



### 2.2.3 Interlocutory decisions

Under Art. 106(2) EPC (formerly Art. 106(3) EPC 1973) a decision which does not terminate proceedings as regards one of the parties (interlocutory decision) can only be appealed together with the final decision, unless the decision allows a separate appeal. Separate appeal is possible against interlocutory decisions regarding admissibility of the opposition (see e.g. **T 10/82**, OJ 1983, 407) or maintenance of a patent in amended form (see e.g. **T 247/85** and **T 89/90**, OJ 1992, 456).

In **T 857/06**, the opposition division had attempted to incorporate the content of its first (non-appealable) interlocutory decision into its second (appealable) interlocutory decision. No final decision had yet been taken and in its absence it could be argued that only the second interlocutory decision could be appealed and not the first. The board found that this would lead to a nonsensical procedural situation, where the board, while prevented from dealing with the appellant's main request, had to decide on lower-ranking requests. Art. 106(2) EPC had therefore to be construed in a purposive manner in this case, where the second interlocutory decision did not leave any substantive issues outstanding and was intended to form the complete basis for the maintenance of the patent in amended form. The first interlocutory decision had to be appealable together with the second (citing **T 762/90** of 23 January 1991).

### 2.2.4 Appeals against decisions of the boards of appeal

See also in this chapter IV.E.7.7 "Binding effect of decision remitting case to department of first instance".

It was established by the Enlarged Board in **G 1/97** (OJ 2000, 322) that:

1. In the context of the EPC 1973, the jurisdictional measure to be taken in response to requests based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a board of appeal having the force of *res judicata* should be the refusal of the requests as inadmissible.
2. The decision on inadmissibility is to be issued by the board of appeal which took the decision forming the subject of the request for revision. The decision may be issued immediately and without further procedural formalities.
3. This jurisdictional measure applies only to requests directed against a decision of a board of appeal bearing a date after that of the present decision.
4. If the Legal Division of the EPO is asked to decide on the entry in the Register of European Patents of a request directed against a decision of a board of appeal, it must refrain from ordering that the entry be made if the request, in whatever form, is based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a board of appeal.

These principles have since been followed in several decisions, for example **J 16/98**, **J 3/98** and **T 431/04**.

This situation has not been changed by the introduction of a petition for review in Art. 112a EPC (**T 365/09**). According to the board, a first difference between appeal and petition evidently lay in the fact that, unlike Art. 106(1) EPC, Art. 112a(3) EPC clearly excludes a suspensive effect of the petition. Moreover, a petition for review can, according to Art. 112a EPC, only be based on fundamental procedural violations or defects during the appeal proceedings, which do not include questions relating to patentability. This can be derived from the exhaustive list of fundamental procedural violations and defects in Art. 112a(2) EPC and R. 104 and 105 EPC. This view has, in the meantime, been confirmed in **G 3/08** (OJ 2011, 10).

In **T 846/01** it was clear that the appellants were not contesting the substance of the opposition division's interlocutory decision, which dealt with the renumbering of the claims and the adaptation of the description, but were actually trying to reopen the issue of validity which had already been decided in an earlier decision of a board of appeal. Under Art. 106 EPC 1973 and in view of the principle of *res judicata*, this finding in the decision was not open to challenge, even though the opposition division decision was accompanied by a form stating the decision was appealable.

A limited judicial review of decisions of the boards of appeal was introduced into the EPC 2000, in Art. 112a EPC. See Chapter IV.F.3 "Petition for review under Article 112a EPC".

### **2.3. Board competent to hear a case**

#### 2.3.1 Technical or Legal Board of Appeal

##### a) General

The responsibilities and composition of boards are laid down in Art. 21 EPC. In **G 2/90** (OJ 1992, 10) the Enlarged Board made it clear that under Art. 21(3)(c) EPC 1973, the Legal Board of Appeal was competent only for appeals against decisions taken by an examining division consisting of fewer than four members and which did not concern refusal of the application or grant. In all other cases, i.e. those covered by Art. 21(3)(a), 21(3)(b) and 21(4) EPC 1973, the technical boards were competent. The provisions of Art. 21(3) and (4) EPC 1973 governing responsibilities and composition were not affected by R. 9(3) EPC 1973.

In **G 3/03** (OJ 2005, 343), the Enlarged Board of Appeal held that in the event of interlocutory revision under Art. 109(1) EPC 1973, the department of first instance whose decision had been appealed was not competent to refuse a request of the appellant for reimbursement of the appeal fee. It was the board of appeal which would have been competent under Art. 21 EPC 1973 to deal with the substantive issues of the appeal if no interlocutory revision had been granted which was competent to decide on the request.

In **G 1/11** (OJ 2014, A122) the Enlarged Board of Appeal held that a technical board of appeal was competent to hear an appeal against an EPO examining division's decision – taken separately from its decision granting a patent or refusing the application – not to refund search fees under R. 64(2) EPC.

b) Technical board of appeal competent

Art. 21(3)(a) EPC expressly states that appeals against decisions concerning the limitation or revocation of European patents should be heard by the technical boards of appeal.

An appeal against a decision of an examining division refusing a request under R. 89 EPC 1973 for correction of the decision to grant was to be decided by a technical board of appeal (**G 8/95**, OJ 1996, 481, overruling **J 30/94**). (A board, however, has no appellate competence, in inter partes opposition appeal proceedings, to review the decision on correction of the grant decision taken in ex parte examination proceedings under R. 89 EPC 1973, since that decision does not form the subject of the appeal proceedings before it; see **T 79/07**, deviating from **T 268/02**).

According to **T 1382/08**, for the purpose of determining competence under Art. 21(3) EPC 1973, a contradictory or unclear impugned decision is to be considered in the light of its legal consequences vis-à-vis the applicant or the impression given to the public as to its legal nature. In the case at issue, it was unclear whether the contested decision of the examining division was actually a refusal of the application or, instead, merely a refusal of a request for a refund of the search fee or confirmation of the loss of rights established in the R. 69(1) EPC 1973 communication. In the latter two cases, the Legal Board of Appeal would have been competent to hear the appeal under Art. 21(3)(c) EPC 1973. The board found that the decision had the effect of a refusal, which meant that the technical board of appeal was competent.

However, in **J 16/13**, the board held that, where the formal order of an appealed decision is obviously erroneous to such an extent that it is essentially incomprehensible when compared with the reasons in the body of the decision, in particular when it plainly does not correspond to any of the foreseen possible legal effects flowing from the substantive issue underlying the appealed decision, and if the competence pursuant to Art. 21(3) EPC is supposed to change from one board to another only because of such an "impossible" order, the formal order can be disregarded for the purposes of Art. 21(3)(a) and (c) EPC, and rather the substantive request underlying the decision must be guiding in determining the board competent to decide the case (**T 1382/08** not followed).

c) Legal Board of Appeal competent

An appeal against the decision of the examining division refusing a request for corrections under R. 88 EPC 1973 filed after grant of the patent, on the other hand, is to be decided by the Legal Board of Appeal. The appeal concerned the preliminary question of whether a request under R. 88 EPC 1973 could be made after grant. This

was purely a question of law, and did not concern the refusal of a European patent application or the grant of a European patent. It was also consistent with **G 8/95**, as answering the preliminary question did not involve any consideration of the text with which the patent should be granted (**J 42/92**).

## **2.4. Entitlement to appeal**

### **2.4.1 Formal aspects under Article 107 EPC**

Under Art. 107, first sentence, EPC, an EPO decision can be appealed only by a party to the proceedings which gave rise to it. Concerning the entitlement to appeal of a transferee of a patent, see Chapter IV.C.2.1 "Party status as patent proprietor".

#### **a) Appeal filed in name of representative**

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

#### **b) Appeal filed by wrong company**

In **T 340/92** the appellant was a company which had obviously been named in the notice of appeal by mistake, instead of a subsidiary, which was the real opponent. The actual appellant was the only party adversely affected by refusal of the opposition, and was readily identifiable through its representative, who was named in the appeal dossier. The board held that this deficiency could be remedied under R. 65(2) EPC 1973. See also **T 875/06**.

However, if the notice of appeal was filed by an adversely affected party, but the grounds of appeal were filed by a different company which was not a party to the opposition proceedings, let alone a party adversely affected by the outcome of those proceedings, the appeal could not be held admissible. No provision having been made in the Implementing Regulations pursuant to Art. 133(3), last sentence, EPC 1973 the EPC 1973 did not allow the representation of one legal person by the employee of another economically related legal person, who could not therefore file the grounds of appeal on the other's behalf (**T 298/97**, OJ 2002, 83).

In the absence of any clear indication to the contrary, a professional representative who was authorised to act for a party adversely affected by a decision and then filed an appeal against this decision had to be presumed to be acting on behalf of the very same party that he acted for in the first instance proceedings, and not on behalf of someone else not entitled to appeal (**T 920/97**). Although the notice of appeal did not indicate the name and address of the appellant as required by R. 64(a) EPC 1973, the appellant corrected the notice of appeal in time and the appeal was thus admissible. See also **T 1911/09**.

## c) Party consisting of plurality of persons

If a party consists of a plurality of persons, an appeal against a decision which adversely affects this party has to be filed on behalf of all these persons through their duly determined common representative (see **G 3/99**, OJ 2002, 347, where multiple opponents file a joint opposition; **T 1154/06**, with respect to joint proprietors of a European patent; see also **R 18/09**, with respect to joint proprietors and a petition for review) (**T 755/09**).

In **G 3/99** (OJ 2002, 347), the Enlarged Board of Appeal held that where the opposing party consisted of a plurality of persons, an appeal had to be filed by the common representative under R. 100 EPC 1973. Where the appeal was filed by a non-entitled person, the board of appeal was to consider it not to be duly signed and consequently invite the common representative to sign it within a given time limit. The non-entitled person who filed the appeal should be informed of this invitation. If the previous common representative was no longer participating in the proceedings, a new common representative should be determined pursuant to R. 100 EPC 1973 (see also **R 18/09**).

In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it had to be clear throughout the procedure who belonged to the group of common opponents or common appellants. **If either a common opponent or appellant (including the common representative) intended to withdraw from the proceedings**, the EPO had to be notified accordingly by the common representative or by a new common representative determined under R. 100(1) EPC 1973 in order for the withdrawal to take effect (for example see **T 562/13**).

Where an appeal is filed by **only one of several joint members** of a party and where this member is not the common representative, the board of appeal should send the common representative a communication giving him the opportunity to fulfil the necessary requirements of the EPC (see **G 3/99**; **T 1154/06**). If the common representative does not do so, the notice of appeal is deemed not to have been filed. Such an appeal is thus treated in the same way as an appeal filed but not signed by an authorised person (**G 3/99**; **R 18/09**) (see **T 755/09**; see also **T 979/12**).

In **T 755/09** the appeal was filed only on behalf of one of several persons who, at the time of filing the appeal, were the joint applicants of the application in suit (see Art. 59 EPC). In principle the appeal had therefore to be held inadmissible in accordance with R. 101(1) EPC. The board pointed out that the case did not come under the category calling for a communication under R. 101(2) EPC inviting the appellant to remedy deficiencies under R. 99(1)(a) EPC within a specified period (see decision **G 1/12**, OJ 2014, A114). The notice of appeal was unambiguous nor did the appellant ever claim that the notice of appeal contained a deficiency under R. 101(2) EPC. The legal remedy foreseen in R. 101(2) EPC therefore could not apply (see also **T 656/98**, OJ 2003, 385).

d) Company in receivership

A company that has gone into receivership can no longer validly file an appeal; only the insolvency administrator can do so on its behalf. In **T 693/05**, the insolvency administrator had authorised the representative to file an appeal, which was held admissible. In **T 1324/06**, the authorised representative of a company which had previously been declared bankrupt filed an appeal on behalf of the company. Relying on R. 101(6) EPC 1973 and R. 152(8) EPC, under which the authorised representative shall be deemed to be authorised until the termination of his authorisation has been communicated to the EPO, the board held the appeal admissible, no such notification having been received from the insolvency administrator or representative.

2.4.2 Party adversely affected (Article 107 EPC)

a) General

Under Art. 107 EPC, any party to proceedings adversely affected by a decision may appeal. A party is adversely affected within the meaning of Art. 107 EPC if the decision fails to meet that party's wishes (see **T 244/85**, OJ 1988, 216; **T 1682/13**). According to **T 234/86** (OJ 1989, 79) a party is adversely affected if the decision does not accede to his main requests or to auxiliary requests preceding the allowed auxiliary request (see also **T 392/91**). This is not the case if the patent proprietor withdraws his main request or preceding auxiliary requests and agrees with the allowed auxiliary request (**T 506/91**, **T 528/93**, **T 613/97**, **T 54/00**, **T 434/00**). In these cases the patent had been maintained in amended form by the opposition division (for more details about the relationship between main and auxiliary requests, see also Chapter III.I. "Main and auxiliary requests").

The question of whether or not a party is adversely affected by a decision taken by an authority as defined in Art. 106 EPC arises in connection with Art. 107 EPC in order to establish who may appeal.

An appeal is inadmissible where the appellant is seeking only to amend not the decision itself but the reasons for it (**T 84/02**) or the sole aim is to settle a point of law not relevant to the case (**J 7/00**), although here the board did decide to rule on the issue (see also **T 1790/08**). Abandoning claims to have a prompt decision in order to be in a position to appeal also results in the appeal being inadmissible where the patentee's requests were actually granted (**T 848/00**).

In **T 298/97** (OJ 2002, 83), the board held that where the notice of appeal is filed by an adversely affected party but the grounds of appeal are filed by a natural or legal person who, although having economic connections with that adversely affected party, is not itself that party, the appeal cannot be held admissible.

## b) Patent applicant

## (i) Patent applicant adversely affected

In **J 12/83** (OJ 1985, 6) the board found that an applicant for a European patent might be "adversely affected" within the meaning of Art. 107 EPC 1973 by a decision to grant the patent, if the patent was granted with a text not approved by him under Art. 97(2)(a) EPC 1973 and R. 51(4) EPC 1973. In **J 12/85** (OJ 1986, 155) the board held that he could be "adversely affected" within the meaning of Art. 107 EPC 1973 only if the grant decision was inconsistent with what he had specifically requested (see also **T 114/82** and **T 115/82**, both OJ 1983, 323 and **T 1/92**, OJ 1993, 685).

In **T 1682/13** the admissibility of an appeal was challenged on the grounds that the only request filed with the statement of grounds had not been the subject of the contested decision. In the board's view, under Art. 107 EPC any party adversely affected by a decision was entitled to appeal. A party was always adversely affected if the contested decision failed to meet that party's wishes at first instance, in other words if it granted the party less than it had requested. This had to be assessed by comparing the request at first instance with the substance of the decision (cf. **T 244/85**, OJ 1988, 216).

In **T 528/93** a request was withdrawn during opposition proceedings and was thus not the subject of the contested decision. The board decided that a virtually identical request filed during appeal proceedings was not the subject of the appeal, because the appellant was not adversely affected by the decision of the opposition division as far as this request was concerned.

In **T 327/13** the board found that **T 528/93** was not relevant to the facts at issue. The function of appeal proceedings is to give a judicial decision upon the correctness of the decision under appeal and not to reopen the opposition proceedings to add an independent claim to a claim set already allowed by the opposition division.

The board went on to say that, to establish whether a party has been adversely affected by a decision, it is not enough to consider the end result in isolation, but to consider the party's complete case, as is defined in Art. 12(2) RPBA, in conjunction with the substance of the decision. Although the board noted that it was clear that the appellants were adversely affected by the opposition division's decision not to accede to the then main request, the decision had not been contested with the appeal. The board therefore concluded that they could not be regarded as "adversely affected" under Art. 107 EPC.

An applicant was 'adversely affected' and thus able to file an appeal where the examining division had rectified its decision but refused to grant reimbursement of the appeal fee (**J 32/95**, OJ 1999, 733).

The grounds forming the basis of a decision on rectification should not be interpreted to mean only the legal basis of the decision, but also the factual reasons supporting the legal basis. An applicant adversely affected by the **factual basis** was thus considered adversely affected in **T 142/96**.

(ii) Patent applicant not adversely affected

In **J 5/79** (OJ 1980, 71) the board 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.

c) Patent proprietor

(i) Patent proprietor adversely affected

In **T 457/89**, by analogy with **G 1/88** (OJ 1989, 189), the board took the view that the appellant (patentee) was adversely affected by the decision revoking his patent, despite failing to comment on a communication within the time specified in an opposition division's invitation under Art. 101(2) EPC 1973 and R. 58(1) to (3) EPC 1973. For, according to **G 1/88**, wherever non-compliance could lead to loss of rights, the EPC 1973 always expressly indicated this and Art. 101(2) EPC 1973 made no provision for any loss of rights.

In **J 17/04** the board found that although the notice of appeal only referred to a correction of the decision under appeal under R. 88 and 89 EPC 1973 (see **T 824/00** below), it made therewith (implicitly) the allegation that the decision under appeal incorrectly limited the regional scope of the patent and that this decision should be set aside. The board was therefore satisfied that the appellant had sufficiently claimed to be adversely affected and the appeal was admissible.

In **T 537/05** the appellant was held adversely affected by the decision under appeal granting the patent in an amended form on the basis of the appellant's main request, because this request was not submitted until after the opposition division had 'decided' that the subject-matter did not meet the requirements of Art. 56 EPC 1973. Giving the wording its true meaning, the opposition division had thus revoked the patent, its actions after the decision were ultra vires, and the patent proprietor thus adversely affected and entitled to appeal.

According to **T 1351/06**, a subsidiary request is only valid if the main request or higher-ranking subsidiary requests are not granted. Under Art. 113(2) EPC 1973, the EPO was bound by the applicant's requests. In the case in point, the main request had not been withdrawn and therefore remained pending. Consequently, the decision to grant a patent on the basis of the subsidiary request was contrary to Art. 113(2) EPC 1973. The appellant had therefore been adversely affected under Art. 107 EPC 1973.

(ii) Patent proprietor not adversely affected

In **T 73/88** (OJ 1992, 557) the board ruled that if a patentee's request that his patent be maintained was upheld by a decision of the opposition division, he could not appeal against adverse reasoning in the decision (here, regarding his claim to priority) because he was not adversely affected by it within the meaning of Art. 107 EPC 1973.



One of the principles representing the fundamental value of legal procedural certainty was that a party was not to be regarded as adversely affected within the meaning of Art. 107 EPC 1973 by a decision which granted his final request. A request under R. 88 EPC 1973 for correction of a document as the sole reason for the appeal was inadmissible (**T 824/00**, OJ 2004, 5). In this case the proprietor had requested correction under R. 88 EPC 1973 of his letter withdrawing all requests (see also **T 961/00** and **J 17/04**).

The argument that the discovery of a prior art disclosure in national proceedings meant that the patent proprietor had subsequently become adversely affected was rejected in **T 591/05** - by granting the patent the department of first instance had acceded to the then valid request of the appellant. Furthermore, the suspensive effect of the appeal was a direct consequence of, and was subordinate to the appeal itself (Art. 106(1) EPC 1973) and, consequently, no circumstance directly arising from the suspensive effect of the appeal could be invoked in support of the admissibility of the appeal itself.

In **T 332/06** the patent proprietor's appeal was admissible at the time it was filed but became inadmissible when the statement of grounds was received, as the patent proprietor only contested that portion of the decision relating to the claims for the contracting state DE. These claims, had been allowed by the opposition division for DE but rejected with respect to the remaining contracting states. The patent proprietor was therefore not adversely affected with respect to DE.

d) Opponent

(i) Rule 82(1) EPC

Under R. 82(1) EPC (previously R. 58(4) EPC 1973), before the opposition division decides to maintain the patent as amended, it shall inform the parties of the text in which it intends to maintain the patent and shall invite them to file their observations within two months if they disapprove of that text.

The Enlarged Board found in **G 1/88** (OJ 1989, 189) that the fact that an opponent had failed, within the time allowed, to make any observations on the text despite an invitation to do so under R. 58(4) EPC 1973 did not render his appeal inadmissible.

To regard silence as betokening consent would be tantamount to withdrawal of the opposition with consequent surrender of the right to appeal. Surrender of a right could not be simply presumed. Deeming silence to be equivalent to surrender would also be inconsistent with the logic of how the EPC operated, since it would be at odds with the way in which it dealt with the loss of rights. Where the legal consequence of an omission was to be a loss of rights, this was expressly stated. Furthermore, under Art. 164(2) EPC 1973 the Implementing Regulations had always to be interpreted in the light of the EPC.

The interpretation of the Implementing Regulations which corresponded most closely to the principles of the EPC thus prevailed. It was a principle of the EPC, however, that

parties' rights were safeguarded by the possibility of appeal to at least one higher-ranking tribunal. The Implementing Regulations should therefore be construed in such a way that R. 58(4) EPC 1973 was not allowed to interfere with the right of appeal under Art. 106 and 107 EPC 1973. The interpretation in the light of the sense and purpose of the procedure under R. 58(4) EPC 1973, lead to the same goal.

In **T 156/90** the opponent had stated that he would have no objection to maintenance of the patent if the claims were amended in a specified way, which they were. His subsequent appeal was dismissed as inadmissible; his argument that the circumstances had changed and he was no longer bound by his consent failed.

In **T 266/92**, on the other hand, the opponent had declared in opposition proceedings that he would withdraw his request for **oral proceedings** if the patentee agreed to an amended wording of the patent, as he did. The board held that the appellant was adversely affected within the meaning of Art. 107 EPC 1973, and was entitled to appeal; 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.

In **T 833/90** the board held that an appeal should be considered admissible if it was not clear or ascertainable whether the opponent (appellant) had agreed to maintenance of the patent. This was followed in **T 616/08**.

(ii) Opponent adversely affected

In **T 273/90** the board concluded that legal uncertainty arising from **inadequate adjustment of the description** to amended claims constituted sufficient grievance under Art. 107 EPC 1973, as the commercial interests of the appellant (opponent) could be adversely affected (likewise **T 996/92**).

In **T 1178/04** (OJ 2008, 80) the board found the appeal filed by the opponent admissible even where the **validity of the opponent's status** was challenged following a disputed transfer, as a person was a party to proceedings for the purposes of Art. 107 EPC 1973 even if his entitlement to take part in such proceedings was brought into question. A decision that he was not entitled to take part in the proceedings would have the effect that he was no longer entitled to take part in the proceedings, but not that he had never been a party. See also **T 1982/09**.

It is not necessary for an opponent to have a **continuing interest**, financial or otherwise, in the prosecution of the opposition or appeal; it suffices that the decision does not accede to one of its substantive requests (**T 1421/05** following **T 234/86**; OJ 1989, 79).

(iii) Opponent not adversely affected

In **T 299/89** the board considered the extent of entitlement to appeal of an opponent who in his opposition had requested only partial revocation but in his appeal wanted the

whole patent revoked. It decided that this was determined by the scope of the original request made in the opposition. The opponent was only adversely affected within the meaning of Art. 107 EPC 1973 **to the extent that this request was not granted**, and he could not on appeal file a wider request.

An opponent is not adversely affected by **obiter dicta reasons** given in a revocation decision and favourable to the patent proprietor, and which it is appropriate for the opposition division to include to obviate remittal in the event of revocation being reversed on appeal (**T 473/98**, OJ 2001, 231).

A respondent (opponent) which is not adversely affected by a decision revoking the patent is not entitled to file an appeal for the sake of **acquiring an independent appellat status** instead of the status of a respondent (party as of right) (**T 193/07**). The board considered that its conclusion was in accordance with the established jurisprudence of the boards of appeal (see e.g. **T 854/02**, **T 981/01**, **T 1147/01**, **T 1341/04** and **T 473/98**). The board also pointed out that purely hypothetical considerations put forward by the opponent in support of the admissibility of its appeal concerning potentially disadvantageous situations that might occur (in the future) in related national litigation proceedings had no legal relevance under Art. 107 EPC.

In **T 1569/11** the opponents did not seek to challenge the decision of the opposition division (i.e. revocation of the patent) but the reasons for the decision. In particular, the opponents wanted the patent to be found invalid under Art. 100(c) EPC. The board noted that, in doing so, they misunderstood the nature and purpose of opposition appeal proceedings, which are not to re-examine a patent but to decide whether or not a first instance decision is correct (cf. **T 854/02**; **T 437/98**, OJ 2001, 231; **T 193/07**).

#### 2.4.3 Procedural status of the parties

##### a) Parties to appeal proceedings

Under Art. 107, second sentence, EPC the parties to proceedings before the department of first instance are also parties to the ensuing appeal proceedings, even if they have not personally filed an appeal. Pursuant to Art. 99(3) EPC, opponents as well as the patentee are parties to opposition proceedings. In addition, Art. 105 EPC makes provision for intervention by the assumed infringer. For further details, see Chapter IV.C.3 "Intervention".

For other proceedings, the general principle applies that the parties to them are those whose legal interests are affected by the decision at issue. In **T 811/90** (OJ 1993, 728), for example, opposition proceedings had been concluded and the time limit for lodging an appeal had expired. Only the patent proprietor lodged an appeal, but against a separate decision on a point incidental to the opposition. It was held that the other party had no right to be a party to the appeal as he had not been a party to the relevant decision. However, in a decision concerning an appeal against a Legal Division decision refusing to suspend grant proceedings under R. 13 EPC 1973, the applicant was to be treated as a party to the proceedings. The request for suspension could not be

separated from the grant proceedings. The applicant's legal position was directly affected by suspension, because for its duration he was denied the rights under Art. 64(1) EPC 1973 (**J 33/95**). According to **T 838/92**, nothing in the EPC 1973 enabled an opposition division or board of appeal to exclude a party from ongoing proceedings.

A patent applicant who was not heard when grant proceedings were suspended at a third party's request pursuant to R. 13 EPC 1973 could still challenge the justification for that suspension. He was a party as of right to any appeal proceedings initiated by the third party against rejection of the latter's request by the EPO (**J 28/94**, OJ 1997, 400).

In **T 643/91** the **appeal** of opponent 1 was rejected as inadmissible. Opponent 2 filed an admissible appeal. Opponent 1 was considered by the board to be "any other party to the proceedings" under Art. 107 EPC 1973 and, as a consequence, to be a party as of right in the appeal proceedings of opponent 2. However, in **T 898/91** it was held that an opponent whose **opposition** has been rejected as inadmissible by the opposition division and who has not filed an appeal against this decision is not entitled to be a party to any appeal by the patent proprietor, because he ceases to be a party to the opposition proceedings once the decision on the admissibility of its opposition takes full legal effect.

Where two opponents lodge appeals contesting different sets of claims and one subsequently withdraws its appeal, it becomes a party as of right under Art. 107 EPC and the other opponent becomes the sole appellant (see e.g. **T 233/93**).

Where a company is dissolved and thus ceases to be a legal person, it loses its capacity to be a party to any proceedings. If it was the original appellant, the appeal consequently lapses (**T 353/95** and **T 2334/08**). However, a party's opponent or appellant status does not lapse merely as a result of bankruptcy proceedings being issued (**T 696/02**).

Third parties commenting under Art. 115 EPC 1973 on the patentability of the invention claimed are not parties to the proceedings before the EPO. See also Chapter III.N "Observations by third parties".

#### b) Rights of parties under Article 107 EPC

In appeal proceedings, the case law recognises the right of all parties to be heard (see **J 20/85**, OJ 1987, 102; **J 3/90**, OJ 1991, 550; **T 18/81**, OJ 1985, 166; **T 94/84**, OJ 1986, 337; **T 716/89**, OJ 1992, 132), albeit within the limits of expediency (see **T 295/87**, OJ 1990, 470). The parties also have a right to oral proceedings.

Furthermore, **G 1/86** (OJ 1987, 447) recognised the validity of the principle that all parties must be treated equally in similar legal situations in proceedings before the boards of appeal.

Decision **T 73/88** (OJ 1992, 557) deduced from this that all parties to proceedings had the right to continue appeal proceedings. If there was already one valid appeal, no further appeals were needed and the fees paid for appeals filed later had to be refunded. However, in decision **G 2/91** (OJ 1992, 206) the Enlarged Board disagreed. It took the

view that from the legal point of view the status of parties who had filed an appeal was not comparable with that of those who had not. It was clear from generally recognised principles of procedural law that the appellant alone could decide whether the appeal filed by him was to stand. Art. 107, second sentence, EPC 1973 only guaranteed non-appellants who were party to proceedings of the first instance that they were parties to **existing** appeal proceedings. A person who was entitled to appeal but did not do so, settling instead for being "automatically" a party to the appeal proceedings, had no independent right of his own to continue those proceedings if the appellant withdrew his appeal. He acquired that right only by filing an appeal himself and paying the associated appeal fee. By the same token, there was also no reason to refund the fee for any appeals filed after the first, unless the requirements of R. 67 EPC 1973 were met. The related issue of whether non-appealing parties can file substantive requests is dealt with in **G 9/92** and **G 4/93** (both OJ 1994, 875; see Chapter IV.E.3.1 "Reformatio in peius"). (NB. The requirements of R. 67 EPC 1973, now R. 103 EPC, have been altered.)

In **T 864/02**, the board found that, according to some case law, a non-appealing party as of right did not have the same procedural status in all respects as did an appellant e.g., it did not have an independent right to continue appeal proceedings if the appellant withdrew its appeal (see **G 2/91**, OJ 1992, 206 and **G 9/92**, OJ 1994, 875). However, the case law also confirmed the right to be heard of all parties to pending proceedings, a specific aspect of the principle that all parties to proceedings pending before the EPO must be treated fairly and equally, as confirmed by **G 1/86** (OJ 1987, 447). According to the board, the only basic legal difference between an appellant and a party as of right lay in the way they became parties to the appeal procedure, the former by notice of appeal and the latter under Art. 107 EPC 1973. Once they were parties to the appeal procedure they had exactly the same rights. The party as of right was thus entitled to raise a novelty objection where the notice of opposition had raised this ground and the submission therefore lay within the framework of the opposition procedure. In **T 591/01** and **T 475/97** the respective parties as of right were allowed to submit requests.

Post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment (**G 9/91**, OJ 1993, 408, point 2 of the Reasons).

In **T 1072/93** the board held that the freedom of the board to offer specific advice to one of the parties as to how an objection might be overcome, even when such an objection stemmed from the board itself, was severely limited, especially in inter partes proceedings where the preservation of judicial impartiality was a paramount requirement. In **T 253/95**, the same board confirmed that boards of appeal in inter partes proceedings must be strictly impartial and found that alerting a party to a possible argument against him and on a ground on which the burden of proof rested on him, in advance of the oral proceedings, would amount to a clear violation of the principle of impartiality, irrespective of the fact that the communication setting out such an argument would also be sent to the other party. In **T 394/03** the board held that, even though the opposition division's decision to reject the opposition had been annulled, it was not necessary, in the absence of a request, to give the patentee and respondent another opportunity to comment, nor, given the impartiality of the board, was there any requirement on principle to do so.

Following **T 394/03**, the board in **T 902/04** having regard to procedural economy, the principle of party disposition and the requirement for judicial impartiality in inter partes proceedings, found it appropriate to decide the case. Since the opponent's request was allowed, there was no need to hold the oral proceedings which only the opponent had requested on a purely auxiliary basis.

c) Retrospective restoration of a company

In the case underlying **G 1/13** (OJ 2015, A42) an opposition had been filed by a company which subsequently, under the relevant national law governing the company, for all purposes had ceased to exist. However, the company was subsequently restored to existence under a provision of that governing national law, by virtue of which the company was deemed to have continued in existence as if it had not ceased to exist. The Enlarged Board held that the EPO had to recognise the retroactive effect of that provision of national law. Thus, where a valid appeal was filed in due time in the name of the non-existent opponent and the restoration of the company to existence with retroactive effect took place after the expiry of the time limit for filing the notice of appeal under Art. 108 EPC, the board of appeal had to treat the appeal as admissible. The Enlarged Board referred to the clearly established principle under the EPC that national law should be referred to in order to determine whether a legal entity existed or had ceased to exist, and had capacity to act. The Enlarged Board also considered that the EPO should follow national law as regards the deemed retrospective existence of such a legal entity. This was merely to apply the general principle that such issues are the exclusive concern of national law.

## 2.5. Form and time limit of appeal

### 2.5.1 Electronic filing of appeal

Pursuant to the Decision of the President dated 10 November 2015 (OJ 11/2015, A91), appeals too may now be filed in electronic form. The case law below relates to cases decided prior to the date this decision entered into force (on 16 November 2015).

Under Art. 108 EPC 1973, notice of appeal was filed in **writing**. Thus an appeal filed via electronic means (epoline<sup>®</sup>), not being "in writing" was rejected as inadmissible in **T 781/04** and **T 991/04**, referring to the EPO Notice dated 9.12.2003 concerning the My epoline<sup>®</sup> portal. Referring to **T 781/04**, **T 991/04** and **T 514/05** (OJ 2006, 526), the board in **T 765/08** stated that documents purporting to be documents filed subsequently for the purposes of R. 2(1) EPC (here the notice of appeal) must be deemed not to have been received if they are filed by technical means not approved by the President of the EPO (here, electronically transmitted). This applies even if the means of transmission is subsequently allowed (**T 331/08**, following **T 514/05**); the board was not entitled to exercise discretionary power to consider whether the appeal, filed via epoline<sup>®</sup>, might nonetheless be deemed to have been filed, since i) to do so would be tantamount to exercising legislative power; 2) such legislative power was however clearly delegated in R. 36(5) EPC1973 to another authority within the EPO, namely the President; 3) thus pursuant to Art. 23(3) EPC1973 the board was precluded from examining whether this

purported notice of appeal could be deemed to have been received, since such a procedure would be *ultra vires*; 4) it was immaterial that this means of communication was now permitted for the filing of appeals. It was the law and instructions in place at the time of filing which had to be applied.

The board in **T 1090/08** also found the appeal inadmissible, as the statement of grounds of appeal were filed via *epoline*<sup>®</sup> prior to the entry into force of the 2009 Decision, but on the facts of the case granted re-establishment of rights in a decision dated subsequent to the entry into of force of the 2009 Decision.

In **T 1427/09** the notice of appeal and statement of grounds were filed in due time but the electronic signatures were not issued to a person authorised to act in the proceedings, in contravention of Art. 8(2) of the 2009 Decision, which is silent on the legal consequences of non-compliance. The board held that the principle that the signature of an unauthorised person should be treated like a missing signature, as set out in **T 665/89**, should apply not only to handwritten signatures, but also to electronic signatures. The electronic filing of a document in appeal proceedings accompanied by the electronic signature of an unauthorised person should therefore be treated under R. 50(3) EPC like the filing of an unsigned document per mail or telefax in the same proceedings.

#### 2.5.2 Form and content of notice of appeal (Rule 99(1) EPC)

R. 99(1) EPC defines the content of the notice of appeal to be filed within the period specified in Art. 108 EPC, taking up the requirements mentioned in R. 64(a) and (b) EPC 1973. Under R. 99(1) EPC the notice of appeal shall contain, under R. 99(1)(a) EPC, the **name and address of the appellant**, under R. 99(1)(b) EPC an **indication of the decision impugned** and under R. 99(1)(c) EPC, a **request** defining the **subject** of the appeal.

However, under R. 64(b) EPC 1973, the appellant already had to include in the notice of appeal a statement identifying the **extent** to which amendment of the impugned decision was requested. This rarely presented a problem in appeals filed by an opponent; as a rule, an opponent would request that the decision impugned be set aside and the patent revoked (partially or in its entirety). However, where the appellant is the patent proprietor, the amended claims are nearly always filed with the statement of grounds of appeal, and it is only then that the precise nature of the requested amendment of the decision impugned becomes apparent. Consequently, this requirement has been moved to R. 99(2) EPC, which defines the content of the statement of grounds of appeal; before, this had been left to board of appeal case law under Art. 108, third sentence, EPC 1973.

The requirement of R. 99(1)(c) EPC takes into account the fact that the appellant's initial request, according to **G 9/92** and **G 4/93** (OJ 1994, 875) and **G 1/99** (OJ 2001, 381) defines the subject of the appeal and thereby the framework of the appeal proceedings.

a) Rule 99(1)(a) EPC

Under R. 99(1)(a) EPC the notice of appeal shall contain the name and address of the appellant.

In **T 2330/10** the board stated that there was a difference between establishing the identity of an appellant and knowing the address where the appellant could be found. The deficiencies concerning the indication of the appellant's name and address as prescribed by R. 99(1)(a) EPC did not necessarily have to be remedied within the two-month time limit pursuant to Art. 108 EPC, but could be remedied later following an invitation under R. 101(2) EPC if there was a reason to issue such invitation. Whether or not the opponent knew the appellant's new address by the end of the two-month period was not relevant, nor was the degree of difficulty the opponent could have had in finding it out. The notice of appeal was therefore filed on behalf of a clearly identified legal person that was party to the first instance proceedings.

According to **T 624/09** it has become standard case law that the provisions of R. 99(1)(a) EPC are satisfied if the notice of appeal contains sufficient information for identification of a party (see e.g. **T 483/90**; **T 613/91** and **T 867/91**). In **T 483/90** the appellant's name was incorrectly given and its 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. 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. In **T 867/91** the notice of appeal did not contain the address of the appellant and did not expressly state that the patentee was the appellant. In **T 624/09** the notice of appeal did not contain the appellant's address.

Similar conclusions were reached in **T 899/95**, citing **J 25/86**, (OJ 1987, 475), which was explicitly concerned with R. 26(2)(c) EPC 1973, as well as **T 483/90**, **T 613/91**, **T 867/91** and **J 39/92**. (Under R. 64(a) EPC 1973 the notice of appeal was required to contain the name and address of the appellant in accordance with the provisions of R. 26(2)(c) EPC 1973. The relevant provisions are now R. 99 EPC and R. 41 EPC respectively). It was alleged in **T 899/95** that the opponent was a legal entity but was not identified by its official designation; its identity was, however, clear. In **T 786/11**, the board held that "IS Limited" did not change its legal identity by being transferred to Mauritius.

An appeal filed by an appellant whose name was changed before the appeal was filed without indicating the change of name met the requirements of R. 64(a) EPC 1973, provided that the appellant was identifiable (**T 157/07**). See also **T 1/97**, **T 786/00** and **T 866/01**. In the latter decision the board agreed that the applicability of R. 65(2) EPC 1973 in conjunction with R. 64(a) EPC 1973 was to be defined as the requirement that deficiencies and omissions in information concerning the appellant were to be remedied on invitation in accordance with R. 65(2) EPC 1973, while the identity of the appellant had to be known and verifiable from the outset of proceedings. However, the requirement regarding sufficient identification of the appellant was to be considered to be met whenever it is possible to establish beyond reasonable doubt the identity of the



appellant on the basis of all information provided by the appellant or his legal representative within the time limit under Art. 108 EPC or in the previous proceedings, including any such information contained in the decision under appeal.

However, in **T 938/94**, where the appellant's name and address were not stated in the notice of appeal and it failed to give this information within the time limit set by the invitation pursuant to R. 65(2) EPC 1973, the appeal was rejected as inadmissible. The board considered **T 483/90** (see above), but noted that in that case no invitation pursuant to R. 65(2) EPC 1973 appeared to have been issued, nor did it seem to have been considered whether a specific invitation to provide the address should not first have been sent.

Similarly, in **T 774/05**, the appeal was rejected as inadmissible, as the appellant's address was not given in the notice of appeal. In accordance with R. 65(2) EPC 1973, the board had invited the appellant to remedy the deficiency within a time limit set by the board, but the appellant failed to do this within the set time limit. The effect of the failure to observe the time limit was clearly set out in R. 65(2) EPC 1973. This rule obliged the board to reject the appeal as inadmissible.

Several decisions have allowed correction of the name of the appellant to substitute a natural or legal person other than the one indicated in the appeal under R. 65(2) EPC 1973 in conjunction with R. 64(a) EPC 1973, if it was the true intention to file the appeal in the name of the said person and if it could be derived from the information in the appeal, if necessary with the help of other information on file, with a sufficient degree of probability that the appeal should have been filed in the name of that person (**T 97/98**, OJ 2002, 183; see also **T 15/01**, OJ 2006, 153, **T 715/01**, **T 707/04** and **T 875/06**). Where there is objectively a deficiency in the notice of appeal indicating a genuine error as regards the identity of the appellant and there is objective evidence in the file indicating with a sufficient degree of probability who the appellant should be, then the notice of appeal may be corrected under R. 101(2) EPC (**T 1961/09**, following **T 97/98**, OJ 2002, 183) (see also **T 540/09**, **T 662/09**).

In **G 1/12** (OJ 2014, A114) the Enlarged Board of Appeal reformulated the question originally posed to ask whether, when a notice of appeal, in compliance with R. 99(1)(a) EPC, contains the name and the address of the appellant as provided in R. 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the **true intention** having been to file on behalf of the legal person which should have filed the appeal, it is possible to correct this error under R. 101(2) EPC by a request for substitution by the name of the true appellant.

The Enlarged Board answered that it was possible, provided the requirements of R. 101(1) EPC had been met. Given the explicit reference in R. 101(1) EPC to Art. 107 EPC and the possibility of remedying deficiencies only within the two-month appeal period under Art. 108, first sentence, EPC, the identity of the appellant, i.e. the person entitled to appeal, had to be established by expiry of the two-month period prescribed in Art. 108, first sentence, EPC at the latest. R. 101(2) EPC concerns deficiencies concerning the indication of the appellant's name and address as prescribed

by R. 99(1)(a) EPC. They may be remedied irrespective of the time limits pursuant to Art. 108 EPC, upon invitation by the board of appeal (see also **T 755/09**).

The Enlarged Board fully endorsed the case law, in which it was considered that an incorrect indication of the appellant's identity is a deficiency which can be remedied, provided "its correction does not reflect a later change of mind as to whom the appellant should be, but on the contrary only expresses what was intended when filing the appeal" (see **T 97/98**).

The Enlarged Board also found that in cases of an error in the appellant's name, the general procedure for correcting errors under R. 139, first sentence, EPC was available under the conditions established by the case law of the boards of appeal. The following principles have been established:

(1) The correction must introduce what was originally intended. It is the party's actual rather than ostensible intention which must be considered.

(2) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one (**J 8/80**).

(3) The error to be remedied may be an incorrect statement or an omission.

(4) The request for correction must be filed without delay.

Furthermore, an allowable correction under R. 139 EPC has retrospective effect (**J 4/85** as endorsed in several subsequent decisions, for example **J 2/92**, OJ 1994, 375; **J 27/96**; **J 6/02**; **J 23/03** and **J 19/03**).

Thus, an appeal filed by mistake in the name of an opponent who no longer exists but who has a universal successor, and which was obviously **intended** to be filed on behalf of the person who is the actual opponent and who was prejudiced by the decision, namely the universal successor, is admissible; if necessary the notice of appeal and statement of grounds of appeal may be corrected to record the name of the true appellant (opponent) (**T 1421/05**).

However, where the effective date of transfer of the patent to the appellant named in the notice of appeal had not actually occurred until after the period for filing a notice of appeal-and it was the appellant's **true intention** to file an appeal on behalf of the name given in the notice of appeal, there is no deficiency in the notice concerning the name of the appellant which may be remedied in accordance with R. 99(1)(a) EPC in conjunction with R. 101(2) EPC nor an error which may be corrected pursuant to R. 139, first sentence, EPC and the appeal is thus inadmissible (**T 128/10** following **T 97/98**; see also **T 2045/09**).

In **T 979/12** the board noted that according to **G 1/12**, which fully endorsed decision **T 97/98** (OJ 2002, 183), the board must establish the true intention of the appellant "on

the basis of the information in the appeal or otherwise on file, i.e. ascertain who must be deemed in all likelihood to have filed the appeal...".

In **T 445/08** of 26.03.2015 the board noted that it was not immediately clear that the appeal filed on behalf of the appellant, a company fully identified with its address and nationality and different from the patent proprietor, was actually intended to be filed on behalf of the appellant and stated that, regarding the requirements listed in **G 1/12**, it could not accept that the mere fact that the appellant was the party adversely affected during the opposition proceedings was sufficient to establish the true intention. The board stated that if it was indisputable that the notice of appeal was to be considered in the context of the file history, the true intention needed to be confirmed by external facts, at least to prevent requirements such as those of Art. 107 EPC being circumvented. It found that in applying R. 139 EPC to a party's request to correct a mistake in the notice of appeal in respect of the identity of the appellant, the principle of legal certainty, according to which parties are bound by their procedural acts, needed to be taken into consideration. The board came to the conclusion that the interests of the respondent were not sacrificed in this case because, apart from the fact that the true intention was to file an appeal on behalf of the entitled person, the request for correction was filed five days after the expiry of the two-month time limit for filing the notice of appeal. The board concluded that the requirements for the correction requested had been met, and thus that the correction was to be allowed.

In **T 445/08** (OJ 2012, 586) it was undisputed that the notice of appeal as filed was not admissible because the appellant company had not been a party to the opposition proceedings and accordingly was not adversely affected by the appealed decision. It was no longer the patent proprietor. The question arose whether the request for correction, which would result in the appeal being admissible, was possible pursuant to R. 101(2) or 139 EPC. The request was filed only after expiry of the relevant two-month period provided for by R. 101(1) EPC.

#### b) Rule 99(1)(b) EPC

Under R. 99(1)(b) EPC, the notice of appeal shall contain an indication of the decision impugned.

According to **J 16/94**, (OJ 1997, 331), for a notice of appeal to comply with Art. 108, first sentence, EPC 1973 and R. 64(b) EPC 1973, it had to express the definite intention to contest an appealable decision. An appeal filed as a subsidiary request, i.e. **conditional** on the main request not being allowed by the department of first instance, was therefore inadmissible. This was because there should be legal certainty as to whether or not a decision was contested in view of, firstly, the time limit under Art. 108 EPC 1973, secondly, the further steps to be taken by the department of first instance under Art. 109 EPC 1973, and particularly in view of the suspensive nature of the appeal under Art. 106(1) EPC 1973. This was confirmed by **T 460/95** (OJ 1998, 588).

c) Rule 99(1)(c) EPC

The notice of appeal shall contain **a request defining the subject** of the appeal (R. 99(1)(c) EPC).

In decision **G 1/99** (OJ 2001, 381), the Enlarged Board of Appeal pointed out that issues outside the subject-matter of the decision under appeal are not part of the appeal. It also noted that within the limits of what in the subject-matter of the decision under appeal adversely affects it, it is the appellant who in the notice of appeal determines the extent to which amendment or cancellation of the decision under appeal is requested.

Under R. 64(b) EPC 1973, the notice of appeal had also to contain a statement identifying the decision which was impugned and the **extent** to which amendment or cancellation of the decision was requested. If the extent to which cancellation of the decision was requested was not expressly stated in the notice of appeal, the board would examine whether the relevant information could be determined from the totality of the appellant's submissions (see **T 7/81**, OJ 1983, 98 and **T 32/81**, OJ 1982, 225; see also **T 925/91**, **T 932/93** and **T 372/94**). However, this requirement now applies to the statement of grounds and no longer to the notice of appeal and can be found, reworded, in R. 99(2) EPC.

According to the board in **T 358/08**, R. 99 EPC has not altered the previous law as to the requirements of either the notice of appeal or the statement of the grounds of appeal as regards the appellant's requests. R. 99(1)(c) EPC is satisfied if the notice of appeal contains a request, which may be implicit, to set aside the decision in whole or, (where appropriate) only as to part. Such a request has the effect of 'defining the subject of the appeal' within the meaning of R. 99(1)(c) EPC. Nor is it necessary in the case of an appeal by an applicant or proprietor for the notice of appeal to contain a request for maintenance of the patent in any particular form. This is something which relates to 'the extent to which [the decision] is to be amended', and which is therefore a matter for the statement of grounds of appeal under R. 99(2) EPC. This has been confirmed in many decisions, e.g. **T 844/05**, **T 509/07**, **T 9/08**, **T 226/09**, **T 689/09** and **T 648/10**.

In **T 620/13** the board pointed out that the notice of appeal is a legal declaration or legal statement made by a party to a proceeding before the EPO, and as such it must contain an unambiguous, clear and most of all, explicit statement, which is recognisable as a legal statement, concerning both the identification of the impugned decision and the subject of the appeal (see also **J 19/90**). It was immaterial that the registrar was able to establish which decision was appealed. Furthermore, according to the correct reading of **T 358/08**, what might be "implicit" was that part of the request which indicates whether the decision is to be set aside in whole or only in part. Decision **T 358/08** lent no authority to the argument that there need not be any request at all. The appeal was rejected as inadmissible.

Many of the decisions below concern the application of R. 64(b) EPC 1973, in particular the requirement concerning the extent to which amendment or cancellation of the

decision was requested in the notice of appeal. (This request, reworded, now forms part of the statement of grounds; R. 99(2) EPC).

It was sufficient to fulfil the requirements of R. 64(b) EPC 1973 if the extent of the request made on appeal could be inferred interpreting the notice of appeal in an objective way (T 85/88, see also e.g. T 32/81, OJ 1982, 225; T 7/81, OJ 1983, 98; T 1/88, T 533/93, T 141/95 and T 308/97).

T 631/91, T 727/91 and T 273/92 confirmed the principle that the appeal's scope could be ascertained from the appellant's overall submissions if the request filed in the appeal proceedings did not make this clear. Since no indication was made to the contrary in the appellant's submissions, the board of appeal assumed that he wished to file a request in the appeal proceedings along the same lines as that filed in the opposition proceedings (see also T 925/91, OJ 1995, 469; T 194/90 and T 281/95).

The wording "... we hereby file notice of appeal to the decision ..." was construed in T 632/91 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. This was followed in T 49/99 and T 1785/06). See also T 9/08 for a corresponding application under R. 99(2) EPC.

If the only ruling in an opposition division decision was that the patent was revoked, a statement by the patent proprietor that he was appealing against the decision was invariably tantamount to his stating that he wished and hence requested that the decision be set aside in its entirety, because setting aside had to be unitary. Hence the content of the notice of appeal was what R. 64(b) EPC 1973 demanded as one of its requirements for an admissible appeal, i.e. a statement identifying the extent to which cancellation of the decision was requested (T 407/02). This has also been applied under R. 99 EPC; see T 912/08, T 624/09, T 689/09 and T 1188/09.

However, where the decision under appeal related to more than one different legal issue, the statement identifying the extent of the appeal as prescribed by R. 64(b) EPC 1973 had to make it clear which issue(s) of the decision were also subjects of the appeal (T 420/03). In the case before the board the two issues were the revocation of the patent and the apportionment of costs. As the notice of appeal was completely silent on the latter and there was nothing which indicated that the decision should be set aside in its entirety, this issue was not within the extent of the appeal.

#### d) Rule 99(3) EPC

Under R. 99(3) EPC Part III of the Implementing Regulations applies *mutatis mutandis* to the notice of appeal, the statement of grounds and the documents filed in appeal proceedings.

R. 99(3) and 41(2)(h) EPC together make it clear that a notice of appeal must be signed by the appellant or his representative, but not that every single document in the notice has to be signed or that the signature has to be appended at a particular place or page.

In **T 783/08**, the debit order had been part of the notice of appeal, so the board held that the signature on it fulfilled the EPC requirements in question. The appeal had therefore been validly filed.

### 2.5.3 Appeal filed within the time limit

In **T 389/86** (OJ 1988, 87) the board stated that an appeal which was filed after pronouncement of a decision in oral proceedings but **before notification** of the decision duly substantiated in writing complied with the time limit pursuant to Art. 108, first sentence, EPC 1973. See also **T 427/99** and **T 1125/07**.

Where the translation of the notice of appeal in an **official language** of the EPO was not filed in due time, the notice was deemed not to have been received according to Art. 14(5) EPC 1973 and the appeal not to have been filed (**T 323/87**, OJ 1989, 343; see also **T 126/04**). Where the notice of appeal was filed in a non-official language by a company not entitled to benefit from the provisions of Art. 14(4) EPC 1973 and a translation into an official language was filed on the same day, the notice of appeal was nonetheless deemed not to have been filed. In view of **G 6/91** (OJ 1992, 491), where the translation was filed at the same time as the original, the EPO could not take it as the "official" notice of appeal and ignore the original as superfluous. As further stated in **G 6/91** "a translation cannot become the original; whatever the date on which it is filed it remains a translation, with all ensuing legal consequences, including the possibility of correction to bring it into conformity with the original" (**T 1152/05** and **T 41/09**). The residence or principal place of business of the professional representative used was irrelevant (**T 149/85**, OJ 1986, 103 and **T 41/09**).

According to **T 1281/01** the legal fiction that the decision (under appeal) had been delivered on the tenth day following its posting (R. 78(2) EPC 1973) did not apply when it had actually been delivered to a previously authorised representative **after** she had notified the EPO that the file had been transferred to another representative. Pursuant to R. 82 EPC 1973, the decision under appeal was deemed to have been notified on the date it was received by the authorised representative and the appeal had thus been filed in due time.

Similarly, where an appellant was **misled** by the EPO into thinking that the decision issued was only a draft, being replaced by a second one, it was sufficient if he filed the appeal within four months of notification of the second written decision (**T 830/03**).

Where the opposition division misleadingly issued two decisions, it sufficed if the statement of grounds of appeal was filed within the time limit applicable to the second decision, even if it was outside the time limit for the first decision (**T 993/06**).

In **T 124/93** the parties were misled by the re-dating of the decision by the opposition division. Following the principle of good faith governing the relationship between the EPO and the parties acting before it, their submissions received after expiration of the normal terms were considered to have been made in due time (see e.g. **T 124/93**, **T 1176/00** and **T 1694/12** in comparable cases).

#### 2.5.4 Payment of appeal fee

If no written notice of appeal has been filed within the time limit the question has arisen whether merely paying the fee for appeal constitutes a valid means of lodging an appeal. In **T 275/86** the board had held that payment with EPO Form 4212 05.80 should be accepted as such a notice since it contained essentially the same information as was required in a notice of appeal within the meaning of R. 64 EPC 1973. However, the board in **J 19/90** stated that merely paying the fee for appeal did not constitute a valid means of lodging an appeal. This applied even if the object of the payment was indicated as being a "fee for appeal" relating to an identified patent application and the form for payment of fees and costs was used. This was confirmed in **T 371/92** (OJ 1995, 324), **T 445/98**, **T 514/05** (OJ 2006, 526) and **T 778/00** (OJ 2001, 554), where the board also added that the failure to indicate the provisions of R. 65 EPC 1973 in the annex to the communication dealing with the possibility of appeal did not make this incomplete or misleading. This applies equally to inter partes proceedings (**T 1926/09**); it is in the public interest in both ex parte and inter partes proceedings to be informed with certainty about the applicant's intention of challenging a first-instance decision.

In **T 595/11** the board held that fee payment is not an issue of admissibility of the appeal, but rather a precondition for the very existence of the appeal, i.e. its deemed filing. If the appeal fee is not paid, the appeal need not be examined at all for admissibility and even less on its merits. Otherwise, it plays no role in the merits of the case, and also has no bearing on those issues that normally affect the admissibility of an appeal, such as timeliness, substantiation, party status or even competence of the deciding body. In fact, an appeal fee may even be reimbursed (see R. 103 EPC), further demonstrating that an appeal fee per se is not indispensable for the delivery of justice. Therefore, in order to avoid any misunderstanding, the board emphasised that the present finding in no way affects the established jurisprudence of the boards that the issue of admissibility of an appeal can be expected to be raised ex officio and at any stage of the proceedings.

In **T 1943/09**, the board held that the only possible conclusion in the light of the provisions of the EPC was that payment of the appeal fee did not suffice to lodge a valid appeal. The legislative amendment under the EPC 2000 whereby R. 99(1) EPC lists the items making up the obligatory content of the notice of appeal removed any doubt there might have been as to the fact that the mere payment of the appeal fee cannot replace the notice of appeal, even if it is effected within two months of notification of the decision against which an appeal is to be filed.

### 2.6. Statement of grounds of appeal

#### 2.6.1 Legal provisions

Under Art. 108 EPC a statement setting out the grounds of appeal shall be filed within four months after the date of notification of the decision in accordance with the Implementing Regulations (see R. 99 EPC).

Under R. 64(b) EPC 1973 a statement identifying the extent to which amendment of the impugned decision was requested had to be included in the **notice of appeal**. Under the EPC 2000 the appellant must indicate 'the reasons for setting aside the decision impugned, or the extent to which it is to be amended' in the **statement of grounds** (R. 99(2) EPC; see also **T 358/08**); up to now this had been left to board of appeal case law under Art. 108, third sentence, EPC 1973.

If the notice of appeal does not contain anything that can be regarded as a statement of grounds, the appeal is inadmissible unless a written statement of grounds is received by the EPO within the time limit set in Art. 108 EPC (R. 99(2) EPC and R. 101(1) EPC). If an appeal is to be rejected as inadmissible solely because the statement of grounds was not filed in due time the fee for appeal is not refundable (**T 13/82**, OJ 1983, 411).

### 2.6.2 Form of statement of grounds of appeal

Whether a document complies with Art. 108 EPC, third sentence, is considered to depend on its substance and not upon its heading or form (**T 145/88**, OJ 1991, 251, where the document headed "Statement of Grounds" was found not to contain even the minimum of reasoning and thus was not a statement of grounds at all). The mere existence of some argumentation and carrying the heading "Statement of the Grounds of Appeal" or "Grounds" does not automatically pass the threshold of Art. 108 EPC, even if clearly relating to the substance of the impugned decision (**T 1581/08**, referring to **T 145/88**). The board went on to point out that sufficiency is also not a question of volume. There is no minimum requirement as to the length or the fullness of detail of the argumentation which is necessary for an admissible appeal. In this context a distinction is to be drawn between insufficiency for the purposes of admissibility and insufficiency as far as the persuasiveness of the grounds is concerned which - if the arguments are not convincing - results in the dismissal of the appeal (see **T 922/05** and below). See also e.g. **T 23/03** and **T 613/07**.

The board in **T 74/12** pointed out that R. 99(2) EPC did not require a case number to be indicated in the statement of grounds of appeal. That logically implied that an appeal could not be found inadmissible simply because the case number was missing, as only the law, viz. the EPC and its implementing regulations, could define the conditions for taking certain procedural steps and the consequences to be expected if those steps were not taken. A procedural principle stated that rights or a means of redress could be lost only if such a consequence was clearly and precisely prescribed.

### 2.6.3 General principles

The examination of whether the requirements of Art. 108, third sentence, EPC are met has to be made on the basis of the contents of both the statement of grounds of appeal and of the decision under appeal (**T 162/97**). Whether a statement of grounds meets the requirements of Art. 108 EPC 1973 can only be decided on a case-by-case basis (**T 165/00**).



In **T 23/10** the board stated that, whether or not sufficient grounds relating to the requests submitted, was immaterial for the purposes of the admissibility of the appeal, because an appeal can only be assessed as a whole. In other words, if the admissibility requirements of Art. 108, third sentence, EPC are fulfilled in respect of at least one request, let alone of several requests, the appeal as a whole will be admissible (**T 509/07**, **T 1763/06**). The fact that the appellant, in the course of appeal proceedings, withdrew the main and auxiliary request and thereby abandoned its refutation of the reasoning of the impugned decision under Art. 100(c) EPC, had no bearing on the assessment of the admissibility of the appeal as filed. The admissibility requirements of Art. 108, third sentence, EPC concerning the appeal filed by the patentee were met within the time limit for filing the statement of grounds of appeal at least as far as the main request and auxiliary requests were concerned. As a consequence, the appeal of the patentee was admissible.

a) Legal or factual reasons to be specified

In **J 10/11** the board reviewed the case law of the boards of appeal on the requirements to be fulfilled in the statement of grounds. If the appellant submits that the decision under appeal is incorrect, then the statement setting out the grounds of appeal must enable the board to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases its arguments, without first having to make investigations of its own (see **T 220/83**, OJ 1986, 249, and **T 177/97**; affirmed by numerous decisions, and in particular recently by **T 573/09**).

Whether the requirements of Art. 108, third sentence, EPC in conjunction with R. 99(2) EPC are met has to be decided on the basis of the statement of grounds of appeal and of the reasons given in the contested decision, taking into account any amendments made to the claims (see e.g. **J 22/86**, OJ 1987, 280; **T 162/97**, **T 2001/14**). Exceptionally, it has been acknowledged that the requirement for admissibility may be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement of grounds that the decision should be set aside (see **J 22/86**). The appellant had made no submissions regarding the causal relationship between the reasons given in the statement of grounds of appeal and the asserted invalidity of the findings of the decision impugned. If no causal relationship were required, any submission, even one not connected with the reasons on which the decision impugned is based, would be acceptable. This would render the provisions of Art. 108 EPC moot. Whilst the grounds do not have to be conclusive in themselves, i.e. justify the setting aside of the decision impugned, they must enable the board to assess whether or not the decision is incorrect. The appeal was rejected as inadmissible.

In **T 395/12** the appeal was also held inadmissible; the applicant's only statement that directly addressed the decision under appeal was that the examining division was "wrong", with no explanation why. Decisions **T 213/85** (OJ 1987, 482) and **T 95/10** clarify that the appeal procedure is not a mere continuation of the examination procedure (in accordance with decisions **G 10/91**, OJ 1993, 420; **G 9/92**, OJ 1994, 875 and **G 4/93**, OJ 1994, 875), but separate therefrom. Where the applicant in the grounds of appeal repeats its arguments set out during the examination phase without taking into account

the decision under appeal, it mistakes the function of the boards of appeal; they are not a second go at the examination procedure, but are meant to review decisions made by the examining divisions, based on the objections raised against the decision in the grounds of appeal, which must therefore relate to the reasons on which the decision under appeal is based. The appeal had also to be considered inadmissible because the grounds failed to deal with all the reasons the examination division advanced for refusing the application. According to **T 213/85** and **T 1045/02**, the grounds of appeal must deal with all those reasons on which the decision under appeal is based. This is consistent with the requirement of Art. 12(2) RPBA, according to which, "The statement of grounds of appeal and the reply shall contain a party's complete case". See also **T 473/09**, where the appeal was also held inadmissible as the grounds failed to deal with all the reasons for refusing the application.

In **T 2532/11** the appeal was found inadmissible as the appellant's statement of grounds did not contain any reference to the impugned decision, let alone any explanation as to why it was wrong and should be set aside.

In **T 220/83** (OJ 1986, 249) the board ruled that the grounds for appeal should specify the legal or factual reasons on which the case for setting aside the decision was based. The arguments had to be clearly and concisely presented to enable the board and the other party or parties to understand immediately why the decision was alleged to be incorrect, and on what facts the appellant based his arguments, without first having to make investigations of their own. Whilst passages from the literature setting out the state of the art might - provided sufficiently precise reference was made to them in the grounds of appeal - be considered an integral part of the grounds, they could not by themselves form a sufficient statement of grounds. This principle was expressly confirmed in many decisions, for example **T 250/89** (OJ 1992, 355), **T 1/88**, **T 145/88** (OJ 1991, 251), **T 102/91**, **T 706/91**, **T 493/95**, **T 283/97**, **T 500/97**, **T 1045/02**, **T 809/06**, **T 2346/10**, **T 294/11** and **T 2001/14** (see also **T 12/00**, where the case was contrasted with **T 220/83** and found to differ on the facts).

In **T 22/88** (OJ 1993, 143), the board held that a written statement announcing only that the appellant would complete an omitted act (here the filing of the translations of the revised claims) did not comprise sufficient reasons, and therefore did not constitute a valid statement of the grounds of appeal.

Where, as a result of contradictions and inexactitudes in an anyway very brief statement of grounds, it is left to the board to make sense of it, the appeal is usually inadmissible (**T 760/08**).

b) Grounds to be analysed vis-à-vis reasons in decision

In **T 213/85** (OJ 1987, 482) the board stated that grounds sufficient for the admissibility of an appeal had to be analysed in detail vis-à-vis the main reasons given for the contested decision. If an opposition had been dismissed on the grounds of insufficient substantiation and the grounds for appeal merely disputed patentability without elaborating on the admissibility of the opposition, the appeal was inadmissible for lack of

adequate substantiation (see also **T 169/89**, **T 2001/14**). According to the board in **T 95/10**, there were three reasons for this:

- First, the appeal procedure is not a continuation of the opposition procedure, but a distinct procedure in which any facts, evidence or arguments considered relevant must, if need be, be resubmitted (see **G 10/91**, OJ 1993, 420; **G 9/92** and **G 4/93**, both in OJ 1994, 875).

- Second, the appellant's analysis of the contested decision is needed in its statement of grounds of appeal because the legal dialogue between the board of appeal, the appellant and the respondent which is being sought on appeal can take place only if the appellant has at least addressed those reasons for the contested decision which it considers incorrect.

- The third reason is that, in the absence of such an analysis, neither the board of appeal nor the respondent can establish why the appellant regards the contested decision as incorrect. It is, however, only based on this knowledge that the respondent can counter the appellant's arguments and that the board is in a position to reach an objective decision. This does not apply if the opposition division's decision itself failed to analyse the facts and arguments submitted by the appellant during the opposition proceedings (see also **T 1188/08**; **T 720/12**)

In **T 501/09** the board was aware that other boards of appeal had found that an appeal based entirely on new evidence may be admissible when the grounds for opposition have remained the same (see **T 1557/05**). The board pointed out that the purpose of the inter partes appeal procedure is mainly to give the losing party a possibility to challenge the decision of the opposition division on its merits. The appeal proceedings are thus largely determined by the factual and legal scope of the preceding opposition proceedings (see **G 9/91** and **G 10/91**, OJ 1993, 408 and 420), and the parties have limited scope to amend the subject of the dispute on appeal. This is reflected in Art. 12(4) RPBA. The board did not admit the fresh evidence, concluded that the appeal was not substantiated and rejected it as inadmissible.

Similarly, in **T 727/09** there was an entirely new set of facts, albeit based on the same ground for opposition. The board noted that if the statement of grounds of appeal is exclusively based on these new documents, there must be a direct and clear link between the contested decision and the grounds for appeal. In the case at issue, the factual basis was, however, entirely new. The appeal was rejected as inadmissible.

Where there had been several independent reasons for the decision to refuse the application and at least one of those reasons was not addressed in the statement of grounds at all or only in insufficient detail, the board could not normally reverse the contested decision, even if it concurred with the appellant in relation to all the reasons for refusal addressed in the statement of grounds. The request of Art. 108, R. 99(2) EPC were not met (**T 899/13**).

However, the case underlying **T 395/13** was different. Although the statement of grounds of appeal contained no substantive arguments addressing the reasoning of the decision under appeal, it nonetheless met the requirements of Art. 108 EPC in combination with R. 99(2) EPC. This was because the main objection of the appellant in the grounds of appeal was that the decision under appeal did not contain sufficient reasoning to enable the appellant to file such arguments. The grounds of appeal contained reasoning as to why the appellant considered the decision under appeal to be deficient in this manner, and hence why that decision should be set aside. R. 99(2) EPC required no more than this and in particular did not specifically require that the statement of grounds of appeal addresses the arguments in the decision under appeal. The board therefore concluded that the appeal was admissible.

In **T 1/88** the board considered that the criteria of **T 220/83** and **T 213/85** were satisfied by a statement of grounds in which it was merely argued by the appellant that a document, which allegedly showed that the process of the patent in suit was obvious, had not been properly evaluated. The question of inventive step, on the lack of which the contested decision had been partly based, was not dealt with in detail. However, as was pointed out in **T 349/09**, where the appeal was found inadmissible for lack of substantiation, the appeal in **T 1/88**, for all its substantiation was minimal, did attack the decision under appeal.

In **T 950/99**, the statement setting out the grounds of appeal included the legal and factual reasons why the decision under appeal should be set aside with respect to at least one ground, namely lack of inventive step. Therefore, even if it did not contain a full reasoning with respect to each and every ground, it nevertheless met the minimum requirement of Art. 108 EPC (referring to **J 22/86**, OJ 1987, 280). In **T 808/01**, the board held that, where the statement of grounds contained several lines of argument and reasons sufficient to render the appeal admissible had been given in support of at least one of them, the appeal was admissible and it did not matter that no such reasoning had been given in support of one of others.

In **T 846/01**, the board held that, for an appeal to be admissible, at least one of the grounds in the written statement of grounds of appeal must relate to a point which could at least arguably have been decided in the appellant's favour by the instance appealed from but which point had not been so decided, and such favourable decision on this point would have produced a different outcome. Following **T 846/01**, the board in **T 1178/04** confirmed that an appeal does not lie against part of a decision of a first instance tribunal if the result would have been the same even if the point had been decided in the appellant's favour.

However, according to the board in **T 1045/02**, a statement of grounds failed to meet the minimum requirements if it dealt with only one of several grounds for refusal. Similarly, in **T 1187/04**, where the appellant had dealt only with the novelty objections and not addressed inventive step, the appeal was held inadmissible.

See also **T 922/05** in Chapter IV.E.2.6.3 c) "Duty of board to be impartial", below.

In **T 760/08**, the appellant had left it to the board to clarify inconsistencies, define the state of the art and consider which of the two features in the characterising portion, either by itself or in combination, the appellant regarded as apt to establish novelty and patentability. In support of its submissions as to the requirements to be met by the statement of grounds, the appellant had cited several decisions, including **T 563/91**, **T 729/90** and **T 162/97**. While those decisions tended to support the appellant's position, they could be countered by a series of other decisions, not cited by it, which set more stringent requirements, above all **T 220/83** (OJ 1986, 249) and **T 1045/02**. On this point, the board had already stated in **T 922/05** that, in its view, the principles set out in Art. 12(2) RPBA, as a generalisation of the relevant case law, which was not entirely consistent and had mostly resulted from the specific circumstances of the individual cases concerned, served as a suitable standard for assessing the admissibility of an appeal. The statement of grounds in question did not meet the standard set by those principles.

In **T 733/98**, where an application was refused under Art. 97 EPC 1973 and R. 51(5) EPC 1973, on the grounds that the applicant neither communicated his approval of the text proposed for grant within the period according to R. 51(4) EPC 1973 nor proposed amendments within the meaning of R. 51(5) EPC 1973 within this period, the statement of the grounds of appeal was inadmissible, as it dealt only with the issues of the admissibility and allowability of new claims filed with the statement of grounds.

c) Duty of board to be impartial

The case law of the boards of appeal was reviewed in **T 922/05** and much of it found to take a relatively lenient position in the sense that the appeals were deemed to be admissible if the competent board was able to infer from the particulars of the case the presumed intentions of the applicant and the probable reasons underlying its actions (see **T 563/91**, **T 574/91**, **T 162/97**, **T 729/90**). However, excessive leniency towards one party would rightly be perceived as an injustice towards the other. The board was of the opinion that submissions of a party which only made it possible for a board to **infer** a line of argumentation did not fulfil the requirements of either the "**clear** reasons" or the "**express** specification of facts and arguments" as prescribed by the RPBA. The statement of the grounds of appeal filed by the appellant remained silent on at least two issues, which would have been clearly relevant for deciding on the appeal, and therefore should have been addressed by the grounds of appeal in order to be complete. The silence of the appellant on these issues was seen by the board as a serious defect of the appeal. This was not changed by the fact that both issues could have been easily dispensed with in just a few sentences, without lengthy argumentation. The appeal was rejected as inadmissible (see also e.g. **T 760/08**, **T 727/09**, **T 450/13**, **T 460/13**).

In **T 450/13** the board pointed out that the statement of grounds of appeal was not sufficiently substantiated with regard to the alleged public prior use attacks. A reference back to first instance proceedings was not a sufficient reasoning to render a submission in the statement of grounds of appeal admissible (see **T 473/09**). The submissions in the statement of grounds of appeal had to be such as to enable the board (and any other party) to understand immediately why the decision was alleged to be incorrect, without

first having to make investigations on its own. To ask the board to do this would mean that the board had to make up the appellant's case in breach of the principle of impartiality (see also **T 1676/08**).

#### 2.6.4 References

##### a) References to earlier submissions

The boards have frequently held that a statement of grounds referring generally to submissions made at first instance, as a rule, cannot be considered sufficient for the purposes of Art. 108, third sentence, EPC (see e.g. **T 254/88**, **T 432/88**, **T 534/89**, **T 90/90**, **T 154/90**, OJ 1993, 505; **T 287/90**, **T 188/92**, **T 646/92**, **T 473/09**, **T 450/13**).

In **T 432/88** the appeal filed only made a general reference to the appellant's submissions in the preceding opposition proceedings and thus amounted to no more than a mere assertion that the contested decision was incorrect, without stating the legal or factual reasons why that decision should be set aside. Consequently, the appellant had left it entirely to the board and the respondent to conjecture in what respect the appellant might consider the decision under appeal to be defective. This was just what the requirement that grounds for appeal be filed is designed to prevent. This was followed in **T 534/89**, where the board pointed out that otherwise the respondent is at a loss to know how to prepare his case and the board cannot direct the appeal proceedings in an efficient way.

Merely referring to one's own first-instance submissions could not normally replace an explicit account of the legal and factual reasons for the appeal. Only exceptionally did the case law allow substantiation to take that form. References to earlier submissions, even when taken together with the contested decision, did not as a rule clearly indicate which grounds of the decision were regarded as mistaken, and why. The board and the opposing party could not then consider the merits of the appeal without making investigations of their own (**T 349/00**). See also **T 165/00**, where the case law was reviewed. Here the board could not share the appellant's view that reference on appeal to pleadings filed at the preceding instance had to be interpreted as a fresh filing of those pleadings and that the statement of grounds therefore had to be regarded as adequately reasoned. This ran counter to the rule highlighted in the boards' case law that grounds of appeal should state the legal and factual reasons why the appeal should be allowed and the contested decision set aside and that it was not enough merely to seek fresh examination of the patentability requirement found not to be met at the previous instance by indicating disagreement with that finding (see **T 220/83**, OJ 1986, 249; **T 213/85**, OJ 1987, 482; **T 145/88**, OJ 1991, 251; **T 1462/08**; **T 2077/11**).

In a small number of isolated decisions, however, the boards have accepted a general reference to submissions at first instance as potentially constituting grounds for an admissible appeal (**T 355/86**, **T 140/88**, **T 216/10**), but these decisions were given in special cases in which those submissions already adequately addressed the grounds underlying the contested decision.

In **T 725/89**, submissions filed with the opposition division before despatch of the contested decision and commenting on the outcome of the oral proceedings directly preceding the decision were deemed to constitute admissible grounds for appeal, even though the actual statement of grounds referred to them only generally.

b) References to other documents

In **T 869/91**, the statement of grounds referred only generally to certain documents, but as the board could gather from further arguments in the statement what the appellant sought to assert on the basis of those documents, it was considered admissible.

Precisely cited passages from the relevant literature become an integral part of the grounds but cannot by themselves form a sufficient statement of grounds (**T 1402/10**, citing **T 922/05**).

#### 2.6.5 New case raised

a) By opponent (appellant)

An appeal unconnected with the reasons given in the appealed decision (lack of inventive step) and directed only to a new ground for opposition (lack of novelty) based on a new document is contrary to the principles laid down in decisions **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), according to which an appeal should be within the same legal and factual framework as the opposition proceedings. It is tantamount to a new opposition and is thus inadmissible (**T 1007/95**, OJ 1999, 733).

However, under Art. 106(1) EPC 1973, appeals lie from decisions rather than from the grounds of such decisions. Apart from other deficiencies, an appeal raising a case entirely different from that on which the decision under appeal was based is still admissible if it is based on the **same** opposition ground (**T 611/90**, OJ 1993, 50, where the opponent, on appealing the finding of the opposition division that the patent was novel and inventive, went on to develop what was in effect an entirely fresh case on lack of novelty). Similarly, the appeal was found admissible in **T 938/91**, where the opponent (appellant) introduced a new alleged public prior use and citation; although a "fresh case" was presented by the appellant to the board, the fresh reasons still fell within the same ground for opposition.

Other decisions where the appeal was found admissible where the opponent (appellant) introduced a fresh case on appeal concerning the same ground for opposition include **T 3/92**, **T 219/92**, **T 229/92**, **T 847/93**, **T 708/95** and **T 191/96**.

In **T 219/92**, although the statement of grounds did not address the reasons given in the contested decision for rejecting the opposition (under Art. 100(a) EPC) as inadequately substantiated, but sought to support that opposition with "better" material. The board pointed out that this could not alter the fact that the admissibility requirements, including indication of an adverse effect and the requisite identification of the extent of the request

(R. 64(b) EPC 1973), were met. In line with the boards' case law, it therefore held that there was no reason to consider the appeal inadmissible.

Following **T 611/90**, the board in **T 252/95** held that grounds within the meaning of Art. 108 EPC 1973 could be deemed to be sufficient if new facts were submitted which removed the legal basis from the decision. That also applied where the grounds for opposition were based on new facts and there was no discussion whatsoever of the grounds for the opposition division's decision. In **T 801/00** the board also found that an admissible appeal can be entirely based on new facts. The arguments presented by the appellant in respect of the new citations were sufficiently clear to enable the board and the other party to understand immediately why the attacked decision was alleged to be incorrect and to which extent it should be cancelled.

According to the case law of the boards of appeal of the EPO (see e.g. decisions **T 389/95**; **T 1063/98**, **T 1029/05**, **T 1915/09**, **T 1314/12**), an appeal invoking a ground for opposition already invoked in opposition proceedings, i.e. remaining within the same legal framework, albeit being based on a completely fresh factual framework does not ipso facto lead to an inadmissible appeal. However, this finding does not necessarily mean that the new items of evidence only filed during the appeal procedure may not be disregarded by the board pursuant to Art. 114(2) EPC (see e.g. **T 389/95**).

In **T 389/95** an appeal was filed on existing grounds for opposition but based solely on new evidence introduced in the grounds of appeal. The board found the appeal to be admissible because the issue of new factual framework was one of fact to be determined objectively as part of the substantive examination of the appeal. Opinion **G 10/91** allowed even a fresh legal ground for opposition to be considered in appeal proceedings if the patentee approved and it followed from this, that an appeal based solely on such a ground was not ipso facto inadmissible; by the same token an appeal based on the same legal ground, albeit on a completely fresh factual framework, might be admissible. See also **T 932/99**. According to **T 1029/05**, it was the consistent jurisdiction of the boards of appeal that an appeal was not to be considered inadmissible merely because it was based on evidence submitted for the first time with the grounds for appeal. See also **T 1082/05**.

In **T 27/13** the board held that the objection under Art. 83 EPC in the statement of grounds constituted a fresh ground for opposition under Art. 100(b) EPC that was outside the legal framework of the opposition proceedings. **T 389/95** as cited in **T 1007/95** found in an obiter dictum that it followed from **G 10/91** – which allowed even fresh grounds for opposition to be considered in appeal proceedings if the patentee approved – that an appeal based solely on such grounds was not ipso facto inadmissible. However, in the light of **G 10/91**'s observations on the legal character of opposition and opposition appeal proceedings and the particular importance it attached to grounds for opposition in that they established the legal framework within which substantive examination of the opposition was in principle to be conducted, the board did point out that it could find the present appeal admissible only if the same ground for opposition was raised when the appeal was filed. Only then could there be any discussion of the possibility of introducing a fresh, additional ground for opposition. The



board therefore took the view that the above-mentioned finding in **T 389/95** lacked any basis in **G 10/91**, such that it was not applicable to cases like the present in which the appeal was based solely on an entirely new ground for opposition. As this finding had not been reflected in subsequent relevant case law even though **T 389/95** had been cited quite frequently, the board regarded it as an isolated decision in this respect that should not be followed, and it followed **T 1007/95** instead. Hence the appeal was inadmissible.

b) By patent proprietor or applicant and appellant

An appeal by the patent proprietor is to be considered as sufficiently substantiated to satisfy the requirements of Art. 108 EPC, third sentence, even if it does not state any specific reason why the decision is contested, provided that two criteria are met:

- there is a change in the subject of the proceedings due to the filing of amended claims together with the statement setting out the grounds of appeal,

- the reasons for the decision are no longer relevant in view of the amended claims (see e.g. **T 105/87**, **T 563/91**, **T 717/01**, **T 934/02**, **T 655/03** and **T 1708/08**).

The board in **T 934/02** added that it was therefore not necessary and would also be pointless for the purposes of adequately substantiating an appeal, to file grounds in support of a version of a claim that the appellant (patent proprietor) was no longer defending in the appeal proceedings. See also **T 1197/03** and **T 642/05**. However, where the application was not refused on the basis that the previous set of claims on file could not be allowed, i.e. for lack of clarity, novelty or inventive step, rather on the ground that there was no agreed set of claims, filing new claims was not an adequate response (**T 573/09**); the statement of grounds should have set out why the appellant should be given the opportunity to have the proceedings continued before the board.

If an appellant desires that the allowability of alternative sets of claims should be considered in an appeal, such alternative claims should normally be filed with the statement of grounds of appeal or as soon as possible thereafter (**T 153/85**, OJ 1988, 1).

In line with the case law, the board in **T 760/08** began by observing that grounds for appeal could be also deemed sufficient where new facts had been submitted which deprived the decision of its legal basis (**T 252/95**), particularly through the filing of new sets of claims (**T 934/02**). Appellants had two options when it came to submitting their statement of grounds: they could attack the opposition division's decision as flawed, so that, provided they made a convincing case with respect to all reasons underlying the decision and the board accepted that case, it would be able and obliged to set the decision aside on all counts.

Alternatively, they could file amended claims which they considered apt to remedy the deficiencies identified by the opposition division in the decision.

In the latter case, however, it was not enough merely to file a new set of claims without comment. Rather, appellants had to set out why and to what extent the amended set of

claims was a response to the factual and legal assessment on which the opposition division had based its decision (**T 220/83**, OJ 1986, 249; and **T 145/88**). What mattered in this connection was not the length of the statement of grounds but its substance: "The requirement of Art. 108 EPC is for a statement which sets out the substance of the Appellant's case; that is, the reasons why the appeal should be allowed and the decision under appeal should be set aside. ... a well-drafted statement of grounds of appeal should contain reasoning that is full but concise. And, in general, it is obvious that the less reasoning that a Statement contains, the greater will be the risk that the appeal will be rejected as inadmissible for non-compliance with Art. 108 EPC." (**J 22/86**, OJ 1987, 280). In **T 933/09** the board considered that the mere filing of amended claims did not exonerate the appellant from the task of expressly specifying in the statement of grounds of appeal the relevance of the amendments for overcoming the objections on which the decision under appeal was based. The appeal was rejected as inadmissible.

**T 2453/09** also confirmed that it is established case law (see e.g. **T 760/08**) that an appeal can be based on new amended claims in so far as the amendments are intended to address the grounds of the impugned decision. See also **T 1538/09**. However, the mere fact of filing amended claims with the statement of grounds of appeal is not sufficient if it does not overcome the reasons for the refusal in the case at issue.

The appellant in **T 1707/07** did not address the reasons given in the decision under appeal and it was thus not clear to the board why the decision under appeal was alleged to be incorrect. The appeal was rejected as inadmissible. See also **T 502/02** and **T 132/03**.

In **T 23/03** the factual basis of the contested decision remained unchanged and the amendments made to the claims filed with the statement of grounds of appeal did not add anything which implicitly could clarify as to why the appellant might be of the opinion that the contested decision no longer applied to the new dependent claims. The appeal was therefore inadmissible.

In **T 295/04**, the statement of grounds contained only a general reference to pleadings submitted during the proceedings at first instance and a set of new claims. Since such a general reference could not be regarded as setting out why the department of first instance's decision should be amended, the appeal was dismissed as inadmissible.

In **T 257/03**, since all the board could gather from the statement of grounds was that the appellant sought the reopening of the entire opposition proceedings, but not why it considered that the opposition division's decision should be amended, it dismissed the appeal as inadmissible.

In **T 1276/05** the patent proprietor/appellant reverted back to a form of claim which had been effectively withdrawn during the opposition proceedings, i.e. the patent as granted, without explaining why the contested decision was wrong. The board noted that the lack of a need for explanation was based on the specific situation of the case before it, wherein - unusually - the offered amendments self-evidently overcame the grounds for the decision and the appeal was thus admissible.

In **T 2532/11** the question also arose whether newly filed requests could be seen as implicit grounds of appeal. A statement of grounds of appeal supported by amended claims may define, at least implicitly, the extent to which the appellant wishes the decision under appeal to be set aside. Many decisions have adopted a lenient position and deemed appeals admissible if the competent board was able to infer from the particulars of the case the presumed intentions of the appellant and the probable reasons underlying its actions (**T 729/90**, **T 563/91**, **T 574/91**, **T 162/97**). Appeals have also been held admissible where there was a change in the subject of the proceedings due to the filing of new claims together with the statement of grounds and the latter set out in detail why the raised grounds for opposition did not prejudice the maintenance of the patent as amended on the basis of these new claims (**T 717/01**, **T 934/02** referring to **J xx/87** (= **J 902/87**), OJ 1988, 323 and **T 105/87**). According to the board, the purpose of the statement of grounds, together with the notice of appeal is to define the scope of the appeal. This definition lies within the discretion of the appellants as a part of the principle of free disposition. Without prejudice to the provisions of Art. 114 EPC, which are of limited application in opposition proceedings, the board of appeal has the duty to assess whether the appeal is well-founded within the frame of the case as presented by the appellants but it cannot guess what the arguments are, let alone, provide arguments in lieu of the appellants. Conversely, the principle of free disposition does not extend such that it should allow the appellants to build a new case, so as to render the decision under appeal purposeless. A direct link must be maintained between the decision under appeal and the statement of grounds of appeal.

#### 2.6.6 Arguments need not be new or relevant

In **T 3/95** the board found that the fact that the points made in the statement of grounds of appeal did not go beyond those made before the opposition division did not detract from the admissibility of an appeal. A requirement that new arguments be submitted to render an appeal admissible would have implied that the appealed decision must have been correct. Nor did the appeal need to have a strong prospect of success.

Irrelevancy and lack of cogency might lead to an unsuccessful outcome of the appeal, but did not of themselves render it inadmissible (**T 65/96**). See also **T 922/05**.

#### 2.6.7 Subsequent withdrawal of relevant objection

The subsequent withdrawal of a relevant objection already substantiated in the statement of grounds of appeal could not retrospectively detract from the admissibility of the appeal as filed (**T 644/97**).

#### 2.6.8 Exceptional circumstances warranting admissibility of appeal

##### a) Immediately apparent the contested decision cannot be supported

In **J 22/86** (OJ 1987, 280) the board made it clear that where the written statement did not contain such full reasons, the requirement for admissibility might be regarded as satisfied if it was immediately apparent upon reading the decision under appeal and the

written statement that the decision should be set aside. According to the board, a well-drafted statement of grounds should contain reasoning that is full but concise. And, in general, it is obvious that the less reasoning that a statement contains, the greater will be the risk that the appeal will be rejected as inadmissible for non-compliance with Art. 108 EPC. The question whether a particular statement alleged to be a statement of grounds of appeal in a particular case meets the minimum requirement of Art. 108 EPC could only be decided in the context of that particular case; and the context of a particular case will normally include the contents of the decision under appeal. In a wholly exceptional case such as the one before the board, it might be immediately apparent to the board upon reading the decision under appeal and the statement of grounds that such decision cannot properly be supported, even though the grounds contained in such statement can fairly be described as minimal. See also **J 2/87** (OJ 1988, 330), **J 6/88**, **T 195/90**, **T 729/90** and **J 1/14**.

b) Patent proprietor requests revocation

An opponent's appeal is admissible when the written statement of grounds is based solely on the fact that the patent proprietor himself filed the request for revocation of the patent after the appeal was filed (**T 459/88**, OJ 1990, 425 and **T 961/93**).

c) Substantial procedural violation

In **T 1020/13** the board held that, if a substantial procedural violation is alleged and adequately substantiated in the statement of grounds of appeal, it is irrelevant for the decision on admissibility of the appeal whether the challenge to the substantive reasons for the decision can likewise be regarded as adequately substantiated.

#### 2.6.9 No partial admissibility of appeal

The admissibility of an appeal can only be assessed as a whole (**T 382/96**, **T 1763/06**, **T 509/07**, **T 2001/14**). There is no support in the EPC for a notion of 'partial admissibility' of an appeal (**T 774/97**, **T 509/07**). The board in **T 509/07** thus found it immaterial for the purposes of the admissibility of the appeal whether or not sufficient grounds relating to the main request had been submitted, where the first auxiliary request clearly complied with the admissibility requirements of Art. 108, third sentence, EPC - where these requirements are fulfilled at least in respect of one request, the appeal as a whole will be admissible. However, it is a different question whether a request in relation to which the admissibility requirements of Art. 108, third sentence, EPC are not met is admitted into the appeal proceedings. In **T 382/96** and **T 509/07**, such unsubstantiated requests were not admitted. See also **T 1763/06** and **T 2001/14**.

#### 2.7. Admissibility of appeal to be checked in every phase of appeal proceedings

The admissibility of the opposition must be checked ex officio in every phase of the opposition and ensuing appeal proceedings. It can and, where appropriate, must be raised by the board in appeal proceedings even if this is the first time this matter is addressed (**T 289/91**, OJ 1994, 649; **T 28/93** and **T 522/94**, OJ 1998, 421).

The board in **T 15/01** (OJ 2006, 153) held that the same principles applied a fortiori to the examination of the admissibility of an appeal. The appellant's procedural objection against the late introduction of the issue at a rather late stage of the appeal proceedings could not therefore succeed; admissibility issues can and have to be examined at every stage of the appeal procedure. The admissibility of an appeal had been called into question with the argument that the appeal was filed on behalf of a legal entity which had already ceased to exist due to a merger.

This was confirmed in **T 1668/07**, where the board therefore had to consider the respondent's new main request that the appeal be deemed inadmissible, although it was filed long after the periods for filing an appeal had expired and after oral proceedings had been arranged.

In **T 670/09**, the respondent did not challenge the appeal's admissibility until two days before the oral proceedings. The board observed that, under Art. 12(2) RPBA, the reply to an appeal had to contain the respondent's entire case. As a rule, respondents had to object to the appeal's admissibility or the board's competence in limine litis, i.e. before submitting their substantive defence. The respondent's objection to admissibility was therefore disregarded.

## **2.8. Cases where admissibility of appeal need not be considered**

In appeal proceedings in which the question of allowability of an appeal can be readily decided (i.e. the appeal is clearly unallowable) but no decision on its admissibility can be taken yet, the issue of admissibility of the appeal can be left open. Similarly, in a number of decision on petitions for review under Art. 112a EPC, the Enlarged Board of Appeal did not arrive at a final conclusion as to whether the petition in question was clearly inadmissible, because it found the petition to be clearly unallowable (**T 1467/11** and **T 2023/09**).

## **2.9. Interlocutory revision**

Under Art. 109(1) EPC, in **ex-parte** proceedings the department whose decision is contested must rectify its decision if it considers the appeal to be admissible and well-founded. Inter-partes proceedings are excluded from rectification. However, this does not prevent the department of first instance rectifying its decision where it erroneously revokes, on grounds of non-compliance, a patent it had decided to maintain in amended form (see **T 168/03**). On expiry of the three-month period under Art. 109(2) EPC 1973, the department of first instance whose decision is contested ceases to be responsible for the matter. Rectification of the decision is then no longer possible (**T 778/06**).

Art. 109(1) EPC provides an exception to the principle of general devolutive effect of the appeal, in order to allow an interlocutory revision. This exception has to be construed narrowly in connection with the interlocutory revision, and not as a broader entitlement for the department of first instance to decide whether an appeal is admissible (**T 1973/09**) (see also **T 473/91**, OJ 1993, 630, **T 808/03**).

In **T 638/01** a form was wrongly filled in and the appeal was sent by the formalities officer acting for the opposition division directly to the boards of appeal, bypassing the procedural step prescribed by Art. 109(1) EPC, viz. consideration for interlocutory revision. The board pointed out that since the granting of interlocutory revision in an appropriate case is **mandatory**, it followed a fortiori that considering a case for interlocutory revision in circumstances where the latter is possible is itself a **mandatory procedural step**. Since, however, the legislative purpose of Art. 109 EPC is overall procedural economy, it made no sense for the board to remit the case to the department of first instance for performance of this omitted step.

### 2.9.1 General

In case **T 139/87** (OJ 1990, 68) the board of appeal made it clear that an appeal by an applicant for a European patent was to be considered well-founded within the meaning of Art. 109(1) EPC 1973 if the main request of the appeal included amendments which clearly met the objections on which the refusal of the application had been based as indicated by the examining division. In such a case, the department that issued the contested decision **must** rectify the decision. Irregularities other than those that gave rise to the contested decision do not preclude rectification of the decision (see also **T 47/90**, OJ 1991, 486; **T 690/90**, **T 1042/92**, **T 1097/92**, **T 219/93**, **T 647/93**, OJ 1995, 132; **T 648/94**, **T 180/95**, **T 794/95**). However, in **T 615/95**, where the examining division considered that interlocutory revision would only be possible on condition several objections were overcome and these objections were unrelated to the refusal and clearly had no link at all to the decision under appeal, the board held that such an approach had no legal basis.

According to **T 1060/13** it is established case law of the boards of appeal that, in the event that the appeal is objectively to be considered as admissible and well-founded, the department of first instance is obliged to grant interlocutory revision (**T 139/87**, OJ 1990, 68; **T 180/95**; **T 2528/12**, **T 1362/13**); there is no room for discretion in the interests of procedural efficiency (**G 3/03**, OJ 2005, 344; **J 32/95**, OJ 1999, 713; **T 919/95**). An appeal is to be considered "well-founded" if at least the main request submitted with the appeal includes amendments which clearly meet the objections on which the decision relies, such that the department of the first instance could reasonably be expected to recognise this and thus rectify its decision. That there are other objections which have not been removed but which were not the subject of the contested decision cannot preclude the application of Art. 109(1) EPC 1973 (**T 139/87**; **T 47/90**, OJ 1991, 486; **T 219/93**; **T 919/95**). Thus, even if the amendments raise new objections not yet discussed, interlocutory revision must be allowed since an applicant should have the right to two instances. Objections or remarks made in an obiter dictum of a decision under appeal cannot be taken into account (see e.g. **T 1640/06** and **T 726/10**; the board disagreed with **T 1034/11**). Refusing interlocutory revision in the case of an admissible and well-founded appeal constitutes a breach of the duty to grant interlocutory revision in such a case and thus a breach of the principle of procedural efficiency (contrary to the finding in **T 704/05**) and cannot be regarded as a substantial procedural violation within the meaning of R. 103 EPC (see e.g. **T 794/95**).

In **T 473/91** (OJ 1993, 630) the board made it clear that the admissibility question under Art. 109 EPC 1973 fell under the jurisdiction of the department of first instance only when this question could be decided immediately on the basis of the appeal submissions themselves. Consequently, the appellate instance had exclusive jurisdiction over a request for restitutio in integrum into a time limit relating to the appeal itself.

In **T 919/95** the appellant was of the opinion that an interlocutory revision had to result in the appeal being allowed. A "cassatory" revision that merely set aside the contested decision and resumed the suspended proceedings was not compatible with the EPC. The interlocutory revision had to be a 'reformatory' revision, i.e. one that conferred on the appellant something that the contested decision deprived him of. The board stated that the requirements of Art. 109 EPC 1973 were met if the reason for the contested decision were removed as a result of an admissible appeal; once the contested decision had been set aside the requested decision could be taken, or the proceedings could be resumed, since further examination was required of new grounds or facts. The latter did not rule out a subsequent refusal. The purpose of interlocutory revision was to speed up the procedure. If an examining division rectified a decision under Art. 109 EPC 1973 merely in order to grant a patent according to an auxiliary request, even though the applicant insisted on his main request, the procedure was not thereby accelerated but slowed down and this would constitute a substantial procedural violation (see also **T 142/96**).

#### 2.9.2 Reimbursement of appeal fee

For further details, see Chapter IV.E.8 "Reimbursement of appeal fees".

Under Art. 109(2) EPC 1973 a case had to be remitted to the boards of appeal without delay and without comments as to its merits if the decision under appeal was not rectified within a specified time after receipt of the statement of grounds of the appeal. Therefore, if further separate issues - such as the reimbursement of the appeal fee - arose out of the appeal, the department in charge of the case was obliged under Art. 109(2) EPC 1973 to take a separate decision on rectification before the end of this time limit as soon as it realised that a decision on any further issue could not be taken within that period (**T 939/95**, OJ 1998, 481). The time limit is currently three months.

Under R. 103(1)(b) EPC, the appeal fee shall be reimbursed if the appeal is withdrawn before the filing of the statement of grounds and before the period for filing that statement has expired. This is intended to go some way towards compensating for the lack of a cross-appeal facility - appeals filed as a precaution in case the other party appeals may be withdrawn if the other party does not file an appeal.

### 3. Substantive examination of the appeal

#### 3.1. Binding effect of requests - no reformatio in peius

The question of law referred to the Enlarged Board of Appeal in **G 9/92** and **G 4/93** (both OJ 1994, 875) asked whether and to what extent a board of appeal could depart from the

request formulated in the notice of appeal when deciding opposition appeal proceedings, to the disadvantage of the appellant.

The Enlarged Board took several factors into account. The aim of the appeal was to eliminate an 'adverse effect'. As the filing of an appeal was subject to a time limit, it would not be consistent to allow non-appealing parties the unrestricted right to alter the extent of the proceedings by submitting their own requests without limitation of time. A non-appealing party as a respondent had the opportunity to make what it considered to be appropriate and necessary submissions in the appeal proceedings to defend the result obtained before the department of first instance.

The Enlarged Board thus concluded that:

1. If the **patentee** was **sole appellant** against an interlocutory decision maintaining his patent in amended form, neither the board of appeal nor the non-appealing opponent (as party to the proceedings as of right under Art. 107, second sentence, EPC 1973) could challenge maintenance of the patent as thus amended.
2. If the **opponent** was **sole appellant** against an interlocutory decision by an opposition division maintaining the patent in amended form, the patentee was primarily restricted in the appeal proceedings to defending the patent as thus maintained. Amendments proposed by the patentee (as party to the proceedings as of right under Art. 107 EPC 1973, second sentence) could be rejected by the board as inadmissible if they were neither appropriate nor necessary (see e.g. **T 321/93**).

As legal uncertainty was created by the fact that the case law of the boards of appeal has not been uniform as regards the principle of prohibition of reformatio in peius when applying or interpreting decision **G 9/92** (OJ 1994, 875), a further question was referred to the Enlarged Board, which was answered in **G 1/99** (OJ 2001, 381). See in this chapter IV.E.3.1.8.

### 3.1.1 Reformatio in peius does not apply separately to each point

According to the established case law of the boards of appeal, the doctrine of prohibition of reformatio in peius cannot be construed to apply separately to each point or issue decided, or the reasoning leading to the impugned decision (see e.g. **T 149/02**, headnote). If an appeal is lodged against an adverse decision of the department of first instance about the main request, then "the whole request is before the board of appeal and within its jurisdiction", and "the board is empowered to reopen and to decide upon matters which have been an issue before the opposition division" (see **T 327/92**, **T 401/95**, **T 583/95**, **T 576/12**).

### 3.1.2 Reformatio in peius and devolutive effect of appeal

In **T 149/02** the board stated that the two general principles of procedure - prohibition of reformatio in peius and the devolutive effect of the appeal, which conferred on the board



the power to consider its subject-matter - were complementary and had to be implemented in such a way that they did not exclude each other.

### 3.1.3 Cases where reformatio in peius does not apply

In **T 1178/04** (OJ 2008, 80) the board held that where the issue was a person's right to be a party, the principle of no reformatio in peius was of no application, bearing in mind the fact that the principle of no reformatio in peius was taken mainly from the well-established principle in German law ("Verschlechterungsverbot"). This principle has no application in those cases where (a) there exist procedural preconditions for making relevant requests to the court ("Verfahrensvoraussetzungen") and (b) these preconditions are of a kind that cannot be waived or dispensed with ("unverzichtbare Verfahrensvoraussetzungen"), such that the court must itself be satisfied that they have been fulfilled. According to the board, in the context of patent proceedings such as these, preconditions of this kind included the admissibility of the opposition itself and the capacity of a person to be a party to the proceedings in the first place.

Referring to **T 1178/04**, the board in **T 384/08** found that the admissibility of the opposition is an indispensable procedural requirement for the substantive examination of the opposition submissions at every stage of the proceedings. The approach adopted in **T 898/91** (see in this chapter IV.E.2.4.3 a) "Parties to appeal proceedings") resulted in an exception to these general principles. If this approach were to be followed, a distinction with respect to the binding effect of findings of the department of first instance would have to be made between a situation where the admissibility of an opposition was accepted by the opposition division and a situation where it was not accepted. The board had difficulties in finding a legal justification for such a distinction. The board therefore had to examine the question of the transfer of status of the opponent ex officio before dealing with the substance of the case.

### 3.1.4 Exceptions to reformatio in peius to be construed narrowly

The respondent (patent proprietor) in **T 1194/06** admitted that a limitation according to the first route mentioned in the decision **G 1/99** (OJ 2001,381) (see in this chapter IV.E.3.1.h)) was possible, but argued that this would result in a substantial restriction of the scope of the claims. The board was aware of the fact that the respondent would lose part of the protection afforded by the patent as maintained by the Opposition Division. It was, however, clear from **G 1/99** that the principle of reformatio in peius had to be respected by the boards of appeal and that an exception to this principle should be construed narrowly. There was no reason to assume that the Enlarged Board of Appeal in **G 1/99** considered even a substantial limitation of the scope of protection unacceptable. Nor did **G 1/99** distinguish between different "types" of unallowable amendment. The board could thus see no reason to assume that an amendment concerning an unallowable disclaimer should be treated in any way differently than other unallowable amendments, even if the question of what was considered to be an unallowable disclaimer was clarified after the decision **G 1/99**.

### 3.1.5 Patentee as sole appellant

Applying the principles expounded in **G 9/92** and **G 4/93** (OJ 1994, 875) the board concluded in **T 856/92** that in a case where the patentee and sole appellant appealed only in respect of some of the claims held allowable in the opposition division's interlocutory decision, neither the board nor the opponent might challenge those claims not questioned by the appellant.

In **T 598/99** the board observed that the principle of *reformatio in peius* applied so as to prevent a sole appellant being put in a worse situation than he was in before he appealed. Where the patentee was the sole appellant, the principle could not serve to protect the opponent (respondent) from being put in a worse situation than he was in before the appeal (**G 9/92**, OJ 1994, 875 and **G 4/93**, OJ 1994, 875). Indeed, whenever a sole patentee was successful in his appeal against the revocation of his patent, the opponent would be in a worse position than before. The fact that the opponent was not entitled to appeal against the decision to revoke the patent was immaterial in that respect.

The board in **T 659/07** found that the applicability of the legal principle of the prohibition of *reformatio in peius* depends on the procedural status of a case, which had therefore to be examined prior to the substantive merits of a request. Where the patentee is the sole appellant, the board further held that the patent as maintained by the opposition division in its interlocutory decisions, cannot be objected to by the board, either at the request of the respondent (opponent) or *ex officio*, even if the patent as maintained would otherwise have to be revoked on the ground that a feature present in both claim 1 as granted and as maintained introduces added subject-matter contrary to Art. 123(2) EPC 1973.

### 3.1.6 Opponent as sole appellant

In **T 752/93**, **T 637/96**, and **T 1002/95** the opposition division had maintained the patent in amended form and only the opponent had appealed. The non-appealing patentee proposed amendments during the appeal proceedings. In **T 752/93** and **T 1002/95** the board found that amendments proposed by a non-appealing patentee could, according to **G 9/92** (OJ 1994, 875), be rejected as inadmissible by the board of appeal if they were neither appropriate nor necessary, i.e. had not been occasioned by the appeal. According to **T 752/93** the patentee should therefore have the opportunity to correct erroneous amendments if these were detected later in the proceedings. Similarly, in **T 637/96**, the respondent (patentee) was able to request restoration of the claim as granted, as the amendment made to it in opposition proceedings did not change its subject-matter (i.e. the claim as granted and amended meant the same thing) and was therefore unnecessary. In **T 752/93** and **T 637/96** the amendments were found not to worsen the sole appellant's position and the board thus considered them appropriate and necessary. In **T 1002/95** the board pointed out that under R. 57a EPC 1973, which came into force after decisions **G 9/92** and **G 4/93**, a patentee was entitled to make "appropriate and necessary" amendments occasioned by grounds for opposition specified in Art. 100 EPC 1973, even if the respective ground was not invoked by the opponent.

In **T 23/04** the board made it clear that the requirements of *reformatio in peius* do not imply any right of the appealing party (opponent) to dictate the form any proposed amendments may take, and certainly to prescribe a form of amendment which would be maximally disadvantageous to the patent proprietor.

In **T 1380/04** the board, referring to **G 1/99** (OJ 2001, 381), held that the deletion of a term by the patentee/respondent could not be allowed, as this would have worsened the legal position of the appellant, contrary to the prohibition of *reformatio in peius*. It was immaterial that the term had only been introduced at the suggestion of the opposition division, as this did not alter the fact that approval of this amendment was the responsibility of the proprietor.

However, if the opponent and sole appellant deliberately refrains from invoking the prohibition of *reformatio in peius* against a claim request submitted by the respondent (patentee) which extended the scope beyond that of the claims as maintained by the department of first instance, the board need not apply the principle of the prohibition of *reformatio in peius* of its own motion. Following the principle of party disposition, any right protecting an appellant against an outcome that puts it in a worse position than if it had not appealed, may be waived (**T 1544/07**).

The board observed in **T 111/10** that the exceptional possibilities for amendment foreseen by **G 1/99** in application of the principle of the prohibition of *reformatio in peius* only applied if the patent would otherwise have to be revoked, i.e. the patent proprietor (respondent) did not have any other possibility of amendment which would allow rescue of even part of the opposed patent. In the case at issue, however, such a possibility existed. Although this would have resulted in a restriction of scope, it could not be considered unduly inequitable for a patent proprietor who, not having appealed, could not from the outset expect to get more than what was already maintained by the opposition division. Decision **T 1979/11** was not relevant as an amendment restricting rather than broadening the scope was not available. Moreover, the broadening of scope was a reaction by the respondent (patentee) to an objection by the appellant (opponent) which had been raised for the first time in the statement of the grounds of appeal. The request was therefore not admitted.

### 3.1.7 Revocation of patent

The principles of **G 9/92** were applied in **T 169/93** to the situation where the patent had been revoked, not amended. The patentee appealed against the decision to revoke (for lack of inventive step). The opposition division had found the patent sufficiently disclosed and novel. The appellant submitted that these issues could not be reopened, as none of the opponents had appealed this finding, relying on decisions **G 9/91** (OJ 1993, 408), **G 10/91** (OJ 1993, 420) and **G 9/92** (OJ 1994, 875). The board disagreed, pointing out that the respondents were unable to file an appeal, not being adversely affected under Art. 107 EPC 1973, their request for revocation having been granted. Moreover, as the patent had been revoked, it was not possible for the appellant to have an even worse outcome. It was thus open to the respondents to re-argue matters which had already been at issue before the opposition division. See also **T 1341/04**, where the board further

noted that the situation arising from a decision to revoke a patent was legally different from the one in which the patent had been maintained by the opposition division in amended form, where the decision could be appealed by both patentee and opponent. It was this situation which led to the conclusion in **G 9/92** and **G 4/93** that the patent proprietor is primarily restricted during the appeal proceedings to defending the patent in the form in which it was maintained by the opposition division, in a case where the opponent is the sole appellant.

### 3.1.8 Exceptions to the rule

Limited exceptions to the rule against *reformatio in peius* exist. In **G 1/99** (OJ 2001, 381) the Enlarged Board of Appeal answered the question referred to it in **T 315/97** (OJ 1999, 554), namely, "Must an amended claim which would put the opponent and sole appellant in a worse situation than if he had not appealed - e.g. by deleting a limiting feature of the claim - be rejected?".

The Enlarged Board held that **in principle** such a claim must be rejected. However, an exception to this principle might be made where the opposition division had allowed an inadmissible amendment. In the case at issue the opposition division had done just that with the agreement of the proprietor, who was thus not adversely affected by the decision and unable to appeal. The patent proprietor (respondent) had filed during the appeal proceedings a main request including the added (and unallowable) limiting feature, and an auxiliary request deleting it (and thus widening the claim). The Enlarged Board found that the main request had to be rejected because it did not meet the requirements of the EPC. Moreover, if the principle of *reformatio in peius* were to be applied without considering the specific circumstances of the case, the auxiliary request would also have to be rejected because it would put the opponent (appellant) in a worse situation than if it had not appealed. The only possible course the board could then take would be to revoke the patent, there being no further remedy for the proprietor. The proprietor would thus definitively lose any protection as a direct consequence of an inadmissible amendment being held allowable by the opposition division. The Enlarged Board considered it inequitable for the patent proprietor not to be given a fair opportunity to mitigate the consequences of errors of judgment made by the opposition division. The patent proprietor should thus be allowed to file requests in order to overcome this deficiency, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limited the scope of the patent as amended;
- if such a limitation was not possible, for an amendment introducing one or more originally disclosed features which extended the scope of the patent as maintained, but within the limits of Art. 123(3) EPC 1973;
- finally, if such amendments were not possible, for deletion of the inadmissible amendment, but within the limits of Art. 123(3) EPC 1973, even if, as a result, the situation of the opponent was made worse.

See **T 594/97**, **T 994/97**, **T 590/98**, **T 76/99** and **T 724/99** for application of the principles enunciated in **G 1/99**.

According to **T 809/99** a non-appealing patent proprietor is primarily restricted on appeal to defending the claims as maintained by the opposition division. If these claims are not allowable, the principle of prohibition of reformatio in peius applies, i.e. an amended claim which would put the opponent and sole appellant in a worse situation than if it had not appealed must be rejected.

The board went on to say that the only exception to this principle as set out in **G 1/99** requires consideration of a particular sequence of possibilities for overcoming the deficiency presented by the claim(s). The first solution for overcoming the deficiency to be considered (an amendment introducing one or more originally disclosed limiting features which would not put the opponent (appellant) in a worse situation than it was in before it appealed) in fact concerns a limitation of the scope of the claim. Such limitation can also be achieved by deleting the alternative embodiment in the claim, which led to the deficiency.

The proprietor's argument that the limitation to only one of the two alternatives would render the scope of protection too narrow for it to be commercially interesting is not a valid reason for dismissing this solution and proceeding to the next possible solution indicated in **G 1/99**.

The board in **T 1033/08** made it clear that **G 1/99** (OJ 2001, 381) did not supersede **G 9/92** and **G 4/93** (both in OJ 1994, 875), but was complementary thereto in that it gave directions for allowing an exception to the principle of prohibition of reformatio in peius as defined in these decisions. Certain conditions had to be fulfilled. A limiting feature introduced during the opposition procedure had to be deleted. The necessity for its deletion had to be caused by the appeal. This meant that the deletion was necessary and appropriate because it was related to a ground of opposition and caused by new facts, evidence or arguments put forward by the appellant, or because of a different evaluation of the situation by the board of appeal. Without the deletion, the patent would have to be revoked. It was not possible to overcome the objection by introducing new features which limit the scope of the patent as maintained. Only if these preconditions were fulfilled, might an objection be overcome by introducing new features which extended the scope of the patent as maintained, but within the limits of Art. 123(3) EPC according to the second option of **G 1/99**.

In **T 974/10** the board emphasised that the Enlarged Board of Appeal had stated in **G 1/99** that, "... if the patent cannot be maintained **for reasons which were not raised at the first instance**, the non-appealing proprietor deserves protection for reasons of equity" (emphasis added by the board in **T 974/10**). As, in the case at issue, the clarity objection was raised by the board for the first time in the appeal, the respondent had to be allowed to file amendments as foreseen in decision **G 1/99**, which decision gave due regard to the principle of equity.

According to **T 1843/09** the prohibition of reformatio in peius as far as it entails a procedural limitation of the proprietor's liberty to change by way of amendments the scope of protection sought prevails "in principle" (**G 4/93**, OJ 1994, 875) until the final settlement of the opposition case and, therefore, also in any proceedings, including further appeal proceedings, subsequent to a remittal under Art. 111 EPC.

The board went on to say that it is clear from **G 1/99** that exceptions to the principle of the prohibition of reformatio in peius are a matter of equity in order to protect the non-appealing proprietor against procedural discrimination in circumstances where that prohibition would impair the legitimate defence of its patent. Therefore, exceptions are not limited to the situation specifically dealt with in **G 1/99**. Rather, the equity approach as taken by the Enlarged Board of Appeal covers, beyond an error of judgment by the opposition division, any change of the factual and/or legal basis on which limitations have been made by the proprietor prior to the appeal by the opponent as the sole appellant, provided the proprietor would be prevented by the prohibition on reformatio in peius from adequately defending its patent against new facts and objections introduced into the proceedings at the appeal stage.

In **T 61/10** the board pointed out that the existence of a causal link between the limiting feature to be deleted and the new situation arising on appeal was a necessary precondition for justifying an exception to the principle of prohibition of reformatio in peius for reasons of equity. In **G 1/99**, **T 1843/09** and **T 1979/11** this condition was fulfilled. However, in the case before the board, the precondition was not fulfilled, so a departure from the principle of prohibition of reformatio in peius based on analogies with the cases cited was not justified.

### 3.1.9 Reformatio in peius and lack of cross-appeal in the EPC

According to an obiter dictum in **T 239/96**, the board took the view that, in the absence of a provision on cross-appeal (in German "Anschlussbeschwerde"), reformatio in peius could not be ruled out altogether under the EPC, as it might serve as a means of avoiding unnecessary litigation, while still satisfying the legitimate expectations of the parties for a fair hearing. The board found that this deficiency in the EPC (i.e. the lack of a cross-appeal) was of prime importance when considering the respondent's procedural position and the issue of reformatio in peius.

## 3.2. Subject-matter under examination

### 3.2.1 Opposition appeal proceedings

#### a) Admissibility of opposition

The admissibility of the opposition, being an indispensable procedural requirement for any substantive examination of the opposition submissions, must be checked ex officio in every phase, including any ensuing appeal proceedings (**T 240/99**).

## b) The notice of appeal

In **T 226/09** the board decided that the request in the notice of appeal for the patent to be maintained on the basis of the first auxiliary request did not limit the subject of the appeal within the meaning of R. 99(1)(c) EPC for the appellant-proprietor and therefore did not rule out a broader request in the statement of grounds.

## c) Unopposed subject-matter not reviewed

No part of a patent's subject-matter (e.g. individual claims) not opposed within the nine-month time limit can be reviewed in either opposition or appeal proceedings. The opponent's statement under R. 76(2)(c) EPC (R. 55(c) EPC 1973) establishes the extent to which the patent is contested and thus the formal competence of the opposition division or board of appeal. The only exception to this principle concerns an opposition explicitly directed **only** to the subject-matter of an independent claim. In such a case, subject-matter covered by claims which depend on the independent claim can also be examined as to patentability (see e.g. **G 9/91**, OJ 1993, 408; see also **T 323/94**).

According to **T 896/90**, detailed grounds for opposition for a single granted independent claim do not mean that only that part of the patent is being contested, if the opponent has indicated that he wants the whole patent revoked. However, in **T 737/92** (in which only arguments against process claims and not against composition claims were submitted) the board found that an opposition was filed only to the extent that it was substantiated (see also **T 318/01**).

Where two opponents lodge appeals contesting different sets of claims and one subsequently withdraws its appeal, it becomes a party as of right under Art. 107 EPC 1973 and the other opponent becomes the sole appellant. The scope of the appeal is defined by the latter's request, which the non-appealing party may not exceed and which binds the board (**T 233/93**).

In **T 653/02** it was held that a board has no competence to examine a newly formulated claim derived by combination of granted claim 1 with a sub-claim not being within the extent to which the patent had been opposed; this did not fall within the exception allowed by **G 9/91** (OJ 1993, 408). In **T 646/02** the board found that the case at issue differed from the facts before the board in **T 653/02**, in that the subject-matter not opposed was described in the patent and was part of the independent claim as granted but was not itself the subject-matter of a dependent claim of the patent as granted. Whether or not the board had competence to examine depended, however, only on whether the patent was clearly restricted to a subject-matter not covered by the notice of opposition. This was done in **T 646/02** by restriction to the subject-matter of the **deliberately excluded dependent claim** and, in the case at issue, by restriction to **deliberately excluded variants** of the invention. The board held that the exception in **G 9/91** was not therefore applicable in the case before it either, since it was applicable only to subject-matter implicitly covered by the notice of opposition and not to those explicitly excluded.

In line with **G 9/91**, a patent proprietor could, in appeal proceedings, amend an uncontested **dependent** claim in accordance with R. 57a EPC 1973 (**T 711/04**).

Although the appeal procedure is to be considered as a judicial procedure in accordance with **G 9/91** (OJ 1993, 408), this does not mean that a board in examining an appeal within the framework of the legal grounds and facts submitted by the parties is limited to only considering passages in documents indicated and facts submitted by the parties. Examination of the appeal may raise further relevant questions within this framework and parties thus be invited to file observations. Moreover, where amendments of the claims were made during opposition proceedings, these are to be fully examined as to their compatibility with the requirements of the EPC (**T 1355/04**).

d) Appeal by patentee against revocation

Where the patentee appeals the revocation of the patent, the board is not bound by the findings of the opposition division; the whole case, including those claims considered novel by the opposition division, and objected to by the non-appealing opponent, must be considered (**T 396/89**). Furthermore, if the patent proprietor as the sole appellant in the opposition appeal proceedings makes amendments to the version of the patent adopted in accordance with an interlocutory decision of the opposition division, the board is both competent and obliged *ex officio* to examine those amendments from both a formal and a substantive point of view, even if the respondents expressly agree to them (**T 1098/01**). Similarly, where the patent proprietor was respondent on appeal against the decision of the opposition division as a whole, it was the board's power and duty to decide for itself on each issue addressed and it was not bound by any finding of that decision (in the respondent's favour) (**T 36/02**).

e) Removal of references in dependent claims

Claims which remain unchanged after the removal of the references in dependent claims need not be examined in opposition appeal proceedings to see if they contain grounds for opposition raised for the first time in those proceedings, unless the patentee consents (**T 968/92**).

f) Abandonment of subject-matter

See also Chapter IV.E.4. "Filing of amended claims in appeal proceedings".

According to **T 123/85** (OJ 1989, 336), the EPC makes no provision for patentees to surrender their patents during opposition proceedings (referring to **T 73/84**, OJ 1985, 241; **T 186/84**, OJ 1986, 79) nor surrender part of the patent so as to limit it. Thus a request withdrawn during opposition proceedings may nonetheless be considered in any ensuing opposition appeal proceedings. This view was followed in many decisions, including **T 296/87** (OJ 1990, 195), **T 934/02**, **T 699/00**, **T 794/02**, **T 1276/05** and **T 1188/09**.



In **T 1018/02**, it was stated that amendments of a European patent had to comply with R. 57a EPC 1973. According to this rule, amendments were possible provided that they were occasioned by grounds for opposition. However, this did not mean that, if a patent proprietor in the first instance chose to defend a main request which was limited in scope compared with the claims as granted, then he could not during the appeal proceedings go beyond the limits of that request. In accordance with **T 407/02**, a patent proprietor who had only defended his patent in limited form before an opposition division, was in principle allowed on appeal to return to a broader version or even to the patent as granted. Following **T 407/02**, the board in **T 1188/09** pointed out that opponents must therefore always be prepared for the possibility that a patent proprietor whose patent has been revoked by the opposition division will seek its restoration as granted on appeal. According to the board in **T 1188/09**, **T 1018/02** expressly followed this approach, which was again upheld in **T 386/04**, where it was explained that supposedly contrary decisions had always been concerned with circumstances in which the amendment to the claim amounted to an abuse of the procedure.

According to **T 386/04**, an appellant (proprietor), whose patent has been revoked, is entitled to seek maintenance of the patent as granted even though its main request before the opposition division had only been the maintenance of the patent in more limited form. The exception to this is where to allow the proprietor to revert to the amended claims would amount to an abuse of procedure. According to the board, this long-standing principle is not contradicted by decisions **T 528/93** or **T 840/93** (OJ 1996, 335), which are concerned with new claims raising new issues, and is not contrary to the statement by the Enlarged Board of Appeal in decision **G 9/91** (OJ 1993, 408), concerning the purpose of an appeal. In this context, there is no procedural logic in distinguishing between cases in which the patent has been revoked and cases in which the patent has been maintained.

The board in **T 28/10** extensively discussed **T 123/85** (OJ 1989, 336) and the case law based on it (including **T 386/04**). The board in that case had observed that the EPC 1973 made no provision for patent proprietors to surrender their patents during opposition proceedings. Given that patents could not be surrendered with effect for the EPO in opposition proceedings, it had rejected the opponent's argument that limited sets of claims filed in the course of the opposition proceedings were to be understood as a surrender. In the circumstances of **T 123/85**, this finding had to be considered to mean only that a European patent, as a subjective right, could not be altered with legal effect - i.e. irrevocably limited - during opposition proceedings by way of a unilateral waiver by the proprietor (see, in this connection, **G 1/90**, OJ 1991, 275; **T 386/01**) and that, therefore, claims amended for the purpose of opposition proceedings could not be deemed a surrender. Nevertheless, it could not be inferred from this that it was necessarily unreservedly permissible under procedural law to revert to a broader version of the claims not initially defended in the opposition proceedings, this constituting an amendment of submissions relevant to the case.

In **T 28/10** the patentee had sought to introduce into the appeal proceedings claims which had not been the basis of discussion before the opposition division. The board found that the legal situation had changed since **T 123/85** and Art. 12(4) RPBA was now

the relevant legal provision rather than case law based on that decision (see Chapter IV.E.4 "Filing of amended claims in appeal proceedings"). It observed that the decision in **T 123/85** had been based on **T 64/85**, in which the board had considered that abusive exercise of the right to make subsequent amendments to submissions could be sanctioned on the basis of Art. 114(2) or R. 86(3) EPC 1973 and so taken the view that the principle of concentration, which underlay those provisions, had restrictive effect. The board in **T 28/10** endorsed this finding that, in addition to the prohibitions on procedural abuse and *reformatio in peius* (see e.g. **T 934/02**), the principle of concentration likewise limited the principle of free party disposition. As far as amendments to claims in opposition or opposition appeal proceedings were concerned, the principle of concentration rule was enshrined in R. 116(2) EPC and in Art. 12(4) and Art. 13 RPBA. Whilst those provisions did not preclude such subsequent amendments entirely by imposing strict time limits on certain submissions, they left it to the decision making department's discretion whether or not to allow them.

g) Withdrawal of request during opposition proceedings

In **T 528/93**, the board had held that where a request was withdrawn during opposition proceedings and was thus not the subject of the contested decision, a virtually identical request filed during appeal proceedings was not the subject of the appeal, because the appellant was not adversely affected by the decision of the opposition division as far as this request was concerned.

h) Ground not properly substantiated by the patentee

In **T 1649/10**, the opposition division held that the subject-matter of claim 1 of the patent as granted did not involve an inventive step within the meaning of Art. 56 EPC 1973 and decided to maintain the patent as amended according to the first auxiliary request then pending. On appeal, appellant I (opponent) raised the issue of the admissibility of appellant II's (patentee) appeal, i.e., lack of substantiation. In this regard, the board held that the mere indication by appellant II that the subject-matter of granted claim 1 was inventive, starting from document D4 as the closest prior art, whereas the impugned decision based its analysis on a combination of D10 as the closest prior art and document D4, did not fulfil the requirements of R. 99(2) EPC as to the necessity for the appellant to indicate the reasons for setting aside the decision. The board was thus not in a position to recognise in the reasoning put forward by appellant II, which relied on D4 as the closest prior art, why the reasoning of the opposition division, which relied on document D10 as closest prior art, had to be rejected. It recalled, in this respect, that in *inter partes* proceedings, it is up to the parties to substantiate their views and not for the board to do so. The appeal filed by appellant II was, hence, rejected as inadmissible (R. 101(1) EPC). Its role in the appeal proceedings was then that of a party as of right under Art. 107 EPC.

i) Ground not properly substantiated by the opponent

In **T 1799/08** the board stated that it is not the function of the boards of appeal to carry out a general review of decisions at first instance, regardless of whether such a review

has been sought by the parties. In view of the character of the inter partes appeal proceedings, it could not be expected that the board, independently of its preliminary opinion on some of the critical issues for deciding on a ground not properly substantiated by the opponent which had initially raised it, would fully investigate that ground, in breach of the principle of equal treatment of the parties, and provide its own reasoning, substituting itself for an opponent which remained passive. The board thus accepted, in the absence of any evidence to the contrary, the patent proprietors' arguments.

j) Ambiguities in the claims

Reviewing and eliminating any ambiguities in the claims and description which are not necessary to refute substantiated grounds of opposition is not part of the review of the contested decision carried out during opposition appeal proceedings. In the event of ambiguities in the claims which are not connected to changes in the granted documents, Art. 69 EPC 1973 stipulates that the description and drawings must be used to interpret the claims, not that the claims must be changed (**T 481/95**).

### 3.3. Patentability requirements under examination in ex parte proceedings

#### 3.3.1 Ex parte proceedings

In **G 10/93** (OJ 1995, 172) the Enlarged Board ruled that, where the examining division had refused an application, the board had the power to examine whether the application or the invention to which it related met the requirements of the EPC 1973. This also held good for requirements the division had not considered in the examination proceedings or had regarded as fulfilled. The board should then, where appropriate, decide either to rule on the case itself or send it back to the examining division.

This followed from the fact that ex parte review was not of a contentious nature. It involved examination of the patentability requirements in proceedings in which only one party (patent applicant) was involved. The departments involved at every instance had to ensure that these requirements were fulfilled. In ex parte proceedings, therefore, the boards of appeal were not restricted either to examination of the grounds for the contested decision or to the facts and evidence on which that decision was based, and could include new grounds even though in ex parte cases too the main aim of appeal proceedings was to review the contested decision.

This decision was based on case **T 933/92**, in which an examining division had refused an application for non-compliance with Art. 123(2) EPC 1973. Whilst sharing the examining division's view with respect to Art. 123(2) EPC 1973, the board felt the application should be refused for lack of inventive step. In the board's view, the question whether grounds could be added or replaced was not resolved by **G 9/91** and **G 10/91**.

If an application for which no search had been carried out in accordance with R. 45 EPC 1973, inter alia for lack of clarity of the claims, had been refused for the same reason, a board of appeal need only examine whether the claims failed to comply with the clarity requirement of Art. 84 EPC 1973 to such an extent that it was not possible to

carry out a meaningful search. Having found that the claims fulfilled the requirements of the EPC to such an extent that it should have been possible to carry out a search, the board in **T 1873/06** remitted the application to the examining division for an additional search to be performed and the substantive examination to be continued. R. 45 EPC 1973 has been streamlined and is now R. 63 EPC. Art. 84 EPC has been subject to minor editorial amendment in English and German only.

In **T 1367/09**, when preparing the communication pursuant to Art. 15(1) RPBA the board did not raise the issue of Art. 84 EPC 1973. Nevertheless, when reconsidering the case in preparation for the oral proceedings the board noted that Art. 84 EPC 1973 should indeed be addressed in the oral proceedings. The board noted that in the light of **G 10/93** (OJ 1995, 172) the board had the power, in ex parte appeal proceedings, to enforce any grounds for refusal of an application, in particular grounds which the examining division did not consider at all or held to be satisfied.

The extent of the obligation to review a case where the appeal is partially withdrawn is discussed in Chapter IV.E.6.3.5 "Partial withdrawal of appeal by sole appellant and opponent".

### **3.4. Facts under examination - applying Article 114 EPC in appeal proceedings**

#### **3.4.1 Boards to examine facts of own motion**

Parties have no right to determine what facts will be taken into account in a board's decision. On the contrary, Art. 114(1) EPC, which also applies in appeal proceedings, requires the board to establish the facts of its own motion (see **T 89/84**, OJ 1984, 562 and **J 4/85**, OJ 1986, 205; the former superseded in so far as the view was taken that a respondent's "cross-appeal" was not necessary).

As the Enlarged Board made clear in **G 8/93** (OJ 1994, 887), the board's obligation under Art. 114(1) EPC 1973 existed only once proceedings were pending (see also **T 690/98**). Earlier, **T 328/87** (OJ 1992, 701) had already ruled that the facts could be investigated only if the appeal was admissible. There were, however, limits to this obligation, for example under Art. 114(2) EPC 1973, where facts and evidence are submitted late. The same applied if an opponent (respondent) withdraws his opposition: in **T 34/94** the board found that, "if in the event of 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) EPC 1973 does not extend to its having to examine the submission of the opponent that a previous oral disclosure took place if the crucial facts were difficult to ascertain without his co-operation" (this confirmed the case law in **T 129/88**, OJ 1993, 598; **T 830/90**, OJ 1994, 713; **T 887/90**, **T 420/91** and **T 634/91**; see also **T 252/93**).

In **T 1574/11** the board observed that the principle of examination by the EPO of its own motion (Art. 114 EPC) also applied to appeal proceedings. Hence it was not restricted to

the facts, evidence or arguments provided by the parties. As the primary purpose of the appeal procedure was to check that the contested decision was correct, the board was in principle entitled to consider the evidence provided therein if it deemed it to be relevant to its own decision. The contested decision had taken E6 into account. It followed that the board was entitled to take E6 into consideration in the appeal proceedings.

**T 182/89** (OJ 1991, 391) sets out what the obligation to investigate involves; Art. 114(1) EPC 1973 should not be interpreted as requiring the opposition division or board of appeal to ascertain whether there was support for grounds for opposition not properly substantiated by an opponent, but as enabling the EPO to investigate fully the grounds for opposition which were both alleged and properly substantiated pursuant to R. 55(c) EPC 1973 (see also **T 441/91** and **T 327/92**). In **T 263/05** (OJ 2008, 329) the board accepted that it had an ex officio duty under Art. 114(1) EPC 1973 to examine amended claims, but only for prima facie non-compliance with the EPC, e.g. lack of clarity or conciseness.

If departments of first instance and/or parties fail to take account of highly relevant matter which is clearly available in the EPO file and which relates to a ground of opposition, the board's competence extends to rectifying the position by consideration of that matter provided, of course, the parties' procedural rights to fair and equal treatment are respected. This is not only consistent with Enlarged Board decisions **G 9/91** (OJ 1993, 408) and **G 10/91** (OJ 1993, 420), but incumbent on the board as the last instance in proceedings concerning the grant or maintenance under opposition of European patents (**T 385/97**). It enhances acceptance of the boards' decisions and their standing as the only judicial body ruling on patentability with effect for all the designated contracting states, if those decisions based on all material are submitted during the appeal proceedings. A document presented in such proceedings should therefore be taken into account if it is not completely irrelevant or at odds with considerations of procedural economy (**T 855/96**).

In **T 715/94** the board held that it was entitled to find novelty-destroying a document submitted but considered irrelevant before the examining and opposition divisions, as novelty had already been questioned and the document cited in the appellant's notice of opposition.

#### 3.4.2 Circumstances where the board need not examine facts of its own motion

**T 60/89** (OJ 1992, 268) held that when alleged facts put forward without proof as causing lack of novelty had occurred a long time previously and the question was no longer pursued by the parties it was not obliged to investigate the matter ex officio under Art. 114(1) EPC 1973. Nor did the board in **T 505/93** consider itself obliged to carry out any further investigation when the opponents refused to take part in oral proceedings where the content of a prior use was to be clarified.

In the context of an appeal by an appellant (opponent) from an opposition division decision maintaining the patent in amended form, the board of appeal only has to consider the appeal as regards claims upon which the appellant (opponent) has

advanced arguments and those claims that are dependent, either wholly or partially, on these claims, and has to apply the provisions of Art. 114(1) EPC 1973 in a restricted manner (**T 223/05**).

### **3.5. Arguments under examination**

The question of whether a party has discharged its onus of proof in relation to the availability to the public of a document is an argument and not a new ground of appeal. The prohibitions or restrictions on additions to the extent to which a patent is opposed, the raising of a new ground for opposition or the introduction of new facts or evidence, do not apply to the admission of a new argument. Indeed, the very purpose of appeal proceedings, particularly oral proceedings, is to provide an opportunity for a losing party to throw new light on relevant aspects of matters which have been decided to his detriment and/or to draw attention to facts in the reasoning of the department of first instance that resulted in a decision adverse to him. This can, in practice, best be achieved by reliance on new arguments. Whilst it is desirable that all relevant arguments be brought at the earliest possible stage of the proceedings, there is no requirement in Art. 108 EPC 1973 that the statement of grounds of appeal be exhaustive as to the arguments to be brought (**T 86/94**).

Similarly, in **T 432/94** the appellant was allowed to redefine the problem to be solved by the invention. The board stated that it could not be concluded from Art. 108, third sentence, EPC 1973 that an appellant was bound to the line of argument he used in the statement of grounds for the whole appeal proceedings; this dealt with an admissibility requirement and did not limit the matter in dispute in appeal proceedings.

### **3.6. Review of first-instance discretionary decisions**

If the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in an appeal, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised such discretion in the same way as the department of first instance. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion if the board concludes it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (**T 640/91**, OJ 1994, 918; see also **T 182/88**, OJ 1990, 287; **T 986/93**, OJ 1996, 215; **T 237/96** and **G 7/93**, OJ 1994, 775, **T 1119/05** and **T 1707/07**).

A board of appeal, when reviewing the opposition division's exercise of discretion under Art. 114(2) EPC, has the power to overrule a decision not to admit a late-filed ground of opposition, if the board concludes that the opposition division based its decision on manifestly incorrect technical assumptions or on an erroneous approach to applying said ground of opposition since this amounts to a misuse of the discretionary power under Art. 114(2) EPC (**T 109/08**).

In **T 1849/12** the impugned communication of the examining division under R. 71(3) EPC which was qualified as a decision had not terminated the proceedings as regards the appellant. Thus, it had adversely affected the appellant by issuing its communication in a way that could not be remedied by means of an appeal after the final decision. The examining division therefore ought to have allowed a separate appeal, especially since the EPC made no provision for an appeal against inaction of the EPO (see, to that effect, also **J 26/87**, OJ 1989, 329). The examining division had failed in its deliberations to take proper account of a crucial factor and so exercised its discretion improperly. Its communication therefore had to be regarded as a separately appealable decision.

#### **4. Filing of amended claims in appeal proceedings**

##### **4.1. Introduction**

See Chapter IV.C.1.3 for decisions on late-filed facts, arguments and evidence in appeal proceedings.

##### **4.1.1 Legal basis**

It is settled case law of the boards of appeal that new requests containing amended claims may exceptionally be admitted in appeal proceedings. According to R. 100(1) EPC, the provisions in R. 137(3) EPC, relating to examination, and in R. 80 EPC, relating to opposition, apply by analogy in appeal proceedings. Under R. 137(3) EPC, further amendments of a European patent application may not be made without the consent of the examining division, while R. 80 EPC provides, in essence, that the description, claims and drawings may be amended if this is occasioned by a ground for opposition under Art. 100 EPC. Moreover, the Rules of Procedure of the Boards of Appeal (RPBA), which were thoroughly revised in 2003, contain detailed provisions placing the admission of subsequent amendments at the boards' discretion. The admissibility of subsequent amendments to a party's submissions (whether they be facts, evidence or requests) was expressly rendered a matter for the board's discretion (see, for a comprehensive account, CA/133/02). When the RPBA were revised again in 2007, the provisions on subsequent amendments were retained, albeit renumbered; on this point, see Chapter IV.C.1 "Late submission".

##### **4.1.2 Rules of Procedure of the Boards of Appeal (RPBA)**

The provisions of the RPBA governing the admissibility of late requests essentially codify the boards' settled case law on this point (**T 87/05**, **R 5/11**). Art. 12 and Art. 13 RPBA (formerly Art. 10a and Art. 10b RPBA 2003, entry into force on 1 May 2003) are essentially aimed at concentrating the parties' submissions at an early stage of the proceedings, to ensure that the case is as complete as possible when it is processed. In particular, amendments which would lead to an adjournment of the oral proceedings should not be admitted. Their purpose is therefore to expedite the proceedings and implement the principle of fairness towards the other party or parties. It follows from this that parties to appeal proceedings are subject to certain restrictions as far as their procedural conduct is concerned. For example, it is a matter for each party himself to

submit all facts, evidence, arguments and requests relevant for the enforcement or defence of his rights as early and completely as possible (**T 162/09**).

Under Art. 12(2) RPBA, the statement of grounds of appeal and the reply must contain a party's complete case and should, inter alia, specify expressly all the facts, arguments and evidence relied on. Under Art. 13(1) RPBA, the boards have discretion to admit and consider any amendment to a party's case after it has filed its grounds of appeal or reply. This discretion must be exercised in view of, inter alia, the complexity of the new subject-matter, the current state of the proceedings and the need for procedural economy. Art. 13(3) RPBA adds that amendments sought to be made after oral proceedings have been arranged may not be admitted "if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings".

Art. 13(1) RPBA thus governs the implications of an initially incomplete case and the admission of later amendments. Art. 12(4) RPBA expressly refers to the boards' power to exclude requests which could have been filed in the first-instance proceedings.

#### 4.1.3 Historical development

It already became apparent in early decisions that the boards do admit amended requests or auxiliary requests in appeal proceedings because they are serious attempts at overcoming objections, or if their late filing can be justified and admitting them does not involve the board or the other party, as the case may be, in an examination which would significantly delay the proceedings. However, requests filed shortly before or during oral proceedings, in particular, may be refused if they are not clearly allowable (**T 95/83**, OJ 1985, 75; **T 153/85**, OJ 1988, 1; **T 406/86**, OJ 1989, 302; **T 295/87**, OJ 1990, 470; **T 381/87**, OJ 1990, 213; **T 831/92**).

In other decisions too, the boards have observed that, when exercising their discretion, they must weigh up all the circumstances of the case. The later the claims are submitted, the stricter the criteria to be applied. The subject-matter of the new claims should not diverge considerably from the claims already filed, in particular they should not contain subject matter which has not previously been claimed. The new claims should be clearly allowable in the sense that they do not introduce new objections under the EPC and overcome all outstanding objections under the EPC (**T 1126/97**, **T 52/99**, **T 468/99**, **T 397/01**, **T 411/02**, **T 81/03**, **T 989/03**, **T 515/06**).

New requests may exceptionally be admitted for reasons of procedural economy, even where not filed until a very late stage (e.g. during the oral proceedings), if the amendments are justified, e.g. where filed in response to objections or comments which were not part contained in the decision under appeal but were raised in writing during the appeal proceedings and moreover do not extend the scope of discussion as determined by the decision under appeal and the statement of grounds of appeal (**T 1126/97**, **T 52/99**, **T 468/99**, **T 397/01**, **T 846/04**, **T 1109/05**).



With regard to the proper exercise of discretion in deciding whether to admit requests filed by the appellant patentee which were not submitted before the opposition division, the crucial questions to be considered are whether or not the amended claims of those requests are clearly allowable, whether they give rise to new objections, whether or not there is proper justification for their late filing (so as to forestall tactical abuse) and whether the board can deal with them without undue procedural delay (**T 153/85**, OJ 1988, 1; **T 206/93**, **T 396/97**, **T 196/00**, **T 50/02**, **T 455/03**, **T 1333/05**).

#### 4.1.4 Principles applicable to amended claims on appeal

In the context of the late filing of amended claims, several decisions refer to the principles developed by the Enlarged Board of Appeal in relation to the inter partes appeal procedure provided for in the EPC, according to which such an appeal primarily serves the parties' right to a review of the first-instance decision in proceedings of a judicial nature. In **G 9/91** and **G 10/91** (OJ 1993, 408, 420) in particular, it was held that the main purpose of the inter partes appeal procedure is to conduct a final review of the decision given at the previous instance and thereby provide the losing party with an opportunity to challenge the decision against it and obtain a judicial ruling on whether it is correct. The appeal proceedings are thus largely determined by the factual and legal scope of the preceding opposition proceedings.

It is settled case law that an appellant patentee who has lost before the opposition division thus has the right to have the rejected requests reconsidered by the appeal board or to file new requests at a timely stage of the appeal proceedings, in particular together with the statement of grounds of appeal or the reply. However, if the patentee wants other (further) requests to be considered, the admission of these requests is a matter for the board's discretion, and not a matter of right (**T 840/93**, OJ 1996, 335; **T 427/99**, **T 50/02**, **T 455/03**, **T 651/03**, **T 240/04**, **T 339/06**).

Given that the aim of opposition-appeal proceedings is to obtain judicial review of the administrative opposition decision, it follows that the board must as a rule take their decision on the basis of the issues in dispute before the opposition division. It can be directly inferred from the above that the parties have only limited scope to amend the subject of the dispute in second-instance proceedings, and this principle is reflected in Art. 12(4) RPBA. The appeal proceedings are not about bringing an entirely fresh case (**T 1705/07**, **T 356/08**, **T 1067/08**, **T 2102/08**, **T 144/09**, **T 881/09**, **T 936/09**, **T 23/10**, **T 935/12**).

The parties are subject to certain restrictions on their procedural conduct, given, in particular, the need in inter partes proceedings to act fairly towards the other party and, more generally, the requirements of due process. The parties to inter partes proceedings are subject to a particular duty to facilitate due and swift conduct of the proceedings, which includes submitting all relevant facts, evidence, arguments and requests as early and completely as possible (**T 1685/07**, **T 2102/08**, **T 253/10**, **T 1364/12**). Admitting subsequent amendments to a party's case must not adversely affect the counterparty's right to submit observations on them (Art. 13(2) RPBA), for example because it cannot duly exercise that right in the time then left (**T 253/10**, **T 1466/12**).

In **ex parte** cases it is established case law that proceedings before the boards of appeal are primarily concerned with examining the contested decision (**G 10/93**, OJ 1995, 172). Since the judicial examination in *ex parte* proceedings concerns the stage prior to grant and lacks a contentious nature, the boards are restricted, in their review of the decision under appeal, neither to an examination of the grounds for the contested decision nor to the facts and evidence on which the decision is based. In **T 980/08** the board stated that this absence of restriction does not amount to a positive obligation for the boards to consider any request filed in appeal especially when the requests bring about a new case. The appeal proceedings are intended to review the correctness of the decision of the first instance rather than to continue examination by other means (see also **T 65/11**).

## 4.2. State of proceedings

### 4.2.1 General

It is the established case law of the boards of appeal that the appeal procedure is designed to ensure that the proceedings are as brief and concentrated as possible and ready for decision at the conclusion of oral proceedings, if scheduled. An important aim of Art. 12 and 13 RPBA is that the parties' submissions are concentrated at as early a stage as possible so that the case is as complete as possible when it comes to processing it (**T 1315/08**). Therefore, amendments to the claims are to be filed at the earliest possible moment (**T 214/05**, **T 382/05**).

Under Art. 12(2) RPBA, the statement of grounds of appeal and the reply must contain the party's complete case. In addition to all facts, arguments and evidence, they should include all requests (**T 764/03**). Art. 13 RPBA leaves it to the board's discretion to consider amendments made to a party's case after filing of the statement of grounds of appeal. In particular, new submissions will not be considered if this would require an adjournment of already scheduled oral proceedings (Art. 13(3) RPBA). The subject-matter to be examined on appeal is thus determined by the statement of grounds for appeal and the reply.

### 4.2.2 Procedural economy

Under Art. 13(1) RPBA, the board must exercise its discretion in view of the need for procedural economy, that is, the need to conclude proceedings swiftly and to create legal certainty. It also follows from the inter-relationship between Art. 12 and 13 RPBA that amendments made to a party's case after filing of the grounds of appeal do not form part of the subject of the appeal and so must be admitted in order to be considered (**T 253/10**). The state of the proceedings and the need for procedural economy taken together imply a requirement for a party to present appropriate requests as soon as possible if such requests are to be admitted and considered (**T 1033/10**, **T 375/11**, **T 1245/11**, **T 2219/12**). Requests filed very late (i.e. shortly before or during the oral proceedings) will therefore be admitted only if they are *prima facie* allowable. The admission of new requests at a very late procedural stage (shortly before the oral proceedings) is only in keeping with the principle of procedural economy if the requests are not unsuitable from the outset to overcome the doubts as to the allowability of the

claims (**T 978/05**, **T 1731/06**, **T 33/07**, **T 321/07**, **T 1650/08**). As far as procedural economy is concerned, an amendment at a late stage in the proceedings is justifiable if it is an appropriate and immediate reaction to unforeseeable developments in the previous proceedings which do not lie in the responsibility of the party submitting the amendment (**T 1990/07**, **T 1354/11**).

The amended claims must not give rise to circumstances relevant for the assessment of patentability which are so new that the other party cannot reasonably be expected to address them without the proceedings being unduly prolonged (**T 651/03**).

Both the timing of the filing of amended claims or auxiliary requests and the difficulty entailed in examining them are important criteria for deciding whether they can be admitted to the proceedings (**T 397/01**): the later the requests are filed, the less likely they are to be held admissible (**T 942/05**); and the more complex the issues raised by amendments and the later those amendments are filed, the greater the risk that the remaining time is insufficient to consider them properly (**T 81/03**).

In **T 1449/05** the board stated that the discretion to permit amendment of a party's case may be exercised against a proprietor who seeks to resile at a late stage in the opposition appeal procedure from a previous long-standing acknowledgement or persistent tacit admission of prior art. Admitting this resilement would require in all fairness the adjournment of the oral proceedings to allow the appellant opponent to search for adequate evidence. This could have been done at an earlier stage of the proceedings (likewise **T 1682/09**).

If an objection (made by a party and/or by the board) is not fully understood in a particular case, it is then, at the very least, incumbent on the party having difficulties in understanding an objection to indicate this at the earliest possible stage and make the appropriate effort to have the objection clarified. A lack of understanding alone cannot justify postponing amendments to a party's case until a later stage in the proceedings (**T 1033/10**).

#### 4.2.3 Parties' right to submit observations on amendments – Article 13(2) RPBA

In **R 9/11** the Enlarged Board held that Art. 13(2) RPBA, which gives parties a right to comment on new submissions filed by others, does not inevitably extend to having all auxiliary requests - without any further examination of their prima facie allowability - automatically admitted into the proceedings. In **R 1/13** the Enlarged Board stated that the petitioner's suggestion that the right to be heard carries with it, in the case of requests filed in response to late objections, a right to a full discussion which transcends the requirement of admissibility is simply incorrect. A late objection may lead to more latitude in the filing of requests in response but there is no certainty of admissibility, let alone of a more thorough discussion if admissibility is achieved. If the petitioner was correct, any request filed in response to a late objection would be admissible even if it clearly had no prospect of overcoming the objection. There can be no such right of automatic admissibility for those making the new submissions.

#### 4.2.4 Unsubstantiated requests

In some decisions, it has been observed that unsubstantiated auxiliary requests cannot be considered in appeal proceedings.

Under Art. 12(2) RPBA, the statement of grounds of appeal and the reply must set out the parties' complete case. In particular, it must be set out why it is requested that the decision under appeal be amended or upheld. Taken as a whole, the RPBA make it clear that appeal proceedings are primarily written in nature, with Art. 12(2) RPBA requiring that the parties' complete case be submitted at the outset. The purpose of this provision is to ensure fair proceedings for all concerned and to enable the board to start working on the case on the basis of both parties' complete submissions. In inter partes proceedings, both rights and obligations should be divided equally among the parties so that the board can perform its independent judicial function (**T 217/10**, **T 1732/10**, **T 1890/09**).

In **T 217/10** the board observed that it was not only for the appellant to substantiate its appeal but equally for the respondent to show at an early stage why it considered that the objections raised in the grounds of appeal did not withstand scrutiny. If auxiliary requests were submitted, reasons usually had to be given to explain how they overcame those objections (at least if this was not obvious from the amendments made). In the case in question, the auxiliary requests had not been accompanied by any reasons, so it was not immediately apparent to the board how they could overcome the objections raised. The board therefore refused to consider them.

In **T 1732/10** the board held that not reacting in substance to the appeal of the opponent, but waiting for the board's preliminary opinion before any substantive reaction is filed, is regarded as an abuse of procedure. This is all the more so if the substantiation for all the requests, which were filed after summons to oral proceedings have been sent, is filed only shortly before the oral proceedings before the board. Such requests – which are not self-explanatory – are considered by the board as submitted only on the date of their substantiation. Such very late requests are contrary to procedural economy, do not take account of the state of the proceedings and cannot be reasonably dealt with by the board without adjournment of the proceedings or remittal to the department of first instance, contrary to Art. 13(1) and 13(3) RPBA (see also **T 1134/11**).

In **T 1836/12** the board held that filing new requests without addressing all the points raised in the annex to the summons to oral proceedings made the procedure inefficient, contrary to the principle of procedural economy. Simply filing unsubstantiated requests did not overcome any objections that had already been raised by the board in the annex to the summons or that were to be expected in the light of the contested decision. Given the lack of substantiation, the board had informed the appellant well in advance that the admissibility of these new requests would have to be discussed at the oral proceedings and that they would be considered filed only on the date of their substantiation (**T 1732/10**).

In **T 1890/09** the board concurred with the previous case law and held that unsubstantiated requests were to be disregarded under Art. 12(4) RPBA because the requirements under Art. 12(2) RPBA were not met. In the case in question, no reasons supporting the auxiliary requests had been filed either with them or at a later stage. In the board's view, it was therefore unnecessary for it to exercise its discretion under Art. 13(1) RPBA and examine whether or not these auxiliary should still be taken into consideration (similarly **T 1732/10**, **T 162/12**, **T 1836/12**).

#### 4.2.5 Amendments after arrangement of the oral proceedings

According to an approach frequently adopted by the boards a request after arrangement of the oral proceedings may be admitted and considered at the board's discretion (i) if sound reasons exist for filing this request so far into the proceedings (this may be the case when amendments are occasioned by developments during the proceedings), (ii) if the auxiliary request does not extend the scope of discussion as determined by the grounds of appeal and the respondent's (iii) if the auxiliary request is clearly or obviously allowable (this means that it must be immediately apparent to the board, with little investigative effort on its part, that the amendments made successfully address the issue raised without giving rise to new ones) (see in particular **T 1634/09** and **T 484/07**, **T 447/09**, **T 2344/09**, **T 1925/10**. Such amendments should in principle allow the granting of a patent based thereon (**T 1748/08**, **T 2250/08**).

However, amendments made after oral proceedings have been arranged (Art. 13(3) RPBA) cannot be admitted if they raise issues which the board or the other party or parties cannot reasonably be expected to address without an adjournment of the oral proceedings. This provision therefore leaves the decision-making board no room for discretion (**T 253/10**).

In **T 81/03**, the board found that requests filed shortly before the minimum deadline set by it in the summons to the oral proceedings had to be regarded as belated where they contained points which could only be dealt with properly in an additional written phase (**T 518/08**).

In **T 253/06**, the board held that it was permissible under Art. 13(3) RPBA to regard as belated auxiliary requests filed after oral proceedings had been arranged but within the prescribed period, if those requests were not substantiated, i.e. not accompanied by reasons explaining why the amendments had been made and how they were intended to overcome the objections raised in the course of the proceedings. In such cases, neither the board nor the other parties to the proceedings could reasonably be expected to consider these points, especially if there were a large number of requests and the features of the claims raised new aspects (**T 2422/09**, **T 351/10**, **T 2497/10**). This conclusion holds all the more true, if such an unsubstantiated request is filed only shortly before the oral proceedings. In this respect an ex-parte is not different from an inter-partes case (**T 1278/10**).

Amended claims filed at such a late stage should be clearly allowable in the sense that it can be quickly ascertained that they overcome all outstanding issues without raising new ones (**T 1126/97**, **T 1993/07**, **T 183/09**).

In **T 133/04**, the appellant had not provided satisfactory evidence that the late-filed requests were apt to take better account of the reasons for the decision than those filed with the statement of grounds of appeal (see also **T 50/98**).

Similarly, in **T 1443/05**, the board refused to admit the auxiliary request under Art. 13(3) RPBA because, as a result of its late filing, the question whether it met the requirements of Art. 123(3) EPC 1973 could not be answered without adjourning the oral proceedings (see also **T 1026/03**, **T 1305/05**, **T 455/06**).

#### 4.2.6 Filing of requests during the oral proceedings

##### a) Efficient conduct of the proceedings

Under Art. 15(6) RPBA, the case should be ready for decision at the conclusion of the oral proceedings before the board, unless there are special reasons to prevent this. The board of appeals have developed several criteria in exercising its discretionary power to admit amended claims submitted for the first time during oral proceedings without any legally relevant excuse for the lateness. An amendment at a late stage is justifiable if it is an appropriate reaction to unforeseeable developments in the proceedings, - for example if it addresses comments or objections first raised in those proceedings (**T 391/11**). New requests can be considered only in exceptional cases, for example if a party is confronted with unexpected developments during the proceedings (**T 1869/10**, **T 2219/12**) or if it would be immediately apparent to the board, with little or no investigative effort on its part, that the new requests are clearly and obviously allowable (**T 5/10**, **T 1912/09**, **T 2219/12**). It is established case law that claims which are clearly not allowable will not normally be admitted. Thus, the general principle is that in order to be admissible, an amended claim belatedly filed in oral proceedings must be clearly allowable by virtue of a clearly permissible amendment (**T 1273/04**, **T 1311/05**, **T 2238/09**). It must be immediately apparent to the board, with little or no investigative effort on its part, that amendments successfully address the issues raised without giving rise to new ones (**T 5/10**). According to **T 1315/08** (ex parte) an especially strict standard should be applied to such requests. As a rule, new requests not filed until the oral proceedings could only be admitted if they eliminated minor objections to an otherwise allowable claim or if they were a reaction to debate in the oral proceedings, especially where this reaction was to limit the claim even further.

In **T 183/09** auxiliary requests 2 to 4 were filed at the oral proceedings. The board summarised by stating that unless an amendment is justified by developments in the appeal proceedings - for example if it addresses objections or comments first raised in the proceedings - it will be admitted only if it does not extend the scope or framework of discussion as determined by the decision under appeal and the statement of the grounds of appeal, and is moreover clearly allowable. From the above the board inferred that procedural economy, that is the need to conclude proceedings swiftly and so create legal

certainty, plays an increasingly dominant role as appeal proceedings progress towards their end. In the final stages of an appeal procedure it may in fact come to outweigh all other factors in the balance of interests that the board must strike when deciding on the admissibility of new requests or of new facts and evidence (**T 1993/07**, **T 532/08**, **T 562/09**, **T 1227/10**, **T 1354/11**).

R. 116 EPC (R. 71a(2) EPC 1973) and Art. 13(3) RPBA have considerably restricted the scope for admitting in opposition appeal proceedings new requests first filed by the patentee in oral proceedings despite specification of a deadline for filing such requests in the summons notice. Such auxiliary requests could be refused as belated under R. 116 EPC, unless they had to be admitted on the grounds that the subject of the proceedings has changed (**T 1105/98**, **T 913/03**, **T 494/04**).

In **T 1617/08** the board stated that the purpose of an oral hearing in appeal proceedings is to give the parties an opportunity to argue their case but not to give an appellant (patentee) the opportunity to repeatedly modify its requests until an acceptable set of claims is found.

In **T 1790/06**, in exercising its discretion the board also took account of the conduct of the respondent (patentee) during the oral proceedings. A party's obligations included taking care not to act in a manner detrimental to the efficient conduct of oral proceedings. At such proceedings, it should not for example submit requests willy-nilly, withdraw them and then resubmit them later. That was unacceptable, for both the board and other parties. Similarly, in **T 2540/12** the respondent's behaviour impaired the efficient conduct of the oral proceedings and the board stated that this in itself was sufficient reason not to admit the new auxiliary request.

b) Amended claims not admitted

In **T 1105/98** the auxiliary request was not submitted until the start of oral proceedings before the board. The board had to make sure that the amended claims fulfilled the formal requirements and appeared likely to succeed, bearing in mind the time needed to ascertain this but also the right to be heard. These conditions were not fulfilled if a further search was needed, so that either the oral proceedings had to be postponed or the matter remitted to the department of first instance for further prosecution. The board in **T 681/02** adopted the view taken in **T 1105/98**, where the board had held that, if the said request was intended as a response to the board's preliminary opinion in preparation for the oral proceedings, it could have been submitted prior to the time limit specified in that opinion, that is to say, up to one month before the oral proceedings.

In **T 162/12** the discussion during the oral proceedings had been essentially limited to the objection raised in the board's annex to the summons, without any new issues coming up which could have left the appellant facing a new situation. Claim 1 of the auxiliary request 1 corresponded to the combination of claims 1 and 2 of the main request. However, the Board had already expressed in its annex to the summons its preliminary opinion that the subject-matter of claim 2 of the main request did not involve an inventive step. The appellant therefore could have filed said auxiliary request,

properly supported by arguments, sufficiently in advance for the board to prepare itself for the oral proceedings. In acting as it did, the appellant kept all its cards to itself whereas the board with its annex to the summons has laid its cards on the table. That could not be considered conducive to efficient proceedings.

In **T 831/92**, the board held that it was contrary to the principle of procedural fairness to file an auxiliary request during oral proceedings before a board of appeal because it was difficult for an opponent to deal with a request not submitted in good time before the oral proceedings (**T 1333/05**). In **T 667/04** the board stated that no exceptional circumstances were put forward excusing the late filing of the request. To have admitted it would have run counter to the principle of procedural fairness (see also **T 233/05**).

During the oral proceedings in **T 14/02**, the respondent (patentee) requested the board's leave to file additional requests in order to limit the claimed subject-matter. The board refused the request on two grounds: firstly, the need for a new request had already been apparent before the oral proceedings since the board had already issued a communication containing a negative provisional opinion setting out why the main request did not appear to be inventive; secondly, the proposed subject-matter of the new requests would have required the other party to perform another search and might have resulted in a remittal.

In **T 236/11** the amended claim consisted of a combination of features that had not been claimed in the proceedings before that. In view of the many different sets of claims filed during the proceedings before the opposition division, the board found the claiming of this combination at this late stage surprising, with the result that neither it nor the appellant was in a position to deal with the claim without postponing the oral proceedings or remitting the case to the department of first instance.

c) Amended claims admitted

In **T 1067/03** (inter partes), the board admitted an auxiliary request first filed during the oral proceedings. It regarded the clarifications in the auxiliary request as a response to the preceding discussion in the oral proceedings. Moreover, the amendment was not so complex that it would have made it impossible to reach a definitive decision in the oral proceedings.

In **T 1045/08** the board considered that the auxiliary requests filed in the oral proceedings responded to objections to the earlier filed requests in particular in view of the newly introduced documents so that it admitted them into the proceedings. In filing a relevant document shortly before oral proceedings a party must accept that the other party may file appropriate new requests also during the oral proceedings, which may raise issues not previously addressed in the proceedings. This may not apply to requests which could reasonably have been filed before the new document was filed.

In **T 2097/10**, the amendment entailed deletion of claim 1 and so eliminated the objections raised. Moreover, the then remaining independent claim, which was already in auxiliary request 1, was *prima facie* allowable. Since the amendment was restricted to



deletion of a claim, it would not unnecessarily delay the proceedings. The appellant could already have filed the relevant request with the statement of grounds of appeal, but the board decided to admit it in the circumstances (withdrawals of opposition; appellant's last chance to save its patent).

In **T 1589/11** the board raised no objection to the introduction by the opponent of new arguments not contained in the statement of grounds of appeal, even though new arguments may, in principle, also represent an amendment to a party's case within the meaning of Art. 13(1) RPBA. That the board found these new arguments convincing only became apparent to the proprietor during the oral proceedings. Under these circumstances the board considered it equitable to allow the proprietor to formulate a response to this finding, especially as the new request could not be seen as adding greatly to the complexity of the case.

In **T 2284/12** (ex parte) the board accepted that the auxiliary requests were filed in reaction to detailed comments and objections of the board that were debated in the course of the oral proceedings. The amendments made could be considered as an attempt by the appellant to overcome all pending objections. They did not raise new issues of particular complexity and contributed to the convergence of the debate. See also similar cases **T 2485/10**, **T 391/11**, **T 1306/11** and **T 1995/12**.

d) Applicant (proprietor) absent from oral proceedings

The EPO can consider and decide only on the text of the European patent submitted to it, or agreed, by the proprietor (Art. 113(2) EPC). Moreover, any party duly summoned to oral proceedings cannot rely on the proceedings being continued in writing or the case being remitted to the department of first instance solely because he failed to appear at the oral proceedings, see Art. 15(3) and (6) RPBA). Under those provisions, the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned; that party may then be treated as relying only on its written case. The board must also ensure that each case is ready for decision at the conclusion of the oral proceedings. The explanatory notes to Art. 15(3) RPBA state that this provision does not contradict the principle of the right to be heard pursuant to Art. 113(1) EPC since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity (see the explanatory note to Art. 15(3) RPBA in CA/133/02 dated 12.11.2002, quoted in **T 1704/06**, **T 1278/10**, **T 2281/12**, **T 1245/14**).

The purpose of oral proceedings is to give parties the opportunity to present their case and to be heard. However, they give up that opportunity if they do not attend the oral proceedings. It is established case law of the boards of appeal that appellants who submit amended claims shortly before the oral proceedings and subsequently do not attend these proceedings must expect a decision based on objections which might arise against such claims in their absence. It is to be expected, for example, that the board will hold the new claims to be unallowable for lack of inventive step (**T 602/03**, **T 991/07**, **T 1403/07**, **T 1587/07**, **T 1867/07**, **T 546/08**, **T 680/10**, **T 795/11**).

Hence, a patent proprietor has to make sure, in the event that he decides not to attend oral proceedings, that all the required documents, including a description adapted to the claims, on the basis of which the maintenance of the patent could be ordered are on file, so that a decision can be taken by the board at the end of the oral proceedings if a given request is found allowable (**T 986/00**, OJ 2003, 554; **T 181/02**, **T 109/02**, **T 776/05**, **T 651/08**). Amended claims filed without an amended description may lead to revocation (**T 1194/08**).

In **T 979/02**, the appellants filed an amended set of claims as a "single main request". The board found that, for reasons of procedural economy, it had no choice but to decide on the admissibility of the request on the basis of whether the request documents were clearly admissible *prima facie*. It concluded that, *prima facie*, both the description and the claims taken alone revealed a number of formal deficiencies.

In the situation where an appellant submits new claims after oral proceedings have been arranged but does not attend these proceedings, the board can refuse the new claims for substantive reasons, specifically lack of inventive step, even if the claims have not been discussed before and were filed in good time before the oral proceedings. This will in particular be the case if an examination of these substantive requirements is to be expected in the light of the prevailing legal and factual situation (**T 1704/06**).

In **T 1867/07** the board concurred with this view and added that a duly summoned party who by its own volition is absent at oral proceedings cannot be in a more advantageous position than this party would have been, had it been present. The voluntary absence of the appellant cannot be a reason for the board not to raise issues it could have and would have raised had the appellant been present, and to decide accordingly (**T 680/10**).

In **T 1587/07**, it was held that the appellant had had to expect that, in its absence, the board would refuse under Art. 13 RPBA to admit its new request, such a refusal being particularly likely where an appellant's attention had been drawn to Art. 13 RPBA in the board's communication. The board explained that, given the appellant's absence from the oral proceedings in this *ex parte* case, it had been unable to discuss with it issues relevant for the purposes of Art. 13 RPBA, such as why features deleted during the proceedings at first instance had been reintroduced at a late stage of the appeal proceedings. Its voluntary absence was not a reason for the board not to raise issues it would have addressed if it had been present (see the similar case in **T 1403/07**).

e) Absence of opponent from oral proceedings

In **T 470/04**, the appellant patentee filed an amended set of 15 claims during the oral proceedings, which were not attended by the respondent (opponent). Since the amended set of claims was based on a combination of claims already on file, had been filed as a response to objections raised by the board during the oral proceedings, did not modify the main point of discussion defined by the decision under appeal and by the statement of the grounds of appeal, i.e. lack of inventive step, and could be easily dealt with by the board at the oral proceedings, the board concluded that the requests were admissible under the circumstances.

In **T 2471/10** the respondents could have reasonably expected amendments like those made in the claims of the appellant's new request and thus they could not have been taken by surprise. Accordingly, the respondents' absence was no obstacle to admitting the appellant's new request into the proceedings and taking a decision on it.

### **4.3. Article 12(4) RPBA - requests not examined at first instance**

#### 4.3.1 General principles

Art. 12(4) RPBA empowers the boards to refuse to admit requests which could have been presented or were not admitted in the first-instance proceedings. In several decisions, they have cited the principles developed by the Enlarged Board of Appeal in **G 9/91** and **G 10/91** (OJ 1993, 408, 420) for the *inter partes* appeal procedure provided for in the EPC (see point 4.3.2). Art. 12(4) RPBA is consistent with the principles developed by the Enlarged Board in relation to the application of Art. 113 and 114 EPC in opposition-appeal procedures (**T 2102/08**). The boards of appeal thus retain, as a review instance, discretion to refuse new material, including requests (claim sets) not submitted during opposition proceedings (**T 240/04**, **T 1705/07**, **T 23/10**, **T 1525/10**). This ensures the fair and reliable conduct of the judicial appeal proceedings (**T 23/10**, **T 1165/10**, **T 301/11**). The admission of new claim requests thus remains a matter of discretion, which may or may not be exercised in a party's favour, on the basis of the facts of the individual case. This legal principle has also been confirmed by the Enlarged Board of Appeal (**R 10/09**, **R 11/11**).

Art. 12(4) RPBA instructs us that consideration is unlikely to be given to new submissions that should have been presented in the first-instance proceedings (**T 339/06**, **T 416/07**). This provision penalises an infringement of the duty to facilitate the first-instance proceedings, i.e. a failure to display due co-operation by submitting facts, evidence and requests as required by a certain point in the proceedings, and so serves to ensure compliance with the requirement of a fair procedure and to expedite processing of the case (**T 28/10**).

In **T 301/11** the board observed that requiring all parties to complete their relevant submissions during opposition proceedings meant that the moment in time when their case had to be complete was not determined by the procedural strategy chosen by them. According to Art. 12(4) RPBA, admission of auxiliary requests into proceedings hinged on the question whether a party to appeal proceedings was in a position to make its submission earlier, and whether it could have been expected to do so under the circumstances (see also **T 23/10**).

Since, in fact, almost every claim request could have been presented before the department of first instance, the question within that context is whether the situation was such that the filing of this request should already have taken place at that stage (**T 273/11**).

In **T 419/12** the board observed that refusing under Art. 12(4) RPBA to admit a request first submitted in appeal proceedings entailed indicating a specific reason why that particular request not only could but should have been submitted at first instance.

The discretionary power under Art. 12(4) RPBA has to be exercised appropriately, which requires the appeal board to consider and weigh up the relevant factors having regard to the particular circumstances of each case (**T 23/10**, **T 1525/10**).

In **T 144/09**, the board noted that the applicability of Art. 12(4) RPBA is not restricted by the time limit for filing the grounds of appeal or any reply thereto. Indeed, a restriction in that sense would not seem to serve any useful purpose and might even result in a possibility of artificially circumventing Art. 12(4) RPBA, irrespective of whether Art. 13(1) RPBA might be a further provision of the rules of procedure which could provide a different barrier to filing such requests.

In both **R 11/11** and **R 13/11** the respective petitioners complained that the board of appeal decided in its discretion under Art. 12(4) RPBA not to admit the petitioner's auxiliary requests. The Enlarged Board held that its case-law clearly showed that petition proceedings may not be used to review the exercise by a board of appeal of a discretionary power if that would involve an impermissible consideration of substantive issues. This has also been confirmed in the specific context of the discretion in Art. 12(4) RPBA.

In **R 4/13** the Enlarged Board stated that in cases where the discretion not to admit requests is exercised by a board in reliance on Art. 12(4) RPBA it is inevitably a matter of speculation whether and in what circumstances the party would have filed such requests. Such speculation is however irrelevant as regards the existence and exercise of the discretion and the board quite correctly did not enter into such speculation. In reality it was not therefore in dispute that the board had jurisdiction not to admit the requests.

#### 4.3.2 Inter partes appeal procedure

##### a) Admission of requests already refused by the opposition division

In the cases below, the opposition division had refused to admit amended claims (as also e.g. in **T 2102/08**, **T 1467/11**).

In **T 28/10**, the board held that, where it had to be decided under Art. 12(4) RPBA whether to admit on appeal submissions already refused at first instance, this amounted to a review of the opposition division's exercise of its discretion under R. 116(2) EPC. Where the way in which a department of first instance had exercised its discretion was challenged on appeal, it was not, according to the Enlarged Board of Appeal's decision in **G 7/93** (OJ 1994, 775), the board's function to review all the facts and circumstances of the case as if it were in that department's place and to decide whether or not it would have exercised such discretion in the same way. If a department of first instance was required under the EPC to exercise its discretion in certain circumstances, it had to have a certain degree of freedom when doing so, without interference from the boards of

appeal. In such cases, a board was only to overrule the way in which the department had exercised its discretion if it came to the conclusion either that it had not done so in accordance with the proper principles or had done so in an unreasonable way, and had thus exceeded the proper limits of its discretion. Only in the event of an improper exercise of discretion was the board to set aside the department of first instance's decision. It would otherwise undermine the discretion conferred on the opposition division under R. 116 EPC (see also **T 902/09**, **T 936/09**, **T 484/11**, **T 241/13**).

In **T 1067/08** the appellant filed a main request which was identical to the sole request not admitted in opposition proceedings. The board stated that appeal proceedings were not just an alternative way of dealing with and deciding upon an opposition and that parties to first-instance proceedings were not at liberty to bring about the shifting of their case to the second instance as they pleased, and so compel the board of appeal either to give a first ruling on the critical issues or to remit the case to the department of first instance. Conceding such freedom to a party (and/or to the department of first instance) would run counter to orderly and efficient proceedings. In effect, it would allow a kind of "forum shopping" which would jeopardise the proper distribution of functions between the departments of first instance and the boards of appeal and would be absolutely unacceptable for procedural economy generally. The board decided not to admit the main request into the appeal proceedings and stated that the exercise of the powers under Art. 12(4) RPBA might also be justified where a party's conduct - e.g. maintaining a single request which the opposition division had declined to admit into the proceedings as an abuse of procedure, and refusing to file amended and/or auxiliary requests - had in effect prevented the department of first instance from giving a reasoned decision on the critical issues, thereby compelling the board of appeal either to give a first ruling on those issues or to remit the case to the department of first instance (see also **T 936/09**, **T 495/10**, **T 2017/14**).

b) Broadening of claims considered by the opposition division

The appeal proceedings do not have the purpose of starting a new examination of different subject-matter, in particular where such subject-matter involves the broadening of claims considered by an opposition division (**T 144/09**, **T 1616/10**).

In **T 144/09**, about one month before oral proceedings in opposition proceedings the patent proprietor added a new feature "space requirement..." into the requests. During the oral proceedings the opposition division raised an objection under Art. 123(2) EPC concerning the inclusion of this feature. It asked the patent proprietor explicitly whether he would file any request that would overcome the objection. However, he didn't file any amended or auxiliary requests. Thus, the patent was revoked. With the statement of grounds of appeal the patent proprietor filed new requests without the space requirement feature. The board stated that no reason could be seen for not having simply deleted the objected feature by way of an auxiliary request during the oral proceedings before the opposition division. A request can be held inadmissible under Art. 12(4) RPBA when added subject-matter held unallowable during proceedings before the opposition division is not removed at least by way of an auxiliary request filed in those proceedings, but only

by way of a request filed during the appeal proceedings (see also **R 11/11** regarding the appellant's petition for review on this matter; see also **T 154/12**).

Also in **T 1616/10** the main request and auxiliary request 1 were not admitted into the proceedings, because claim 1 was broader than all requests underlying the appealed decision and the requests could have been filed in first-instance proceedings.

In **T 1964/12** in view of the objections of lack of novelty and/or lack of an inventive step raised by the opponents, the patent proprietor had decided not to argue novelty and inventiveness of the process claims as granted and had instead, intentionally limited their subject-matter. The board found that, by doing so, it had deliberately chosen not to obtain a decision from the opposition division on the process claims as granted. Allowing it to revert on appeal to the process claims as granted would go against the need for procedural economy. Accordingly, the board decided not to admit the main request into the proceedings.

c) Requests not submitted by proprietor in opposition proceedings

According to established case law it is clear from the wording of Art. 12(4) RPBA that the board in inter partes proceedings has discretion over whether or not to admit requests which could have been presented by the patent proprietor in first-instance proceedings, but were not. The precondition of whether the request at issue could have been presented in the first-instance proceedings relates to the question of whether the presenting party could have been expected to present its request in the first-instance proceedings in the circumstances of the specific case (**T 1538/10**).

In **T 240/04**, the board refused to consider the third auxiliary request because the appellant could have submitted it before the opposition division. Indeed, it even ought to have done so because the amended independent claim concerned a technical problem which was only remotely related to the original one and presented facts not previously examined. The appellant therefore had to expect that the board would be unable to decide the matter. To admit a new request in those circumstances would practically give patentees the opportunity to compel a remittal to the department of first instance as they pleased, which would not only put the opponent at a disadvantage but would also run counter to the principle of procedural economy.

In **T 339/06**, the patent granted comprised several independent claims in the same category. The board found that the new request might force it to give in the appeal proceedings a first ruling concerning only subject-matter relating to a fundamentally different embodiment from those which had been the subject of the opposition division's decision. Thus, in particular, the admissibility of a request first submitted in appeal proceedings and relating solely to an independent claim which, although within the scope of the opposition, had not been considered in the first-instance decision had to be decided on in the light of whether it could also have been submitted earlier (see also similar case **T 38/13**).

In **T 1705/07** the appellant for the first time in the appeal proceedings submitted requests which no longer contained the process claims on which the contested decision was based, but which now only comprised claims of another category, namely product and use claims. The board found that the auxiliary requests submitted for the first time in the appeal proceedings related to fundamentally different subject-matter. Consequently, admitting them into the proceedings would mean that the matters in dispute were fundamentally different from both a substantive and a patent-law point of view, so that the upshot would normally be a remittal to the department of first instance. As a result, the proceedings would last longer and the public would be deprived of legal certainty regarding the validity of the contested patent, which would not be compatible with the principle of procedural economy. If these claims were to be discussed and decided upon in the appeal proceedings, that would enable the appellant to make good this omission - for which it itself bore responsibility - solely for its own benefit. In accordance with the legal principle "*nemo auditur propriam turpitudinem allegans*", however, it was not permissible for any party, in this case the appellant, to benefit from an omission of its own, since this would be unjust to the opposing parties.

In **T 1125/10** the appellant had not reacted to the obviously relevant documents filed shortly before the oral proceedings before the opposition division and had not attended those proceedings. In deciding whether to exercise its power to hold inadmissible requests first submitted in appeal proceedings, what the board had to determine was whether the fact that the new requests had not already been examined at first instance was down to the opposition division or whether the conduct of the appellant had in fact prevented such an examination (as had been found in **T 1067/08**). The board held that it was the appellant's total inaction in the face of obviously relevant new documents which had prevented the opposition division from taking a reasoned decision on the subject-matter of the amended claims based on those documents, meaning that, even though the appellant had again chosen not to attend the proceedings, it now had to decide on the matter at first and final instance or remit the case to the department of first instance. The board therefore decided not to admit the appellant's new requests into the proceedings.

In **T 379/09** the patent proprietor filed, only one month before the oral proceedings before the board of the appeal, a new request aimed at overcoming an objection raised by the opposition division, although the nature of the objection had been set out in the summons to oral proceedings issued by the opposition division. Furthermore, admitting the request would have caused a considerable delay of the procedure.

In **T 936/09** the board stated that under the EPC, there is no legal obligation for the patent proprietor to take an active part in opposition proceedings. However, the patent proprietor is not free to present or complete his case at any time that he wishes during the opposition or opposition appeal proceedings, depending, for example, on his procedural strategy or his financial situation. If a patent proprietor chooses not to respond in substance at all to the opposition, for example by filing arguments or amended claims, or chooses not to complete his submissions at the stage of the first-instance proceedings, but rather presents or completes his case only in the notice of appeal or the statement setting out the grounds of appeal, then he will need to face the

prospect of being held to account for such conduct by the board when, for example, exercising its discretion under Art. 12(4) RPBA. This applies in particular if, as in the present case, all the reasons for revocation of the opposed patent were known to the patent proprietor before it received the impugned decision.

Likewise in **T 1400/11** the appellant (patent proprietor) had not reacted to the opposition filed against its patent, despite having been made aware of all the reasons ultimately leading to its revocation, and had only mounted a defence on appeal. Its approach amounted to circumventing the opposition proceedings in an attempt to shift the whole case to the appeal stage and compel the board to give a first ruling or remit the case to the opposition division. This would also have put the respondent at an unfair disadvantage: if the appellant's main request were admitted and decided upon by the board, the respondent would in effect be deprived of the opportunity to have the matter reviewed at two instances. Since the appellant had not submitted an admissible request on which to base the appeal proceedings, the appeal was dismissed.

In **T 23/10** the board stated that a patentee withholding claim requests in opposition proceedings is precluded from having those requests admitted on appeal, since the patentee would otherwise be permitted to disadvantage the adverse parties by conducting appeal proceedings contrary to its actions before the opposition division (endorsed in **R 13/11**).

Following the decision in **T 23/10**, the board in **T 1165/10** found that, since the patent proprietors could, in the knowledge of the objections of the opponents and the opinion of the opposition division, have submitted further requests in the first-instance proceedings but had deliberately refrained from doing so, the introduction of new requests during appeal proceedings could only be seen as an attempt to start the opposition anew, which amounted to a clear abuse of procedure.

In **T 872/09** none of the patentee's auxiliary requests was admitted into the proceedings because it had deliberately chosen not to defend any of them during the first-instance opposition proceedings, even though it was aware that the opposition division had found its main request unallowable.

In **T 301/11** the board stated that the fact that no auxiliary request was filed in opposition proceedings after time had been requested by and allotted to the appellant could only be seen as a deliberate choice not to have any further request decided upon by the opposition division on any other issue (see also **T 144/09**). The appellant had thereby deliberately prevented a decision of the opposition division on the other grounds of opposition.

d) Resubmission of requests withdrawn at opposition stage

Under Art. 12(4) RPBA, a board of appeal has discretion to refuse to admit requests which could have been presented or were not admitted in the first- instance proceedings. In the boards' view, this applies all the more to requests that were filed and subsequently withdrawn during the first-instance proceedings, since such a course of events clearly



shows that these requests could have been presented in those proceedings. The purpose of an appeal is to review what was decided at first instance and, as a logical consequence, not what was not decided (**T 528/93**, **T 1186/06**, **T 390/07**, **T 1587/07**, **T 361/08**, **T 340/10**, **T 1525/10**, **T 140/12**).

A request which has been withdrawn can, in principle, if admitted by the department or board hearing the case, be reintroduced to the proceedings, whereas a request which has been **abandoned** cannot be resubmitted at a later stage (**T 926/12**).

(i) Request not admitted

One criterion to be considered by a board of appeal in exercising its discretion is whether the withdrawal of a request has prevented the department of first instance from giving a reasoned decision on the critical issues, thereby compelling the board either to give a first ruling on those issues or to remit the case to the department of first instance. In **T 679/09** the withdrawal of auxiliary requests I to IV in the opposition proceedings had exactly this effect. While the appellant may not have intended to avoid a decision of the opposition division on the admissibility of inter alia auxiliary request III, this was the inevitable result of its withdrawal (**T 495/10**, see also **T 933/04**, **T 1067/08**, **T 935/12**).

In **T 1525/10** the board stated that if the appellants had wanted to preserve their right to have any of auxiliary requests I to III considered by a board of appeal, they should have maintained them in opposition proceedings. It is incumbent on both the EPO and users of the European patent system who are parties to proceedings before it to act in good faith. A proprietor who files auxiliary requests by which it delimits the framework of the opposition proceedings and then deliberately withdraws them in order to avoid any adverse decision being reached infringes this general principle by seeking to introduce these requests into appeal proceedings.

The claim request which had been replaced by another request in the proceedings before the opposition division because it was manifest that it would fail, thereby avoiding a formal decision, but which had then been filed again on appeal, was considered inadmissible by the board (**T 390/07**).

In **T 691/09**, the board deemed the belated introduction of a request which had been withdrawn during the oral proceedings before the opposition division to be an abuse of procedure.

In **T 1697/12** the board did not admit the main request into the appeal proceedings which had been withdrawn during oral proceedings before the opposition division. The board stated that even though it might not have been the proprietor's intention to avoid a decision by the opposition division, the inevitable result of the withdrawal of the request was that a decision thereon was avoided since it was not thereby the subject of the reasoned decision of the opposition division. The patent proprietor had argued that in **T 937/11** an auxiliary request, which had been withdrawn before the opposition division, was re-filed and admitted in appeal. The board held that the case underlying **T 937/11** was different from the present one. The auxiliary request in that case contained the

same critical issue as the main request before the opposition division; the withdrawal of the auxiliary request did not therefore have the effect of avoiding a decision of the opposition division on this issue, since it was decided when issuing a reasoned decision on the main request.

(ii) Request admitted

In **T 2599/11** the board admitted the sole request into the appeal proceedings that was withdrawn in opposition proceedings. The board was of the opinion that the purpose of the appeal proceedings as defined in **G 9/91** and **G 10/91** (OJ 1993, 408, 420) did not prevent the appellant from submissions and requests which, after revocation of its patent by the opposition division, reverted to a more broadly worded version in appeal proceedings than the claims defended in opposition proceedings, if these broader claims did not amount to a completely fresh case. With respect to Art. 12(4) RPBA the board had to consider whether the non-filing of the sole request or the withdrawal of the similar request A in the opposition proceedings prevented the opposition division from giving a reasoned decision on the critical issues. The board referred to **T 361/08** according to which it is not the patentee's right to revert to granted claims if these claims did not form a basis for the decision under appeal because the request comprising these claims was withdrawn in the first-instance proceedings. In the case at issue, the board concluded that the critical issues in the opposition and the appeal proceedings were identical in so far as the question had to be answered whether the claimed subject-matter involved an inventive step. Hence, the sole request of the appellant did not bring an entirely fresh case and was admitted into the proceedings (see also **T 467/13**).

In **T 937/11** the main request was identical to auxiliary request 1 which was withdrawn before the opposition division. The board stated that the circumstances of the present case had to be distinguished from the situation underlying **T 1525/10** and **T 390/07** (see above). Because the opposition division's reasons for rejecting the main request evidently applied likewise to the claims of auxiliary request 1, the appellant did not avoid a decision on the ground for opposition when it withdrew auxiliary request 1. Moreover, the appellant neither surprised nor disadvantaged the opposing parties on appeal when it turned the withdrawn auxiliary request 1 into its main request before the board. The appellant maintained the claims that had been rejected by the opposition division, took issue with the ground for revocation upon which the decision on the main request was based and gave reasons as to why the decision taken by the opposition division was incorrect. The appellant thus did not change its case on appeal but sought to obtain a judicial ruling on whether the contested decision with respect to Art. 100(c) EPC was correct.

In **T 883/12** the request was very similar to the request which was withdrawn. The proprietor argued convincingly why it had not been unreasonable to withdraw a number of the auxiliary requests before the opposition division without a decision having been taken on them, namely because the opposition division had deemed, with respect to a higher ranking request, that a particular feature was required in order to allow an inventive step to be recognised; the claims of the withdrawn auxiliary requests did not include this feature. The board stated that the current request was not one which could

reasonably have been filed in the first instance proceedings (i.e. in the sense of being both submitted and maintained, such that a decision on it would be taken by the department of first instance).

e) Request admitted as a normal procedural development

According to established case law, amendments, including amended requests, are usually admitted into appeal proceedings if they are justified by the normal development of the proceedings or can under the circumstances be considered a normal reaction of a losing party (**T 1072/98**, **T 540/01**, **T 848/09**, **T 2485/11**).

In **T 848/09** the board considered the filing of the present main request to be a legitimate and normal reaction to the decision to revoke the patent, because the amendment concerned the addition of a feature of a dependent claim which further limited the subject-matter. Moreover, the request was filed at the earliest possible stage of the appeal proceedings, namely with the statement of grounds (see also **T 881/09**). Even if, theoretically, the patent proprietor might have been able to file this request at the end of the oral proceedings before the opposition division, the board considered the situation to be different from **T 144/09** (see above), since it did not appear that the patent proprietor made a "considered and deliberate choice" not to file the request. Rather, the reasons for the revocation of the patent were not so explicitly known as in case **T 144/09** and plausibly the formulation of a suitable new request overcoming the objection was not immediately evident.

In **T 134/11** the board observed that the mere fact that a request could have been filed in the first-instance proceedings as such does not lead automatically to the inadmissibility of this request (as in this case there would be no discretionary power of the board). On the contrary, normally such a request is inadmissible only in exceptional circumstances. For example, such circumstances may arise where, by the filing of a request only at the appeal stage, a decision by the opposition division on certain issues is avoided and the decision is shifted to the second instance (this is referred to as "forum shopping" in decision **T 1067/08**). In the case at issue it was credible that it was not the appellant's intention to avoid any decision of the opposition division on the current main request. Furthermore the current main request did not raise any new issues but represented merely a continuation of the approach chosen by the appellant all through the first-instance opposition proceedings. The main request thus was admissible. Contrary to the respondent's view, this finding was not at variance with decisions **T 144/09** and **T 936/09**. The reason for not admitting certain requests in these decisions was essentially that the proprietor had not filed any request in the first-instance opposition proceedings which could have overcome the opposition division's objection and in fact had done so only in the appeal.

In **T 2485/11**, the appellant had filed an amended main request and an auxiliary request during first-instance proceedings in an attempt to overcome objections of lack of novelty and inventive step raised in the notice of opposition. At the oral proceedings, the opposition division concluded that the amended requests did not comply with Art. 123(2) EPC. The appellant, unlike in **T 144/09** and **T 936/09**, took the opportunity

offered to it and filed further requests modifying the amendments in the main request, in order to overcome the opposition division's objection under Art. 123(2) EPC. The fact that, after these requests had also been considered to contravene Art. 123(2) EPC, the appellant did not file a further request could not be regarded as an abuse simply because, theoretically, it could have filed amendments. Moreover, the auxiliary requests were filed at the earliest possible stage in the appeal proceedings, namely with the statement of grounds of appeal. Hence, given the circumstances of the case, the appellant's submission of auxiliary requests 1 to 5 was considered to be a normal and legitimate reaction of a losing party (see also similar case **T 2244/11**).

#### 4.3.3 Ex parte appeal procedure

##### a) Admission of requests already refused by the examining division

Art. 123(1) EPC provides that the applicant shall be given at least one opportunity to amend the application of his own volition. R. 137(3) EPC subjects any other amendments to the examining division's consent. As made clear by R. 100(1) EPC, this provision applies analogously on appeal against examining division decisions (**T 1969/08**). According to Art. 12(4) RPBA, the board has the power to hold inadmissible requests which were not admitted in the first instance proceedings.

It is the established jurisprudence of the boards of appeal that the power of the examining division to consent to amendments under R. 137(3) EPC is a discretionary power. According to **G 7/93** (OJ 1994, 775) the way in which the examining division should exercise its discretion to allow an amendment of an application must depend upon the circumstances of each individual case, and must also depend upon the stage of the pre-grant procedure which the application has reached. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion if it comes to the conclusion either that the department of first instance, in its decision, has not exercised its discretion in accordance with the right principles or that it has exercised its discretion in an unreasonable way. The exercise of a discretionary power has to strike a balance between, in particular, the applicant's interest in obtaining adequate protection for his invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. Moreover, the exercise of a discretionary power has to be reasoned, otherwise it would be arbitrary (**T 246/08**). The board in **T 1929/13** referred to further criteria, also set out in the Guidelines: (a) the amendments remedy a deficiency in response to the preceding communication, provided they do not give rise to new deficiencies; (b) the amendments improve the clarity of the description or claims in a clearly desirable manner; (c) need to avoid unnecessary delay and excessive and unjustified additional work for the EPO (Guidelines, H-II, 2.3 – November 2015 version).

##### b) Requests not submitted in examination proceedings

In **T 1178/08** the board pointed out that a board in an ex parte case has discretion over whether or not to admit requests which could have been presented to the first instance, but were not (Art. 12(4) RPBA). It must exercise that discretion having regard to the

particular circumstances of the individual case. The board considered that this view is consistent with the view taken in previous decisions in the different context of inter partes cases (see **R 10/09**, **T 144/09** and **R 11/11**, which rejected the petition for review of **T 144/09** as clearly unallowable, and **T 1007/05**). The board was aware that amended claims filed together with the statement of grounds of appeal have in many cases been admitted into appeal proceedings if they constituted a legitimate reaction to the reasoning underlying the appealed decision. Indeed, such amended claims filed with the statement of grounds of appeal may achieve the goal of "a more defined and controlled initial phase of proceedings" (see **T 1007/05**), in particular if they serve to avoid later amendments. But this does not mean that the board is obliged to admit amended claims solely because they were filed with the statement of grounds of appeal. In the present case, the applicant had been given several opportunities to file amended claims in the first-instance proceedings. No auxiliary requests were filed. In reply to the summons to oral proceedings, which already set out the essential reasons for the later decision, the applicant merely requested a decision according to the file. By presenting its sole and amended request only in appeal proceedings the applicant was making it impossible for the board to examine the contested decision.

In **T 1802/12** the applicant had been given several opportunities to file amended claims in the first-instance proceedings. The board concluded that the auxiliary request could and should have been submitted during the first-instance proceedings. Although the examining division issued only one communication pursuant to Art. 94(3) EPC, the clarity objections raised therein had been reiterated in great detail in the annex to the summons to oral proceedings. In reply to the summons to oral proceedings which had been postponed twice as requested by the appellant, the appellant reacted by not attending them. No new arguments were put forward and the application was ultimately refused by the examining division (see also similar case **T 892/11**).

In **T 1472/08**, the board concluded that the purpose of examination-appeal proceedings could not be to completely reopen the examination proceedings by admitting claims defining features more broadly if those claims could already have been presented in those proceedings and the broader definitions were not apt to overcome the objections raised in the contested decision or by the board (see also **T 2000/09**).

In **T 1212/08**, the examining division had raised objections as to the clarity, novelty and inventive step of the claimed subject-matter in its summons to oral proceedings, prompting the applicant to request a decision on the basis of the documents on file. Auxiliary request 2 having first been filed with the grounds of appeal, the board considered whether this new subject-matter should be examined and decided on for the first time on appeal, or whether it should remit the case to the department of first instance for further prosecution. It found, however, that neither of these procedural options was appropriate and acceptable, taking the view that the feature derived from the description was a new aspect which had no equivalent in the original claims, while remittal of the case would make the proceedings considerably longer. It observed that these two inappropriate options would never have arisen if auxiliary request 2 had been presented on time before the examining division. The applicant ought to have had the examining division exhaustively assess and then decide on all subject-matter for which it

intended to seek protection, even if only on a subsidiary basis, especially if, as it conceded, it wished the board to rule on it. However, it had consciously waived the right to such assessment and decision by the examining division by requesting a decision on the basis of the file immediately after receiving the summons to oral proceedings (see also **T 892/11**).

The board in **T 1108/10** endorsed **T 1212/08**, finding that the two inappropriate procedural options would not have arisen if the sets of claims in the auxiliary requests had been presented on time at first instance. Appeal proceedings were not a continuation of examination at first instance or a second, parallel procedure for the substantive examination otherwise to be carried out by the examining division which applicants could freely opt to launch depending on the circumstances.

In **T 1841/08** the board stated that as the auxiliary requests had not been filed before the examining division, although the examining division repeatedly pointed out deficiencies, admitting these requests into the appeal proceedings would mean that the board would have to examine them for the first time in appeal proceedings, or refer the matter back to the examining division.

c) Resubmission of requests withdrawn during examination

In **T 902/10** the board held that it is established case law that the Boards of Appeal do not admit requests that were withdrawn during first instance proceedings (**T 922/08**); if the board were to admit such a request, it would be contrary to the main purpose of *ex parte* appeal proceedings, which are primarily concerned with examining the contested decision (cf. **G 10/93**, OJ 1995, 172), i.e. with providing the adversely affected party (the applicant) with the opportunity to challenge the decision on its merits and to obtain a judicial ruling as to whether the first-instance decision was correct (see also **T 2278/08**, **T 1306/10**).

In **T 922/08** claim 1 of the main request filed with the statement of grounds of appeal was identical to claim 1 filed as a first auxiliary request before the examining division. During the oral proceedings before the examining division, the applicant withdrew this request of its own volition. The board stated that even if the withdrawal of the present main request during the examination procedure was not considered an abandonment of this request for subsequent appeal proceedings as argued by the appellant, the fact that the request was withdrawn in the first-instance proceedings precluded the issue of a reasoned decision on its merits by the examining division. Reinstating this request upon appeal would compel the board either to give a first ruling on the critical issues, which runs contrary to the purpose of a second-instance ruling, or to remit the case to the department of first instance, which is clearly contrary to procedural economy. It is precisely with the purpose of forestalling these unsatisfactory options that Art. 12(4) RPBA provides the board with the discretionary power to hold inadmissible requests which could have been presented (or were not admitted) in the first-instance proceedings (see also **T 1156/09**, **T 1231/09**, **T 902/10**, **T 184/13**).

In **T 122/10** the auxiliary requests 2 - 4 were filed during the oral proceedings. The claimed subject-matter of the auxiliary requests was identical to the subject-matter of the requests filed with the grounds of appeal which were withdrawn by the applicant in the course of the proceedings. The board stated that although reference was made to Art. 12(4) RPBA which sets out that the board shall take into account everything presented with the grounds of appeal, and thus in this case the auxiliary requests 2 to 4 as presented during oral proceedings, such provision can only be understood to apply if such requests have not previously been **withdrawn** as was the case here. Once the appellant chose to withdraw its earlier filed requests, the provisions of Art. 13(1) RPBA apply since an amendment to the party's case has been made.

d) Feature re-introduced on appeal

In **T 1969/08** the board stated that if a feature objected to as "obscure" by the examining division and omitted from all requests subsequently filed by the applicant is then reintroduced in the claims filed one month before oral proceedings in the appeal proceedings without commenting on the objection raised earlier against this feature, the board may refuse to admit these claims into the proceedings at its discretion under Art. 12(4) RPBA.

e) Interlocutory revision

In **T 1832/10** the board stated that notwithstanding the amendments contained in the claims and carried out by the appellant in an attempt to overcome the objections raised, the examination division did not make use of the possibility of granting interlocutory revision pursuant to Art. 109(1) EPC. However, according to the established case law (**T 139/87**, OJ 1990, 68), an appeal by an applicant was to be considered well-founded within the meaning of Art. 109(1) EPC if the main request included amendments which clearly met the objections on which the refusal of the application has been based. In view of the fact that it is not normally the function of the appeal board to consider and decide upon claims which were filed during the prosecution of the examination but were neither commented nor decided upon by the examining division and in order to give the appellant an opportunity to have the issue decided upon by two instances, the board remitted the case to the first instance.

#### **4.4. Criteria for consideration of amended claims**

##### 4.4.1 Introduction

Under Art. 13(1) RPBA, it is at the board's discretion to admit any amendment to a party's case after it has filed its grounds of appeal or reply. Art. 13(1) RPBA merely lists examples of factors to be considered by the board in exercising its discretion (complexity of the new subject-matter, current state of proceedings and procedural economy) and not an exhaustive set of criteria which must be cumulatively met, such that other considerations and well-established criteria relevant to the admissibility issue can also be taken into account (**R 16/09**, **R 1/13**, **T 253/10**, **T 484/11**). As a rule, the boards' decisions should be based on the issues in dispute at first instance, which does not rule

out the admission of new submissions, but does subject it to the fulfilment of certain criteria, given that no entirely "fresh case" should be created on appeal (on this point, see also **T 356/08**, **T 1685/07**, **T 162/09**).

Thus, in addition to the factors referred to in Art. 13(1) RPBA, the following criteria may, according to settled case law, likewise be decisive: there must be sound reasons for filing a request at a late stage in the proceedings, as may be the case where amendments are occasioned by developments during the proceedings or where the request addresses still outstanding objections. The amendments must be prima facie clearly allowable, and their introduction must not constitute an abuse of procedure. They must not extend the scope of discussion determined by the grounds of appeal and the respondent's reply or introduce new facts on which the other party has had no opportunity to comment. Nor may they lead to an excessive delay in the proceedings. The time at which requests comprising amended claims were filed and the number of amended claim sets are also factors to be considered. Besides the timing of the request, an important factor is whether the various claim versions "converge" or "diverge", in other words whether they develop and increasingly limit the subject-matter of the independent claim of a main request in the same direction and/or in the direction of a single inventive idea, or whether they entail different lines of development because, for instance, they each incorporate different features. The scope of the amendment and the degree of difficulty or complexity involved in examining it are relevant, while the request's chances of success may also be important (see, on the last point, **T 951/91**, OJ 1995, 202; **T 81/03**, **T 942/05**, **T 1474/06**, **T 162/09**, **T 1634/09**, **T 376/10**, **T 683/10**, **T 484/11**, **T 409/12**).

#### 4.4.2 Clear allowability of amended claims

##### a) General

In accordance with the case law, the boards refuse to consider late-filed auxiliary requests on the ground that they are inadmissible where they are directed to subject-matter which prima facie is not allowable. The subject-matter must be so clear and straightforward that it can be easily understood and regarded as allowable. Claims are clearly allowable if the board can quickly ascertain that they do not give rise to new objections and overcome all outstanding objections under the EPC and their patentability could be assessed without giving rise to any difficulty or delay (on this point, see **T 153/85**, OJ 1988, 1; **T 270/90**, OJ 1993, 725; **T 955/91**, **T 92/93**, **T 401/95**, **T 862/00**, **T 1004/01**, **T 1202/02**, **T 922/03**, **T 87/05**, **T 1785/07**, **T 824/07**, **T 615/08**, **T 421/09**). It must be immediately apparent to the board, with little investigative effort on its part, that the amendments made successfully address the issue raised, without giving rise to new ones (**T 1634/09**, **T 1743/09**). There must be no doubt that the late-filed requests meet the formal requirement and that they constitute a promising attempt to counter all outstanding objections (**T 33/07**, **T 321/07**, **T 1650/08**, **T 1168/08**, **T 1634/09**).



## b) Examples

In **T 1004/01**, the amendments to the claims related solely to a narrower definition of features and values which were so clear and straightforward that a person skilled in the art could easily understand them. It was not unusual, the board found, for several auxiliary requests to be submitted in appeal proceedings, since they were the patentee's last opportunity to have the patent maintained.

In **T 1128/10**, it was immediately apparent that the amendments made successfully addressed the issue raised without giving rise to new ones. Therefore, they were admitted into the proceedings.

In **T 70/04**, the board refused to admit an auxiliary request for maintenance of the patent in a further amended form. Although the amendment indicated was a combination of two claims, it was quite extensive and raised new issues which had not yet been considered in the opposition or appeal proceedings, mainly because of a greatly increased number of variables compared to claim 1 as maintained.

In **T 708/05** the board stated that the fact that a board of appeal reverses a conclusion reached in a decision at first instance is a matter which a party must always be prepared for. In the present circumstances the introduction of a disclaimer to establish novelty at this late stage, a proposal which had previously been on the table but which had been abandoned in the meantime by the appellant, is not conduct which warrants the exercise of the board's discretion in the appellant's favour. Furthermore, the subject matter of this new request would still give rise to several objections and would therefore not amount to clearly allowable subject-matter.

In **T 1650/08** the board did not limit the preliminary assessment of the allowability of the late filed requests to issues under Art. 123 EPC but also considered issues of novelty and inventive step on which the opposition was based but which were not dealt within those proceedings. The board did not consider it as a necessary prerequisite that the proposed amendments overcome all outstanding objections with certainty but that they result at least in an arguable case. The board saw no reason in admitting amendments which would result in clearly non-allowable request as this would only lead to unnecessary delays.

### 4.4.3 Response to objections

In general, the boards admit amendments filed in response to comments and objections made by the rapporteur or the other party. However, undesirable procedural delays should be avoided (see **T 38/89**, **T 459/91**, **T 1059/92**, **T 648/96**). Amended claims may be admitted into the proceedings if the introduced amendments are properly justified, e.g. have been filed as a response to objections, evidence or comments which were not part of the decision under appeal but have been raised in writing during the appeal proceedings (**T 397/01**, **T 253/10**). They must also constitute a promising attempt to counter the objection raised (**T 1859/06**).

In the cases below, the amended requests were admitted:

In **T 93/11** the amendments were the direct result of the board's communication. Furthermore, they also overcame the formal objections of the board, which was procedurally expedient. Finally, they simply narrowed down the subject-matter claimed to the core of the invention. The board further considered that there was no general prohibition on reacting to a board's communication by submitting new requests, let alone when these took account of all the objections raised or repeated therein. Furthermore, the number of issues to be discussed at the oral proceedings was substantially reduced.

In **T 794/94**, the board recognised that patents in the field of genetic engineering sometimes gave rise to exceptional problems which made it difficult to formulate a suitable request and therefore amounted to exceptional circumstances justifying late submission of requests designed to meet objections which had already been considered at length. However, there was no right to file an endless succession of new requests in substitution for requests found inadmissible or unallowable by the board (see also **T 607/05**, **T 516/06**).

In **T 1148/97**, the board took the view that late-filed claims could still be admitted if the amendments to the wording of the claims limited the scope of the subject-matter claimed to such an extent that revocation of the patent could be avoided and maintenance of the patent as amended ordered after swiftly conducted proceedings (**T 710/99**, **T 30/03**).

In **T 385/06** the patent proprietor filed amendments before the final date set in the board's communication. In the judgment of the board, these amendments might be seen as a response to the board's observations relating to two grounds for opposition. Hence these amendments were allowable under R. 80 EPC, since they were occasioned by grounds for opposition invoked by the opponents. Since the amendments were filed two months before the oral proceedings and since the patent proprietor specified in detail the passages of the patent specification, essentially dependent claims, on which these amendments were based, the board considered that the parties and the board could reasonably be expected to deal with the amendments without adjournment of the oral proceedings.

In **T 610/94** too, the board admitted sets of claims filed during the oral proceedings because they had been limited and took account of the deficiencies it had identified. In **T 626/90**, there was no question of the appellants having been unfairly taken by surprise, because the amendments in both requests were nothing more than a limitation of the claimed subject-matter to preferred embodiments of the invention as described in the patent in suit (**T 1097/99**). Likewise, in the ex parte proceedings **T 1400/04**, the amended claims were admitted because the oral proceedings did not need to be adjourned.

#### 4.4.4 Converging or diverging versions of claims

It is settled case law that the admissibility of amendments depends, among other things, on whether the amended claims converge with or diverge from the subject-matter previously claimed, i.e. whether they develop and increasingly limit the subject-matter of

the independent claim of a main request in the same direction and/or in the direction of a single inventive idea, or whether they entail different lines of development because, for instance, they each incorporate different features (**T 240/04**, **T 1685/07**, **T 980/08**, **T 1589/08**, **T 1690/08**, **T 1969/08**, **T 162/09**, **T 2513/11**). Whether the claims of auxiliary requests converge is to be understood in the sense that the subject-matter of the lower ranking requests is further defined i.e. with the intention to counter objections with regard to the preceding requests (**T 1134/11**).

In **T 565/07** the board ruled that although patentees too should be able in principle, under R. 80 EPC, to limit a patent's subject-matter by including the features of a dependent claim in response to objections that the granted independent claim was not patentable, if they exercised that right repeatedly in a variety of directions – e.g. by filing requests in parallel or in sequence – the board would end up having to decide in which of several versions the patent was to be maintained. That would be at odds with Art. 113(2) EPC, which required the board to decide upon "the text submitted to it ... by the applicant". In other words, it was up to the patentee to decide the text for further prosecution and also one or more sets of claims which in any event had to be in line with that decision and thus its chosen direction of limitation (on this point, see **T 382/96**, **T 446/00**, **T 1685/07**).

In **T 1685/07**, the auxiliary requests, which had not been filed until after the summons to oral proceedings, said completely different things. The board ruled that, when deciding whether to admit new requests first introduced during the appeal proceedings, it was particularly important to ascertain whether the applicant or patent proprietor submitting more than one request was following a consistent line of defence in its various requests and not, particularly towards the end of the proceedings, using a "screen" of different versions of claims to create, for both the other party and the board of appeal, an obscure and unacceptable procedural situation in which they were obliged to select from a multiplicity of varying versions the one which could in the final analysis be valid.

In **T 1750/08** the board admitted the auxiliary request because the amendment as a further limitation of a feature that underlay the opposition division's decision to maintain the patent in amended form and that was already central to the discussions in the appeal (converging request).

#### 4.4.5 Discretion to admit amended claims at any stage of the appeal proceedings

The board in **T 577/97** found that decisions not to admit auxiliary requests ought, in principle, to be limited to exceptional cases in which the filing of the auxiliary requests could be said to amount to an abuse of procedural rights (see also **T 148/05**). In **T 681/02**, the board observed that, in the specific case underlying the decision in **T 577/97**, the auxiliary request had contained a single amendment in the form of a new claim which corresponded to a granted claim with a further restriction. It could therefore be assumed that the subject-matter of the auxiliary request had been searched, so that, in contrast to the case now in hand, it could be examined definitively in the oral proceedings. In some decisions, the boards cite **T 577/97** in relation to their discretion to accept amended claims at any stage of the appeal proceedings. In **T 1124/04** the board

was confronted at a very late stage in the oral proceedings with the filing of further auxiliary requests. According to the appellant, the necessity of further restricting the claimed subject-matter had become apparent during the oral proceedings, in particular because the board considered D2 as the closest prior art. In line with **T 577/97**, the board held that it has at least the discretion to accept amended claims even at a late stage of the appeal proceedings, thus also during the oral proceedings. Of course, it has to be ascertained that the procedural fairness is not jeopardised by the admission of such late filed claims (**T 952/99**, **T 360/01**, **T 500/01**, **T 872/01**, **T 45/03**, **T 696/04**, **T 148/05**).

#### 4.4.6 Last chance

Some decisions considered whether a patentee should always be given a "last chance" to save its patent. It has been thoroughly discussed and clearly established by the boards of appeal that there is no absolute right for a patentee to such a "last chance" request. On the contrary, the admissibility of a late-filed request is always a matter for the board's discretion (**T 837/07**). Moreover, as stated inter alia in decision **T 446/00**, the concept of a "last chance" suggests one last chance at the end of the proceedings and not multiple "last chances" on numerous occasions during the course of the appeal. However, a patentee is normally given an opportunity to limit his claims even at the oral proceedings, so that he is given a last chance to obtain a patent (**T 577/97**, **T 707/08**).

In **T 1067/10** the board stated that the argument of its being the patentee's last chance in view of the non-admission of requests cannot be accepted since the appellant had had ample opportunity to file amended sets of claims at an earlier stage in the proceedings and did not need to wait until the oral proceedings to do so.

#### 4.4.7 Change of subject-matter

In **T 1273/04**, the board held that an amended claim belatedly filed in oral proceedings could only be admitted if it was clearly allowable by virtue of a clearly permissible amendment. However, this principle had to be tempered in examination appeal proceedings by having regard to the extent to which the application had been examined. Applying this to the case in hand, the board found that claim 1 of the main request had been amended in a clearly permissible manner. However, the amendment had shifted the subject-matter claimed in a divergent manner which would require a new study of the prior art and potentially even review of the search in order to assess novelty. The main request was therefore refused.

In **T 651/03**, the board found that claim 1 of the first auxiliary request had been amended in such a way that its category had been changed from a product claim to a use claim. The board concluded that this change extended the patent protection and therefore ran counter to Art. 123(3) EPC 1973. The late-filed request was therefore clearly non-allowable.

In **T 267/09** the board pointed out while the whole discussion in the opposition proceedings and in the appeal proceedings up to and including the oral proceedings

before the board was focused only on the independent product claims. The late filed auxiliary requests were directed to method claims. With this change in the category the appellant shifted its case in an unexpected manner in an entirely different direction and in fact created another case. Admitting these requests into the proceedings, taking the respondent and the board by surprise, would run counter to the need for procedural economy and to the principle of procedural fairness.

#### 4.4.8 Need for additional search

##### a) General

It was already apparent from the boards' early decisions that late-filed claims that might have required an additional search would not be admitted into the proceedings. In **T 14/02**, intended requests as suggested by the respondent in the oral proceedings would not just have involved a minor change in the wording of claim 1 but rather major limitations of the claim which in all likelihood would have required a new search by the appellant and could have caused a remittal to the first instance (see also **T 51/90**, **T 270/90**, OJ 1993, 725; **T 25/91**). In **T 48/91**, the board refused the amended claims as inadmissible because they contained additional features the impact of which was either unclear or impossible to assess without further investigations such as carrying out proper comparison tests (see also **T 234/92**, in which a feature from the description was introduced to claim 1, so that an additional search might have been required, and **T 1105/98**, in which an additional search was needed).

In **T 870/07**, the board admitted the main request filed during the oral proceedings as it was in no doubt that the additionally claimed subject-matter had also been searched. The situation was not new in the sense that the board was faced with an incomplete search preventing it from examining the claimed subject-matter.

##### b) Features taken from the description – Art. 13(3) RPBA

In some cases, requests filed after the scheduling of oral proceedings refer to features derived solely from the description. This raises the question of whether such features were included in the original search, or whether an additional search is necessary. It cannot be automatically assumed that they were considered in the original search or that the opponent is responsible for carrying out such a search (**T 1732/10**, see also **T 447/09**, **T 1273/11**). In **T 1650/12** and **T 2482/10** the question was raised of whether it was the opponent's duty to carry out a search with regard to late-filed amendments taken from the description or whether it was a matter for the opposition division to do so in accordance with the Guidelines. According to the consistent case law of the boards of appeal, if an additional search is needed to assess the patentability of claims amended with features from the description at such a late stage that either the oral proceedings must be adjourned or the case must be remitted to the department of first instance for further prosecution, Art. 13(3) RPBA is against the admissibility of such claim requests. Under Art. 13(3) RPBA, amendments to submissions after oral proceedings have been arranged are not admitted when they raise questions that the board or the other party cannot be expected to address without adjourning those proceedings. Remittal of the

matter to the opposition division to conduct such a search would amount to the same thing as adjourning oral proceedings, and this would also be necessary if the opponent were obliged to carry out such a search (**T 1273/11**, **T 2575/11**).

If an additional search is needed to assess the lack of patentability asserted as the ground for opposition, so that either the oral proceedings must be adjourned or the case must be remitted to the first-instance department for further prosecution, it is unreasonable to expect the other parties to accept this (**T 494/04**).

In ex parte case **T 979/07**, the board said that admitting a set of claims filed only in oral proceedings and necessitating an additional search because it shifted the claimed invention to other technical matter would de facto give applicants in appeal proceedings carte blanche to get oral proceedings postponed or the whole examination procedure reopened. That would be at odds with the requisite procedural economy (see also **T 407/05**, **T 1123/05** and **T 764/07**).

c) Carrying out an additional search

In **T 2127/09**, the search division considered that the claimed subject-matter was merely an obvious implementation of game rules on known hardware and did not carry out a search. At the oral proceedings before the board the appellants (applicant) submitted an amended set of claims as sole request in response to the board's objections. The board stated that it was necessary to carry out an additional search in accordance with R. 63 EPC. The board emphasised that remittal should be seen as an exceptional procedural possibility, and that it had also to be examined whether the applicant could have been expected to have made earlier the amendments which were made during the appeal before the board (see Art. 12(4) RPBA), and thereby could have requested the examining division to perform the necessary search. The board decided to admit the amendments to the claims.

#### 4.4.9 Dependent claims

In **T 1060/04**, the amended claim 1 resulted from a combination of claim 1 as granted and features of a number of dependent claims as granted. The appellant patentee had submitted the relevant claims to the board during the oral proceedings. On the question whether the patentability of the dependent claims had to be examined, the board held, inter alia, that the fact that an opposition directed to the subject-matter of an independent claim also implicitly covered subject-matter defined in claims dependent on the independent claim (see **G 9/91**, OJ 1993, 408, point 11 of the Reasons) did not necessarily mean that the parties and the board had to be prepared to assess the allowability and patentability of amended independent claims as granted, including the subject-matter of claims dependent on them, at any time during the proceedings (see also **T 794/94**).

In **T 67/09**, the board rejected the appellants' view that auxiliary requests 1 and 2 were admissible because the amendments were essentially limited to a combination of granted claims the subject-matter of which had already been challenged in the

proceedings at first instance. Given that only the patent as granted had been discussed in both the opposition and the appeal proceedings, neither the board nor the respondent had had any reason to look at the subject-matter of dependent claims when preparing for the oral proceedings, especially since no request directed to them had previously been filed (see also **T 1752/09**).

In the *ex parte* case **T 569/08**, the belatedly filed auxiliary request resulted from a combination of features derived from a number of original claims. The board observed that original dependent claims which had been searched were normally predestined to serve as fallbacks in the event that an independent claim was not allowable. However, that was not so throughout the entire proceedings since, depending on the procedural stage, amendments to the application might be subject to the discretion of the examining division or board. In the case at issue, the board considered it incompatible with due procedural economy to shift the subject-matter to be decided on in the appeal proceedings to subject-matter which could have been presented to the examining division and which would have to be examined as to inventive step for the first time by the board. Thus, even a combination of originally filed claims could be disregarded on appeal.

#### 4.4.10 Number of auxiliary requests

In **T 516/06** the board stated that there is no right to file an endless succession of new requests in substitution for requests found inadmissible or unallowable by the board. Proceedings must come to an end some time. If the contrary was true, oral proceedings could easily be misused, in particular in *ex parte* proceedings, to test the board's opinion as to what subject matter might be patentable and to tailor claims accordingly. In such cases, while not "holding the pen", the board would nonetheless be the ghost-writer of what was ultimately claimed.

In **T 309/09**, the board had doubts as to whether the number of auxiliary requests could generally be considered a factor on the basis of which their admission under R. 137(3) EPC could properly be denied outright. Whilst it did not wish to rule out that a large number of auxiliary requests might be a sufficient reason in specific cases, it decided that the question could be left unanswered in the case before it, as in any event six auxiliary requests could not automatically be considered excessive.

In **T 280/11** the board found that the patent proprietor, which in written proceedings had filed a very high number of requests (a main request and 681 auxiliary requests, 454 of them just three days before the oral proceedings) and had submitted a further four auxiliary requests during the oral proceedings, had to expect a significant portion of the time available on the day of the proceedings to be taken up solely with the administrative handling of all the 686 requests. After the board had discussed and rejected these requests at the oral proceedings, or (in the case of new auxiliary requests 682 to 685) after lengthy debate had refused to admit them into the proceedings, the proprietor could not reasonably expect to be granted a further break late in the afternoon of the same day to allow further requests to be drafted and submitted.

#### 4.4.11 Amended claims not admitted with divisional applications pending

In **T 840/93** (OJ 1996, 335) the board held that in the light of **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), special attention must be given to late-filed requests at the appeal stage when divisional applications are still pending. If the distinction between the subject-matter of the divisional applications was unclear and some of them were still pending before the department of first instance, it was inappropriate to admit, during oral proceedings at the appeal stage after opposition, new requests which are neither immediately allowable nor bona fide attempts to overcome objections raised.

In **T 28/92** the claims were not obviously allowable and the alternative of admitting the requests, but referring the matter back to the department of first instance for further examination, was not acceptable, particularly as there were still pending divisional applications of the application on which the patent in suit was based. The board would not wish to increase the number of proceedings in which much the same subject-matter was already being considered by various instances of the EPO.

#### 4.4.12 Board's communication

In **T 1168/08**, the board stated that the appellants' justification for the late filing of the new requests, namely that they had been filed in reaction to the board's communication, was not acceptable here, because the argumentation in support of the board's preliminary opinion that the claimed subject-matter had no basis in the application as originally filed and lacked novelty corresponded in substance to the reasoning of the respondent in reply to the grounds of appeal. A board communication under Art. 15(1) RPBA is intended as guidance for the oral proceedings. It helps the parties to focus their argumentation on issues that the board considers crucial for reaching its decision. Where the board's communication contains a preliminary opinion based solely on the issues raised by the parties and their arguments, that communication cannot be taken as a justification for submitting new requests that the parties could have filed earlier (see also **T 253/10**, **T 582/12**).

### 4.5. Reinstating broader claims in appeal proceedings

#### 4.5.1 General

The limitation of claims may represent attempts to respond to objections by the EPO or an opponent without necessarily involving any immediate intentions of substantive abandonment. In this case the question arises of whether the applicant or patent proprietor can reinstate broader claims which had been proposed at an earlier stage of the proceedings.

Previously, the boards consistently ruled that a proprietor who has defended his patent to only a limited extent in opposition proceedings is not prohibited a priori (i.e. except in specific cases where the *reformatio in peius* prohibition applies or there has been abuse of procedure) from returning to a broader version of his patent, including the granted version, in subsequent appeal proceedings. Intervening limitations of the patent do not



imply any express abandonment of parts of it but are to be regarded merely as attempts to word the patent so as to delimit it against objections (see inter alia **T 123/85**, OJ 1989, 336; **T 296/87**, OJ 1990, 195; **T 331/89**, **T 900/94**, **T 699/00**, **T 880/01**, **T 794/02**, **T 934/02**, **T 1018/02**, **T 386/04**, **T 1276/05**). In **T 331/89**, the board found the reactivation of earlier claims to be an abuse of procedure because the request had not been filed until the oral proceedings and, in view of its content, was not immediately allowable.

This case law must, however, be interpreted in the light of Art. 12(4) RPBA.

Since adoption of R. 116(2) EPC and Art. 12(4) and 13 RPBA, the relevant legislation differs from that applicable at the time of the decision in **T 123/85**. Whether sets of claims presented on appeal are to be considered is therefore not to be determined in accordance with the case law established in that decision, but rather in accordance with the procedural rules now applicable to appeal procedures and the specific circumstances of the case. Accordingly, the admission of auxiliary requests is subject to Art. 12(4) RPBA, which provides that the boards may at their discretion disregard sets of claims which were found to be late filed and not admitted at first instance or which ought already to have been presented at first instance. This discretion also applies to sets of claims presented for the first time on appeal as a means of defending a broader version of the patent than that at issue in the opposition proceedings (**T 28/10**, **T 36/12**, **T 467/13**).

Referring to **T 28/10**, the board stated in **T 671/08** that there was no absolute right of the patent proprietor to revert in appeal to the patent as granted nor that he is in principle hindered from doing so. There will be cases, as the present case shows, in which the admission of such a request poses no additional work and other cases in which such a request may even constitute an abuse of the proceedings. It follows thus that if such a request is submitted in appeal the board has to exercise its discretion under Art. 12(4) RPBA and decide whether to admit or not such a request.

In **T 1282/05**, on being summoned to oral proceedings the appellants had filed new requests, the claims in the amended requests relating to matter not previously claimed or discussed in the appeal proceedings. The independent claims in these requests were worded far more broadly than the matter previously claimed in the appeal proceedings and essentially constituted a return to the original claim 1. The board found that the amendments could not be regarded as a response to objections in the summons, nor had the appellants given any reasons for them. Moreover, the statement of grounds gave no indication that such a return towards the originally claimed matter was intended. Hence the appellants' actions constituted an infringement of Art. 12(2) RPBA. Furthermore, comparable requests could have been submitted before the department of first instance (**T 1420/06**).

In **T 2075/11** the patent as granted could clearly have been defended in the opposition proceedings but the appellant (patent proprietor) had instead chosen to limit it, which meant that no first-instance decision had been taken on the granted version (see also similar case **T 933/04**). The board did not regard the appellant as having abandoned the patent as granted but it was of the firm view that admitting the request for maintenance as granted at the appeal stage went against the principle of procedural economy. If

admitted, the board would be compelled to give a first ruling on the request, a task incompatible with its role as a review body, or to remit the case, which would considerably delay the proceedings and make them more costly for the other party. The very purpose of Art. 12(4) RPBA was to avert such a situation.

In **T 796/02**, the board held that it amounted to an abuse of procedure to withdraw a request with broader claims in appeal proceedings in order to prevent the board from taking a negative decision on it, but then re-introduce those broader claims before the opposition division, after a remittal of the case for further prosecution on the basis of much more limited claims was obtained.

#### 4.5.2 Patent revocation

According to **G 9/92** and **G 4/93** (OJ 1994, 875), in opposition appeal proceedings the extent to which the patent proprietor is entitled to make amendments depends on the result of the first instance proceedings and on whether the patent proprietor himself filed an admissible appeal or is merely the respondent (on this point, see Chapter IV.E.3.1 "Binding effect of requests - no reformatio in peius").

Where the patent proprietor is appealing against the revocation of his patent, he is entitled to revert to a more broadly worded version of the patent, and in particular the one as granted, even if he had filed a restricted version at the commencement of appeal proceedings (**T 89/85**; **T 296/87**, OJ 1990, 195; **T 373/96**, **T 65/97**, **T 564/98**, **T 2285/08** and **T 476/09**). According to **T 386/04** an appellant-proprietor, whose patent has been revoked, is entitled to seek maintenance of the patent as granted even though its main request before the opposition division had only been the maintenance of the patent in a more limited form. Only in exceptional circumstances, where it would amount to an abuse of procedure, it should not be allowed to revert to the granted claims. This long standing principle is not contradicted by decisions **T 528/93** or **T 840/93** (OJ 1996, 335), which are concerned with new claims raising new issues, and is not contrary to the statement by the Enlarged Board of Appeal in decision **G 9/91** (OJ 1993, 408) concerning the purpose of an appeal (see also **T 1276/05**).

In **T 933/04**, the appellant's main request was derived from the patent as granted. This granted version had not, however, been the subject of the opposition division's decision. It had indicated that the patent as granted (now the main request) was not novel, with the result that it had not been pursued. The board refused to admit the main request because the appellant ought not to have withdrawn it from the proceedings if it had intended to pursue it (see also **T 1067/08**, **T 2075/11**).

In **T 476/09** the conduct of the appellant did not amount to an abuse of procedure. It was true that the claims of the request before the opposition division were more restricted than the claims of the present requests submitted by the appellant with the statement of grounds of appeal in that the claims before the opposition division defined the external additive to include hydrophobic titanium oxide and hydrophobic silica. However, this definition of the external additive had no bearing on the opposition division's decision. Therefore, the fact that this definition was not contained in the claims of the present

requests did not raise any new issues which have not yet been dealt with by the opposition division. Hence, the appellant did not leave the factual and legal scope of the first instance opposition proceedings with its new requests in appeal proceedings.

## **4.6. Circumstances extraneous to proceedings**

### **4.6.1 Introduction**

In some cases, the parties justify the amendment of claims with circumstances extraneous to the proceedings. The boards have refused to accept the following justifications: **T 160/89** (heavy workload); **T 148/92** (doubts as to the definitive embodiment of the invention; appellant's frequent need to travel); **T 626/90** (lack of timely instructions), **T 583/93** (OJ 1996, 496; lack of communication between the patentee and the licensee); **T 575/94** (new instructions); **T 1697/13** (necessary consultation of the applicant) and **T 2575/11** (transfer of the patent and change of representative).

In **T 764/03**, the only reason given by the appellant for the failure to introduce the auxiliary requests at an earlier stage of the proceedings was that the patentee had taken so long to reach a decision on the patent content which it considered useful to prosecute from a competition point of view. The board observed that only the rules and the circumstances of the appeal proceedings in question could be considered when determining at what stage of appeal proceedings requests had to be filed, when they had to be regarded as belated and what the legal consequences of such belatedness were. Circumstances extraneous to the proceedings, such as e.g. licensing negotiations with competitors or infringement proceedings were not factors which could be taken into account in assessing when in the appeal proceedings requests affecting the patent's content had to be filed, unless they were put forward as grounds for a request for accelerated handling of a case (see also **T 356/08**, **T 28/10**).

### **4.6.2 Change of party or representative**

According to the established case law of the boards of appeal, a change of representative usually results from the party's own decision and is generally not an acceptable ground for late filing (**T 1748/08**).

In **T 830/90**, the board refused to accept a change of representative as justification for the late filing of the requests. The same view was taken by the board in **T 382/97**, in which it held that the mere change of a representative was not a valid ground justifying the late filing of requests since it was an arbitrary move by the relevant party by which it could influence which procedural actions had to be considered as belated and which as timely. It was evident that such a situation would be contrary to any reasonable procedural conduct. Only if the change of representative was necessitated by proven exceptional and extraordinary circumstances might the board come to different conclusions.

In **T 1032/96**, the board held that the late transfer of the case to the representative owing to the illness of a colleague was not sufficient justification for the failure to submit the set of claims until just three days before the date of the oral proceedings. The claims were deemed to be late.

In **T 1282/05**, the board held, *inter alia*, that a withdrawal of the representative did not justify the late return to broader subject-matter which had not yet been discussed in the appeal proceedings because the board had to assume that all actions of the former representative had been performed in consultation with and with the approval of the appellant, to whom they therefore had to be imputed.

In **T 1585/05** the board noted that the fact that the late filed requests were filed by a new representative bore no weight on the admissibility of the claims, since the ultimate responsibility for filing requests always remains that of the proprietors, so that the Board has to consider that, unless otherwise proven, all actions undertaken by the former representative were undertaken in agreement with the proprietors and thus expressed their desires (see **T 1420/06**). The new representative was therefore bound to continue the proceedings from the point they had reached when he took over from his predecessor.

A change in the person handling the case is not an extraordinary circumstance justifying the filing of a request at a late stage in appeal proceedings, especially where the objections to be overcome were raised at the outset (**T 1457/08**).

A change of professional representative is not an objective excuse for not filing appropriate requests along with the statement of grounds of appeal, and in particular for not maintaining the main request underlying the decision under appeal. In fact, this rather presupposes a deliberate choice by the appellant. In any case, a change of representative at the time of filing the statement of grounds of appeal certainly cannot justify the filing of the main request only one month before the date of oral proceedings before the board (**T 1351/10**).

## **5. Parallel proceedings**

The board in **T 18/09** stressed that, in the case of parallel proceedings before a national court and the boards of appeal, parties should inform both tribunals of the position as early as possible and ask the appropriate tribunal for acceleration in order to avoid duplication of proceedings. Whether acceleration is requested by one party, or both or all parties in agreement, or by a national court, all parties must accept a strict procedural framework including short time limits. It must also be understood that acceleration can have no effect on the equal treatment of all parties and cannot confer any advantage on any one party.

## **6. 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.

### **6.1. Closure of the substantive debate**

The EPC does not prescribe when the substantive debate should be regarded as closed. Particularly if oral proceedings take place but end without a decision being delivered, it has often had to be decided whether or not subsequently filed documents should be taken into consideration. A distinction needs to be made between the following situations:

- (i) the board does not announce its decision at the end of the oral proceedings, but reserves the right to deliver its decision subsequently in writing, but without explicitly stating that the debate is closed;
- (ii) the board declares at the end of the oral proceedings that the debate is closed and announces that the decision will follow in writing.

In the first case, the boards have generally found that submissions filed after the oral proceedings were out of time and could be considered only if they were relevant (Art. 114(2) EPC 1973). See, for example, **T 456/90** and **T 253/92**.

In the second case, two solutions have been adopted by the boards. One - adopted in **T 762/90** - consists of stating under "Summary of facts and submissions" that a document was filed after closure of the debate and that the board would not consider it. Under this option, the document was automatically excluded from the file. This solution was also adopted in **T 411/91**.

The other solution - adopted in **T 595/90** (OJ 1994, 695) - is to rule that submissions filed after closure of the debate could not be taken into account unless the board decided to reopen the debate. Under this option the submission had by implication to be examined.

In **T 1629/06**, the day before the oral proceedings, the appellant announced its intention not to attend the oral proceedings and requested, without reasons, that the procedure be continued in writing. The board dismissed the request.

#### **6.1.1 Decision taken as the file stands**

In **T 784/91** the board took the view that if in ex parte proceedings the appellant indicated that he did not wish to comment on the case, this could be construed as signifying agreement to a decision being taken on the case as the file stood.

#### **6.1.2 Proceedings after delivery of the decision**

In **T 843/91** (OJ 1994, 818) it was stated that once a decision had been taken the board was no longer empowered or competent to take any further action apart from drafting the written decision (see also **T 296/93**, OJ 1995, 627, where the board disregarded

statements filed after the announcement of the decision, and **T 515/94**). In **T 304/92** the respondent's request to file new claims after the chairman had announced the board's decision was rejected, but recorded (with the response) in the summary of facts.

However, in **T 212/88** (OJ 1992, 28) a request for apportionment of costs submitted after the substantive decision had been announced at the end of the oral proceedings had been, exceptionally, admitted. Although the practice of the boards was that all requests by parties, including any request as to costs, should be made before any decision was announced in oral proceedings, this practice had not been published and so there was no reason why parties or their representatives should have been aware of it. In **T 598/92** an error in a claim was corrected at the request of the appellant one day after the decision was delivered at the end of oral proceedings.

After the board in **T 1518/11** had announced its decision to dismiss the appeal against the refusal of the application in suit and closed the oral proceedings, the appellant stated by letter that the appeal was withdrawn. However, since the decision had already been announced at the oral proceedings and thereby became effective on that day, the appeal proceedings had already terminated (following **T 843/91**, OJ 1994, 818) and the appellant's submission made after the announcement of the board's decision was without any legal effect. Furthermore, a statement of withdrawal of appeal made by the (sole) appellant after the final decision of the board had been announced at oral proceedings did not relieve the board of its duty to issue the decision in writing, setting out the reasons for the decision, and notify the appellant of it (following **T 1033/04**).

## **6.2. Interlocutory decisions of a board**

The finding that an appeal is admissible may be given in an interlocutory decision. Art. 110 EPC and R. 101 EPC show that the boards have to examine whether an appeal is admissible before considering its merits. An interlocutory decision might be appropriate where the points of law concerning admissibility are of general significance and require a speedy decision (see **T 152/82**, OJ 1984, 301; and also **T 109/86** of 20.7.1987). (There is an exception where the appeal is clearly unallowable but admissibility cannot be checked, see IV.E.2.8 "Cases where admissibility of appeal need not be considered").

The boards have also issued interlocutory decisions on re-establishment in respect of the time limits for appeal (**T 315/87** of 14.2.1989 and **T 369/91**, OJ 1993, 561), on the admissibility of an opposition (**T 152/95** of 3.7.1996), and to inform the public rapidly (pending the final decision) that a mention of grant in the European Patent Bulletin was incorrect because of the appeal's suspensive effect (**J 28/94**, OJ 1995, 742). Referral of a point of law to the Enlarged Board is also an interlocutory decision.

### 6.3. Withdrawal of the appeal

#### 6.3.1 Article 114(1) EPC and withdrawal of the appeal

Under Art. 114(1) EPC the EPO shall examine the facts of its own motion in proceedings before it. The question has arisen whether this is relevant in the event of the withdrawal of the 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. The Enlarged Board found that the provision of Art. 114(1) EPC 1973 did not allow for continuation of the proceedings once the appeal had been withdrawn. This was evident from the legislative rationale of the EPC. If Art. 114(1) EPC 1973 applied to all withdrawal situations, then the R. 60(2) EPC 1973 exception for oppositions would be superfluous. Nor was withdrawal of the appeal covered by "relief sought" within the meaning of Art. 114(1), second part of sentence, EPC 1973 to which the EPO would not be restricted in examining the facts; it constituted a procedural act not requiring the consent of the relevant board (point 8 of the Reasons). The appeal procedure was that proper to an administrative court, so any exception from general procedural principles such as the "principle of party disposition" had to be supported by much weightier grounds than in administrative proceedings. Neither Art. 114(1) EPC 1973 nor the interests of the general public or the respondent constituted arguments against this interpretation. Art. 114(1) EPC 1973 was restricted to the examination of the facts. The interests of the general public were primarily safeguarded by the opposition system. It could be assumed that the patent did not disturb those who had not filed an opposition, so there was no need to continue the appeal proceedings in order to safeguard their interests. Nor were the respondents' interests any more in need of protection if they had not themselves filed an appeal, as was explained in detail in **G 2/91** (OJ 1992, 206). Finally, the Enlarged Board pointed out that when the sole appellant withdrew his appeal, the suspensive effect of the appeal lapsed and the opposition division's decision thus became final as regards the substantive issue.

#### 6.3.2 Board's duty to issue decision when appeal is withdrawn after the decision is announced

A statement of withdrawal of appeal made by the (sole) appellant after the final decision of the board has been announced at oral proceedings does not relieve the board of its duty to issue and notify to the appellant the decision in writing setting out the reasons for the decision in order to conclude the decision-taking procedure triggered by the announcement of the final decision at the oral proceedings, which had already become effective under **G 12/91** (OJ 1994, 285) (**T 1033/04**).

### 6.3.3 Board's powers to decide on issues after withdrawal of the appeal

If the sole appellant says he has withdrawn his appeal, but the parties are in dispute as to whether he did so admissibly, then the board is empowered to rule on that issue (**T 659/92**, OJ 1995, 519).

After withdrawal of an appeal it is still permissible to decide on ancillary questions (**T 85/84**). Thus in **T 21/82** (OJ 1982, 256), **J 12/86** (OJ 1988, 83), **T 41/82** (OJ 1982, 256) and **T 773/91**, the board of appeal dealt with requests for reimbursement of the appeal fee filed after withdrawal of the appeal, and in **T 117/86** (OJ 1989, 401), **T 323/89** (OJ 1992, 169), **T 614/89** and **T 765/89** with requests for apportionment of costs.

### 6.3.4 Withdrawal of appeal after filing of intervention

According to **T 195/93**, the fact that the appellant withdrew his appeal after an intervention was filed could not immediately lead to termination of the proceedings. The board had to consider the admissibility of the intervention (see also Chapter IV.C.3. "Intervention").

### 6.3.5 Partial withdrawal of appeal by sole appellant and opponent

Partial withdrawal of an appeal by the sole appellant (opponent) following an allowable limitation of the patent's subject-matter under Art. 123 EPC 1973 during appeal proceedings deprived the board of its discretionary power to examine the substantive merits of the remaining, limited subject-matter. The patent had to therefore be granted in its amended form (**T 6/92** and **T 304/99**). In **T 127/05** the board recalled that an opponent who was the sole appellant had the possibility of withdrawing his appeal if he found that the outcome would be disadvantageous to himself. In **G 7/91** and **G 8/91** (OJ 1993, 346 and 356) the Enlarged Board of Appeal ruled that as far as the substantive issues settled by the decision at first instance were concerned, appeal proceedings were terminated when the sole appellant withdrew his appeal. It followed that an opponent who was the sole appellant could, if he so wished, force the non-appealing patent proprietor to "live with" a deficiency which he had introduced. A patent proprietor who filed an appeal could prevent himself from being placed in such a situation. The board also did not agree that decision **G 1/99** (OJ 2001, 381) restricted amendment to a response to an objection first raised in appeal proceedings.

### 6.3.6 No withdrawal of appeal with retrospective effect

The mere fact that a representative had filed a notice of appeal before taking note of the appellant's adverse instruction did not justify a correction to the effect that no appeal had been filed. The request amounted to a withdrawal of the appeal with retrospective effect, which was not provided for in the EPC (**T 309/03**, OJ 2004, 91).



### 6.3.7 Request for withdrawal of appeal to be unambiguous

A notice of abandonment of the patent was held to be tantamount to withdrawing the appeal in **T 1003/01**. In **T 60/00**, however, the appellant's statement that it had decided not to pursue the appeal was not regarded as unambiguous withdrawal of the appeal, derived from the principles laid down in earlier case law: effective withdrawal does not depend on the term "withdrawal" being used (**J 7/87**, OJ 1988, 422); a request for withdrawal should only be accepted without question if it is completely unqualified and unambiguous (**J 11/80**, OJ 1981, 141); and where any doubt as to a party's intent exists, the declaration made can be construed as a withdrawal only if the related subsequent facts confirm that such is the party's true intent (**J 11/87**, OJ 1988, 367). In **T 2347/11** the letter of "withdrawal" of an application in this case did not relate unambiguously and without doubt to the case at issue and thus could not be understood as withdrawal of the appeal.

According to the board in **T 1244/08**, where an appellant holding a patent revoked by an opposition division stated that it did not agree with the text of the patent as granted and was not proposing an amended one, this was tantamount to a withdrawal of the appeal and immediately brought the proceedings to an end.

### 6.3.8 Conditional withdrawal of appeal

Procedural declarations may be made with the proviso that certain conditions are met, as long as a case is already pending (**J 16/94**, referring to Art. 108, first sentence, and R. 64(b) EPC 1973; **T 854/02**) and these conditions do not concern facts outside the proceedings (**T 502/02**). Thus, whereas a conditional appeal is not possible, the conditional withdrawal of an appeal may be valid (**T 6/92**; **T 304/99**). However, the withdrawal of an appeal can take effect only if the appeal is still pending (**T 1402/13**).

When an appellant has clearly withdrawn his appeal, the appeal proceedings can be closed without a reasoned written decision, even if the appellant has appended to his declaration of withdrawal an obviously non-allowable request for a refund of the appeal fee (**T 1142/04**).

## 6.4. Deemed withdrawal of patent application

If a European patent application is finally deemed to be withdrawn after an admissible appeal against a decision refusing it has been filed, the appeal can usually be considered disposed of, because there is no possibility of a European patent being granted for the application. However, where, as in the case before the board, the sole aim of the appeal is to obtain a finding by the board that a substantial procedural violation occurred in the first instance proceedings, such that the appealed decision is to be set aside and the appeal fee reimbursed, the appeal cannot be dealt with in this way. In these circumstances the appellant has a legitimate interest in receiving a decision on the merits of the appeal (**T 2434/09**).

## **7. Remittal to the department of first instance**

### **7.1. General**

Under Art. 111(1) EPC the board of appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed. 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.

### **7.2. Remittal following filing or late submission of relevant new document**

#### **7.2.1 Opposition appeal proceedings**

If a new citation (such as an anticipatory document) is filed during opposition appeal proceedings, the question arises whether the case is to be remitted to the department of first instance. In board of appeal case law (see **T 258/84**, OJ 1987, 119; **T 273/84**, OJ 1986, 346; **T 215/88**, **T 611/90**, OJ 1993, 50; **T 621/90**, **T 166/91**, **T 223/95**), the prevailing view is that, if a document filed for the first time in opposition appeal proceedings is relevant enough to be taken into consideration, the case should as a rule be remitted under Art. 111(1) EPC 1973 to the department of first instance so that the document can be examined at two levels of jurisdiction and the patent proprietor is not deprived of the possibility of subsequent review. However, it is established board of appeal practice that where the board comes to the conclusion that the document is not such as to prejudice the maintenance of the patent, the board may itself examine and decide the matter under Art. 111(1) EPC 1973 (**T 326/87**, OJ 1992, 522; **T 416/87**, OJ 1990, 415; **T 626/88**, **T 457/92**, **T 527/93**, **T 97/90**, OJ 1993, 719).

In **T 611/00** the appellant relied on the same grounds of opposition as it had at first instance, but it based its appeal on completely new evidence. The board held that in order to admit this new evidence it had to balance two demands of public interest, that of procedural fairness and that of preventing unwarranted monopolies. If the board found that the documents should be taken into account, it had to ensure that the respondent received fair procedural treatment in the further conduct of the case. Therefore the request for the case to be remitted to the department of first instance had to be allowed.

In **T 736/01** the board stated that since it was not the function of an appeal to examine and decide upon a fresh case resulting from the newly submitted and admitted prior art (see **T 26/88**, OJ 1991, 30; **T 611/90**), it would exercise its discretion under Art. 111(1) EPC 1973 and remit the case to the opposition division.

In **T 361/03** a document submitted by the appellant (opponent) one month before the oral proceedings fundamentally altered the factual framework of the case under appeal. The board admitted the document but held remittal justified. This had the twofold purpose of allowing this fresh case to be examined at two levels of jurisdiction and of giving the respondent a reasonable opportunity to consider possible fallback amendments and possible evidence that could be produced in defence of such amended requests.

However, according to the board in **T 764/07** it is the established jurisprudence of the boards of appeal that an appellant has no absolute right to have each individual issue considered by two instances, Art. 111(1) EPC leaving it to the discretion of the board whether to exercise any power within the competence of the department of first instance or to remit the case to that department. In **T 1913/06**, for example, documents filed with the opponent's (appellant's) grounds of appeal were admitted into the proceedings and the respondent's request for remittal refused, taking into consideration the imperative of procedural efficiency and the public interest in a streamlined and efficient procedure. The patent (which had been granted 4 years earlier) was revoked on the basis of the admitted documents. See also **T 1007/05**.

In **T 1070/96** the board stated that even though, as a rule, a case should be remitted to the department of first instance if a new document is so relevant that it has considerable influence on the decision to be taken, a remittal is not appropriate if the board is able to deduce from the reasoning of the decision under appeal how the opposition division would have decided had it known of the late-filed document.

In **T 111/98** the board held that the amendment of the claims in response to the citation of a new document during appeal proceedings was not as such a sufficient reason to remit the case to the department of first instance. Remittal remained at the discretion of the board.

#### 7.2.2 Ex parte appeal proceedings

In ex parte appeal proceedings too, if a document is relied upon for the first time during the appeal proceedings and it is admitted because it is relevant, the case has often been remitted to the department of first instance (see e.g. **T 28/81**, **T 147/84**, **T 170/86**, **T 198/87**, **T 205/87**).

The board in **T 963/09** had raised certain objections to the application based on a document it had introduced. The appellant requested that the case be immediately remitted to the examining division for further prosecution. The board refused. In **G 10/93** the Enlarged Board had decided that a board of appeal in ex parte appeal proceedings had the power to raise new objections and to introduce new documents, stating that this did not mean that boards of appeal carried out a full examination of the application as to patentability requirements. If, however, there was reason to believe that a condition for patentability might not have been satisfied, the board either incorporated it into the appeal proceedings or ensured by way of referral to the examining division that it was included when examination was resumed. First, it was clear that an objection raised by a board in the form of a non-binding preliminary opinion did not bind that board and so did not bind an examining division to which the case was later remitted. Secondly, if the case was eventually remitted to the examining division with the instruction to examine the new objection, it might be necessary to include an indication of the relevant grounds, facts and evidence to be considered. Thirdly, where a board of appeal was willing to decide on a new objection itself, it was only fair for the board to fully disclose its concerns to the appellant in order to give it the best possible opportunity to either convince the board that the case should be remitted or argue against the new objection.

In **T 991/01** the examining division sent the appellant a computer-generated translation of a Japanese patent application after the oral proceedings before it, and no copy was kept in the file, so that the board of appeal was unaware of its existence until the appellant referred to it in the oral proceedings before the board. The case was remitted.

In **T 1343/12** since it appeared that the assessment of inventive step hinged to a great extent on the true disclosure of D1, the case was remitted to the examining division for re-consideration of the issue of inventive step in the light of a certified translation thereof.

### 7.2.3 Patent in jeopardy

In **T 326/87** (OJ 1992, 522) the board added that remittal to the department of first instance is particularly desirable if the new citation puts the maintenance of the patent at risk: where this is not the case, the board itself may decide on the matter, as for example in **T 253/85**, **T 49/89**, **T 565/89** and **T 881/91**.

In **T 638/89** the board of appeal followed this line of argument in remitting the case to the opposition division because a document cited for the first time in the statement of grounds for appeal was highly relevant and should therefore be admitted into the proceedings.

That remittal is not automatic where the patent is at risk is shown by **T 1060/96**. Here the respondent had had one year to challenge consideration of a document submitted by the appellant (opponent) during the appeal procedure and one year prior to oral proceedings. Moreover, the document was technically very simple and merely reinforced the teaching of known documents. The board refused the respondent's request for remittal and revoked the patent. See also **T 111/98**, **T 416/00** and **T 642/01**.

### 7.2.4 New facts or evidence

In **T 125/93**, where a highly relevant document was filed by the patentee shortly before the date appointed for oral proceedings, the board admitted it into the proceedings pursuant to Art. 114(1) EPC 1973, which had the concomitant effect of altering the factual framework of the case under appeal compared with that upon which the decision under appeal had been based. The legal consequence of such a shift in the framework being well settled, and there being no "special reasons" of the kind referred to by the Enlarged Board in **G 9/91** and **G 10/91** (OJ 1993, 408 and 420), the board referred the case back to the opposition division for further prosecution.

Many decisions have confirmed that if fresh evidence, arguments or other matter filed late in the appeal proceedings raise a case substantially different from that on which the contested decision was based, the case should be remitted to the department of first instance where this was demanded by fairness to both parties. See, for example, **T 611/90**, **T 97/90**, **T 847/93**. The board in **T 611/90** pointed out that 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. In **T 852/90** the board, although it rejected the request for remittal,

stated that the need to remit should the case alter followed from the immutability of the legal requirement that appeals should remain appeals, despite the investigative powers conferred upon the boards by Art. 114(1) EPC 1973, as well as the principle that appeals under the EPC are judicial proceedings, whose task is to decide whether an appealed decision was right on its merits. (The late-filed evidence amounted to no more than an amplification - albeit a significant one - of the case already canvassed before the opposition division).

However, the board in **T 97/90**, found that it did not follow from **T 611/90** that all cases in which a new ground of objection was raised late in the appeal must be remitted to the department of first instance. On the contrary, this should only be done if the admission of the new ground into the appeal proceedings would lead to revocation of the patent. The board therefore decided that there was no need to remit the case. See also **T 113/96** and **T 577/97** for decisions where remittal was refused.

In **T 1469/07** the appellant and interveners observed that it was in the interest of the public and of legal certainty to have a final decision as quickly as possible. However, the board noted that the fresh case was caused not by the respondent but by the new evidence filed by the appellant and the interveners. Accordingly, in the exercise of its discretion, the board considered that the case against the patent had altered to such an extent that the respondent had a legitimate reason to have its full case considered at two instances. Therefore remittal of the case to the department of first instance was appropriate (Art. 111(1) EPC) (see also **T 78/11**).

The board in **T 402/01** of 21.2.2005 pointed out that a patent proprietor had no automatic right of remittal after the citation of a new document with the grounds of appeal, even if there was a change in factual framework, at least in cases where the document was filed in reaction to amendment of the claim, providing that both parties' right to a fair hearing (Art. 113(1) EPC 1973) was not jeopardised. See also **T 133/87** and **T 1252/05**.

Referring to **T 402/01** and also **T 111/98**, the board in **T 1493/06** agreed; in **T 111/98**, implicitly referring to the right to be heard pursuant to Art. 113(1) EPC 1973, it was considered that remittal due to the admission of a new document should rather be an exception, for example if, without remittal, a party would not have had sufficient opportunity to defend itself against an attack based on the new document. In the case before the board in **T 1493/06**, the board had introduced document D7 at an early stage in the appeal procedure in a first communication, and subsequently issued another fully reasoned objection based on document D7 in the communication accompanying the summons to oral proceedings. The board, applying the criterion of **T 111/98**, therefore considered that the appellant had had sufficient opportunity to react to the introduction of document D7, so that remittal was not necessary in order to comply with Art. 113(1) EPC.

Nonetheless, citing **T 402/01**, the board in **T 1600/06** found that even if the patent proprietor has no automatic right of remittal after the citation of a new document, the patent proprietor's right to be heard in accordance with Art. 113(1) EPC may require

remittal when, as in the case before it, the new document alters the legal and factual framework of the case significantly and a "fresh case" results.

In the absence of strong mitigating circumstances for the late filing of a fresh case, the late-filing party should bear all the additional costs incurred by his tardiness (**T 611/90**, OJ 1993, 50; **T 97/90**).

### **7.3. Remittal following substantial amendment to claims in the appeal proceedings**

The amendment of claims during an appeal from a decision to refuse a European patent application is a matter of discretion under R. 137(3), last sentence, EPC (previous R. 86(3), last sentence, EPC 1973).

According to **T 63/86** (OJ 1988, 224), where substantial amendments to the claims are proposed on appeal, which require substantial further examination, the case should be remitted to the examining division. In this way, the applicant's right to appeal to a department of second instance is maintained, both in relation to the exercise of discretion under (the then) R. 86(3) EPC 1973, and in relation to the formal and substantive allowability of the amended claims. Several boards of appeal have applied this case law in their decisions; e.g. **T 200/86**, **T 296/86**, **T 341/86**, **T 98/88**, **T 423/88**, **T 501/88**, **T 47/90** (OJ 1991, 486), **T 184/91**, **T 919/91**, **T 599/92**, **T 1032/92**, **T 1067/92**, **T 96/93**, **T 186/93**, **T 462/94**, **T 1628/08**, **T 1818/08** and **T 2287/08**).

In **T 746/91** the board applied the principles laid down in **T 63/86** and remitted the case to the opposition division for it to examine and decide whether discretion should be exercised in favour of the appellant, and if so, whether the claims complied with the provisions of the EPC. The board took this view in the particular circumstances because the opposition proceedings had themselves been comparatively brief and had not involved the holding of oral proceedings. It had thus adhered to the principle whereby it should be established swiftly whether or not a patent can be maintained. Moreover, the amended claims had been filed with the statement of grounds, i.e. at the earliest possible stage in the appeal proceedings.

In **T 125/94** the board remitted the case to the department of first instance because the amended claims had not only substantially changed the factual framework of the contested decision, but could also require a search in an additional classification unit to determine the closest prior art.

According to the board in **T 1201/00**, if a case is likely to have to be remitted to the opposition division for it to assess the unexamined issue of inventive step, a new auxiliary request first submitted during oral proceedings before the board designed to overcome an objection of lack of novelty compared with a cited document may exceptionally be admitted and also remitted to the opposition division for final novelty examination against that document if none of the requests that took precedence can be granted for lack of novelty. The need for the department of first instance to assess inventive step against all the cited prior art means that novelty examination against one cited document would not entail a significant delay in the opposition proceedings.

However, the amendment of the claims in response to the citation of a new document during appeal proceedings is not as such a sufficient reason to remit the case to the department of first instance (**T 111/98**). Following this decision, the board in **T 98/00** did not remit the case despite the appellant's request to do so, finding that it would make no sense if the boards were ipso facto obliged to remit the case whenever new matter was raised in appeal proceedings, irrespective of the nature of such matter. In **T 893/07** the board interpreted **T 111/98** to mean that what actually appears to be essential when a board exercises its discretion to remit a case is whether the factual framework has substantially changed during the appeal proceedings. As it had not, remittal was refused. The board in **T 1493/06** stated that in decision **T 111/98**, implicitly referring to the right to be heard pursuant to Art. 113(1) EPC 1973, it was considered that remittal due to the admission of a new document should rather be an exception, for example if, without remittal, a party would not have had sufficient opportunity to defend itself against an attack based on the new document. In the case before it, the board introduced document D7 at an early stage in the appeal procedure in a first communication, and subsequently issued another fully reasoned objection based on document D7 in the communication accompanying the summons to oral proceedings. The appellant had thus had sufficient opportunity to react to the introduction of document D7, so that remittal was not necessary in order to comply with Art. 113(1) EPC 1973.

In **T 908/07**, the board held that a late-filed claim admitted in the exercise of the board's discretion mainly because the board and the opponent could be clearly expected to deal with the issues raised without adjournment of the oral proceedings, should not normally be remitted to the department of first-instance for examination in respect of the grounds for opposition on which the first instance decision was based.

In **T 1300/06** the board recalled that, in accordance with **G 9/91** (OJ 1993, 408), in cases where Art. 100(c) EPC 1973 was not an original ground of opposition and the opposition division did not consider it necessary to use its discretion to introduce it into the opposition proceedings, the consideration of this Article for the granted claims at appeal stage was possible only with the patentee's consent. This, however, did not prevent the board from examining anew the formal requirements of the EPC in respect of any other request containing amendments and filed in order to overcome original grounds of opposition. The fact that objections raised under these articles - and the arguments submitted therefore - might also have been relevant to the granted claims could not prevent the board from considering them in the context of the new amended request, since each request had to be considered on its own. The case was therefore remitted.

#### **7.4. Remittal following a substantial procedural violation**

##### **7.4.1 Legal basis**

A board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise (Art. 11 RPBA).

Remittal to the department of first instance is therefore normally also ordered where a substantial procedural violation occurred in the first instance proceedings (**T 125/91**, **T 135/96** and **T 1065/99**), even where the violation affects only one of two opponents (**T 125/91**).

#### 7.4.2 Violation of right to be heard

The violation of the principle of the right to be heard is considered as a fundamental deficiency of first instance proceedings and remittal is often ordered accordingly (**T 125/91**, **T 808/94**, **T 1399/04**). The board in **T 1399/04** pointed out that it is, however, also acknowledged that there is no absolute right for a party to have every aspect of a case examined in two instances (referring to **T 133/87**). Other criteria, e.g. the general interest that proceedings are brought to a close within an appropriate period of time, have also to be taken into account. See also e.g. **T 594/00** and **T 343/01**. For further details, see Chapter III.B. "Right to be heard".

Where a remittal by a board of appeal for further prosecution on the basis of new evidence was immediately, i.e. without an intervening communication announcing the resumption of the proceedings, followed by the revocation of the patent, then the party had had no opportunity to present comments. It was necessary that the parties be expressly asked whether or not they wished to present their comments or in the case where the parties had already made detailed submissions during the preceding appeal proceedings, whether or not these submissions should be regarded as complete. The board in **T 1425/05** pointed out that these principles had been followed in decisions **T 769/91**, **T 120/96**, **T 679/97**, **T 742/04** for opposition proceedings and in decisions **T 922/02** and **T 1494/05** for examination proceedings.

In **T 1077/06**, the board could not identify a legal basis in the EPC from which it could be concluded that a party, appealing against a decision of a department of first instance, which had been taken in violation of its right to be heard, had retrospectively abandoned its right to be heard before the department of first instance when it did not appear at oral proceedings before the department of second instance. Since the appellant whose right to be heard had been violated requested the remittal of the case to the department of first instance, in the specific situation of the case at issue, this request took precedence over apprehensions regarding an undue delay of the procedure (see also **T 594/00**).

In **T 1505/06** the board was faced with reviewing a decision of the opposition division on an issue in respect of which it did not know the reasons for the decision. No review of the decision of the opposition division in this respect was therefore possible and the board was unable to ascertain whether the right to be heard of the proprietor/appellant had been respected. It therefore had no choice but to remit the case to the opposition division for further prosecution pursuant to Art. 111(1) EPC 1973 so that the proprietor had a renewed opportunity to present its case at oral proceedings.



### 7.4.3 Violations of Article 19(2) EPC (composition of the opposition division)

The board in **T 1349/10** pointed out that violations of Art. 19(2) EPC concerning the composition of the opposition division are considered to be substantial procedural violations which have led to a remittal of the case under Art. 111(1) EPC and to the reimbursement of the appeal fee in several cases (see **T 251/88**, **T 939/91**, **T 382/92**, **T 476/95**, **T 838/02**). In two of these cases (**T 251/88** and **T 838/02**), the boards had asked the appellant or all parties whether they invoked the procedural violation before they decided on the remittal. In both cases, the patent had been revoked by the opposition division. However, in the judgment of the board in **T 1349/10**, violations of Art. 19(2) EPC should lead to a remittal regardless of the parties' position at least in situations where third parties were affected by the outcome of the defective first instance proceedings.

### 7.4.4 Unclear whether appellant adversely affected

Where the decision of the opposition division contained obvious mistakes, causing the decision under appeal to be contradictory and legally obscure such that it was unclear whether the appellant was adversely affected, this constituted a substantial procedural violation and the board remitted the case to the department of first instance for further prosecution (**T 616/08**).

### 7.4.5 Special reasons not to remit under Article 11 RPBA

Under Art. 11 RPBA, if there are 'special reasons', a board need not remit a case to the department of first instance even where there were fundamental deficiencies in the first instance proceedings.

#### a) Circumstances held not to constitute special reasons under Article 11 RPBA

See **T 1399/04** in Chapter IV.E.7.4.2 "Violation of right to be heard" above.

In **T 48/00** the substantial procedural violation before the department of first instance had clearly amounted to a fundamental deficiency - the patent was revoked without any discussion at the oral proceedings of the grounds of opposition. The only reason advanced as to why remittal would not be appropriate was the respondent's argument that this would delay the final decision in the case and it would therefore be prejudiced by the continued existence of a patent it considered invalid. The board agreed that remittal would undoubtedly delay the case, although the degree of prejudice to the respondent was difficult to assess. It was also beyond doubt that the respondent bore no blame for the situation. The respondent did, however, have the opportunity to challenge the validity of the patent in national courts whereas, for the appellant, revocation as a result of opposition proceedings would represent a final loss of its rights in all the designated states. Taking into account the interest, to the public as well as to the parties, in ensuring justice is done - and seen to be done - the board considered that delay was an insufficient reason not to order remittal.

Infringement proceedings before the German courts did not constitute a special reason in **T 914/98**, where the board held that the fundamental right of the appellants to a fair hearing before the opposition division had to outweigh any advantage that might accrue to the respondents by having the board deal fully with the case rather than remit it.

In **T 515/05**, although the board found that the appellant's right to be heard had been violated at first instance, it considered that remittal was not appropriate, essentially because (i) the arguments of the appellant had been taken into account in the decision under appeal, (ii) the appellant in the meantime had had the opportunity, and indeed availed itself of it, to expand its argumentation before the board, and (iii) no concrete reason was given by the appellant for the necessity for remittal (e.g. no intention was declared to produce further evidence which would need more time for preparation). In the circumstances a remittal to the opposition division would only unnecessarily delay the proceedings.

b) Circumstances held to constitute special reasons under Article 11 RPBA

Art. 11 of the Rules of Procedure of the Boards of Appeal (RPBA) provides that a case shall be remitted to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. Violation of the principle of the right to be heard is considered to be a fundamental deficiency of first-instance proceedings, and remittal is often ordered accordingly. It is, however, generally acknowledged that there is no absolute right for a party to have every aspect of a case examined in two instances. Other criteria, in particular the general interest that proceedings are brought to a close within an appropriate period of time, have also to be taken into account. There is no obligation for the board to remit the case at issue to the department of first instance (**T 1548/11**).

In **T 1548/11** in the judgment of the board, special reasons spoke against a further remittal of the present case to the opposition division, in particular the length of the opposition (appeal) proceedings to date (including two appeal procedures) and the considerable further delay which would ensue from a remittal. Moreover, it was observed that the appellant whose right to be heard had been violated requested the board not to remit the case to the opposition division but to decide itself on the remaining issue of inventive step. In these circumstances, remittal of the case to the department of first instance would be inequitable. The board thus exercised its discretion under Art. 111(1) EPC 1973 and Art. 11 RPBA in the sense that it would decide itself on the merits of the appeal.

In **T 1254/11**, the board assumed, *arguendo*, that both the fact that no decision to enlarge or reduce the opposition division had been added to the publicly available file and the fact that the appointment of the new chairman could only be traced from the internal register of the EPO constituted fundamental deficiencies in the proceedings before the opposition division. However, unlike the situation in **T 990/06**, it was possible to determine from the file that the division had been lawfully enlarged and, at a later stage, lawfully reduced again. The board considered that these circumstances constituted special reasons for not remitting the case within the meaning of Art. 11

RPBA. The aforementioned fundamental deficiencies, assumed merely for the sake of argument, were of a formal nature. They would not, in the board's view, justify substantially delaying the proceedings.

In **T 274/88** the board agreed that where an irregularity has been remedied during appeal proceedings, the matter should still normally be remitted to the department of first instance. However, in this particular case, which was *ex parte*, the board did not remit because, after correction, the subject-matter of the application was patentable, the appellants had expressly waived their right to have the issues considered at two instances, and the examining division had already indicated that it was favourably disposed on the question of patentability.

Similarly, where the board was able, in *ex parte* proceedings, to decide in the appellant's favour, remittal was not considered necessary (**T 749/02**).

In **T 1929/12**, even though the decision under appeal suffered from a fundamental deficiency within the meaning of Art. 11 RPBA, the board found that no purpose would be served by remitting the case to the examining division, which would most likely eventually have issued another, better reasoned decision to the same effect. This consideration, combined with the fact that both the board and the appellant were able to deal with the decision under appeal in view of the minutes, constituted, in the board's view, special reasons for not remitting the case under Art. 11 RPBA.

In **T 2068/14** the board argued that although in this case a fundamental deficiency in the sense of Art. 11 RPBA had taken place, the clarity objection raised by the board with respect to the appellant's claims (Art. 84 EPC) was immediately apparent upon examination of the disclosure of the claimed subject-matter. This constituted a "special reason" justifying not remitting the case to the department of first instance. The board pointed out that it would be contrary to the principles of legal certainty and efficiency to remit a case when the appellant had not adequately dealt with objections raised by the board that would prejudice the grant of a European patent.

In **T 427/11** the board held that special reasons spoke against a remittal of the present case to the opposition division, in particular the length of the proceedings to date and the considerable further delay which would ensue from a remittal. Additionally, the opposition division had evidently taken note of all the inventive step objections raised, even though the corresponding reasoning in the decision under appeal was incomplete. Consequently, considering all the relevant facts, the board concluded that a remittal of the case to the department of first instance would be inequitable. The board thus exercised its discretion under Art. 111(1) EPC 1973 and Art. 11 RPBA in the sense that it would itself decide on the merits of the appeals.

In **T 679/97** a remittal by a board of appeal for further prosecution on the basis of new evidence was immediately, i.e. without any intervening communication announcing the resumption of proceedings, followed by the rejection of the opposition. Despite this substantial procedural violation by the opposition division, the board decided not to remit, in view of the interest of the parties in having the case finally decided. Under similar

circumstances, however, cases have been remitted to the department of first instance, see e.g. **T 742/04** and **T 1425/05** and in this chapter IV.E.7.4.2 "Violation of right to be heard".

## **7.5. Introduction of new arguments and amendment of the description**

If no new documents are introduced, but merely arguments presented from a different point of view, or if the claims are maintained on the basis of an auxiliary request which the department of first instance has already indicated that it would be prepared to accept, then the desideratum of keeping the procedure as short as possible requires that there should be no remittal (**T 5/89**, OJ 1992, 348; **T 392/89** of 3.7.1990 and **T 137/90**). See also **T 1210/05**.

The board in **T 1913/06** made it clear that a case should not be remitted to the department of first instance for consideration of submissions made at the oral proceedings which the board or the other party could not reasonably be expected to deal with without adjournment of the oral proceedings and which had not been admitted under Art. 13(3) RPBA). See also **T 764/07**.

Remittal to the department of first instance to bring the description into line with amended claims should be avoided if at all possible for reasons of procedural economy, and although Art. 111(1) EPC 1973 permits it (**T 977/94**). However, remittal in such circumstances may still be necessary; in **T 1149/97**, although the appellant had also submitted amendments to the description at the oral proceedings, the board considered it expedient to remit the case to the department of first instance for further prosecution in accordance with the discretion under Art. 111(1) EPC 1973. Adaptation of the description and the drawings to the more restricted subject-matter now claimed needed careful consideration so that full consistency with the amended claim was guaranteed.

## **7.6. Exercise of discretion to remit**

### **7.6.1 No absolute right to have issue decided on by two instances**

It is established case law that there is no absolute right to have an issue decided upon by two instances. See, for example, **T 133/87**, **T 249/93**, **T 83/97**, **T 402/01**, **T 399/04** and **T 1252/05**. This is the case even if as a consequence the patent is revoked for the first time by the board of appeal (see e.g. **T 557/94**, **T 839/05**). Other criteria, e.g. the general interest that proceedings are brought to a close within an appropriate period of time, have also to be taken into account by the board when deciding whether or not to remit a case (**T 839/05**).

### **7.6.2 Function of appeal**

Although both the appellant and the respondents wished the board to make a final decision rather than remit the case to the opposition division, the board in **T 869/98** refused, pointing out that it is not normally the function of the appeal board to consider and decide upon questions which were raised for the first time during the appeal

proceedings. As there had been no assessment of inventive step at all during the written appeal proceedings, the board exercised its discretion under Art. 111(1) EPC 1973 and referred the case back to the opposition division.

### 7.6.3 Interests of procedural economy

In **T 887/98** the board held that remittal was not justified: the appellant (patent applicant) had indeed been able to put forward his arguments in proceedings at both first and second instance, and had been given plenty of time to study a document D2 before the oral proceedings. Furthermore, the examining division had found another document to be prejudicial to inventive step, so introducing D2 into the proceedings before it would not affect its decision. For these reasons, plus considerations of procedural economy, the board refused the appellant's request for remittal.

In the interests of overall procedural economy and effectiveness, the board in **T 473/98** (OJ 2001, 231) also found it entirely appropriate and desirable that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC 1973 employing the standard decision formula, by way of obiter dicta, findings which could obviate a remittal in the event of the revocation being reversed on appeal. See also **T 915/98**. In **T 275/99** the board stated that, from a purely procedural point of view, no objection could be made to the fact that the examining division had left open the issue of inventive step in the appealed decision, and the case was remitted.

In **T 839/05**, since the amendments were of a different nature for each auxiliary request, a possible consequence of remittal could have been further remittals on subsequent appeal proceedings, which would unduly lengthen the proceedings. Thus, with due consideration made for procedural economy and to avoid further delay, the board decided not to remit the case but to decide on it itself in accordance with Art. 111(1) EPC 1973.

### 7.6.4 Final decision reached after expiry of patent

In **T 249/93** the board confirmed that remittal lay within the discretion of the board. Where remittal might mean that a final decision was not reached until after the expiry of the patent, the board would be inclined to decide the issue itself, unless there were strong reasons for not doing so.

### 7.6.5 Fresh case

See also in this chapter IV.E.7.4.2 "Violation of right to be heard".

According to **T 83/97** it is not mandatory for the appellate instance to remit every time a fresh case is raised before it, i.e. the right to two instances might not in each and every procedural situation be an absolute right of the parties concerned. (In fact, the matter was remitted as the board found that it would have been a violation of Art. 113 EPC 1973 to have given a final decision on all outstanding substantive matters against the requests

of the parties, who had had no advance warning of such a procedural possibility, and in view of the long-standing practice of the boards of appeal).

In **T 1007/05** new documents had been introduced into the proceedings and discussed. Under these circumstances the board held that it would only be reasonable to remit a case which had been extensively discussed if exceptional circumstances justified this action, for instance if the introduction of documents into the proceedings had created an entirely new situation. See also **T 1864/09**.

#### 7.6.6 Article 32 TRIPS

Nor does Art. 32 TRIPS limit the board's discretion concerning remittal. In **T 557/94** the board held that Art. 32 TRIPS (which provides for the judicial review of any decision to revoke a patent) did not oblige the reviewing instance to remit the case to the department of first instance, where the department of first instance did not revoke the patent and the reviewing instance intended to deviate from the decision of the first instance. Art. 111 EPC 1973 empowered the board to decide on the merits of the case without restriction and it would be alien to at least the majority of legal systems in the EPC contracting states to limit the power of the reviewing instance in such a way that - dependent upon the "result" of the decision under attack - it would be bound to remit the case to the department of first instance. Nor could it be assumed that the states negotiating TRIPS intended the introduction of such a limitation. This was approved in **G 1/97** (OJ 2000, 322).

#### 7.6.7 Circumstances to be taken into account

In **T 265/05**, the board explained that, when exercising its discretion under Art. 111(1) EPC 1973 either to decide or to remit the case, the board should take account of its particular circumstances and the parties' wishes (here the parties requested the board to decide the case). Given that the opposition division would have had to carry out any further examination of its own motion without the participation of the respondents, the only compelling reason the board could see for not allowing the request immediately itself would be a situation of prima facie lack of patentability based on the available information, or a situation of fundamental uncertainty because of lack of information. As this was not the case, the board chose to exercise its discretion under Art. 111(1) EPC 1973 to decide the case itself.

### **7.7. Binding effect of decision remitting case to department of first instance**

#### 7.7.1 General

Under Art. 111(2) EPC the EPO department of first instance is bound by the ratio decidendi of the board of appeal if the case is remitted to the department whose decision was appealed in so far as the facts are the same. If the decision under appeal was taken by the Receiving Section, the Examining Division shall also be bound by the ratio decidendi of the board of appeal.

The ratio decidendi of a decision under Art. 111(2) EPC 1973 is the ground or the reason for making it - in other words, the point in a case which determines the outcome of the judgment (**T 934/91**, OJ 1994, 184). It is not contained in the order but in the section "Reasons for the Decision" and it is thus of no importance for its binding effect that a particular matter is not mentioned in the order (**T 436/95**).

"Res judicata" means a matter finally settled by a court of competent jurisdiction, rendering that matter conclusive as to the rights of the parties and their privies, such a final judgment constituting an absolute bar to a subsequent legal action involving the same claim, demand or cause of action, and the same parties or their privies (**T 934/91**, OJ 1994, 184).

The fact that the boards of appeal are courts was established in **G 1/86** (OJ 1987, 447, point 14 of the Reasons, German and French versions - the Enlarged Board of Appeal held that the English translation, "act as courts", was inaccurate).

#### 7.7.2 Department of first instance bound by decision of board of appeal

Under Art. 111(2) EPC the EPO department of first instance is bound by the ratio decidendi of the board of appeal if the case is remitted to the department whose decision was appealed. Thus, when after remittal the proprietor files new requests which require examination to be re-opened on issues that have already been judged upon by the board of appeal, without the justification that might be provided, for example, by the proprietor's being faced with a new situation, then such requests should be deemed inadmissible (**T 383/11**).

For the avoidance of doubt, the board in **T 366/92** pointed out that according to Art. 111(2) EPC 1973 the examining division was bound by the board's decision only to the extent that it had been decided that the subject-matter of Claim 1 was novel when compared with the prior art known from D2 and that the claim met the requirements of Art. 84 and 123(2) EPC 1973. See also **T 255/92**.

According to **T 934/91** (OJ 1994, 184), boards of appeal have the power to apportion and also to fix costs: Art. 104(1) and (2) and 111(1) EPC 1973, having due regard to Art. 113(1) EPC 1973. Such a decision constituted an absolute bar to the opposition division's considering afresh, let alone deciding upon, either the fact or the quantum of the apportionment, or their reviewing the reasons (ratio decidendi) for which the apportionment had been made. The board found that the purported decision of the opposition division on this point was in law a mere communication of the clear and immutable legal position brought about by the earlier decision of a final court of competent jurisdiction, namely, the technical board of appeal.

However, a board of appeal decision has the binding effect referred to in Art. 111(2) EPC only if the case is remitted to the department of first instance. A board of appeal decision in another case is not binding on the department of first instance (see **T 288/92**; and also **J 27/94**, OJ 1995, 831).

### 7.7.3 Opposition proceedings following remittal to examining division

A decision by a board of appeal on an appeal from an examining division decision is not binding in subsequent opposition proceedings or on appeals therefrom, having regard both to the EPC and to the principle of *res judicata* (**T 167/93**, OJ 1997, 229). The binding effect is also not restricted to cases where the composition of the board remained unchanged (**T 436/95**). Following **T 167/93**, the board in **T 1099/06** pointed out that opposition proceedings are separate and distinct from examination proceedings and are characterised by the nature of the public interest. The legislative and procedural framework has quite clearly been designed to allow the public interest in challenging granted patents by opposition to take priority over any considerations of certainty or apparent consistency. The board pointed out that to the extent this principle is recognised in the law of the EPC, it is of extremely narrow scope and must meet the six criteria set out in **T 167/93** (OJ 1997, 229) - the issue must have been (a) judicially determined; (b) in a final manner, (c) by a tribunal of competent jurisdiction; (d) where the issues of fact are the same; (e) the parties (or successors in title) are the same; and (f) the legal capacities of the parties are the same. Thus a decision in earlier examination appeal proceedings could not be *res judicata* in subsequent opposition appeal proceedings, the criteria (c), (e) and (f) not being satisfied.

Under Art. 111(2) EPC 1973, if a board of appeal remitted a case for further prosecution to the department whose decision was appealed, that department was bound by the *ratio decidendi* of the board in so far as the facts were the same. After grant, however, the opposition division was in no way legally bound by the previous decision of the board, on an appeal from the examining division, even in so far as the facts were the same, although it should not deviate from a previous decision of a board of appeal on such a point, unless there appeared to be very clear reasons for doing so (**T 26/93**).

### 7.7.4 Board of appeal bound in subsequent appeal proceedings following remittal

See also in this chapter IV.E. 2.2.4 "Appeals against decisions of the boards of appeal".

The problem of being bound by an earlier board of appeal decision where a case is remitted also arises in connection with a subsequent appeal against the ensuing decision.

The boards of appeal take the view that a binding effect also exists in this case (see, for example, **T 21/89**, **T 78/89**, **T 55/90**, **T 757/91**, **T 113/92**, **T 1063/92**, **T 153/93** and **T 1545/08**), often on the basis that board of appeal decisions are final and without appeal, so that no EPO body - not even boards of appeal - can take a new decision on facts which have already been decided. In **T 690/91** the argument was that the same binding effect applied to any subsequent appeal proceedings since, according to Art. 111(1) EPC 1973, the board might exercise the same power as was within the competence of the department which was responsible for the decision appealed. Art. 111(1) EPC remains unchanged. The board found that a board was bound in the second of two successive *ex parte* appeal proceedings by the *ratio decidendi* of the decision in the first appeal proceedings where the facts remained the same. It was to be



assumed that this was the case where there was no connection between a feature amended during the second proceedings and findings of the first board of appeal playing a key role in the decision.

See also **T 720/93** for the extent to which a board considered itself bound by an earlier board of appeal decision in the same case. Although the claim pending before the board represented different facts from in the first proceedings since it was a different type of claim and contained a number of different features, the board found some findings of the first decision binding for the second proceedings.

The board in **T 843/91** (OJ 1994, 818) pointed out that there were no provisions in the EPC 1973 allowing an appeal against a decision of a board of appeal. Decisions of the boards of appeal were final, as a decision can only be contested where it is expressly provided for under statute. When the first board of appeal delivered its decision, the content and text of the patent claims became *res judicata* and could no longer be amended in proceedings before the EPO (see also **T 153/93**). Under the EPC 2000, the Enlarged Board of Appeal has been given competence to decide on petitions for review under Art. 112a EPC, in order to make possible a limited judicial review. Thus decisions of the boards of appeal can now be contested, but only on limited grounds (see Chapter IV.F.3 "Petition for review under Article 112a").

#### 7.7.5 Type of remittal

##### a) Divisional applications

The principle of *res judicata* also applied in the case of a divisional application when a decision on the same subject matter had been taken by a board of appeal in the case of the parent application (**T 51/08**). Thus, subject matter on which a final decision had been taken by a board of appeal in the parent application could not be pursued in the divisional application. Furthermore, if the statement setting out the grounds of appeal in a case did not go beyond submitting and arguing for a set of claims which constituted such subject matter, the appeal was not sufficiently substantiated.

##### b) Remittal only for adaptation of the description

In **T 757/91** the board decided that if, after the case was remitted, the only issue still outstanding was the adaptation of the description to the amended claims which were held valid in the first appeal proceedings, that issue was the only one which could be considered in further appeal proceedings. When the first board of appeal delivered its decision, the content and the text of the patent claims became *res judicata* and could no longer be amended in proceedings before the EPO (see also **T 55/90**, **T 843/91**, OJ 1994, 832 and **T 113/92**).

Remittal for the description to be amended does not render it possible for an opponent to challenge substantive patentability again by appealing the opposition division's decision after remittal, where a final decision has been taken on this and the scope of the patent (**T 1063/92**).

On remittal the board had made no mention of any adaptation of the description that might be necessary. The patentee proposed amendments to the description which were accepted by the opposition division. The opponent appealed against this decision, challenging the novelty and clarity of the claims as already decided upon by the board of appeal. Following **T 843/91** (OJ 1994, 832), the board in **T 153/93** found that all findings of fact that were a *conditio sine qua non* of the finally binding parts of the decision were *res judicata* with the result that new facts, evidence or arguments seeking to cast doubt upon these facts could not be considered either by the opposition division or the board of appeal.

c) Board's silence on adaptation of description

Where the board, in the decision remitting the case to the department of first instance, is silent on the question of the adaptation of the description, this does not necessarily imply that no adaptation is required, but merely that the matter was not considered or decided. The point is therefore not *res judicata* and so can be raised in a subsequent appeal (**T 636/97**).

d) Remittal for the continuation of proceedings

Where a board of appeal issued a decision rejecting certain claimed subject-matter as not allowable and remitted the case for further prosecution in accordance with an auxiliary request, under Art. 111(2) EPC 1973, the examination for allowability of the rejected claimed subject-matter could not be re-opened, either by the examining division during its further prosecution of the case, or by the board of appeal in any subsequent appeal proceedings (**T 79/89**, OJ 1992, 283; see also **T 21/89**).

In the opposition proceedings following the remittal for continuation of the proceedings, an amendment of the patent claims could change the actual basis of an appeal decision. In such a case the binding effect of Art. 111(2) EPC 1973 no longer applied. This differed from the situation where the case was remitted for adaptation of the description - here the previous instance was bound by the *ratio decidendi* of the board's decision, and the decision on the patentability of the claims was final, even if the facts had changed (**T 27/94**).

Art. 111(2) EPC 1973 stated unambiguously that the department of first instance and the board of appeal which was again concerned with the case were bound by the *ratio decidendi* of the remitting decision only "in so far as the facts are the same". The opposition division was thus not bound by the first decision if new claims were submitted which were not in conflict with the *ratio decidendi* of the decision. The situation was different if the board had dismissed the decision under appeal and remitted the case to the department of first instance with the order to maintain a patent with claims whose wording had been defined by the board. In such a case the department of first instance was not entitled to admit amended claims, since they were part of the *res judicata* of the decision of the board (**T 609/94**).

## 8. Reimbursement of appeal fees

### 8.1. Introduction

According to R. 103(1)(a) EPC (R. 67 EPC 1973) the reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the board of appeal deems an appeal allowable, if such reimbursement is **equitable** by reason of a **substantial procedural violation**.

R. 103(1)(b) EPC, introduced with the EPC 2000, goes some way towards compensating for the lack of a cross-appeal facility. Appeals filed as a precaution – in case the other party appeals – can be withdrawn if the other party does not file an appeal, at an early stage of the proceedings, during the period between the expiry of the respective periods for filing the notice of appeal and filing the statement of grounds of appeal, i.e. before any great expense or effort on the part of the parties or the EPO.

R. 103(2) EPC, introduced by decision of the Administrative Council of 13 December 2013 (CA/D 16/13; OJ 2014, A3), provides for a reimbursement of the appeal fee at 50% if the appeal is withdrawn after expiry of the period under R. 103(1)(b) EPC, provided withdrawal occurs (a) if a date for oral proceedings has been set, at least four weeks before that date or (b) if no date for oral proceedings has been set, and the board has issued a communication inviting the appellant to file observations, before expiry of the period set by the board for filing observations.

R. 103(3) EPC (formerly R. 103(2) EPC) governs the competence of the department of first instance and of the board of appeal in the matter of the reimbursement of the appeal fee and codifies the case law of the Legal Board of Appeal (**J 32/95**, OJ 1999, 733; see in this chapter IV.E.8.5.2 "Competence to decide on reimbursement").

For the rules formally applicable to patent applications pending on the date of entry into force of the EPC 2000, see **J 10/07** (OJ 2008, 567); for the applicability of R. 103(1)(b) EPC see **T 2052/08**.

### 8.2. General issues

#### 8.2.1 Absence of request for reimbursement – examination ex officio

The boards may, even in the absence of a request to this effect, examine ex officio whether the reimbursement of the appeal fee is equitable by reason of a substantial procedural violation (**J 7/82**, OJ 1982, 391; **T 271/85** of 22.3.1989; **T 346/88**, **T 598/88**, **T 484/90**, OJ 1993, 448, and **T 736/14**).

## 8.2.2 Distinction between an appeal deemed not to have been filed and an inadmissible appeal

For the issue of reimbursement of the appeal fee the distinction between an appeal not deemed to have been filed and an inadmissible appeal is relevant. As a general rule, in the former case, the appeal fee is reimbursed; in the latter case, it is not.

### a) Appeal deemed not to have been filed due to late payment of the appeal fee

Reimbursement of the appeal fee is ordered if an appeal is deemed not to have been filed because the **appeal fee** was not paid in due time in accordance with Art. 108, second sentence, EPC 1973. In this case, since the purpose of the fee cannot be achieved, the fee must be repaid without the board of appeal having to make any specific order to that effect (**J 21/80**, OJ 1981, 101; **J 16/82**, OJ 1983, 262; **T 324/90**, OJ 1993, 33 and **T 239/92**). However, in **T 79/01**, **T 1289/10**, **T 1535/10** and **T 2210/10**, where the appeal fee had also been paid late, reimbursement of the appeal fee was not ordered (see **T 1553/13**, OJ 2014, A84). See also in this chapter IV.E.8.2.4.

In **J 18/12** the Legal Board held that the final non-existence of the patent application in a substantive sense did not mean that the appeal proceedings had not come into existence (as opposed to the legal fiction of non-existence when an appeal was deemed not to have been filed). This situation regularly arose in proceedings before the EPO, e.g. where a decision of the Receiving Section not to accord a filing date was appealed.

### b) Notice of appeal not filed in due time

An appeal can only be said to have been filed, i.e. has come into existence, if the notice of appeal was filed in due time and the appeal fee was paid in due time (see **T 445/98**). The appeal fee is reimbursed in a case where only the appeal fee was paid but the **notice of appeal** was not filed in due time because in such a case no appeal has ever existed (**T 696/95** citing **T 371/92**, OJ 1995, 324; see also **T 41/82**, **T 778/00**, **T 1479/09**, **T 377/11**; see also **T 2274/11**).

### c) Appeal inadmissible

When an appeal is filed but inadmissible it has come into existence and it is in principle not possible to repay the appeal fee (**T 445/98**, see also **J 16/94**, **T 372/99**; **T 752/05**). For the distinction between the existence of an appeal and the admissibility of an appeal, see also **T 460/95** (20.10.1997) and **T 778/00**, OJ 2001, 554.

The appeal fee cannot be refunded on the basis that no statement of grounds was filed, or it was filed too late (**T 13/82**, OJ 1983, 411; **T 324/90**, OJ 1993, 33, **T 576/93**). This also applies where the grounds of appeal have deliberately not been filed in order to make the appeal inadmissible (**T 89/84**, OJ 1984, 562; **T 543/99**).

In **J 15/01** the board ruled that the fact that an appeal was against a communication, as opposed to a decision under Art. 106(1) EPC 1973, did not justify refunding the appeal

fee. If - as in the case before it - the board concluded that there had not been an appealable decision under Art. 106(1) EPC 1973, this made the appeal inadmissible but did not mean it had never existed, the requirements under Art. 108 EPC 1973 having been met. The appeal fee could not therefore be refunded.

Only in exceptional circumstances can the appeal fee be reimbursed in the case of an inadmissible appeal (see **J 38/97** concerning a violation of the principle of the protection of legitimate expectation, see in this chapter IV.E.8.6.3).

#### d) Translation of notice of appeal

In **T 323/87** (OJ 1989, 343) the translation of the notice of appeal had not been filed in due time. The board held that, pursuant to Art. 14(5) EPC 1973, the notice of appeal was deemed not to have been filed, and ordered reimbursement of the appeal fee. In **T 1152/05** it was also decided that, since the appeal of the patent proprietor was deemed not to have been filed, it followed that the appeal fee was paid without reason and had to be reimbursed. In **T 126/04**, on the other hand, the board decided that failure to file a translation of the notice of appeal in due time meant that the appeal was inadmissible.

#### 8.2.3 No legal ground for payment

The grounds for reimbursement listed in R. 103(1) EPC aside, fees may also be refunded if there was no legal ground for their payment, e.g. in the event of payment by mistake or overpayment, see Art. 12 RFees e contrario (**T 1284/09**).

#### 8.2.4 Reimbursement of the appeal fee in case of a request for re-establishment

In **T 1192/07** the request for re-establishment in respect of the time limit for paying the **appeal fee** was refused. As a result, the appeal was deemed not filed because the appeal fee had not been paid in time. Therefore, the appeal fee had to be refunded. In **T 1465/08** the board refunded the appeal fee in a case where the request for re-establishment in respect of the time limit for paying the appeal fee was deemed not to have been filed with the consequence that the appeal was deemed not to have been filed. In **T 257/07** the request for re-establishment in respect of the time limit for filing the **notice of appeal** was refused, and therefore the appeal was deemed not to have been filed and the appeal fee reimbursed (see also **T 1962/08**). In **T 1289/10** the board rejected the request for re-establishment in respect of the time limit to file a notice of appeal and pay the appeal fee. The appeal was dismissed as inadmissible; the appeal fee was not reimbursed.

#### 8.2.5 Appeal withdrawn

Under the EPC 1973, when appeal proceedings were terminated by the withdrawal of the appeal, R. 67 EPC 1973 was in general not applicable (see **J 12/86**, OJ 1988, 83; **T 41/82**, OJ 1982, 256; **T 773/91**, **J 30/94**; **T 372/99**; **T 543/99**; **T 1216/04**, **T 552/07**; for exceptions to this rule in case of a violation of the principle of the protection of legitimate expectations see **J 30/94** and **T 308/05**).

Under the EPC 2000, however, the appeal fee is reimbursed if the appeal is withdrawn before the filing of the statement of grounds of appeal and before the period for filing that statement has expired (R. 103(1)(b) EPC). For cases where this provision was first applied, see **T 1495/08**, **T 2052/08**, **T 1822/09**. If the withdrawal of the appeal occurs after the expiration of the period for filing the statement of grounds, reimbursement is not possible under R. 103(1)(b) EPC (**T 1527/09**), even if the withdrawal was only one day late (**T 1613/08**). For a case in which the **application** was withdrawn after the expiration of the period for filing the statement of grounds and the appeal fee was thus not reimbursed, see **T 683/08**.

According to R. 103(2) EPC, as amended on 13 December 2013 (CA/D 16/13; OJ 2014, A3), the appeal fee is reimbursed at 50% if the appeal is withdrawn after expiry of the period under R. 103(1)(b) EPC and certain conditions are met (see in this chapter IV.E.8.1). These rules apply to appeals pending at their entry into force, i.e. on 1 April 2014, and to appeals filed thereafter. In **T 1086/09** the board held that a letter received on 28 March 2014 stating that the appeal should be withdrawn "hereby" would mean that the appeal was withdrawn on 28 March 2014, and thus no longer pending on 1 April 2014. In **T 370/11** the board held that the 50% are to be calculated on the basis of the appeal fee actually paid, and not on the basis of the rate of the appeal fee applicable on the date of withdrawal or reimbursement.

#### 8.2.6 Intervention in opposition appeal proceedings

In **T 791/06** the intervention of appellant III was considered, by the board, to be an admissible intervention in opposition appeal proceedings, and so only the required opposition fee needed to be paid, as established by **G 3/04**. Hence there was no legal basis for retaining the appeal fee, which in any case had been paid as a precaution. The board concluded that the appeal fee paid by the intervener should be reimbursed.

#### 8.2.7 Several appellants

In **T 552/97** the board interpreted R. 67 EPC 1973, looking in particular at the English text, as meaning that, where several appeals have been filed, each appellant's appeal fee may be reimbursed if such reimbursement was equitable.

### 8.3. Allowability of the appeal

R. 103 EPC stipulates as a precondition for reimbursement that the appeal must be allowable. It is clear from the wording and purpose of the provision that "allowable" is to be understood to mean that the board of appeal, in substance at least, "follows" the relief sought by the appellants, in other words allows their requests (**J 37/89**, OJ 1993, 201; **T 863/08**; **T 1111/09**). The fact that the appeal is allowed only in part is no impediment to a refund (**J 18/84**, OJ 1987, 215; see also **T 129/01**; **T 604/01**; **T 863/08**, **J 1/13**). However, in special circumstances the appeal fee is reimbursed even if the appeal is not allowed (see in this chapter IV.E.8.2.2.a)).

## 8.4. Substantial procedural violation

According to R. 103 EPC (R. 67 EPC 1973) it is one of the preconditions for reimbursement of the appeal fee that a substantial procedural violation has taken place.

### 8.4.1 Definition

A "substantial procedural violation" is an objective deficiency affecting the entire proceedings (**J 7/83**, OJ 1984, 211). Whether or not there is a substantial procedural violation is to be determined on an objective basis (**J 32/95**, OJ 1999, 733; **T 160/09**).

#### a) Violation must be of procedural nature

In **T 12/03** the board stated that a substantial procedural violation is an objective deficiency in the procedure in the sense that the rules of procedure have not been applied in the manner prescribed by the Convention. According to **J 6/79** (OJ 1980, 225), the giving of incorrect information by the EPO about the rules of procedure, which, if followed by the applicant, could lead to the same consequences as the incorrect application of those rules, could also be considered as lying within the scope of a "procedural violation". In **T 690/06** the board held that an error of judgment on substantive issues by the examining division did not constitute a "procedural" violation (see also **T 698/11**). See also in this chapter IV.E.8.4.5.

#### b) Violation must be substantial and affect the entire proceedings

In **T 682/91** the board of appeal emphasised that a procedural violation which did not adversely affect the rights of the parties could not be considered substantial. The seriousness of a procedural violation derived from its adverse effects.

In **J 14/99**, as in **J 15/99**, **J 21/98** (OJ 2000, 406), **J 22/98** and **J 6/99**, it was decided that a procedural violation which had not played any part in the decision could not be considered substantial (see also **T 2385/10**). In **T 2249/08** the board found it a requirement that the criticised discretionary decision of the department of first instance was decisive for the outcome of the decision under appeal (see also **T 1340/10**).

In **T 1740/06** the board held that the procedural violation of the right to be heard in the case at issue was not substantial. None of the cited circumstances suggested that the examining division could have arrived at any other outcome than the rejection of the application if the proceedings had been conducted correctly.

In **T 5/81** (OJ 1982, 249) it was stated that an alleged violation affecting a part of the decision other than its ratio decidendi could not be a substantial violation within the meaning of R. 67 EPC 1973 (see also **T 959/00**).

In **T 990/91** the board held that, since there was no need for the examining division to put the new argument, which was supererogatory and incidental, forward in its decision in order to refuse the application, the lack of opportunity to reply to it could not be

considered to be a procedural violation, let alone a substantial one sufficient to warrant the reimbursement of the appeal fee (see also **T 1085/06**).

In **T 725/05** the board examined whether or not a party to inter partes proceedings can be adversely affected by an obiter dictum contained in a decision of an opposition division. The board referred to **T 473/98** (OJ 2001, 231) where it was decided this was not the case and that the inclusion of an obiter dictum was appropriate for an opposition division as it may obviate the need for remittal.

In **T 712/97** the board held that the opposition division had considered the respondent's experimental report, but had not relied on it in a way adverse to the appellant. Therefore, the refusal to admit the appellant's experimental report into the proceedings, while a violation of the appellant's right to present comments on the respondent's experimental report, had no substantive effect on the outcome of the proceedings and did not amount to a substantial procedural violation.

In **T 219/93** the board remitted the case to the department of first instance since it clearly called for revision under Art. 109 EPC 1973. The contested decision had also been inadequately reasoned on one point within the meaning of R. 68(2) EPC 1973. Nevertheless, the board decided not to reimburse the appeal fee because the refusal had been made principally on other grounds, and the board did not consider the procedural violation to be so substantial within the meaning of R. 67 EPC 1973 that the reimbursement would be equitable.

In **T 107/05** the board held that the opposition division had overlooked the opponent's arguments as regards E5. The lack of consideration of the opponent's arguments on this document had not been conclusive for the outcome of the appealed decision (this distinguished the case at issue from **T 135/96**). The mistake made by the opposition division could be regarded as a procedural violation but in this particular case not as a substantial one.

In **T 689/05** and **T 933/10** the boards held that the examining division's rejection of the applicant's request that the oral proceedings be held in Munich instead of The Hague had to be reasoned, R. 111(2) EPC, R. 68(2) EPC 1973. In **T 933/10** it was held that this violation justified the reimbursement of the appeal fee. However, in **T 689/05** the board held that the established procedural violation did not affect the entire proceedings before the examining division. The missing part of the reasoning concerning the transfer of the oral proceedings to Munich had no influence on the reasons for refusing the application. It would have been disproportionate to set aside the entire impugned decision because of the partial lack of reasoning of the decision under appeal. In **T 1142/12** the board rejected the appellant's argument that under Art. 116 EPC the parties have not only a right to oral proceedings but also the right to have their case heard at the proper place (here, Munich instead of The Hague). Therefore, according to the board no substantial procedural violation occurred.

In **T 677/08** the board held that, by not allowing the video conference, the examining division took a procedural decision by which the appellant was adversely affected.



Failing to address some of the appellant's arguments was a procedural violation. However, the board did not consider the procedural violation to be fundamental. In the communication, the examining division gave a reason why the video conference was not allowed, namely that there was no video conference room available on the given date. The request was thus not refused arbitrarily but based on a legitimate criterion. Failing to address the appellant's arguments was not a deficiency affecting the entire procedure.

In **T 1607/08** (see also **T 2246/13**) a procedural violation of the principle of the protection of legitimate expectation occurred. Since this violation led to the revocation of the patent and came as a surprise to the patent proprietor, it constituted a substantial procedural violation. In **T 2321/08**, the examining division violated the procedure foreseen in Art. 94(3) EPC. This procedural violation was considered substantial because its immediate consequence was the refusal of the application.

c) Procedural violation must be committed by the department whose decision is under appeal

In **T 469/92** the alleged procedural violation was not an act of the opposition division, whose decision was the subject of the appeal, but instead that of the examining division. Even if such an act were in breach of the procedural requirements of the Convention, a board of appeal would not have the power to order reimbursement.

In **T 1875/07** the board stated that a substantial procedural violation can only be committed by one of the departments charged with the procedure mentioned in Art. 15 EPC 1973 but not by the President acting under Art. 10 EPC 1973. Therefore, the non-disclosure to the public of the details of a system for performance evaluation for examiners cannot amount to a substantial procedural violation.

#### 8.4.2 Oral proceedings

a) Request for oral proceedings

The refusal of a request for oral proceedings usually amounts to a breach of the right to be heard, and as such, a violation justifying the reimbursement of the appeal fee (**T 209/88**, **T 283/88**, **T 598/88**, **T 668/89**, **T 663/90**, **T 766/90**, **T 795/91**, **T 35/92**, **T 686/92**, **T 556/95**, **T 647/99**).

According to **T 405/96**, there is a substantial procedural violation justifying the reimbursement of the appeal fee where, despite a request by the appellants, no oral proceedings have been convened. In the case in point, receipt of the request by the EPO was proven by the appellants' producing a duly stamped acknowledgment of receipt. The fact that the department of first instance could not be held responsible for the loss within the Office was irrelevant. The same applied to the failure by the opposition division, because of an oversight, to hold oral proceedings in response to a clear request by the appellants (**T 671/95**).

Failure to summon the parties to oral proceedings was considered to be a substantial procedural violation in **T 209/88** and **T 93/88** (see also **J 16/02**). In **T 560/88** the board of appeal held that there was a substantial procedural violation where a clear auxiliary request by the appellant for oral proceedings had not been granted (see also **T 543/92**).

In **T 19/87** (OJ 1988, 268), however, the board held that the finding - albeit wrong - that there had been no request for oral proceedings was not a procedural violation within the meaning of R. 67 EPC 1973. Furthermore, failure to seek clarification from the appellant did not constitute a breach of any procedure.

In **T 731/93** the board held that the refusal of a request for **further** oral proceedings constituted a substantial procedural violation where fresh evidence had been admitted.

b) Submissions of parties as response to summons

In **T 1183/02** (OJ 2003, 404) the board held that a response to a summons to oral proceedings before the examining division which contained good faith responsive amendments and arguments did not stay the summons. Hence omitting to confirm that the summons remained valid did not constitute a substantial procedural violation within the meaning of R. 67 EPC 1973.

In **T 343/08** the board stated that there is no general duty for an examining division to provide feedback on an applicant's reply to a summons to oral proceedings, in advance of such oral proceedings.

c) Request for interview

In **T 182/90** (OJ 1994, 641), **T 119/91**, **T 523/91**, **T 366/92**, **T 397/94** and **T 245/15** the boards of appeal stated that it was not a substantial procedural violation within the meaning of R. 67 EPC 1973 if a request to be called back by or have an interview with the primary examiner was ignored. It was for the examiner's discretion whether to conduct such informal discussions in accordance with the Guidelines, bearing in mind the particular circumstances of the case (see also **T 300/89**, OJ 1991, 480).

d) No reasons for refusal of request for postponement

In **T 1505/06** the board held that the failure of the opposition division to include in its decision its reasons for refusing the request for postponement was a substantial procedural violation.

e) Minutes

In **T 642/97** a party alleged that the minutes were incomplete or wrong since essential submissions were not reflected in the file. The board held that the party could request the opposition division to correct the minutes to preserve its rights (**T 231/99**). In the absence of such a request, the allegation of a substantial procedural violation could not be justified (see also **T 99/08**).

In **T 835/10** (referring to **T 437/98**) the appellant alleged that new arguments had been given in the decision of the examining division. The board did not agree and stated that the minutes gave a summary of what was discussed and did not have to expand the different steps of the reasoning given in writing later.

In **T 685/14** the appellant stated that it had not, contrary to R. 124 EPC, received a copy of the minutes of the oral proceedings before the examining division. Therefore, he had not known to which auxiliary request the appealed decision referred. The board took the view that the failure to transmit the minutes was a procedural deficiency but, per se, not a fundamental one. A party should be in a position to file an appeal based on its own notes. Although the decision did not contain the complete wording of the auxiliary request, some features were reproduced, which allowed the appellant to assess whether these reasons applied to its personal copy of the auxiliary request. Moreover, even after having received the minutes, the appellant had neither challenged their consistency with the decision, nor extended its case by any additional considerations. The board dismissed the appeal and refused the request for reimbursement of the appeal fee.

In **T 853/10** the board held that, when judging whether a substantial procedural violation occurred during the oral proceedings, the board could rely only on the minutes of the oral proceedings, which were not disputed by the patent proprietor (see also **T 642/97**), and on the facts agreed upon by all parties.

#### 8.4.3 Right to be heard

The right to be heard (see Chapter III.B) is an important procedural right intended to ensure that no party is caught unawares by reasons given in a decision turning down his request on which he has not had the opportunity to comment. A decision which fails to take into account the arguments submitted by a party and which is based on a ground on which the party had had no opportunity to present its comments, contravenes Art. 113(1) EPC and constitutes a substantial procedural violation, see among many other cases **J 7/82** (OJ 1982, 391); **J 14/82** (OJ 1983, 121), **T 197/88** (OJ 1989, 412), **T 716/89** (OJ 1992, 132), **T 197/91**, **T 640/91** (OJ 1994, 918), **T 734/91**, **T 880/91**, **T 392/92**, **T 892/92** (OJ 1994, 664), **T 951/92** (OJ 1996, 53), **T 1045/92**, **T 1101/92**, **T 220/93**, **T 479/94**, **T 778/98**, **T 594/00**, **T 1039/00** and **T 203/15**.

Other violations of Art. 113(1) EPC may also constitute a substantial procedural violation, see the various cases listed in Chapter III.B.2. For a case in which the board found a violation of the right to be heard but held that a reimbursement was not equitable, see **T 433/08** (see in this chapter IV.E.8.6.1).

The infringement of Art. 113(2) EPC has, in principle, also to be considered to be a substantial procedural violation justifying the reimbursement of the appeal fee (see **T 647/93**, OJ 1995, 132; see also **T 32/82** and **J 19/84**), for example when the final requests were not clarified (**T 666/90**, **T 552/97**, **T 1439/05**, **T 382/10**) or when the opposition division overlooked amended claims presented in a submission **T 543/92** and **T 89/94**). See Chapter III.B.3 "Text submitted or agreed by applicant (patent proprietor) - Article 113(2) EPC".

#### 8.4.4 Inadequate reasons given in the decision at first instance

The obligation to provide adequate reasoning in a decision in accordance with R. 111(2) EPC (R. 68(2) EPC 1973) is closely linked to the principle of the right to be heard under Art. 113 EPC (**T 1340/10**). A failure to do so is to be considered a substantial procedural violation justifying the reimbursement of the fee for appeal (see among many other cases **T 493/88**, OJ 1991, 380; **T 522/90**, **T 360/91** and **T 392/91**, **T 142/95**, **T 648/96**, **T 278/00**, **T 1016/00**, **T 604/01**, **T 362/02**, **T 749/02**, **T 427/03**, **T 571/03**, **T 897/03**, **T 316/05**, **T 1366/05**, **T 1612/07**, **T 1870/07**, **T 87/08**, **T 353/11**, **T 2366/11** and **T 129/14**).

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 had nothing to do with a procedural violation. See also **T 698/10**, where the board added that the examining division was under no obligation to explicitly address every argument presented by the applicant as long as the reasoning given enabled the appellant and the board to examine whether the decision was justified or not. See also Chapter III.B.2.4 "Consideration of the parties' arguments in the written decision".

For cases concerning the obligation under R. 111(2) EPC, R. 68(2) EPC 1973, see Chapter III.K.4.2 "Reasons for the decision", and in particular Chapter III.K.4.2.3.

#### 8.4.5 Error of judgment by a department of first instance

A number of decisions discussed whether an error of judgment by a department of first instance could be regarded as a substantial procedural violation justifying reimbursement of the appeal fee (**T 19/87**, OJ 1988, 268; **T 863/93**; **T 107/05**; **T 1078/07**). See also IV.F.3.3.3 "Review of substantive law excluded".

In **T 367/91** the board stated that to base a decision only on a wrong assessment of prior art and/or the claimed invention had to be regarded as a substantive error, not a procedural violation (see also **T 144/94**, **T 12/03** and **T 1340/10**). In **T 17/97**, the appellant's request for reimbursement of the appeal fee was based on the fact that the opposition division had disregarded a document. In the board's judgment an erroneous assessment of the relevance of a document did not, by its very nature, constitute a procedural violation within the meaning of R. 67 EPC 1973.

The misinterpretation of a document does not constitute a procedural violation (**T 1049/92**, **T 162/82**, OJ 1987, 533, **T 1031/12**). In **T 588/92** the board pointed out that a different opinion on the specialist knowledge to be applied when interpreting the technical content did not amount to a procedural violation. Even a gross error of judgment on the part of the examining division does not justify reimbursement of the appeal fee (**T 860/93**, OJ 1995, 47). Misinterpretation of a letter to an EPO department constitutes an error of judgment and not a substantial procedural violation (**T 621/91**). In **T 970/10** the board held that an incorrect assessment of a document with regard to its

date of availability to the public related to a factual error in respect of the substantive requirements under Art. 54(2) EPC, and not to an error in respect of procedural law.

In **T 687/05** the board held that the fact that the decision under appeal was based on an incorrect interpretation of Art. 100(c) EPC 1973 did not constitute a "procedural" violation, but was simply an error in the application of the law (see also **J 8/13** and **T 378/14**). Nor does it amount to a procedural violation if the examining division wrongly finds that a claim is not sufficiently clear to comply with the requirements of Art. 84 EPC 1973, even where there has been a possible error of judgment and failure to seek clarification from the appellant (**T 680/89**).

The fact that a board comes to a different conclusion from the department of first instance does not by itself mean that the latter has committed a substantial procedural violation (**T 87/88**, OJ 1993, 430; **T 538/89**, **T 182/92**, **J 14/12**, **T 203/15**). In **T 208/00** the board considered that the department of first instance had to be granted a certain degree of latitude in exercising its power of discretion, which in this case it had not overstepped in a clearly inappropriate manner. It stated that it was not equitable to reimburse the appeal fee, especially as under the established case law of the boards of appeal (see **T 860/93**) not even "a gross error of judgment" by the department of first instance was regarded as justifying such reimbursement. In **T 248/00** the board decided that, where a late submission was not admitted, an irregularity had taken place if the department had exercised its discretion incorrectly, that is to say on the basis of irrelevant or arbitrary considerations (see also **T 1651/10**). The board held that, even if the non-admission might ultimately prove to be incorrect, such application of the law did not amount to a substantial procedural violation. The issue was, rather, whether the opposition division's discretion had been incorrectly exercised in not admitting a late-filed request.

Normally there is no procedural violation justifying reimbursement of the appeal fee if the wrong procedure is adopted in a situation where the EPC does not lay down clearly what procedure is to be followed and the case law has not yet established any settled practice (**T 234/86**, OJ 1989, 79). In **T 208/88**, OJ 1992, 22 the board 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. In **T 494/07** the board held that if two apparently similar case constellations were decided differently, this could at most be regarded as an error of judgment. In the case at issue, the board held that not following an earlier board decision did not constitute a substantial procedural violation. In decision **T 875/98** the board noted that the Convention did not contain any rule of procedure which imposed on an opposition division an obligation to abide, in its decision concerning a certain case, by a decision in a different case. It held that a single decision did not establish a "case law" which had to be adhered to in another opposition case, not even if the subject-matter of the two respective cases was closely related. In **J 9/05** and **J 18/05** the board had to decide on the examining division's decisions that R. 69(1) EPC 1973 communications were deemed to have been duly delivered to the addressees on the tenth day following its posting. The board held in each case that whilst the examining division had evaluated the evidence as to the postal delivery incorrectly, this amounted to an error of judgment and could not be characterised as a procedural non-compliance, a prerequisite for the application of R. 67 EPC 1973.

#### 8.4.6 Cases concerning the decision-making process and the decision

##### a) Issuing of decision

###### (i) Issuing of decision before expiry of time-limit to comment

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 (see also **T 663/99**; see also Chapter III.B.2.5.2).

###### (ii) Excessive length of proceedings

In **T 823/11** the board held that the length of the proceedings before the examining division had been affected by unacceptable delays, in particular the delay of more than five years between the supplementary European search report and the examining division's first communication, and the delay of more than two years between the applicant's reply to the examining division's third communication and the summons to oral proceedings. The board considered the duration of the proceedings before the department of first instance of more than twelve years after entry into the European phase as excessive. According to the board, in **T 315/03** even a shorter delay of ten years in a much more complex opposition case had amounted to a substantial procedural violation. The board also referred to the judgment of the European Court of Human Rights in *Kristiansen and Tyvik AS v. Norway* (application No. 25498/08), in which the examination and (administrative) appeal proceedings of a patent application had taken a total of eighteen years. Taking into account the duration of patent protection of twenty years, the Court had found "the length of the administrative proceedings before the patent authorities" to be excessive because it "in effect rendered meaningless any exercise by them [the applicants] of their right of access to a court".

In **T 900/02** the board found that the extreme length of the delay - three years and seven months - between oral proceedings and the issue of a written decision amounted to a substantial procedural violation.

In **T 358/10**, the board found that it had taken an inordinately long time to draw up the contested decision and the minutes of the oral proceedings in writing and issue them to the parties. Sending the minutes 19 months after the oral proceedings had taken place and notifying the decision 22 months after its pronouncement at the end of those proceedings were inherently unacceptable procedural violations which, by themselves, sufficed to justify refunding the appeal fee (see also **T 243/87**, **T 563/11**).

In **T 1131/12** the board stated that, although a delay of five years between a last communication and the written decision would be wholly unacceptable, there was no causal link between this excessive delay and the outcome of the examining division's decision. Moreover, the appellant had only filed and substantiated the request for reimbursement shortly before the oral proceedings. For these reasons, the board refused the reimbursement request under Art. 12(1)(a) and (2) RPBA.

## (iii) Lack of competence

A decision taken by a department that is not competent amounts to a substantial procedural violation justifying the reimbursement of the appeal fee (see **T 2411/10** where the Receiving Section, and not the examining division, was competent to decide). A substantial procedural violation is deemed to have occurred if the decision has been taken by a formalities officer who was not competent to decide (**J 10/82**, OJ 1983, 94; **T 114/82**, OJ 1983, 323; **T 790/93**, **T 749/02**).

## (iv) Decision not approved by all members

In **T 225/96** the board ruled that to issue the parties with a draft decision not approved by all opposition division members present at the oral proceedings was a substantial procedural violation.

## b) Content of decision

## (i) Written decision deviates from oral decision

In **T 425/97** the board decided that any substantive deviation of the decision notified in writing from that given orally at the oral proceedings amounted to a procedural violation. **T 1365/09** held that a contradiction between the decision rendered at the oral proceedings and the written decision as sent to the parties contravened R. 111(1) EPC and amounted to a substantial procedural violation.

## (ii) Decision deviates from previous communication

In **T 2006/08** the board found that although the opposition division had expressed an opinion on the issue of sufficiency of disclosure in favour of the patentee in two communications, this opinion was clearly labelled as being preliminary and non-binding. The board also held that a preliminary, provisional opinion did not prevent a party from making its complete case. It was the responsibility of a party to ensure that the facts and evidence filed were not only unequivocally clear but also as complete as possible. If a party decided to retain or not to file further evidence to support its case, it would run the risk that an adverse decision might be issued based on the available (incomplete) evidence on file. The board rejected the request for reimbursement of the appeal fee.

In **T 980/06**, the contested decision had regarded a claim as patentable, whereas in the sole previous communication the examining division had taken a negative view. In such circumstances, a second communication would have been useful. However, its absence was not a "substantial" procedural violation.

## (iii) Failure to deal with objection

The board of appeal in **T 740/94** held that the failure of the opposition division to deal with an objection under Art. 100(b) EPC 1973 against an amended claim in its decision

to maintain the patent in amended form clearly constituted a substantial procedural violation (see **G 10/91**, OJ 1993, 420, point 19 of the Reasons).

(iv) Board decision containing similar facts not followed

In **T 494/07** the board held that the strict legal obligation to follow the ratio decidendi of a decision of a board (Art. 111(2) EPC 1973) was limited to the same application and the same instance whose decision has been contested in the appeal, but did not extend to other applications (or even to other instances in the same application). This was so even if the subject-matter of the two applications was highly similar (see **J 27/94**, OJ 1995, 831).

(v) Remarks on substantive matters in decision on admissibility

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**).

(vi) Applying legal provision not yet in force

In **T 991/02** an opposition division decision was set aside for lack of a legal basis. The opposition division's application of a new rule, not yet in force in this case, constituted a substantial procedural violation.

c) Signature on decision and minutes

In **T 390/86** the board held that the written reasons for a decision delivered during oral proceedings could only be signed by members of the deciding body who had taken part in the oral proceedings (see also **T 563/11**). In **T 2076/11** the appeal fee was reimbursed as the written decision and the minutes of the oral proceedings were signed by the director of the organisational unit. See also Chapter III.B.2.8 "Changes in the composition of the opposition division after oral proceedings".

In **T 211/05**, the board took the view that for a person to take part in a decision when not entitled to do so (here the director signing the decision instead of the second examiner), resulting in failure to comply with the principle that the power to examine a patent application must not only be exercised personally but also be seen – by both the applicant and the public – to be exercised personally, constituted a substantial procedural violation, in particular because it deprived the applicant of his right to be heard by the full examining division.

d) Composition of opposition division under Art. 19(2) EPC

The board of appeal ordered reimbursement of the appeal fee in **T 382/92** because the composition of the opposition division had not complied with the requirements of Art. 19(2) EPC 1973. The chairman and one member of the opposition division had



already been members of the examining division which had decided on the application leading to the patent concerned (see also **T 939/91**, **T 960/94**, **T 825/08**, **T 1349/10**, **T 1700/10**, **T 79/12**).

e) Requests

(i) Obligation to reason refusal of request

According to **T 961/00**, it is a party's procedural right to file and maintain such requests as are regarded by the competent organ as unallowable or even inadmissible. If a party does so, then the competent organ has to give a decision on it (see **T 1105/96**, OJ 1998, 249), but cannot simply disregard it and deal with the case as if the request did not exist. This would constitute a substantial procedural violation (see also **T 234/86**, **T 484/88**, **T 155/88**).

In **T 1157/01** the decision under appeal had omitted to give reasons for the refusal of the higher ranking requests still pending before the examining division; this amounted to a substantial procedural violation (see also **T 488/94**; for opposition procedure see **T 234/86**, OJ 1989, 79).

(ii) Auxiliary requests and order of requests

In **T 883/07** the board held that in accordance with generally recognised procedural requirements, albeit not codified specifically in the EPC, once a higher order request was refused that request was off the table and the next request in the order chosen by the requester had to be considered as if it were the sole request. The examining division's failure to examine the auxiliary requests independently of the main request amounted to a substantial procedural violation within the meaning of R. 67 EPC 1973.

In **J 23/96** the board held that an auxiliary request was filed in case the main request was refused; the auxiliary request then took its place and had to be dealt with in the same decision. The examining division's failure to deal with the auxiliary request for re-establishment in the decision under R. 69(2) EPC 1973 (R. 112(2) EPC) amounted to a substantial procedural violation.

In **T 320/99** (referring to **T 1105/96**) the examining division considered the auxiliary request allowable, but nonetheless issued a decision refusing the main request and thus the application. The correct course of action would have been to issue a communication under R. 51(4) EPC 1973 based on the auxiliary request. The issue of the decision was a substantial procedural violation which justified the reimbursement of the appeal fee.

(iii) Requests not taken into account because of delay within EPO

In **T 231/85** (OJ 1989, 74) the board held that failure to take the applicant's requests into account as a result of a delay within the EPO (in this case six weeks) constituted a substantial procedural violation (see also **T 598/88**). In **T 205/89**, owing to a mistake by a formalities officer, a request for an extension of the time for submitting comments in

opposition proceedings never reached the opposition division, which therefore took its decision without considering the argument presented in the subsequently filed submission.

(iv) Requests not filed by correct party

In **T 1178/04** a procedural violation within the meaning of R. 67 EPC 1973 had occurred, in that the requests relating to the patentability of the claimed invention were made in the oral proceedings before the opposition division by a party to whom the opposition had been purportedly but invalidly transferred. These requests were inadmissible.

f) Amendments

In **T 246/08** the board stated that a refusal to allow amendments made in advance of any amendment being submitted could not be a reasonable exercise of discretion pursuant to R. 137(3) EPC (former R. 86(3) EPC 1973) and was ipso facto a substantial procedural violation (see also **T 872/90**).

In **T 121/06** the board held that issuing a communication under R. 51(4) EPC 1973 in which amendments were proposed which the applicant could not reasonably be expected to accept without further discussion constituted a substantial procedural violation.

In **T 901/10** the appellant implied that the way in which the examining division had applied R. 137(3) and (4) EPC amounted to a substantial procedural violation. The board agreed that it was an undesirably long delay that, after the application had entered the European phase, no examination report had been issued for six years. Nevertheless such delays, undesirable as they may be, do not oblige the examining division to be more lenient under R. 137 (3) EPC. The appeal fee was not reimbursed.

In **T 1354/13** the appellant argued that it was only informed during the oral proceedings before the examining division about the objection under R. 137(4) EPC, which did not leave sufficient time to prepare comments. The board held that an applicant who presents extensively revised claims at a late stage of the proceedings has to be prepared for the possibility that the admissibility of these claims will be considered under Art. 123 and R. 137 EPC. The request for reimbursement of the appeal fee was refused.

g) Partiality

In **T 900/02** the board stated that a suspicion of partiality must inevitably arise if a member of an opposition division, or any other first instance body, first solicits and then accepts employment with a firm in which a partner or other employee is conducting a case pending before that member, even if it occurred after oral proceedings had been held. This amounted to a substantial procedural violation.

In **T 585/06** the appellant (opponent) considered that the presence of a former member of the boards of appeal, as a consultant of the patent proprietor, at the oral proceedings

before the opposition division led to partiality of the opposition division. The board stated that the former member did not act as an authorised representative but only as consultant of the patent proprietor. He did not address the opposition division, not even under the control of the representative of the respondent. This amounted to an important difference to the facts underlying case **G 2/94**. In the case at issue, the former member only gave hints by whispering to the authorised representative, who was absolutely free to accept them or not, but did not make any intervention of his own motion. The appellant's representative accepted at the beginning of the oral proceedings that the former member would sit beside the representative of the respondent and assist him. Even during the oral proceedings no objection was made to his presence. Moreover, no substantiated reasons of partiality of the opposition division were submitted by the appellant. The request for the reimbursement of the appeal fee was refused.

h) Suspensive effect of appeal

In **J 5/81** (OJ 1982, 155) it was held that there was a substantial procedural violation where the Receiving Section had ignored the suspensive effect of an appeal in contravention of Art. 106(1) EPC 1973.

i) Non-compliance with board order

**T 227/95** related to a situation where a decision was taken by a board to remit the case to the department of first instance (opposition division) for further prosecution and not, as assumed by the division, with instructions to maintain the patent. The fact that the opposition division had not carried out the board's order amounted to a substantial procedural violation with regard to Art. 111 EPC 1973. The case was remitted again to the department of first instance, and the appeal fee was reimbursed.

j) Search

In **T 1411/08** and **T 1515/07** the boards considered that the examining division had to be held to have committed a substantial procedural violation because it had not performed an additional search that was manifestly necessary (see also **T 1924/07**). In **T 1924/07** the board held that a distinction had to be drawn between, on the one hand, whether the examining division had acted despite realising that the features were technical and not notorious, thereby indicating a situation where a search was "manifestly necessary" (cf. **T 1515/07** and **T 1411/08**), and on the other hand, whether the features had been erroneously overlooked or misjudged, i.e. an "error of judgment" had occurred (cf. **T 690/06** and **T 698/11**); the latter case could not be considered a procedural violation.

In **T 291/93** it was held that a simple reference by the appellant to an inadequate search of the prior art could not be taken as sufficiently supporting an allegation that a substantial procedural violation had occurred.

k) Guidelines

The examining division's failure to follow a procedure set out in the Guidelines is not in itself a substantial procedural violation unless it also constitutes a violation of a rule or principle of procedure governed by an Article of the Convention or one of the Implementing Regulations. This is because the Guidelines are not legally binding (**T 42/84**, OJ 1988, 251; **T 51/94**, **J 24/96**, OJ 2001, 434).

In **T 647/93** (OJ 1995, 132) the board stated that it was normally desirable for examining divisions to act in accordance with the Guidelines, but pointed out that these were not rules of law, so failure to follow a procedure set out in them was not in itself a substantial procedural violation (**T 51/94**, **T 937/97**).

l) Third party observations not mentioned in decision

In **T 283/02**, the opposition division had duly forwarded the observations by third parties to the patentee, who had made no comment. The failure of the opposition division to mention these observations in its decision did not constitute a substantial procedural violation, even though a mention would have been desirable.

m) Referral pending before Enlarged Board

Where a decision of the examining division depended entirely on the outcome of proceedings before the Enlarged Board of Appeal on a legal question or point of law raised under Art. 112 EPC 1973 - and this was known to the examining division - the further examination of the application had to be suspended until the matter had been decided by the Enlarged Board of Appeal. Failure to do so amounted to a substantial procedural violation under R. 67 EPC 1973 (**T 166/84**, OJ 1984, 489). See also Chapter IV.F.2.5.3 "Stay of first instance proceedings following a referral".

n) Refusal of application on one ground only

In **T 859/97** the board took the view that it was sufficient for the examining division, when deciding to refuse a European patent application under Art. 97(1) EPC 1973, to state one ground only which in their opinion would prejudice the grant of a European patent. In the case in point, the examining division was unable to grant a patent because it had concluded that the subject-matter of claim 7 was not new. Consequently, it was under no obligation to comment on the patentability of claims 1 to 6. The requirements of R. 67 EPC 1973 were thus not met.

#### 8.4.7 Cases concerning documentation and communications passing between the EPO and the parties

a) Ambiguous communication or wrong form

In **J 3/87** (OJ 1989, 3) it was stated that if an EPO communication was not as clear and unambiguous as it ought to be, and led a reasonable recipient into error, that amounted

to a substantial procedural violation, even if the ambiguity of the communication was partly due to an unfortunate provision of the law.

In **J 17/92** the appellants complained that the examining division had used the wrong form for its communication, namely a form threatening that the application would be refused if a response was not filed. The board considered that the failure of the examining division to withdraw the wrong form and the threatened sanction of a possible refusal of the application amounted to a substantial procedural violation.

b) No reply to communication under Article 101 EPC

In **T 362/02** the opposition division had revoked the patent for the sole reason that the appellant had not replied to a communication under Art. 101(2) EPC 1973 inviting him to file observations. The board found that this decision was a substantial procedural violation because the EPC did not provide any sanction for a party's failure to reply to a communication under Art. 101(2) EPC 1973. Further, revocation of a patent for mere failure to reply to a communication was contrary to the clear intention of the law, which required a proprietor to agree to the form in which a patent was granted or amended and to use clear and unambiguous words if he wished to abandon a patent.

c) Wrong type of communication

In **J 10/07** (OJ 2008, 567), the board found that, although the Receiving Section was not to be blamed for issuing a communication under R. 43(2) EPC 1973, as the drawings could not have been in the file on that date, it should not have issued the notification under R. 43(3) EPC 1973 but a communication pursuant to R. 43(1) EPC 1973. This amounted to a substantial procedural violation. If the Receiving Section had followed the legally correct procedure, an appeal would not have been necessary.

d) Period set for opponent to reply to patentee's response

In **T 138/08** the appellant (opponent) complained that he had not been given sufficient time to reply to the patentee's observations filed in response to the opposition. The question before the board was whether two months and 21 days was sufficient time to present comments. The board observed that the communication of the observations of the patentee had been made merely for information and the opposition division had not raised any matter of substance in the communication. The opponent had been free to decide whether to comment on it or to remain silent. Had he decided to remain silent, no act would have been required; had he decided to react to the letter of the patentee, sending a request for the time considered necessary for the reply would have sufficed. For that simple act a period of two months was considered sufficient. Therefore, the reimbursement of the appeal fee under R. 103(1)(a) EPC was not justified.

e) Observations not forwarded to other party

In **T 789/95** the file contained no indication that a copy of the opponent's observations had been forwarded to the patent proprietor. It was therefore to be assumed that the

communication of the observations to the patent proprietor had been omitted, in contravention of the Guidelines. In the board's view, this constituted a substantial procedural violation, as it infringed the principle that all parties to proceedings must be accorded the same procedural rights.

f) Appointment of professional representative

In **J 20/96** the EPO had waited one year and three months before requesting the appointment of a professional representative and nearly another year before asking for the appellant's new address. Although conceding that the Receiving Section had been slow to request the appointment of a professional representative, the Legal Board ruled that this was not a substantial procedural violation because such appointments were a matter for the appellant; similarly, it was also up to him or his representative to provide his address.

g) Warning in relation to grace period

As to the EPO's obligation to issue a warning in relation to the grace period of R. 85a EPC 1973 (this provision was deleted in the EPC 2000), and the question of whether or not this warning constituted a "courtesy service", see **J 17/04** and **J 32/97**.

## **8.5. Reimbursement of appeal fee in case of interlocutory revision**

### 8.5.1 Requirements

Pursuant to Art. 109 EPC a department whose decision is contested must rectify its decision if it considers the appeal admissible and well founded; this applies in ex parte cases only. R. 103 EPC (R. 67 EPC 1973) allows for reimbursement of the appeal fee in the case of interlocutory revision. The grant of interlocutory revision constitutes a necessary, but not sufficient, prerequisite for the department of first instance to allow a request for the reimbursement of appeal fees (**T 1222/04**). The words "if such reimbursement" in R. 103 EPC refer both to interlocutory revisions and appeals; this means that in the event of interlocutory revision, too, it is a prerequisite that a substantial procedural violation has occurred and that reimbursement is found equitable in the discretion of the deciding body (**T 939/95**, OJ 1998, 481; see also **T 79/91**, **T 536/92**).

### 8.5.2 Competence to decide on reimbursement

As to the question which department is competent to decide on the request for reimbursement in cases of interlocutory revision, the legal situation defined by **G 3/03** (OJ 2005, 344) and **J 32/95** (OJ 1999, 733) is now enshrined in R. 103(3) EPC (see **T 625/09**, **T 206/10**). Decision **J 32/95** held that if the department of first instance considered the request for reimbursement of the appeal fee not to be well-founded in the event of interlocutory revision, it had to remit the request to the board of appeal for a decision. In **G 3/03** the Enlarged Board of Appeal held that in the event of interlocutory revision under Art. 109(1) EPC 1973, the department of first instance whose decision had been appealed was not competent to refuse a request from the appellant for

reimbursement of the appeal fee. The board of appeal which would have been competent under Art. 21 EPC 1973 to deal with the substantive issues of the appeal if no interlocutory revision had been granted was competent to decide on the request. **G 3/03** was, for example, applied in **T 1379/05**, **T 1315/04**, **T 245/05**, **T 1863/07** and **T 2352/13**.

In **T 21/02** an appeal had been fully dealt with by interlocutory revision by the department of first instance and was thus no longer pending when a request for reimbursement of the appeal fee was submitted. The board held that the facts of the case differed from those underlying decisions **G 3/03** and **J 32/95** and that in the case before it, the request had been submitted in the absence of a pending appeal and hence could not constitute an ancillary issue to be dealt with in appeal proceedings. The board was thus not empowered to decide on the request for reimbursement of the appeal fee (see also **T 1703/12**, **T 2134/12**, **T 2008/14**).

The board in **T 242/05** added that once interlocutory revision had been granted, the appeal was *res judicata*. In the absence of a pending appeal, any request for reimbursement of the appeal fee filed after the decision to grant interlocutory revision will be considered inadmissible, regardless of whether the decision was taken by the examining division or the board of appeal as the body competent to consider the appeal (see also **T 70/08**). The board also commented that the first-instance department should decide such matters itself; there was no point referring them to the boards of appeal.

In **T 893/13** the board disagreed with **T 21/02** and **T 242/05**, in particular with the finding that non-reimbursement of the appeal fee by the examining division in the case of interlocutory revision must be equated with the situation in which the board of appeal has refused a corresponding request. Since the examining division was not competent to decide that the appeal fee was not to be reimbursed, an interlocutory revision without an order for reimbursement could not be construed as a decision not to reimburse. A request for reimbursement of the appeal fee could be validly filed even after interlocutory revision, since R. 103 EPC entrusted the boards with the decision on "all other ... matters of reimbursement" based on only two conditions: that the decision was rectified and that the appeal fee was not reimbursed by the examining division.

### 8.5.3 Examining division should have rectified decision

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 justifying the reimbursement of the appeal fee (see also **T 808/94**, **T 898/96**, **T 861/03**, **T 1113/06**, **T 971/06**, **J 7/07**; see also **T 685/98**, OJ 1999, 346). In **T 183/95** no reimbursement was ordered, however. The board in this case pointed out that interlocutory revision could be granted at the discretion of the department of first instance when it was considering whether the appeal was "well founded". In this case, the remittal of the appeal could not be said to have been manifestly wrong from a procedural point of view (see also **T 536/92**). In **T 2528/12** too the board declined to order reimbursement, because although interlocutory revision had not been granted, as it should have been, that was not a substantial procedural error. That the grant

proceedings had taken longer as a result had not adversely affected the appellant in a legal sense.

In **T 794/95** the board took the view that, under the circumstances of the case, the examining division should have rectified its decision under Art. 109(1) EPC 1973. The board did not, however, consider it equitable to order the reimbursement of the appeal fee, since the examination procedure up to the decision under appeal was not tainted with any failure and the necessity for the appellant to file an appeal emerged exclusively from the substance of the decision, not because of any procedural shortcomings up to this stage and equally not from the later incorrect handling of the appeal by the examining division (i.e. the failure to rectify its decision).

In **T 685/98** (OJ 1999, 346) the board held that where a fundamental procedural right had manifestly been violated in a refusal pursuant to Art. 97(1) EPC 1973, or in the foregoing examination procedure, a further substantial procedural violation occurred if the examining division failed to grant interlocutory revision on appeal (following **T 647/93**, OJ 1995, 132; see also **T 1765/13**), since such a right had to be safeguarded irrespective of the substantive merits of the case.

In **T 898/96** the board took the view that, as soon as the applicant approved in the notice of appeal the text of the application as specified previously in a communication under R. 51(4) EPC 1973, there was no reason why the patent should not have been granted, even if the applicant did not approve this text before filing the appeal. Thus the decision of the examining division to refuse the application having regard to Art. 113(2) EPC 1973 should have been rectified by way of interlocutory revision. The failure to rectify such a decision in this way was a substantial procedural violation. However, the board did not consider the refund of the appeal fee to be equitable, for the very reason that the applicant did not approve this text of the application until he filed an appeal.

In **T 704/05** the board found that the examining division could have set its decision aside by way of interlocutory decision pursuant to Art. 109(1) EPC 1973. However, given that the examining division was expressly precluded from giving its reasons for not granting interlocutory revision, it was not open to the board to criticise this omission. The mandatory but necessarily silent judgment made pursuant to Art. 109(1) EPC 1973 as to whether an appeal refuted the reasons for a refusal was not an exercise of discretion and ipso facto left no room for an inquiry as to whether discretion had been properly exercised. The board was aware that a number of decisions of the boards of appeal had taken a different view on this point - to the extent of sometimes castigating such omission as a substantial procedural violation - but respectfully suggested that these decisions had not given sufficient weight to the implications of the silence imposed on the examining division by Art. 109(2) EPC 1973.

The board in case **T 1982/07** said that it is fundamental to the principle of fair trial that in the examination an applicant, when confronted with new prior art documents, is not only given the right to be heard, but also the right to react thereto by amending the claims in order to overcome the prior art references. In the case at issue, when confronted with a highly relevant document, it would have been necessary to give the applicant the



opportunity to amend the claims, if need be by introducing features of the description. The way the examining division exercised its discretion under R. 86(3) EPC 1973 (now R. 137(3) EPC) was therefore erroneous, as this did not allow the applicant to react appropriately, but rather tied its hands to an extent neither mandated by procedural efficiency nor justified in the light of the prior art documents. The examining division thus exercised its discretion in an unduly restrictive manner, thereby committing a substantial procedural violation. Therefore, it would have been incumbent on the examining division to rectify the decision pursuant to Art. 109(1) EPC, but this was not done. The board ordered the remittal to an examining division that had not previously dealt with this case.

#### 8.5.4 Rectification decision maintaining earlier decision

According to **T 691/91**, Art. 109 EPC 1973 provided for two legally viable alternatives: to maintain or to annul the decision which was appealed. In the case at issue, the examining division had chosen a third way; maintaining the earlier decision by issuing a decision on rectification. This alternative was not covered by the provisions of Art. 109 EPC 1973. The way in which the examining division proceeded resulted in the appellant having to file a second appeal against the decision on rectification. The board ordered reimbursement of the second appeal fee because the decision on rectification was *ultra vires*, and reimbursement of the first appeal fee because a violation of the right to be heard had occurred during the examination proceedings (see also **T 252/91**).

#### 8.5.5 Re-opening examination after rectification

In **T 142/96** the practice of re-opening examination after rectification was held to be contrary to the principle of procedural economy underlying Art. 109 EPC 1973 and so constituted a substantial procedural violation.

In **T 2247/09** the examining division had granted interlocutory revision, proceeded with the examination of the new subject-matter put forward with the appeal, and refused the application again in its second decision. The appellant claimed that he had had to pay two appeal fees in order to have the claims considered by a board of appeal. The board noted that the reasons given in the examination division's second decision differed from those given in its first decision. Moreover, the decision to grant interlocutory revision had been correct because the applicant's new request had removed the reasons for the decision under appeal. The examining division then had to proceed with the examination of the new subject-matter. The mere fact that this further examination again resulted in the refusal of the application did not constitute a substantial procedural violation.

### 8.6. Reimbursement must be equitable

#### 8.6.1 Causal link between substantial procedural violation and filing of appeal

For the reimbursement of the appeal fee to be equitable the boards require a causal link between the substantial procedural violation and the filing of the appeal (**T 388/09**, **J 9/10**, **T 2373/11**). In **T 281/03** the board held that for the reimbursement to be equitable the appeal had to be at least in part caused by the substantial procedural violation. In

**T 1198/97** and **T 1101/92** the board expressly observed that there was a causal link between the violation of the appellant's right to be heard and the necessity to appeal; thus reimbursement of the appeal fee was equitable.

In **T 2111/13** the board held that, according to established case law, for the reimbursement of the appeal fee to be equitable a causal link between the substantial procedural violation and the filing of the appeal is required. According to an alternative approach, a procedural violation is not to be deemed substantial if the outcome of the proceedings would not have been different had the violation not occurred (see in this chapter IV.E.8.4.1.b)). In the case at hand, the board saw no need to choose between these two approaches and rejected the appellant's request for reimbursement.

In the cases that follow the boards held that reimbursement was not equitable because no causal link could be established.

In **T 2106/10** the board acknowledged that several deficiencies occurred in the first instance proceedings, but reiterated that any reimbursement of the appeal fee has to be equitable and depends on the question whether these procedural deficiencies are 1) substantial and 2) forced the appellant to file the present appeal. As none of the alleged procedural deficiencies raised by the appellant were specifically related to the refusal of the main request, the appellant had had to file the appeal irrespective of whether or not the alleged substantial procedural violations had occurred. In **T 41/97**, a refund was not equitable because the procedural error (refusal of interlocutory revision prior to receipt of the statement of grounds of appeal and before the expiry of the period for filing it) was not the reason the appeal had been filed (see also **T 1891/07**, **T 1994/11**, **T 2227/09**).

In **T 711/11** the appellant alleged that the examining division found a lack of unity without providing adequate reasoning. The board stated that lack of unity was not the sole ground given in the contested decision for refusing the application. The appellant would in any case have had to file an appeal in view of the ground of lack of inventive step. Therefore, the board considered the reimbursement of the appeal fee not equitable.

In **T 893/90** the contested decision to refuse the application on the grounds of lack of novelty was based primarily on document 1, on which, in contrast to document 2, the appellant had had adequate opportunity to put forward comments. The board stated that the decision under appeal had been fully reasoned, and that the procedural violation as regards the reliance on document 2 was thus not sufficiently closely linked to the need to pay an appeal fee for it to be equitable to reimburse the fee.

In **T 601/92** the opposition division had not commented, either in a communication or in its decision, on auxiliary request (5) submitted by the patent proprietor in good time before the decision was issued. Because auxiliary request (2), which had been submitted in the appeal proceedings and which preceded auxiliary request (5), was allowed, the board did not see any reason, despite the procedural violation, to reimburse the appeal fee, as this would not have been equitable.

In **T 2377/09** the board took the view that reimbursement of the appeal fee solely on the grounds of the established procedural violation would not be in accordance with the equitability requirement of R. 67 EPC 1973 (R. 103 EPC). This was because the rejection decision was based on additional, alternative grounds which had given the appellant no cause to claim a substantial procedural violation and against which it would in any case have had to appeal to get the decision set aside (with reference to **T 893/90**, **T 219/93**, **T 4/98** (OJ 2002, 139) and **T 978/04**).

In **T 272/05** a substantial procedural violation occurred but had no influence on the outcome of the proceedings; since the party had to appeal anyway, refund of the appeal fee was not equitable.

In **T 840/07** the appellant's request which had succeeded in the appeal was the same as the main request which it had filed before the examining division but had later replaced. The appellant had not pursued that request to the point where it became the subject of a decision. The board concluded that the appellant had had no choice but to appeal if it wanted the result it had eventually obtained before the board. To reimburse the appeal fee would have given the appellant a fee-free appeal which would be inequitable (see also **T 784/11**, referring to **T 4/98**).

In **T 1891/07** the board held that despite the presence of a substantial procedural violation it would not be equitable to reimburse the appeal fee because the violation could not have been causative in filing the appeal since it occurred after the notice of appeal had been filed.

In **T 1990/08** the appellant submitted that the examining division had committed a procedural violation as it had not provided a translation of D1 but had used it to deny inventive step. The board held that even if the inventive step objection including the appraisal of document D1 in the decision were disregarded, the contested decision would still be negative as it had also relied on Art. 84 and 123(2) EPC to refuse the application. Regardless of whether a substantial procedural violation had occurred or not, the appellant had had to appeal in order to obtain a reversal of the first-instance decision. The alleged procedural violation could not have been the immediate and only cause of the need to appeal and to pay an appeal fee.

In **T 433/08** the board and the parties agreed that a violation of Art. 113(1) EPC had occurred because the opposition division had relied in its decision on a document, which had not been referred to in the course of the opposition proceedings. The board refused, however, the request of the opponent (appellant) to reimburse the appeal fee because it found the reimbursement not equitable. The opposition division would not have reached a decision more favourable to the opponent if it had not taken into account said document. Thus, the opposition division had not acted to the detriment of the opponent. The board concluded that the rights of the opponent (appellant) were not curtailed to an extent that would make the reimbursement of its appeal fee equitable by reason of a substantial procedural violation.

In **T 1680/11** the board held that an alleged procedural violation with respect to a decision to rectify under Art. 109 EPC could not justify refunding the appeal fee. A decision to grant an appeal could not be the reason for filing the appeal, as it was - by its very definition - taken after the appeal had been filed.

#### 8.6.2 Conduct of appellant

The conduct of the appellant may render the reimbursement of the appeal fee not equitable even if a substantial procedural violation occurred, in particular if the appellant made no use of opportunities given to it to participate in the initial proceedings (**J 4/09**, **T 1500/10**).

##### a) Reimbursement held not to be equitable

In **J 22/85** (OJ 1987, 455) the board did not consider a reimbursement of the appeal fee to be justified because the appellant had failed to provide the Receiving Section with the evidence subsequently submitted in the appeal proceedings.

In **J 4/09**, the board said that, as a rule, an applicant could be regarded as behaving inequitably if it made no use of opportunities to participate in the initial proceedings. In this case, it had not reacted to the Receiving Section's communication; only in its statement of grounds for appeal had it drawn attention to an obvious inconsistency.

In **J 18/96** (OJ 1998, 403) the Receiving Section had failed to observe the provisions concerning examination on filing. Although the appeal was allowed on the ground, *inter alia*, of a procedural violation, the reimbursement of the appeal fee was not equitable because the appellants themselves had contributed to the failure of the proceedings before the Receiving Section.

In **T 674/12** the board held that the appellant, by filing different unclear requests, did not help to expedite the proceedings and contributed to the fact that the decision of the examining division was based on a request which was no longer in the proceedings. The board considered the reimbursement of the appeal fee not to be equitable.

In **T 167/96** the impugned decision did not meet the minimum requirements for a reasoned decision. Although there was no doubt that this lack of reasoning amounted to a substantial procedural violation, the board did not consider that a refund of the appeal fee was equitable. Indeed, it was clear from the file history that the proprietor had been afforded a very considerable period of time by the department of first instance to file appropriate amendments, but had not replied. The appellant had availed himself of the appeal procedure to file necessary amendments which the opposition division had sought in vain over a period of years to elicit from him (see also **T 908/91**).

In **T 1216/02** the search division had sent a supplementary European search report to the applicant (appellant) with a wrong citation which was deceptively similar to the correct one. The examining division had refused the application because of the applicant's "incomprehensible" response to its second communication. The appellant had

requested that the examination procedure be resumed to enable him to provide a response based on the right document. The board held that, albeit for reasons outside the knowledge and control of the examining division, the refusal decision had been based on evidence on which the applicant had not had an opportunity - viewed objectively - to present his comments. This constituted an objective substantial procedural violation under R. 67 EPC 1973. However, the board did not deem reimbursement of the appeal fee equitable, because the appellant should have facilitated further substantive examination in the event of remittal or interlocutory revision by including in his statement of grounds of appeal a substantive response to the examining division's communication, based on the document which, at the time when the appeal was filed, he had known to be correct.

In **T 1500/10** the board held that if oral proceedings took place at the instance of the EPO because it considered this to be expedient under Art. 116(1) EPC and the duly summoned party does not attend them without serious reasons, this conduct might have the consequence that it would not be equitable to reimburse the appeal fee.

#### b) Reimbursement held to be equitable

In **T 281/03** dated 17 May 2006 the board held that reimbursement of the appeal fee was equitable despite the fact that the appellant had continuously delayed his case on inventive step until the last moment. The board noted that delaying detailed substantiation of the ground of inventive step raised in the notice of opposition until the last moment of opposition proceedings should be avoided if possible, since it created an unexpected situation for the other parties and the opposition division. However, where the inventive step argument was based on the same document as the novelty argument, and the novelty of the features in question depended on how the document was interpreted as a whole, it might be difficult, if not impossible, for an opponent to argue lack of inventive step without a precise statement of how the document was understood, and the features actually found to be different by the opposition division.

#### 8.6.3 Violation of the principle of the protection of legitimate expectations

In **T 308/05** the board ruled that the appeal fee was to be reimbursed even though the appeal had been withdrawn. The board referred to **J 30/94** and **J 38/97** (see below) and held that, in exceptional cases it was possible - outside the scope of R. 67 EPC 1973 - to consider refunding the appeal fee for reasons of equity. A refund had been ordered, for instance, in cases where the principle of the protection of legitimate expectations had been violated. The fact that in the case in point the EPO had been found to have breached the principle of the protection of legitimate expectations, and that the consequence had been the filing of an appeal which was objectively superfluous, made it necessary for reasons of equity to refund the appeal fee paid by the appellant.

In **J 30/94** the board held that Art. 109(2) EPC creates a legitimate expectation of the parties that an appeal is remitted to the board of appeal within a reasonable time after the decision of the department of first instance not to allow the appeal. In the case at hand it took seven years for the appeal to be remitted to the board of appeal. The board

found it equitable under these exceptional circumstances to order the reimbursement of the appeal fee although the appeal had been withdrawn. In **J 38/97** the appeal was found inadmissible but the appeal fee was nevertheless refunded. The board took the view that the appellant, having requested an appealable decision, could legitimately expect the impugned decision to be issued by the competent department and not by a person lacking legal authority. In accordance with the principle of good faith, it was equitable in these circumstances to order the reimbursement of the appeal fee.

## F. Proceedings before the Enlarged Board of Appeal

1.	Introduction	1216
2.	Referral under Article 112 EPC	1217
2.1.	General	1217
2.2.	Composition	1217
2.3.	Referral by a board of appeal	1217
2.3.1	General	1217
2.3.2	Discretion of the board	1218
2.3.3	Relevance of the referred question for the underlying case	1219
2.3.4	Question of law	1220
2.3.5	Pending proceedings	1220
2.3.6	Ensuring uniform application of the law	1221
2.3.7	Point of law of fundamental importance	1222
2.4.	Referral by the President of the EPO	1222
2.4.1	General	1222
2.4.2	Discretion of the President	1223
2.4.3	Different decisions	1223
2.4.4	Two boards of appeal	1223
2.5.	Procedural issues	1224
2.5.1	Question already decided by the Enlarged Board	1224
2.5.2	Question already pending before the Enlarged Board	1224
2.5.3	Stay of first instance proceedings following a referral	1225
2.5.4	Stay of appeal proceedings following a referral	1225
3.	Petition for review under Article 112a EPC	1226
3.1.	General	1226
3.2.	Transitional provisions	1226
3.3.	Scope of review by the Enlarged Board of Appeal	1227
3.3.1	Grounds for a petition for review	1227
3.3.2	Grounds listed exhaustively	1227
3.3.3	Review of substantive law excluded	1228
3.4.	Article 112a(1) EPC - party entitled to file a petition for review	1229
3.5.	Rule 106 EPC - obligation to raise objections	1229
3.5.1	Purpose	1230
3.5.2	Requirements of a valid objection	1230
3.5.3	Examples of invalid objections	1231
3.5.4	Minutes as evidence that the objection was raised	1231
3.5.5	Objection could not have been raised	1231
3.5.6	Compliance with Rule 106 left open	1232
3.6.	Rule 107 EPC - contents of the petition for review and time limits	1232
3.7.	Article 12(1) RPEBA - late-filed submissions in the review procedure	1233
3.8.	Rule 109 EPC - composition of the Enlarged Board and review procedure	1233
3.9.	Factual bases for the review - minutes and grounds for the decision	1234
3.10.	Burden of proof	1234
3.11.	Article 112a(2)(a) EPC - alleged breach of Article 24 EPC	1234
3.12.	Article 112a(2)(b) EPC - person not appointed as a board member	1235
3.13.	Article 112a(2)(c) EPC - alleged fundamental violation of Article 113 EPC	1235

3.13.1	General	1235
3.13.2	"Fundamental" violation of Article 113 EPC - causal link	1235
3.13.3	No prior assessment of the merits of a submission	1235
3.13.4	Objective approach - board's intention irrelevant	1236
3.13.5	No obligation to provide detailed reasons for a decision in advance	1236
3.13.6	Boards' obligation to remain neutral	1236
3.13.7	Parties' obligation to participate actively in the appeal proceedings	1236
3.13.8	Reasons for a decision allegedly surprising	1236
3.13.9	Timing of a decision allegedly surprising	1238
3.13.10	Consideration of the parties' arguments in the written decision	1238
3.13.11	Parties' obligation to know the case law, references to decisions	1239
3.13.12	No right to be heard separately on all requests	1239
3.13.13	No right to a further hearing at first instance	1239
3.13.14	No right to a referral under Article 112 EPC	1239
3.13.15	No right to a communication; communication allegedly misleading	1239
3.13.16	Late-filed submissions - boards' discretion under Article 13 RPBA	1240
3.13.17	Alleged violation of Article 113(2) EPC	1240
3.13.18	Further examples of unsuccessful petitions	1240
3.13.19	Successful petitions under Article 112a(2)(c) EPC	1241
3.14.	Article 112a(2)(d) EPC - any other fundamental procedural defect	1242
3.14.1	Rule 104(a) EPC - failure to arrange requested oral proceedings	1242
3.14.2	Rule 104(b) EPC - failure to decide on a party's request	1242
3.14.3	Successful petition under Rule 104(b) EPC	1243
3.15.	Article 112a(2)(e) EPC - criminal act having an impact on a decision	1244
3.16.	Rule 108(3) EPC - effects of a successful petition for review	1244
4.	Removal from office of a board member	1245
4.1.	General	1245
4.2.	Composition	1245
4.3.	Removal and judicial independence	1245
4.4.	Independence from disciplinary proceedings	1245
4.5.	Adversarial judicial proceedings	1246
4.6.	Publication of the decision	1246
4.7.	Reimbursement of costs	1246

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## 1. Introduction

The Enlarged Board of Appeal is responsible for proceedings under Art. 112 EPC (referral of points of law by boards of appeal or the President of the EPO), proceedings under Art. 112a EPC (petitions for review against decisions of the boards of appeal) and proceedings under Art. 23(1), first sentence, EPC (removal from office of a member of the boards of appeal).

The provisions governing the procedure before the Enlarged Board are set out in the EPC, the Implementing Regulations and the RPEBA. The latter are binding upon the



Enlarged Board, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention (Art. 19 RPEBA).

The members of the Enlarged Board are mainly appointed from among the members of the boards of appeal, who continue to exercise their functions in the Legal Board or their respective technical boards ('internal members'). This double function is in itself not a reason for exclusion or objection under Art. 24 EPC (see **R 12/09** of 3.12.2009, **R 19/12** of 25.04.2014 and **R 2/14** of 17.02.2015 for petition for review proceedings). Legally qualified members of national courts or quasi-judicial authorities may also be appointed as members of the Enlarged Board ('external members'), and may continue their judicial activities at national level (Art. 11(5) EPC).

## **2. Referral under Article 112 EPC**

### **2.1. General**

Art. 112 EPC defines the conditions in which legal uniformity within the European patent system may be established by means of a referral to the Enlarged Board of Appeal. It requires the boards (Art. 112(1)(a) EPC) or the President (Art. 112(1)(b) EPC) to deem the referral necessary, either in order to ensure uniform application of the law or if points of law of fundamental importance arise. For a referral by the President, a further admissibility criterion is that two boards of appeal must have given different decisions on the question referred (**G 3/08**, OJ 2011, 10).

This chapter concerns Art. 112 EPC as such. The Enlarged Board's answers to referred questions of law are covered in the chapters corresponding to these questions.

### **2.2. Composition**

In proceedings under Art. 112 EPC, the Enlarged Board consists of five legally and two technically qualified members; chairman must be a legally qualified member (Art. 22(2) EPC). If a board of appeal refers a question to the Enlarged Board, at least four members of the Enlarged Board must not have taken part in the proceedings before the referring board (Art. 2(4) RPEBA).

### **2.3. Referral by a board of appeal**

#### **2.3.1 General**

Under Art. 112(1)(a) EPC a board of appeal *shall* refer a question to the Enlarged Board of Appeal if it considers that a decision is required, in order to ensure uniform application of the law or because a 'point of law of fundamental importance' arises. With the EPC 2000, the English wording was changed from "important" to "fundamental importance" in order to bring it into line with the French and German versions (see **G 1/12**, OJ 2014, A114).

Only questions on a specific point, not entire cases, may be referred to the Enlarged Board (e.g. **T 184/91**, **T 198/12**). The Enlarged Board of Appeal is not a third instance within the EPO, but part of the second instance constituted by the boards of appeal (**T 79/89**, OJ 1992, 283). However, the Enlarged Board's answers to the referred points of law are binding on the referring board in respect of the appeal in question (Art. 112(3) EPC; see also **J 8/07**).

The Enlarged Board of Appeal is not bound by the way the referring board formulated the question, and may redraft the referred question (see, for example, **G 2/08**, OJ 2010, 456, **G 2/10**, OJ 2012, 376, and **G 1/13**, OJ 2015, A42). The Enlarged Board does not consider referred questions narrowly, but in a way as to clarify the points of law which lie behind them (**G 3/14**, referring to **G 2/88** and **G 6/88**, OJ 1990, 93 and 114).

The Enlarged Board of Appeal in petition for review proceedings under Art. 112a EPC is not a "Board of Appeal" within the meaning of Art. 112(1)(a) EPC that could initiate referral proceedings under that provision (**R 7/08**, **R 1/11**, **R 7/12**). The Disciplinary Board of Appeal has no power to refer questions to the Enlarged Board of Appeal either (**D 5/82**, **D 7/82**, **D 9/91**, **D 30/05**).

If a board is not empowered to decide a question (here: whether to hold oral proceedings before the examining division in Munich instead of in The Hague), it is not empowered to refer that question to the Enlarged Board (**T 1142/12**).

Questions can be referred by a board either of its own motion or following a request from a party. If a board rejects a party's request for referral, it must give reasons in its final decision (Art. 112(1)(a) EPC). This was considered necessary to provide the parties with a certain guarantee, on the one hand, and to enable a certain degree of standardisation of the jurisprudence on the other (travaux préparatoires, BR/177/72, p. 31). Providing parties with a right of reference was, however, rejected (BR/168/72, p. 51).

The parties to the appeal proceedings are parties to the proceedings before the Enlarged Board (Art. 112(2) EPC). The Enlarged Board may invite the President of the EPO to comment on questions of general interest; the parties are entitled to submit their observations on the President's comments (Art. 9 RPEBA). Third parties may send written statements (*amicus curiae* briefs) to the Enlarged Board (Art. 10 RPEBA).

### 2.3.2 Discretion of the board

Several decisions state that referring a question under Art. 112(1)(a) EPC lies within the discretion of the boards (e.g. **T 1016/10**: "established jurisprudence"; **T 365/05**, **T 1242/04**, OJ 2007, 421; **T 390/90**, OJ 1994, 808: even if a point of law of fundamental importance is concerned). However, while the view of the referring board is decisive for assessing whether a referral is required, such assessment should be made on objective criteria and should be plausible (**G 3/98**, OJ 2001, 62; **G 2/99**, OJ 2001, 83). One of the criteria identified in **T 1242/04** was whether the question can be answered beyond all doubt by the board itself, in which case it does not need to be referred to the Enlarged Board (see also in this chapter IV.F.2.3.7).

Under Art. 21 RPBA, a referral of questions to the Enlarged Board of Appeal must be made in cases where the board considers it necessary to deviate from an interpretation of the EPC contained in an earlier opinion or decision of the Enlarged Board of Appeal. According to Art. 20(1) RPBA, if a board wishes to deviate from an earlier decision taken by a board of appeal, a referral is not compulsory, but the board must give the grounds for deviation unless such grounds are in accordance with an earlier opinion or decision of the Enlarged Board (**T 560/13**; see also **T 1676/08** and **T 1020/03**, OJ 2007, 204). Moreover, the President of the EPO must be informed of the diverging decision (Art. 20(1) RPBA), in order to enable the President to make use of its own right of referral if appropriate (**G 1/89**).

### 2.3.3 Relevance of the referred question for the underlying case

The referred question must not have a merely theoretical significance for the original proceedings which would be the case if the referring board were to reach the same decision regardless of the answer to the referred question (**G 3/98**, OJ 2001, 62, **G 2/99**, OJ 2001, 83; see also **T 547/08**). In other instances the Enlarged Board stated that "the referred point of law is relevant for deciding the case underlying the referral" (**G 2/04**, OJ 2005, 549) or that "answers to the questions referred are necessary for each Board of Appeal to be able to dispose of their respective appeals on the correct legal basis" (**G 1/05**, OJ 2008, 271, **G 1/06**, OJ 2008, 307; see also **G 2/06**, OJ 2009, 306). In **T 154/04** (OJ 2008, 46; see also **J 16/90**, OJ 1992, 260; and **T 1044/07**) the board held that the answer to the referred question must be "essential to reach a decision on the appeal in question".

In **T 520/01** (see also **T 787/06**) the board referred to **G 3/98**, did not maintain the patent on grounds other than those to which the question related, and thus refused the party's referral request. In **T 469/92**, the board granted the appellant's main request, and therefore did not consider its auxiliary referral request.

In **G 1/98** (OJ 2000, 111) one of the questions referred by the board concerned objections of which the appellant had not been made aware before, and the appellant expressed its intention to the Enlarged Board to make the required amendments. As a result, the Enlarged Board doubted the relevance of the referred question and deemed it inappropriate to offer guidance. In **G 7/95** (OJ 1996, 626, see also **G 9/92**, not published in OJ) the Enlarged Board, having regard to the particular facts of the case before the referring board, deemed it not necessary to answer the referred question either.

In **G 1/09** (OJ 2011, 336) a board referred a question on whether a *rejected* patent application was still pending under R. 25 EPC 1973 (R. 36 EPC; divisional applications) when no appeal had been filed but the time limit for filing an appeal had not yet expired. In his comments under Art. 9 RPEBA, the President of the EPO raised two additional questions, namely whether a *granted* application was still pending in such a situation, and whether the filing of an inadmissible appeal could maintain the pendency of the application beyond the expiry of the time limit for filing an appeal. The first additional question was – although not relevant for the decision in the underlying case – answered

by the Enlarged Board in an *obiter dictum*, whereas the second was considered not to be covered by the referral decision.

In **G 2/03** (OJ 2004, 448) the Enlarged Board stated that not all substantive requirements had been examined by the referring Board and that the referred question could, in the end, turn out to be irrelevant. Taking into account the usual order of examination according to which the referred question (on the allowability of disclaimers) was examined before substantive requirements such as inventive step, the Enlarged Board considered the referral nevertheless admissible. In **G 2/99** (OJ 2001, 83), the Enlarged Board had doubts whether the answer to the referred question would have an impact on the decision in the underlying proceedings, but deemed the referral nevertheless admissible, for reasons of procedural efficiency. In **G 2/07** (OJ 2012, 130) the referrals were considered admissible "irrespective of whether an answer is actually required on all aspects which the referred questions might in theory be seen as embracing".

In **G 1/14** the question referred to the Enlarged Board was whether an appeal is inadmissible or deemed not to have been filed if the notice of appeal is filed and the fee for appeal paid after expiry of the time limit (see Chapter IV.E.8.2.2 "Distinction between an appeal deemed not to have been filed and an inadmissible appeal). Until 1 April 2015 the wording of R. 126(1) EPC was limited to "Notification by post ... by registered letter with advice of delivery" (since amended to: "Notification by postal services ... by registered letter with advice of delivery or equivalent"). In the Enlarged Board's view notification of first-instance decisions by the postal service UPS was not covered by R. 126(1) EPC as formerly in force, so the referring board's finding that the appeal had not been lodged in time was inoperative. As this meant there was no need to refer the question, the Enlarged Board dismissed the referral as inadmissible.

#### 2.3.4 Question of law

Only questions of law, not technical issues (e.g. **T 287/11**: the interpretation of technical features of a specific claim; **T 181/82**: whether the person skilled in the art can understand the technical content of a prior art document; see also **T 1798/08**) may be referred to the Enlarged Board. Similarly, in **T 118/89** the board stressed that only questions of law, not questions of fact may be referred.

#### 2.3.5 Pending proceedings

A board may only refer a point of law to the Enlarged Board of Appeal "during proceedings on a case" (Art. 112(1)(a) EPC). If the underlying appeal is withdrawn (see **T 1040/04** and **G 3/06**, Declaratory order of 26 April 2007), or the underlying application deemed to be withdrawn (**G 2/14**; see OJ 2015, A13), the proceedings before the Enlarged Board are terminated.

The referral to the Enlarged Board must precede the decision of the board of appeal (**T 2271/08**). After a board has issued a decision in respect of certain issues, it has no power to refer a question to the Enlarged Board in connection with the issues already

decided, even though other issues are still pending in proceedings on the same case (**T 79/89**, OJ 1992, 283).

For a referral to be admissible, the appeal has to be admissible. This principle does, however, not apply if the referral itself concerns the admissibility of the appeal. Without this exception, the boards would be denied the opportunity to refer questions on important points of law concerning the admissibility of an appeal. This would contradict Art. 112(1)(a) EPC where no restrictions of that kind appear (**G 1/12**, OJ 2014, A114; see also **G 8/92**, not published in the OJ; **G 3/99**, OJ 2002, 347; **G 2/90**, OJ 1992, 10 and **G 2/04**, OJ 2005, 549).

### 2.3.6 Ensuring uniform application of the law

In order to be admissible, the referred question must either concern a non-uniform application of the law by the boards or, alternatively, a point of law of fundamental importance. According to Art. 112 EPC, this requirement concerns not only referrals by a board but also referrals by the President, which, however, must in any case concern 'different decisions' of the boards (see in this chapter IV.F.2.4.1).

Non-uniform application of the law under Art. 112(1)(a) EPC refers to non-uniform application of the law by the boards of appeal. A lack of uniformity between the law as applied by the boards of appeal and national courts can, in theory, bring to the fore a point of law of fundamental importance (**T 712/10**). Allegedly non-uniform decisions concerning "a different legal situation" (here: filing claims of a different category in the appeal) do not qualify under Art. 112(1)(a) EPC (**T 137/09**). The application of the same legal principles may, because of the specific facts of each individual case, lead to different results in different cases (**T 2477/12**).

In **G 1/12** (OJ 2014, A114), the Enlarged Board considered the requirement of non-uniform application of the law to be fulfilled because some decisions allowed deficiencies in the appellant's name to be remedied under R. 101(2) EPC, whereas in other decisions on analogous situations the boards applied R. 139 EPC. A minority of the members of the Enlarged Board (see Art. 18(2) RPEBA) was of the opinion that this merely demonstrated that, as long as the removal of the deficiency does not lead to a change of the appellant's true identity, both procedures are available according to consistent case law.

In **T 154/04** (OJ 2008, 46) the board found that deviating from an opinion given in another decision of a board of appeal or a deviation from national jurisprudence are not per se valid reasons for referral under Art. 112(1)(a) EPC. According to the board, the legal system of the EPC allows for the evolution of the case law, which is not case law in the Anglo-Saxon meaning of the term. In **T 15/01** (OJ 2006, 153) the board did not consider a referral to the Enlarged Board necessary, because only one previous decision of the boards deviated from its own conclusion as to the exhaustion of priority rights. In **T 248/88** the board also held that a single and isolated non-uniform decision does not qualify under Art. 112(1)(a) EPC.

### 2.3.7 Point of law of fundamental importance

The requirement that the referred question must either concern a lack of uniform application of the law by the boards or a point of law of fundamental importance concerns both referrals by a board and referrals by the President (see in this chapter IV.F.2.4.1).

**G 1/12** (OJ 2014, A114) concerned the correction of errors regarding the identity of the appellant and, in this context, the admissibility of an appeal. The Enlarged Board held that the referred question related to a "point of law of fundamental importance" because it was relevant to a large number of similar cases (see also **T 271/85**, OJ 1988, 341, **T 1242/04**, OJ 2007, 421 and **T 1676/08**: "a substantial number of similar cases") and therefore of great interest not only to the parties to the specific appeal proceedings in question. Settling this point of law was important not only to the users of the European patent system but also to the boards of appeal and the department of first instance in examination and opposition proceedings. A minority of the members of the Enlarged Board disagreed (see Art. 18(2) RPEBA) and considered the referral inadmissible. According to the minority, the majority's view implied that "importance" within the meaning of Art. 112 EPC was nothing more than mere relevance. The number of cases affected, however, was neither a suitable nor an appropriate criterion for establishing the admissibility of a referral. In **G 1/13** (OJ 2015, A42), the Enlarged Board confirmed the view of the majority in **G 1/12**.

In **T 26/88** (OJ 1991, 30), it was held that a question is not sufficiently important when the legal framework on which the question is based (here: R. 58(5) EPC 1973) has changed in the interim and the question is therefore unlikely to arise again very often. Similarly, in **T 2459/12**, the board stated that a question regarding a point of law the answer to which would affect only a relatively small number of applicants for a limited period of time, after which it would become obsolete (here: due to an amendment to R. 164 EPC), was not a question relating to a point of law of fundamental importance.

The lack of case law on a particular issue is in itself not a sufficient reason to refer a question to the Enlarged Board (**T 998/99**).

In **J 5/81** (OJ 1982, 155) the appellant requested the referral of a question which the board considered an important point of law. The board refused the appellant's request nevertheless, as the question could be answered by reference to the EPC without doubt (see, for example, also **J 14/91** (OJ 1993, 479), **T 1196/08**, **T 1676/08**, **T 2477/12**). In **T 39/05**, the board already denied the existence of an important point of law if a question could be answered by reference to the EPC without doubt.

## 2.4. Referral by the President of the EPO

### 2.4.1 General

Under Art. Art. 112(1)(b) EPC, in order to ensure uniform application of the law (see in this chapter IV.F.2.3.6) or if a point of law of fundamental importance (see in this chapter

IV.F.2.3.7) arises, the President of the EPO may refer a point of law to the Enlarged Board "where two boards of appeal haven given different decisions on that question".

#### 2.4.2 Discretion of the President

Under Art. 112(1)(b) EPC, the President of the EPO *may* refer a point of law. In exercising his or her right of referral, a President of the EPO is entitled to make full use of the discretion granted by Art. 112(1)(b) EPC. His appreciation of the need for a referral may change even after a relatively short time, for example because his assessment of the case law of the Boards of Appeal has changed, or a change in the presidency has taken place (**G 3/08**, OJ 2011, 10).

#### 2.4.3 Different decisions

According to the Enlarged Board in **G 3/08** (OJ 2011, 10), the term "different/abweichende/divergentes" decisions in Art. 112(1)(b) EPC has to be interpreted in the light of the provision's object and purpose according to Art. 31 of the Vienna Convention on the Law of Treaties. The purpose of the presidential referral right under Art. 112(1)(b) EPC is to establish uniformity of law within the European patent system. Having regard to this purpose, the notion "different decisions" has to be understood restrictively in the sense of "conflicting decisions". Legal development is an additional factor which must be carefully considered. Development of the law is an essential aspect of its application and inherent in all judicial activity. Consequently, legal development as such cannot on its own form the basis for a referral, because case law does not always develop in linear fashion, and earlier approaches may be abandoned or modified.

Legal rulings are characterised not by their verdicts, but by their grounds. The Enlarged Board of Appeal may thus take obiter dicta into account in examining whether two decisions satisfy the requirements of Art. 112(1)(b) EPC (**G 3/08**; see also **G 3/93**, OJ 1995, 18).

A discrepancy between Office practice of the EPO and the case law of the boards of appeal is not in itself not sufficient to justify a referral by the President, unless the practice of the EPO is warranted by the case law (**G 4/98**, OJ 2001, 131).

In **G 3/95** (OJ 1996, 169), the Enlarged Board considered the President's referral inadmissible due to the absence of different, i.e. conflicting decisions. In **G 3/08** (concerning Art. 52(2) EPC, computer programs), the Enlarged Board said that **T 424/03** indeed deviated from **T 1173/97**, but that this was a legitimate development of the case law and that there was no divergence which would make the referral admissible.

#### 2.4.4 Two boards of appeal

Different decisions by a single technical board in differing compositions may be the basis of an admissible referral by the President (**G 3/08**, OJ 2011, 10). In **G 1/04** (OJ 2006, 334), the Enlarged Board found the President's referral, based on two different decisions of the same technical board of appeal, admissible and stressed that the

decisions were rendered by the board in completely different compositions, and that other technical boards had adopted the findings of one of the conflicting decisions.

In **G 4/98** (OJ 2001, 131) the Enlarged Board stated that, if the President's power of referral were to be defined by a restrictive reading of "two Boards of Appeal", no referrals would be possible with respect to the Legal Board of Appeal. This would unduly restrict the effect of Art. 112 EPC, since conflicting decisions could also occur within that board.

## 2.5. Procedural issues

### 2.5.1 Question already decided by the Enlarged Board

Should a board consider it necessary to deviate from an earlier opinion or decision of the Enlarged Board, the question must be referred to the Enlarged Board (Art. 21 RPBA).

In **T 297/88** the board examined under which circumstances it was possible to re-refer a question which had already been decided by the Enlarged Board. It took the view that a board may only refer the same point of law another time to the Enlarged Board if the Enlarged Board's arguments were so weak that doubts as to the correctness of the decision were unavoidable. This was also the case where the arguments were based on a false premise so that there were doubts about the conclusion drawn. Finally, a decision of the Enlarged Board could also be questioned where the premise was correct, the arguments were conclusive and the conclusion therefore also correct, but where legal or technical developments occurring in the interim made it desirable in the public interest to have the question reviewed again by the Enlarged Board.

In **T 82/93** (OJ 1996, 274; see also **T 80/05**, **T 1213/05**) the board rejected the requested referral because the question had already been decided by the Enlarged Board.

In **G 9/93** (OJ 1994, 891), the Enlarged Board confirmed the referring board's view that the concept of opposition proceedings set out in **G 1/84** differed fundamentally from that in **G 9/91** and **G 10/91**, which it endorsed.

### 2.5.2 Question already pending before the Enlarged Board

In **T 208/88** of 20 July 1988, the board referred a question already pending once again to the Enlarged Board, because new aspects had emerged which it deemed useful for the Enlarged Board's decision. The same questions, supplemented by an additional question, were also referred again in **J 15/90** (see also **T 83/05** of 08.07.2013), because the board wished to give the Enlarged Board the opportunity to consider another type of case. In **T 803/93** (OJ 1996, 204) the board complemented the questions already pending and said that important questions of law should, if possible, be considered in the context of proceedings involving parties having opposing interests in relation to these questions. In **T 184/91** the President of the EPO had referred questions to the Enlarged Board. The board referred the already pending questions again, stating that nothing prevented a board from reiterating questions that are pending, in order that the parties to an appeal may enjoy being parties to the proceedings before the Enlarged Board. In



**T 1553/13** of 20 February 2014 and **T 2017/12** of 24 February 2014 two different technical boards referred an almost identical question to the Enlarged Board.

### 2.5.3 Stay of first instance proceedings following a referral

According to the board in **T 166/84** (OJ 1984, 489), where a decision of the examining division depends entirely on the outcome of proceedings before the Enlarged Board of Appeal on a legal question raised under Art. 112 EPC 1973 - and this was known to the examining division - the further examination of the application must be suspended until the matter is decided by the Enlarged Board of Appeal. Failure to do so amounts to a substantial procedural violation under R. 67 EPC 1973 (R. 103(1)(a) EPC).

According to the Guidelines for Examination (E-VI, 3 – November 2015 version), where the outcome of examination or opposition proceedings depends entirely on the answer to questions referred to the Enlarged Board, the proceedings *may* be stayed by the examining or opposition division on its own initiative or on request of a party. Under a previous version of the guidelines (E-VI, 3 – September 2013 version), the proceedings were to be stayed "only upon request of at least one of the parties" (see also Notice from the EPO dated 1 September 2006 concerning staying of proceedings, OJ 2006, 538).

When **G 3/14** (concerning clarity objections in opposition proceedings) was pending before the Enlarged Board, the President of the EPO decided that all proceedings before the opposition divisions where the decision depended entirely on the outcome of the Enlarged Board's decision were to be stayed *ex officio*, thereby superseding the then general practice under the guidelines to stay proceedings only upon request of a party (Notice from the EPO dated 7 August 2014 concerning the staying of proceedings due to referral **G 3/14**, OJ 2014, A87, see also Notice from the EPO dated 2 October 2015 concerning the staying of proceedings due to referral **G 1/15**).

### 2.5.4 Stay of appeal proceedings following a referral

It follows from Art. 112(3) EPC that the proceedings before the referring board are stayed until the Enlarged Board gives its decision. Proceedings before other boards of appeal may also be stayed.

In **T 426/00** of 27 June 2003, the board had to answer questions that were identical to the questions raised in a referral pending before the Enlarged Board (concerning Art. 123(2) EPC, disclaimers). The board raised the purpose of ensuring a uniform application of the law under Art. 112 EPC and the need to comply with the spirit of Art. 16 RPBA 1980 (Art. 21 RPBA 2007; see in this chapter IV.F.2.3.2). In order not to anticipate the Enlarged Board's evaluation of the questions before it, the board suspended the appeal proceedings.

In **T 1875/07**, the board acknowledged the patentability of the invention under Art. 52(2) EPC but did not consider the claimed subject-matter to be inventive. A referral on Art. 52(2) EPC was pending before the Enlarged Board. According to the board, the legal basis on which an application is refused (here: Art. 52(2) or Art. 56 EPC)

determines only the reasons for the decision, but not the decision itself. Since the decision in the appeal proceedings did not depend entirely on the outcome of the referral, the board refused the request to suspend the appeal proceedings (see also **T 787/06**, **T 1044/07** and **T 1961/09**).

### **3. Petition for review under Article 112a EPC**

#### **3.1. General**

Art. 112a EPC was introduced with the EPC 2000, following a suggestion of the Enlarged Board of Appeal (**G 1/97**; OJ 2000, 322). Its purpose is not to make the Enlarged Board of Appeal a third instance but to provide for a limited judicial review of decisions of the boards of appeal. The grounds on which a petition for review can be based have been exhaustively defined by the legislator. These are, firstly, fundamental procedural defects which occurred in appeal proceedings and, secondly, the existence of a criminal act which may have had an impact on a decision (Art. 112a(2) EPC).

Art. 112a EPC expands on the right to a fair trial guaranteed by Art. 6 EHRC (**R 9/14**). The examples in Art. 112a(2)(a) to (c) EPC and particularly the wording of Art. 112a(2)(d) EPC make it clear that only fundamental (but not minor) procedural defects can be the basis for a petition for review (explanatory remarks in OJ SE 4/2007, 126; see also **R 8/14**). Review proceedings are confined to procedural defects so fundamental as to be intolerable for the legal system and overriding the principle that proceedings which have led to a final decision should not be re-opened in the interest of legal certainty (**R 16/12**). Article 112a EPC provides an "exceptional means of redress" (**R 1/08**, **R 2/12**, **R 5/14**, **R 18/11**, **R 3/14**; see also **R 9/14**), an "extraordinary legal remedy" (travaux préparatoires, MR/21/00; see also **R 1/08**, **R 20/10**, **R 1/11**, **R 3/11**), the provisions of which have to be applied strictly (**R 1/08**, **R 23/10**). A petition for review has no suspensive effect (Art. 112a(3) EPC).

From 13 December 2007 (the entry into force of Art. 112a EPC) to 1 May 2016, 114 decisions of the Enlarged Board on petitions for review (petitions withdrawn or deemed not to have been filed excluded) have been published on the Internet. In five cases (**R 7/09**, **R 3/10**, **R 15/11**, **R 21/11**, **R 16/13**) the decision under review was set aside and the appeal proceedings re-opened; the remaining petitions were rejected.

#### **3.2. Transitional provisions**

The decision of the Administrative Council of 28 June 2001 on the transitional provisions under Art. 7 of the Act revising the EPC of 29 November 2000 provides that "Article 112a EPC shall apply to decisions of the Boards of Appeal taken as from the date of its entry into force" (see **R 2/08**). Referring to **G 12/91** (OJ 1994, 285), the Enlarged Board in **R 5/08** interpreted 'taken' to be the date a decision given orally is pronounced, not the date of notification. A petition based on a decision dated prior to, yet not notified to the parties until after entry into force of the EPC 2000, is therefore inadmissible.

### 3.3. Scope of review by the Enlarged Board of Appeal

#### 3.3.1 Grounds for a petition for review

A petition for review may only be filed on the grounds listed in Art. 112a(2) EPC. Those defined in Art. 112a(2)(a) to (c) EPC concern a breach of Art. 24 EPC governing exclusion of and objection to members of a board of appeal; the participation of persons not appointed as a member of the boards of appeal; and the fundamental violation of Art. 113 EPC. In addition, Art. 112a(2)(d) EPC opens up the possibility of using the Implementing Regulations to define further fundamental procedural defects on which a petition for review might be based (explanatory remarks in OJ SE 4/2007, 126). Currently, two such defects have been listed in R. 104(a) and (b) EPC, which provide that a petition may also be based on a fundamental procedural defect arising from either a failure to arrange for the holding of oral proceedings requested by a party, or a failure to decide on a request relevant for the board's decision. Finally, a petition for review may also be filed on the ground that a criminal act may have had an impact on the decision (Art. 112a(2)(e) EPC).

#### 3.3.2 Grounds listed exhaustively

The grounds for a petition for review have been exhaustively defined by the legislator, namely in Art. 112a(2) EPC in conjunction with R. 104 EPC (**R 1/08**; see also **R 10/09**, **R 14/09**, **R 16/09**, **R 17/09**, **R 18/09**, **R 20/09**, **R 20/10**, **R 6/11**, **R 13/11**, **R 19/11**, **R 20/11**, **R 2/12**, **R 18/12**, **R 4/13**, **R 5/13**, **R 5/14**, **R 7/14**, **R 9/14**, **R 6/15**). What is not defined by the Implementing Regulations does not qualify as a procedural defect under Art. 112a(2)(d) EPC (**R 16/09**). The erroneous application of a procedural rule, which does not in itself belong to the grounds for review enumerated in the EPC, can only be considered if it results in one of the procedural defects listed in Art. 112a(2) EPC in conjunction with R. 104 EPC (**R 2/08**, **R 20/10**, **R 18/12**).

In particular, the following issues cannot be considered in review proceedings:

- allegedly insufficient reasoning (**R 6/11**; see also **R 1/08**, **R 19/11**, **R 5/13**), unless this involves a fundamental violation of Art. 113 EPC
- the alleged violation of Art. 114 EPC in conjunction with R. 116(1) and (2) EPC or, respectively, R. 101 and 99(2) EPC (**R 14/09**)
- the refusal to allow the recording of oral proceedings, the use of a different (but equivalent) terminology than the one used in the EPC during the oral proceedings or the non-validation of the minutes at the end of the oral proceedings (**R 17/09**)
- the alleged inadequate keeping of minutes, the alleged incompetence to decide on the exclusion from file inspection or the alleged misunderstanding of a party submission (**R 20/09**)
- the alleged violation of Art. 6 ECHR (**R 18/09**), unless this involves a fundamental violation of Art. 113 EPC (see **G 3/08**, OJ 2011, 010, as to the general applicability of fundamental procedural rights in EPO proceedings)
- the alleged violation of the principle of legitimate expectations (**R 13/11**)
- the allegedly incorrect reversal of the burden of proof (**R 21/10**)

- alleged irrationality or "Wednesbury unreasonableness" (**R 19/11**)
- allegedly insufficient time allowed for the oral proceedings (**R 2/12**)
- the alleged violation of the right to be heard in respect of another party (**R 5/14**)
- the alleged lack of technical understanding of a board member, so that the board did not consist of two "technically qualified members" as required by Art. 21(4)(a) EPC (**R 3/12**)
- the alleged violation of Art. 4(3) EPC, or of Art. 11, 15(4) and 20 RPBA (**R 9/14**)
- the alleged violation of Art. 15(5) and 15(6) RPBA, unless this involves a fundamental violation of Art. 113 EPC or a fundamental procedural defect under Art. 112a(2)(d) EPC in combination with R. 104(b) EPC (**R 7/14**; see also **R 10/08**)
- the alleged violation of Art. 114 EPC, of Art. 13 RPBA, or the alleged lack of impartiality (**R 10/14**).

As R. 106 EPC implies, only procedural defects actually attributable to a board of appeal can be reviewed under Art. 112a EPC. Procedural defects that occurred in first instance proceedings may not be the subject of a petition for review (**R 20/10**, **R 8/11**; see also **R 19/12** of 12.04.2016).

### 3.3.3 Review of substantive law excluded

Under no circumstances may the petition for review be a means to review the application of substantive law. This restriction is justified because the function of the petition for review is to remedy intolerable deficiencies occurring in individual appeal proceedings, not to further the development of EPO procedural practice or to ensure the uniform application of the law (explanatory remarks in OJ SE 4/2007, p. 126; **R 13/10**: "established case law" since **R 1/08**). The Enlarged Board has no competence under Art. 112a EPC to examine the merits of the decision and to go into the substance of a case (**R 4/09**, **R 13/10**), not even indirectly (**R 19/11**, **R 6/13**). A review of the correct application of substantive law would amount to the Enlarged Board being a third instance which has been explicitly excluded (**R 3/09**; see also **R 13/09**). The Enlarged Board cannot act as a third instance or second-tier appellate tribunal in petition proceedings (**R 9/10**, **R 11/11**, **R 5/13**; see also **R 1/08**, **R 3/09**, **R 13/09**).

Not being competent to decide on the merits of a case necessarily implies that the Enlarged Board has no power to control the normal exercise a board makes of its discretion (**R 10/09**). The exercise of discretion is only subject to review if arbitrary or manifestly illegal (**R 10/11**), thereby involving a fundamental violation of the right to be heard (**R 9/11**; see also **R 17/11**).

In **R 13/12** the Enlarged Board stated that it had to remain vigilant and thwart any attempt to blur the frontier between what might clearly be a matter for a violation of the right to be heard under Art. 113 and 112a(2)(c) EPC, and anything else presented as a violation of the right to be heard but which actually pertained to the substantive merits of the decision under review.

Thus, the following issues cannot be considered in review proceedings:

- the assessment of inventive step (**R 1/08**, **R 12/09**, **R 6/11**, **R 14/13**, **R 6/15**), including the determination of the closest prior art (**R 5/13**)
- the interpretation of a prior art document (**R 9/08**, **R 8/09**, **R 4/11**)
- the assessment of clarity (**R 15/10**)
- the assessment of public prior use (**R 19/10**)
- the assessment of evidence (**R 21/09**)
- whether to remit a case to the department of first instance (**R 10/09**, **R 9/10**, **R 12/09**)
- whether to admit a new request (**R 10/11**, **R 11/11**, **R 13/11**, **R 4/13**) or a new document (**R 10/09**, **R 17/11**) under Art. 12 RPBA; or under Art. 13(1) RPBA (**R 1/13**)
- whether an appeal is admissible (**R 10/14**, **R 10/09**)
- whether or not the exception to reformatio in peius mentioned in **G 1/99** (OJ 2001, 381) applies to a particular case (**R 4/09**; see also **R 10/14**)
- whether to refer a question to the Enlarged Board of Appeal under Art. 112 EPC (**R 17/14**)
- whether the boards are empowered to decide on a request to hold oral proceedings before the examining division in Munich instead of in The Hague (**R 13/14**).

#### **3.4. Article 112a(1) EPC - party entitled to file a petition for review**

Under Art. 112a(1) EPC, any party adversely affected by the decision of a board may file a petition for review. In the case underlying **R 1/11**, the patent had been transferred and the transferee had filed an appeal against the decision of the opposition division to revoke the patent. The transfer of the patent had, however, not been registered in line with R. 22 EPC before the expiry of the period for filing the notice of appeal. Therefore, the decision under review had rejected the transferee's appeal as inadmissible. The transferor's appeal, filed after the expiry of the period for filing a notice of appeal, had also been considered inadmissible. Both the transferee and the transferor filed a petition for review. The Enlarged Board held that the requirement of Art. 112a(1) EPC that the petitioner be adversely affected for a petition to be admissible was fulfilled with respect to the transferee, irrespectively of its party status before the board of appeal, since the adverse effect resulted from the refusal to acknowledge that it had the status of appellant (his petition was, however, considered clearly unallowable in the end). The transferor's petition, on the other hand, was considered clearly inadmissible because, not being the current proprietor, the transferor was not adversely affected by the impugned decision.

#### **3.5. Rule 106 EPC - obligation to raise objections**

Under R. 106 EPC, a petition under Art. 112a(2)(a) to (d) EPC is only admissible where an objection in respect of the procedural defect was raised during appeal proceedings and dismissed by the board, except where such objection could not be raised. A large number of petitions for review are (at least partly) rejected as inadmissible because the petitioner failed to raise a valid objection under R. 106 EPC.

### 3.5.1 Purpose

The purpose of R. 106 EPC is to give the board a chance to react immediately and appropriately by either removing the cause of the objection or by dismissing it (see e.g. **T 1544/08, T 144/09, T 1977/13**), thereby ensuring legal certainty for the parties and the public as to whether the ensuing substantive decision of the board is open to review under Art. 112a EPC (**R 4/08, R 1/10, R 14/11, R 16/12**). By ensuring that errors can be corrected by a board before a final decision is taken, R. 106 EPC also ensures that unnecessary petitions for review are avoided (**R 14/11, R 18/12**).

### 3.5.2 Requirements of a valid objection

Raising an objection under R. 106 EPC is a procedural act and a precondition for access to the extraordinary legal remedy under Art. 112a EPC (**R 4/08, R 7/08, R 3/11, R 7/11, R 16/12**). Its validity depends on the fulfilment of two criteria (**R 4/08, R 7/08, R 8/08, R 1/10, R 17/10, R 7/11, R 5/12, R 6/12, R 16/12**: "established jurisprudence", **R 3/14**):

- **form**: the objection must be expressed by the party in such a form that the board is able to recognise immediately and without doubt that an objection under R. 106 EPC is intended;
- **content**: the objection must be specific, indicating clearly and unambiguously on which procedural defect the petitioner intends to rely.

An objection under R. 106 EPC is additional to and distinct from other statements, such as arguing or even protesting against the conduct of the proceedings or against an individual procedural finding (**R 2/08, R 7/08, R 9/09, R 1/10, R 14/11, R 21/11, R 16/12**). An objection must be expressly described as such (**R 8/08, R 21/11**). However, even if an objection does not contain an explicit reference to R. 106 EPC, it can qualify as an objection under R. 106 (**R 21/09**; see also **R 17/14**).

Only an objection which, in substance, raises a procedural defect which can be the subject of a petition for review under Art. 112a(2)(a) to (d) EPC can be regarded as an objection within the meaning of R. 106 EPC. Objecting, in substance, to the board's conclusion on clarity does not qualify as such an objection, even if the petitioner explicitly refers to Art. 113 EPC (**R 18/12**).

An objection cannot be formulated prematurely, i.e. before a procedural defect has come into existence (**R 14/11**; see also **R 8/08, R 17/10**). If, on the other hand, an objection is made during oral proceedings, the fact that it is only raised after further requests have been discussed has no bearing on the admissibility of the petition (**R 21/09**). In **R 1/14** the Enlarged Board held that it is an indispensable prerequisite for the admissibility of a petition that an objection is raised "in good time", i.e. at a time when the board can still rectify the alleged violation. An objection to a refusal to postpone the date of oral proceedings must therefore be made before or, at the latest, at the beginning of these oral proceedings.

An accompanying person cannot validly make procedural declarations, such as an objection under R. 106 EPC (**R 9/09**; see also **R 3/08**).

Different alleged procedural defects must be objected to separately under R. 106 EPC (**R 5/13**; see also **R 10/14**), and also have to be considered separately by the Enlarged Board (**R 3/08**, **R 17/11**).

### 3.5.3 Examples of invalid objections

Examples of acts not qualifying as an objection under R. 106 are:

- contesting insufficiency of disclosure or offering new documents (**R 7/08**)
- requesting that a late-filed document is not admitted into the proceedings (**R 9/09**, **R 17/10**)
- protesting against the hearing of an expert (**R 2/11**)
- an objection against the board raising a new line of argument or a request for remittal or postponement (**R 14/11**)
- requesting a board to make a statement on the scope of a claim, which request is repeatedly refused (**R 3/14**)

### 3.5.4 Minutes as evidence that the objection was raised

The test whether an objection was validly raised during oral proceedings is normally the minutes which, as prescribed by R. 124(1) EPC, must contain the relevant statements of the parties (**R 4/08**, **R 17/10**). The absence in the minutes of an objection under R. 106 EPC and of any request for correction of the minutes is a strong indication, that such objection, if any, was at least not duly qualified (**R 3/11**; see also **R 5/14**, **R 6/13**, **R 3/14**). Unless duly corrected, the minutes of the oral proceedings authenticate the facts they relate (**R 7/11**). If a party is convinced that a violation of its right to be heard has occurred during the oral proceedings it will require this to be recorded in the minutes (**R 2/12**). However, in **R 3/08** the Enlarged Board also took private minutes taken by an employee of the petitioner into account.

### 3.5.5 Objection could not have been raised

Under R. 106 EPC, last subset, an objection is not a requirement for the petition to be admissible where such objection could not be raised during the appeal proceedings. Therefore, if the alleged procedural defect becomes apparent to the parties only through the written reasons for the decision (in **R 3/10**: through the announcement of the decision), the admissibility of the petition is not conditional upon a corresponding objection having been raised during the oral proceedings (**R 4/08**; see, by way of example, also **R 1/08**, **R 2/08** (written procedure), **R 9/08**, **R 3/09**, **R 4/09**, **R 7/09**, **R 11/09**, **R 19/10**, **R 8/11**, **R 21/11**, **R 14/13**). If a petition addresses mostly the reasoning of a decision, the benefit of the doubt is given to the petitioner as to its possibility to raise an objection before the end of appeal proceedings (**R 1/11**, see also **R 18/14**).

If the petitioner requested the correction of the minutes of oral proceedings in order to establish what, in its view, had been the order of the procedural steps followed by the board, the lack of possibility for the petitioner to raise an objection cannot be excluded, even if the request to correct the minutes was rejected (**R 16/09**).

In the proceedings underlying **R 10/08**, the petitioner wanted to submit a new auxiliary request, allegedly during the announcement of the decision at the oral proceedings, but the board had declared itself formally bound by the decision as announced. The petitioner could thus no longer raise an objection "during the appeal proceedings".

#### 3.5.6 Compliance with Rule 106 left open

If a request is unallowable, it can be left open whether the petitioner complied with R. 106 EPC (**R 15/09**, **R 18/09**, **R 20/09**, **R 16/11**, **R 2/12**, **R 16/12**, **R 1/13**, **R 15/13**, **R 7/14**, **R 17/14**).

#### 3.6. Rule 107 EPC - contents of the petition for review and time limits

R. 107 EPC corresponds to the similar provisions requiring substantiation of an opposition or an appeal. The contents of a petition must be sufficient for the petitioner's case to be properly understood on an objective basis and must enable the Enlarged Board (and any other parties) to understand immediately why the decision in question suffers from a fundamental procedural defect. The petition must thus set out the reasons why it requests that the impugned decision be set aside, specify the facts, arguments and evidence relied on and must do so within the time limit for filing the petition, namely two months after notification (**R 5/08**; see also **R 4/13**, **R 17/13**). The time limit of two months after notification (Art. 112a(4) EPC) is mandatory (**R 3/14**). Filing a petition and paying the fee before the orally announced decision has been notified to the petitioner in writing does not make it inadmissible under Art. 112a(4) EPC (**R 20/09**, **R 5/14**).

With regard to requests, the only requirement which can be derived from the wording of R. 107(2) EPC is that the petition must make it clear that the petitioner wants the decision of the board of appeal to be set aside (**R 5/08**). An implicit request to set aside the decision is sufficient (**R 9/10**).

The obligation to file a reasoned statement cannot be construed so narrowly as to mean that any kind of reasoning is sufficient to fulfil this requirement, as long as it is only extensive enough (**R 20/10**). For the petition to be admissible, it is however sufficient that one ground is sufficiently reasoned in the request (**R 2/08**).

If a petition does not comply with R. 107(2) EPC (requiring substantiation of the request), it must be rejected as inadmissible (**R 6/10**). Equally, in case of failure to remedy a deficiency under R. 107(1)(a) EPC (here: the missing name and address of the petitioner), the petition is rejected as inadmissible under R. 108(2) EPC (**R 6/09**). The established jurisprudence of the boards of appeal that mere payment of the appeal fee is not an act which suffices for the admissible filing of an appeal applies *mutatis mutandis* to petition for review proceedings (**R 2/10**).



### 3.7. Article 12(1) RPEBA - late-filed submissions in the review procedure

Pursuant to Art. 12(1) RPEBA the Enlarged Board may consider new submissions made by the petitioner after expiry of the time limit for filing the petition for review, if this is justified for special reasons. In **R 12/10** and **R 4/13** no such reasons were advanced by the petitioner, and the Enlarged Board rejected the late-filed submissions. In **R 15/13** the Enlarged Board stated that "special reasons" could not extend to the late introduction of grounds not relied on unless or until the grounds in the petition proved insufficient. In **R 4/12** and in **R 16/12** the Enlarged Board said that an entirely new complaint submitted for the first time during the oral proceedings before the Enlarged Board had no bearing whatsoever on the findings as to the petition's admissibility and merits reached on the basis of the grounds, facts, arguments and evidence set out in the petition.

In **R 2/08** the Enlarged Board accepted the petitioner's additional explanations in response to its communication, and in **R 18/09** a late-filed external legal opinion on the admissibility of the petition.

### 3.8. Rule 109 EPC - composition of the Enlarged Board and review procedure

Unless otherwise provided, the provisions relating to proceedings before the boards of appeal apply (R. 109(1) EPC). The RPEBA also apply in proceedings under Art. 112a EPC (Art. 1 RPEBA).

Petition for review proceedings consist of two stages. In the first stage, a panel of the Enlarged Board composed of three members (two legally qualified, one technically qualified) examines all petitions for review and rejects those which are clearly inadmissible or clearly unallowable (unanimity is required; R. 109(2)(a) EPC). Those not rejected are considered by a panel composed of five members (four legally qualified, one technically qualified; R. 109(2)(b) EPC). In these cases, the three-member panel under R. 109(2)(a) is supplemented by two further legally qualified members (Art. 2(3) RPEBA). The chairman of the board against whose decision the petition was filed may not take part in the proceedings (Art. 2(6) RPEBA).

The travaux préparatoires stress the need for a quick screening process to be conducted by a three-member panel of the Enlarged Board in order to reject petitions which clearly cannot succeed. In the basic proposal for the revision of the EPC it was even stated that no oral proceedings should take place before the three-member panel (CA/100/00, p. 139). However, this sentence was deleted (see explanatory remarks on the revision of the EPC, OJ SE 4/2007, p. 126) and, as far as the petitioner is concerned, Art. 116 EPC also applies in the first stage of the proceedings (**R 5/08**).

Parties other than the petitioner are not to be involved in the first stage of petition for review proceedings (R. 109(3) EPC; **R 7/14**). In **R 5/08** the Enlarged Board held that non-petitioner parties, as long as they are not involved, have no right to be heard that could be violated. Although not summoned to oral proceedings in the first stage, non-petitioner parties may, however, attend such proceedings which are public.

Petition for review proceedings should by their nature be dealt with as speedily as possible, acceleration requests are therefore unnecessary (**R 18/09**, **R 15/13**). In **R 11/12** the board also stated that petitions for review should, in the interest of legal certainty, be dealt with expeditiously, and did not consider a planned birthday party a reason justifying the fixing of a new date for oral proceedings before the Enlarged Board.

R. 109(1) EPC provides that certain specific procedural time limits do not apply to petition for review proceedings. This allows the Enlarged Board to shorten these time periods in the interest of procedural efficiency. However, it clearly provides no justification for parties to disregard time limits set by the Enlarged Board itself (**R 5/08**).

In **R 18/09** the Enlarged Board held that the principles set out in **G 3/99** (OJ 2002, 347), also apply to petition for review proceedings, namely that a plurality of persons acting in common must be treated as a single party (a "group party") and that such a group party must act through a common representative.

In **R 21/11**, the Enlarged Board stated that the only condition for the fee for a petition for review to be reimbursed under R. 110 EPC is that the proceedings before the board of appeal are re-opened (a reimbursement request is not required).

### **3.9. Factual bases for the review - minutes and grounds for the decision**

The factual bases for a review procedure under Art. 112a EPC are the minutes of the oral proceedings and the grounds for the decision under review (**R 15/09**, **R 6/14**). However, in **R 3/10** the Enlarged Board also took signed declarations of persons who had attended the oral proceedings into account.

### **3.10. Burden of proof**

The petitioner bears the burden of proving its allegations (**R 4/09**). However, in **R 15/11** the petition was allowed and the Enlarged Board stated that it is not for the party which alleges a breach of its right under Art. 113(1) EPC to prove that it has not been heard (*negativa non sunt probanda*). It would rather be the task of the boards to draft their own texts in a way that enables the reader, taking into account all documents on file, to conclude that the right to be heard was respected with regard to the grounds on which the decision is based.

### **3.11. Article 112a(2)(a) EPC - alleged breach of Article 24 EPC**

For general information on Art. 24 EPC, see Chapter III.J "Suspected Partiality". The present chapter deals with decisions of the Enlarged Board under Art. 112a(2)(a) EPC.

In **R 16/10** the Enlarged Board rejected the petitioner's argument that Art. 24(1) EPC, concerning the exclusion of members from a board, includes not only the specific situation where one of the members has represented a party in the case in question but also the general situation where a member has previously acted as representative of that party in any matter. In **R 20/09** the Enlarged Board confirmed that, in cases of suspected

partiality of a board member, Art. 112a(2)(a) EPC requires that a decision has been taken on the suspected impartiality (Art. 24(4) EPC).

In **R 17/09** the Enlarged Board found that in English the term "man in the street" has no pejorative associations, but is commonly used to describe an average citizen.

### **3.12. Article 112a(2)(b) EPC - person not appointed as a board member**

The Enlarged Board has not yet ruled on a petition for review alleging that a board of appeal included a person not appointed as a board member.

According to Art. 19(1), second sentence, RPBA only members of the Board shall participate in the deliberations; the Chairman may, however, authorise other officers to attend. In **T 857/06** the board held that, under this provision, a board's assistant may attend and take part in the deliberations.

### **3.13. Article 112a(2)(c) EPC - alleged fundamental violation of Article 113 EPC**

#### 3.13.1 General

The decisions of a board of appeal may only be based on grounds or evidence on which the parties have had an opportunity to present their comments (Art. 113(1) EPC), and a patent application or a patent may only be examined in the text submitted or agreed by the applicant or proprietor of the patent (Art. 113(2) EPC). For general information on the right to be heard under Art. 113 EPC, see Chapter III.B "Right to be heard".

In most petitions for review, the alleged fundamental violation of Art. 113(1) EPC is among the grounds on which the petition is based. All petitions for review that have been successful so far concern a fundamental violation of Art. 113 EPC (see in this chapter IV.F.3.13.19 and in this chapter IV.F.3.14.3).

#### 3.13.2 "Fundamental" violation of Article 113 EPC - causal link

A violation of Art. 113 EPC can only be considered fundamental within the meaning of Art. 112a(2)(c) EPC if there is a causal link between the alleged violation and the final decision (**R 1/08**, **R 11/08**, **R 11/09**, **R 13/09**, **R 6/13**, **R 17/14**). Such a necessary causal link does not exist when, even if a procedural violation can be demonstrated, the same decision would have been taken for other reasons (**R 22/10**, **R 19/09**).

#### 3.13.3 No prior assessment of the merits of a submission

When determining whether a party's right to be heard has been violated, it is irrelevant whether a party's standpoint, which it alleges it would have taken had it been given the opportunity, would have been well-founded. The right to be heard is a fundamental right of the parties which has to be safeguarded irrespective of the merits of a submission. The necessity to respect it is absolute and cannot be made dependent on a prior assessment of the likelihood that the petitioner's arguments would have convinced the

board (**R 3/10**, **R 5/13**). In **R 21/11** the Enlarged Board stated that it could not be ruled out that a different decision would have been reached if the party had been heard on the point on which it alleged its right to be heard had been infringed.

#### 3.13.4 Objective approach - board's intention irrelevant

When determining whether a fundamental violation of the petitioner's right to be heard occurred, an objective approach must be applied. It is not relevant whether the board deliberately refused an opportunity to comment or acted in good faith (**R 3/10**).

#### 3.13.5 No obligation to provide detailed reasons for a decision in advance

It is settled case law that a board of appeal is not required to provide the parties in advance with all foreseeable arguments in favour of or against a request (**R 1/08**; see, by way of example, also **R 13/09**, **R 18/09**, **R 4/13**). In other words, parties are not entitled to advance indications of all reasons for a decision in detail (see, by way of example, **R 12/09**, **R 15/09**, **R 4/11**, **R 18/12**, **R 2/13**, **R 9/14**). This principle also applies to an interpretation of a passage in the state of the art forming only part of such reasons (**R 19/11**, **R 15/12**, **R 16/13**).

#### 3.13.6 Boards' obligation to remain neutral

According to settled case law, a board must remain neutral in *inter partes* proceedings, both in its communications to the parties and in oral proceedings (**R 15/09**; see also **R 11/08**), especially when the opposing party is not present (**R 9/14**). By giving a party possible reasons to decide against its requests (**R 18/09**, **R 15/10**), by prompting a party to make further submissions (**R 9/11**, **R 3/13**, **R 17/13**), by informing a party of a possible different interpretation of a passage in a prior art document (**R 19/11**; see also **R 18/09**), or by suggesting a possible wording of a claim (**R 4/09**, **R 22/10**; see also **R 7/14**) a board would assist a party and compromise its neutrality.

#### 3.13.7 Parties' obligation to participate actively in the appeal proceedings

Corresponding to a board's obligation to remain neutral (see in this chapter IV.F.3.13.6), parties are obliged to participate actively in the appeal proceedings (**R 2/08**, **R 6/12**, **R 12/12**), in particular in *inter partes* proceedings (**R 15/09**, **R 12/09**). Parties and their representatives are responsible for the conduct of their case and it is for them to submit the necessary arguments to support their case on their own initiative and at the appropriate time (**R 17/12**; see, by way of example, also **R 18/09**, **R 13/11**, **R 17/12**, **R 1/13**, **R 15/13**). It is for the parties to address any point they consider relevant and fear may be overlooked and to insist, if necessary by way of a formal request, that it be discussed in the oral proceedings (**R 17/11**).

#### 3.13.8 Reasons for a decision allegedly surprising

While the boards are not obliged to provide the parties in advance with all reasons for a decision in detail (see in this chapter IV.F.3.13.5), Art. 113(1) EPC requires that

decisions may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments, which implies that a party may not be taken by surprise by the reasons of a decision, referring to unknown grounds or evidence (**R 3/13**; see also **R 15/09**, **R 21/10**). "Grounds or evidence" under Art. 113(1) EPC is understood as the essential legal and factual reasoning on which a decision is based (see Chapter III.B.2.3.2 "The meaning of 'grounds or evidence'"). In **R 3/10**, **R 15/11** and **R 16/13** the petition was allowed because of surprising reasons on which the parties had not been given an opportunity to comment (see in this chapter IV.F.3.13.19).

Grounds or evidence within the meaning of Art. 113(1) EPC need not emanate from the board, it is sufficient if another party raises the objection (**R 2/08**; see also **R 1/08**, **R 1/13**). If the reason given in a decision corresponds to an argument put forward by the other party, the petitioner was aware of it and thus not taken by surprise (**R 4/08**, **R 12/09**; see also **R 8/14**), unless the board clearly indicated that it regarded those arguments as not convincing (**R 11/12**).

A subjective surprise (in **R 6/11**, **R 1/13**: the petitioner's belief that the board would decide in its favour) has no bearing on whether a party knew the issues which might be raised and had an adequate opportunity to comment thereon (**R 13/11**, **R 17/12**; see, by way of example, also **R 12/09**, **R 22/10**, **R 1/13**, **R 3/13**).

To determine which subject matter (grounds, facts and evidence) could have been expected to be discussed, and whether new facts and grounds were introduced ex officio by a board of appeal in its decision, the Enlarged Board has to check the file history (**R 8/13**).

Establishing the closest prior art is part of the process of arriving at a decision and takes place only after all arguments have been heard, in the final deliberations of the board. If the closest prior art is redefined because of an amendment to a claim, the board is not obliged to address this at oral proceedings (**R 8/14**).

Dismissing a party's interpretation of a document in a decision in a way which does not introduce any change in the factual and legal framework of the debate does not infringe the right to be heard, in the same way as "arguments" can be put forward by a party in the absence of the other party, as stated in **G 4/92 (R 2/13)**.

Several further cases in which the petitioner claimed that the decision under review took it by surprise were rejected by the Enlarged Board, stating that

- the decision was "based on a line of reasoning that can be said to have been in the proceedings" (**R 4/11**, **R 11/12**, **R 18/12**);
- the argument in question was "part of the appeal proceedings" (**R 7/12**);
- the document in question "formed part of the debate" (**R 8/09**);
- it is sufficient that the "relevance [of a factor] becomes clear during the proceedings" (**R 9/14**);
- the decision did "not contain any reasons which could not be objectively foreseen" (**R 22/10**);

- "a representative with normal experience and training could foresee what the crucial issues were for the board" (**R 8/13**).

### 3.13.9 Timing of a decision allegedly surprising

Reading out the opponent's request "that the decision under appeal be set aside and that the European patent [...] be revoked" indicates that the board intends to deliberate on patentability and that it can pronounce the revocation of the patent as a whole (**R 14/10**, **R 7/14**). When a board, after discussing novelty, interrupts oral proceedings for deliberation, a party should be aware that the board could take a negative decision on novelty (**R 4/12**). It can, however, be surprising for a party if only novelty was discussed and a request is then rejected due to lack of inventive step (**R 3/10**; see in this chapter IV.F.3.13.19).

It is not sufficient to claim that the duration of the oral proceedings resulted in a violation of the right to be heard. The petitioner must rather establish that, for reasons of lack of time, it was deprived of the possibility to properly defend its case, resulting in a decision based on grounds that it did not have an opportunity to comment upon (**R 2/12**).

### 3.13.10 Consideration of the parties' arguments in the written decision

The right to be heard under Art. 113(1) EPC requires that those involved be given an opportunity not only to present comments (on the facts and considerations pertinent to the decision) but also to have those comments considered, that is reviewed, with respect to their relevance for the decision in the matter (**R 23/10**; see also **R 13/12**). Art. 113 (1) EPC obliges the decision-making body to allow the parties to present the necessary arguments on all essential aspects of the case, to take note of these arguments and to acknowledge them in its decision (**R 8/11** and **R 19/12** of 12.04.2016).

It is, however, not necessary to consider each and every argument of the parties in detail in a decision (**R 19/10**, **R 17/11**, **R 6/12**, **R 15/12**, **R 2/13**, **R 19/12** of 12.04.2016). The boards may also refute arguments implicitly, and may disregard irrelevant arguments (**R 13/12**, **R 21/10**).

Issues and arguments relevant for the decision must be considered, whereas irrelevant arguments may be disregarded (**R 13/12**). The allegedly insufficient consideration, by a board, of arguments concerning a procedural defect before the department of first instance can only constitute a fundamental violation of the right to be heard when the alleged procedural defect impacted on the decision at first instance (**R 19/12** of 12.04.2016).

Oral remarks made by a chairman directly before a decision is pronounced do not form part of the reasons that must reflect, within certain limits, a party's arguments (**R 4/12**).

Decisions of boards of appeal are open only to review but not to appeal, and thus not covered by R. 111(2) EPC which requires that decisions which are open to appeal be reasoned (**R 6/11**; see, however, also **R 12/10**; see also in this chapter IV.F.3.3.2).

### 3.13.11 Parties' obligation to know the case law, references to decisions

Even under the assumption that the information given by a technical board of appeal on a decision of the Enlarged Board of Appeal was unclear, parties are deemed to know the case law, at least when represented by an authorised representative. Thus, a party cannot plead lack of such knowledge as an excuse (**R 4/09**).

The reference to decisions in a decision, even decisions not cited to the party earlier in writing or at the oral proceedings, also does not constitute a fundamental violation of the right to be heard (**R 17/09**).

A qualified professional representative can be assumed to be familiar with the analytical sequence of the problem-solution approach (here: the submission of comparative test results to prove an effect). Special guidance from the board is not necessary (**R 9/14**).

### 3.13.12 No right to be heard separately on all requests

A party has no absolute right to be heard separately on each and every one of its auxiliary requests. The right to be heard is satisfied if a party had the opportunity to comment on the grounds for a decision on the main request, and the remaining requests are not allowed on the same grounds (**R 6/11**; see also **R 11/08**, **R 3/12**, **R 14/10**).

### 3.13.13 No right to a further hearing at first instance

As there is no right to remittal, there is no right to a further hearing before the department of first instance that could be violated (**R 9/10**; see also **R 12/09**).

### 3.13.14 No right to a referral under Article 112 EPC

The right to be heard is not infringed if a board decides, after having heard the parties, not to refer a particular question to the Enlarged Board of Appeal (**R 8/11**; see also **R 17/14**).

### 3.13.15 No right to a communication; communication allegedly misleading

The communication of a board, if any, is a means at the board's disposal to streamline the appeal proceedings and above all the oral proceedings. Not issuing a communication does not constitute a violation of the right to be heard (**R 16/09**). If a board decides not to issue a communication, it can be assumed that it regards the whole file as relevant for discussion at the oral proceedings (**R 14/12**).

While a preliminary opinion can be criticised for not mentioning the issue whether auxiliary requests are admissible, the omission of an issue which the petitioner and the board knew could arise (here: because of the other party's submission) cannot be characterised as misleading (**R 13/11**). Discrepancies between a board's provisional opinion as expressed in a communication preparing oral proceedings and its analysis in its final decision is in itself not a fundamental procedural defect (**R 3/09**).

### 3.13.16 Late-filed submissions - boards' discretion under Article 13 RPBA

There is no obligation to hear a party on substantive issues before deciding on the admissibility of a proposed auxiliary request. In the proceedings under review in **R 16/09** the petitioner had expressed its intention to present an auxiliary request in the closing stages of the oral proceedings without having prepared a set of amended claims. The Enlarged Board stated that requiring a board to always invite a party to supply a text of amended claims before a decision on the admissibility of a proposed auxiliary request is taken, would deprive it of the discretion explicitly provided by Art. 13 RPBA.

The mere fact that a board takes into account the lateness of an auxiliary request when exercising its discretion under Art. 13 RPBA - although it did not explicitly raise this issue in the oral proceedings - does not infringe the right to be heard (**R 5/11**).

### 3.13.17 Alleged violation of Article 113(2) EPC

Art. 113(2) EPC does not give a right to the applicant to have a request for amendment considered. It merely forbids the EPO from considering and deciding upon any text of an application other than that submitted or agreed by the applicant or proprietor. If the petitioner did not indicate, before the debate was closed, a wish to amend the requests on file or to file a further request, the board did not decide upon any text other than that submitted by the proprietor (**R 10/08**, referring to **G 7/93**; see also **R 11/11**).

### 3.13.18 Further examples of unsuccessful petitions

If a party informs the board that it will not be attending the oral proceedings and the case is then decided in the party's absence, the party's right to be heard is not infringed (**R 17/13**).

The principle of efficiency requires a board of appeal to focus on what is relevant for the decision. If a case can be decided on the basis of sufficiency of disclosure, discussing any other ground such as inventive step would concern an obiter dictum (**R 16/12**).

The assertion that the petitioner learned during the break in the oral proceedings, from a third party who had presented himself as the examiner who had taken the decision, that its appeal was going to be dismissed has no bearing on an alleged infringement of the right to be heard (**R 4/12**).

National judgments and documents submitted in national proceedings may be introduced into appeal proceedings. Accepting such documents as evidence - to be freely assessed by the board - does not, as such, violate the right to be heard (**R 21/09**).

An infringement of Art. 15(5) RPBA, by not stating the final requests before declaring the debate closed, does not necessarily involve a violation of Art. 113 (1) EPC (**R 10/08**; with regard to Art. 15(4) RPBA, see also **R 6/15**).



Oral submissions made by an accompanying person are under the discretionary control of the EPO. The denial of a request - made shortly before the oral proceedings - for an accompanying person to present oral submissions (requiring interpretation) is not a fundamental violation of Art. 113(1) EPC (**R 3/08**, referring to **G 4/95**).

### 3.13.19 Successful petitions under Article 112a(2)(c) EPC

In the *inter partes* proceedings under review in **R 16/13** the petitioner had filed a document with comparative test results. In its written decision, the board of appeal stated that this document did not prove the advantages of the claimed substance because some of the parameters referred to in the claim had not been specified in the document. This issue had not been raised in the proceedings and according to the Enlarged Board it had not been possible for the petitioner to infer the board's reasoning, on the basis of his own expertise, from the way the proceedings developed. The Enlarged Board allowed the petition, stating that the right to be heard is violated when a board gives, *ex officio*, reasons in its decision without having given the party adversely affected an opportunity to comment on these reasons, and, as far as the patentee is concerned, an opportunity to submit new requests. In **T 1378/11** the board stated that **R 16/13** could not be understood to give the parties the right to find out from the deciding body how it assesses the facts and arguments on which its decision is likely to be based. In **R 8/13** the petitioner relied on **R 16/13** and argued that the board's claim construction had come as a surprise. The Enlarged Board highlighted the differences between the cases and rejected the petition for review.

In the *ex parte* proceedings under review in **R 15/11** the board had held that the request did not comply with the requirements of Art. 84 EPC. According to the Enlarged Board, there was no explicit or implicit indication in the file of the appeal procedure from which it could be derived that a possible lack of clarity was at any time discussed with the petitioner or that at least an objection was raised in this respect. The Enlarged Board allowed the petition and held that a minimum prerequisite for an opportunity to comment on a specific ground (here: Art. 84 EPC) was that the petitioner was aware or could have been aware that compliance with that ground was at issue. A statement in the communication concerning a potential discussion of, *inter alia*, Art. 84 EPC did not amount to a specific objection regarding the request at issue.

In the *inter partes* proceedings under review in **R 3/10** the chairman had stated after the parties' submissions on novelty "that the Board will decide on patentability". The board had then closed the debate and held that the main request was novel but lacked an inventive step. According to the Enlarged Board, the term "patentability" covered a variety of potential objections and the chairman could not have meant to address all of them. Thus, the petitioner had no reason to assume that the board's decision would address more than what had been previously discussed, *i.e.* novelty. As the petitioner had not been given the opportunity to comment on inventive step, the Enlarged Board allowed the petition.

In **R 7/09** the petition was allowed, as the EPO was not able to establish delivery of the opponent's statement of grounds of appeal to the patentee and subsequent petitioner.

The petitioner had therefore been unaware of the grounds on which the decision of the board of appeal revoking his patent was based. The fact that the statement of grounds became available to the public and, thus, also to the petitioner by way of electronic file inspection had no bearing on the right of parties to be individually and specifically informed by the Office.

### **3.14. Article 112a(2)(d) EPC - any other fundamental procedural defect**

Under R. 104 EPC, a fundamental procedural defect may have occurred where the board of appeal, contrary to Art. 116 EPC, failed to arrange for the holding of oral proceedings requested by the petitioner, or decided on the appeal without deciding on a request relevant to that decision. What is not defined by the Implementing Regulations does not qualify as a procedural defect within the meaning of Art. 112a(2)(d) EPC (**R 16/09**; see in this chapter IV.F.3.3.2).

#### **3.14.1 Rule 104(a) EPC - failure to arrange requested oral proceedings**

The right to oral proceedings under Art. 116(1) EPC forms a substantial part of the right to be heard under Art. 113(1) EPC. Non-compliance with a request for oral proceedings deprives the party of an important opportunity for presenting its case (**T 1050/09**) and may constitute a fundamental procedural defect which merits the same treatment as the cases covered by Art. 112a(2)(a) to (c) EPC (CA/PL 5/02 Rev. 1 Add. 1, p. 26).

In **R 2/12** the petitioner argued that R. 104(a) EPC should be understood not only as an obligation to arrange oral proceedings but also to give the parties enough time to exercise their right to be heard. The board held that the duration of oral proceedings is, as such, not listed among the procedural defects that might justify filing a petition for review (see also **R 21/10**).

#### **3.14.2 Rule 104(b) EPC - failure to decide on a party's request**

According to R. 104(b) EPC, a fundamental procedural defect under Art. 112a(2)(d) EPC may have occurred where the board decided on the appeal without deciding on a request relevant to that decision. Like R. 104(a) EPC (see in this chapter IV.F.3.14.1), R. 104(b) EPC also reflects an aspect of the right to be heard (**R 21/11**).

While not explicitly defined in the EPC, requests are in general directed to legal consequences sought by the parties. The arguments provided by the parties in support of these legal consequences do not normally belong to the legally binding requests (**R 19/10**; see also **R 17/11**). Only requests submitted in writing or requests which the party had recorded in the minutes of the oral proceedings fall under R. 104(b) EPC (**R 3/14**; see also travaux préparatoires, CA/PL 5/02 Rev. 1 Add. 1, p. 27). It is not a procedural duty of the boards of appeal under R. 104(b) EPC to analyse the submissions of the parties in order to identify potential requests which were not explicitly made (**R 19/10**, **R 17/11**).

A request "relevant to that decision" within the meaning of R. 104(b) EPC is a request that could possibly have led to a different decision (**R 21/11**). If a board refuses a party's request for maintenance of the patent and for reimbursement of the appeal fee, the party's request for remittal is no longer relevant (**R 17/13**). The decision to revoke a patent necessarily includes the rejection of all auxiliary requests (**R 15/09**).

In the appeal proceedings under review in **R 13/14** the appellant had requested that the examining division's refusal of its request to hold oral proceedings in Munich instead of in The Hague be set aside. The board had stated, in the reasons for the decision, that it was not empowered to decide on this request. The Enlarged Board held that this statement, even if not expressed in the usual and formal terminology, had to be considered as a decision on the appellant's request.

In **R 10/08** (see also **R 6/14**), the Enlarged Board referred to **G 12/91** (OJ 1994, 285) and stated that the last point in time to intervene is not the moment a decision is announced but the moment at which the chairman declares the debate closed for deliberation. The petitioner should then have requested that the debate be re-opened if it intended to file a further request. Whether the petitioner intervened during or after the announcement of the decision is not relevant.

In **R 11/08** the Enlarged Board dismissed the petitioner's allegation that the board had not ruled on a request which it had considered too general.

In **R 14/10** the Enlarged Board confirmed that, if a party's request is unclear, it is the duty of the deciding body to ask for clarification before deliberation (see also **R 7/14**). However, if the requests as read out by the chairman in conformity with Art. 15(5) RPBA do not correspond to a party's intention, it is that party's duty to intervene at that point.

### 3.14.3 Successful petition under Rule 104(b) EPC

In **R 21/11**, so far the only allowable petition based on R. 104(b) EPC, the petitioner (patentee) claimed that the board had decided on the appeal without deciding a request for admission of a second expert testimony filed by fax. The Enlarged Board found that R. 104(b) EPC was a specific manifestation of the right to be heard which applied regardless of whether the party's submission might have persuaded the board. The argument that the undecided request was irrelevant because its admission would not have made a difference could only be accepted if it could be shown that all aspects "lost" as a result of its non-admission had been taken into account in the decision under review. According to the Enlarged Board, the procedural defect asserted by the petitioner constituted an infringement of its right to be heard, both under Art. 112a(2)(d) in conjunction with R. 104 EPC and under Art. 112a(2)(c) in conjunction with Art. 113(1) EPC. While the petitioner had argued that this infringement consisted in the board's failure to take account of the second testimony in its decision, the Enlarged Board saw the infringement in the board's failure to consider the request for its admission. Had that request been granted, it could have influenced the outcome, so that there was a causal link between the denied opportunity to comment and the board's

decision (see in this chapter IV.F.3.13.2). The contested decision was therefore set aside.

### **3.15. Article 112a(2)(e) EPC - criminal act having an impact on a decision**

Under Art. 112a(2)(e) EPC, a petition for review may be based on the ground that a criminal act may have had an impact on a decision. A competent court or authority must have finally established that the criminal act occurred; a conviction is not necessary (R. 105 EPC). Deviating from the general rule, the time limit for filing the petition is two months after the criminal act has been established, and in any event not later than five years after notification of the decision (Art. 112a(4) EPC).

In **R 2/10** the petitioner referred to alleged criminal acts which had, however, not been established by a criminal court or authority. The Enlarged Board rejected the petition as clearly inadmissible, due to failure to observe the time-limit for filing the petition.

### **3.16. Rule 108(3) EPC - effects of a successful petition for review**

If the petition is allowable, the Enlarged Board sets aside the decision of the board of appeal and orders the re-opening of the proceedings before the board (R. 108(3) EPC). The limitation of the petition for review to a particular part of the decision (e.g. the non-reimbursement of the appeal fee) is admissible. Although Art. 112a(5) and R. 108(3) EPC do not explicitly provide for setting a decision aside only partially, this possibility follows from general procedural principles (**R 19/12** of 12.04.2016).

The replacement of board members under R. 108(3) EPC after a petition for review has been held allowable lies in the discretion of the Enlarged Board, to be exercised fairly and proportionately in the light of the facts (**R 21/11**). Unless there is a compelling reason for proceeding otherwise, the Business Distribution Scheme must be adhered to and applied to a case re-opened before the board (**R 15/11**).

In **R 16/13**, the Enlarged Board rejected the request that members be replaced because it was not substantiated. In **R 21/11**, the Enlarged Board also rejected the petitioner's request that members be replaced, stating inter alia that such a replacement would necessitate the repetition of the whole appeal proceedings, which would be disproportionate. However, after the decision in **R 21/11** had been taken, the chairman of the technical board concerned retired, and the appeal proceedings had, in any event, to be repeated. As a consequence, both the technically and the legally qualified member recused themselves under Art. 24(2) EPC (**T 584/09** of 1 March 2013).

In **T 379/10** (decision of 21 September 2015), the board cited **R 21/11**, in which it was held that the re-opening of appeal proceedings did not mean that the parties had to be given another opportunity to comment on all the matters in dispute. Rather, proceedings re-opened after a successful petition for review had to be restricted to rectifying the defect found in the review decision.

## **4. Removal from office of a board member**

### **4.1. General**

According to Art. 23(1) EPC, first sentence, members of the Enlarged Board of Appeal and the boards of appeal may not be removed from office during their term of appointment, except if there are serious grounds for such removal and if the Administrative Council, on a proposal from the Enlarged Board of Appeal, takes a decision to this effect. According to Art. 12a RPEBA, the Administrative Council or the Vice-President of the EPO in charge of the boards of appeal may make a request to the Enlarged Board to make a proposal, to the Administrative Council, for the removal from office of a board member.

### **4.2. Composition**

According to Art. 2(5) RPEBA (see also Art. 10 BDS/EBA), the Enlarged Board in proceedings under Art. 23(1) EPC consists of five legally and two technically qualified members. The chairman of the Enlarged Board who is, under current practice, also Vice-President of the EPO in charge of the boards of appeal must be replaced by his alternate, and two of the legally qualified members must be external members of the Enlarged Board (see Art. 11(5) EPC).

In **G 2301/15** the Enlarged Board held that the arrangements laid down in Art. 2(5) RPEBA and Art. 10 BDS/EBA for the composition of the Enlarged Board in proceedings under Art. 23(1) EPC were compatible with the EPC and general principles of law. It could not be inferred from Art. 23(1) EPC that a proposal to remove a member from office must be decided by the full Enlarged Board (consisting of all internal and external members under Art. 1 BDS/EBA).

### **4.3. Removal and judicial independence**

The Enlarged Board stated in **G 2301/15** that removing an irksome judge from office could be used to indirectly influence decisions. It was crucial to judicial independence that judges cannot be removed without special institutional safeguards. The requirement that a board member may only exceptionally be removed from office on a proposal from the Enlarged Board intended to make sure that unsubstantiated or groundless allegations could not be used as pretext for getting rid of an irksome judge.

### **4.4. Independence from disciplinary proceedings**

According to Art. 12a(8) RPEBA, proceedings under Art. 23(1) EPC are to be conducted independently of any disciplinary or national proceedings. According to the Enlarged Board in **G 2301/15**, Art. 23(1) EPC requires that the Administrative Council may apply to a board member the most severe disciplinary sanction available (dismissal) only if it has first received a proposal for his or her removal from office from the Enlarged Board. The administrative disciplinary proceedings before the appointing authority are separate from

the judicial proceedings before the Enlarged Board, which must satisfy itself that the allegations are true, and so serious as to require the removal from office.

#### **4.5. Adversarial judicial proceedings**

In **G 2301/15** the Enlarged Board held that proceedings under Art. 23(1) EPC were to be conducted in proper judicial form. A request by the Administrative Council initiated adversarial proceedings to which the board member concerned is a party as respondent (Art. 12a(4) RPEBA). The Administrative Council's request must set out all the facts, arguments and evidence relied on; all documents referred to must be attached (Art. 12a(5) RPEBA). According to the Enlarged Board, this provision requires that the Administrative Council's request specify individual incidents and the evidence for them, and give reasons why they constitute a serious ground within the meaning of Art. 23(1) EPC. It was not be up to the Enlarged Board to define of its own motion which facts may be derived from documents and exhibits. Simply referring to facts and evidence and leaving the Enlarged Board to reconstruct the events for itself neither satisfied the requirements of Art. 12a(5) RPEBA nor the respondent's right to know the charges against him. As the Administrative Council's request was not substantiated as prescribed by Art. 12a(5) RPEBA, the Enlarged Board rejected the request as inadmissible.

#### **4.6. Publication of the decision**

According to Art. 18(3) RPEBA, the final decision of the Enlarged Board in proceedings under Art. 23(1), first sentence, EPC may be published, due regard being taken of the confidentiality of the proceedings. Case **G 2302/15** was terminated following the Administrative Council's withdrawal of its request that the Enlarged Board make a proposal for the removal from office of a board member. The Enlarged Board's decision was final in that it terminated the proceedings, albeit for non-substantive reasons. The Enlarged Board decided that the decision be published.

#### **4.7. Reimbursement of costs**

According to Art. 12a(10) RPEBA the Enlarged Board may on request propose the reimbursement of some or all costs incurred in the proceedings by the respondent if the request to make a proposal for their removal from office has been rejected (see **G 2301/15**). In **G 2302/15** the proceedings were terminated following the Administrative Council's withdrawal of its request during oral proceedings. The Enlarged Board proposed the reimbursement of all costs incurred by the respondent, as the costs for preparing his defence had turned out to be unnecessary as a result of the withdrawal.

## V. PROCEEDINGS BEFORE THE DISCIPLINARY BOARD OF APPEAL

1.	Introduction	1247
2.	European qualifying examination	1249
2.1.	Formalities and conditions for enrolment	1249
2.1.1	Required qualification or equivalent knowledge	1249
2.1.2	Professional experience	1250
2.2.	Examination conditions	1252
2.3.	Marking the answer papers	1253
2.4.	Grades / passing the examination	1254
2.5.	Substantiation of EQE decisions	1255
2.6.	Appeals against decisions of the Examination Board and the Examination Secretariat	1255
2.6.1	Competence of the board of appeal	1255
2.6.2	Time limit for appeal / rectification of decisions	1256
2.6.3	Objective review of the marks awarded	1256
2.6.4	Legitimate interest	1259
2.6.5	Complaints about the conduct of the examination - duties of the Examination Board	1260
3.	Disciplinary matters	1260
3.1.	Disciplinary measures	1260
3.2.	Appealability of decisions in disciplinary matters	1262
4.	Code of Professional Conduct	1262
4.1.	General professional obligations	1262
4.2.	Professional secrecy	1262
4.3.	Advertising	1263
5.	Appeals against decisions of the Disciplinary Board of Appeal	1263

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### 1. Introduction

Representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO (Art. 134(1) EPC). Any natural person who is a national of a contracting state, has his place of business or employment in a contracting state and has passed the European qualifying examination may be entered on the list (Art. 134(2) EPC). Under Art. 134(8) EPC (cf. Art. 134(7) EPC 1973), legal practitioners from the contracting states are also entitled to act as representatives, subject to the conditions specified therein.

Art. 134a EPC, introduced under the EPC 2000, incorporates the substance of former Art. 134(8) EPC 1973 and anchors in the Convention the existence of the Institute of Professional Representatives before the EPO ("*epi*").

For further information on representation before the EPO, see Chapter III.R. "Representation". For more details of the changes introduced by the EPC 2000, see also OJ SE 4 and 5/2007.

All persons on the list of professional representatives must be members of the *epi* (Art. 134a(2) EPC; see also Art. 5(1) of the Regulation on the Establishment of an Institute of Professional Representatives before the EPO, OJ 1997, 350; for amendments to the Regulation, see OJ 2002, 429, OJ 2004, 361 and OJ 2007, 12), and are subject to the Regulation on Discipline for Professional Representatives, adopted by the Administrative Council of the European Patent Organisation (RDR, OJ 1978, 91; as amended: OJ 2008, 14), and to the Code of Conduct of the Institute of Professional Representatives before the EPO, adopted by the *epi* (OJ 2003, 523). These provisions are also published in Supplementary publication – OJ 1 of each year.

The first instance bodies which rule on infringements of the rules of professional conduct are the *epi* Disciplinary Committee and the EPO Disciplinary Board (Art. 5 RDR; see also Additional Rules of Procedure of the Disciplinary Committee and of the Disciplinary Board, OJ 1980, 176, and 177 and 183, respectively; for amendments, see OJ 2007, 552; also published in Supplementary publication – OJ 1 of each year).

The Disciplinary Board of Appeal (DBA) hears appeals against decisions of the *epi* Disciplinary Committee and the EPO Disciplinary Board (Art. 5, 8 RDR). See also Additional Rules of Procedure of the Disciplinary Board of Appeal, OJ 1980, 176 and 188; for amendments, see OJ 2007, 548; for consolidated version, see Supplementary publication – OJ 1 of each year.

The European qualifying examination (EQE), referred to in Art. 134(2)(c) EPC, is governed in particular by the Regulation on the European qualifying examination for professional representatives before the EPO (REE, OJ 2009, 9; also Supplementary publication 2, OJ 2014, 2), which entered into force on 1.1.2009, and by its Implementing provisions (IPREE, Supplement to OJ 5/2009, 20; as amended: Supplementary publication 2, OJ 2014, 18). These provisions replace the REE 1994, (last published: Supplement to OJ 12/2008, 1), and the IPREE 1994 (last published: Supplement to OJ 12/2008, 15). The content of the former Instructions (Instructions concerning the qualifications required for enrolment for the EQE, Supplement to OJ 12/2008, 19; Instructions to candidates concerning the conduct of the examination, Supplement to OJ 12/2008, 24; Instructions to candidates for preparing their answers, Supplement to OJ 12/2008, 29; and Instructions to invigilators, Supplement to OJ 12/2008, 35) has been largely incorporated into the IPREE and the current Instructions to candidates concerning the conduct of the EQE (Supplementary publication 2, OJ 2014, 38).

A number of substantive changes were introduced by the REE which entered into force on 1.1.2009 and its IPREE. These include first the creation of a Supervisory Board (Art. 1(6), 2, 3 REE), which is responsible for adopting the IPREE (Art. 3(7) REE), and the introduction of a pre-examination from 2012 (Art. 1(7), 11(7) REE, R. 10 IPREE). Other modifications are: simplification of the enrolment requirements in respect of academic qualifications and professional experience (Art. 11 REE, R. 11 to 15 IPREE);



replacement of the rules on modular sitting by the option to take one or more papers at one sitting (Art. 15 REE); extension of the compensation system to all candidates (Art. 14 REE, R. 6 IPREE); streamlining of the appeal procedure (Art. 24 REE).

Under Art. 24 REE (cf. Art. 27 REE 1994), the DBA hears appeals against decisions of the EQE Examination Board and Secretariat.

Appeals against Examination Board and Secretariat decisions which were decided by the DBA under earlier provisions are referred to below if considered still relevant. For more detailed information on the old rules and related DBA decisions, see the 5th edition of the Case Law of the Boards of Appeal.

## 2. European qualifying examination

In principle, only persons who have passed the EQE may be entered on the list of professional representatives (Art. 134(2)(c) EPC; see also Art. 134(3) EPC).

### 2.1. Formalities and conditions for enrolment

In **D 4/08** the board confirmed the Examination Secretariat's strict application of the published closing date for enrolment for the EQE, stressing its importance for the timely and orderly preparation of the examination. According to **D 7/08**, it was the candidate's responsibility to file the complete application, including the enrolment form and all necessary supporting evidence, by the closing date (see also **D 12/08**, **D 15/09**).

#### 2.1.1 Required qualification or equivalent knowledge

To qualify for registration and enrolment, candidates must normally possess a university-level scientific or technical qualification, i.e. a bachelor's degree or equivalent academic degree awarded at the end of a full-time course of a minimum of three years, with at least 80% of the course hours taken to obtain this degree having been devoted to scientific and/or technical subjects (Art. 11(1)(a) REE, R. 11 IPREE, also R. 12 IPREE). The qualifying subjects include biology, biochemistry, construction technology, electricity, electronics, information technology, mathematics, mechanics, medicine, pharmacology and physics (R. 13 IPREE). There is no legal requirement as to the minimum number of course hours required; to establish if a candidate's degree can be considered as having been devoted mostly (80%) to science/technology, the legislator chose the number of years (a "minimum" benchmark easier to establish than the number of hours) and the percentage of courses devoted to technical and/or scientific subjects (**D 13/14**). The board in **D 9/14** emphasised that the 80% is always to be calculated from the required course hours for the particular degree under scrutiny (which in the case in hand required four years of study). It furthermore accepted that a calculation based on credits may be suitable for the purposes of R. 11(2) IPREE but that, in the case of any discrepancy between the calculations based on course hours and those based on credits, the former is authoritative.

Otherwise, under R. 14 IPREE, equivalent knowledge may be demonstrated on the basis of at least ten years' experience in the activities defined in Art. 11(2)(a) REE – see also in this chapter V.2.1.2 and furthermore the board's interpretation of R. 14 IPREE in **D 9/14**.

In similar cases **D 1/12**, **D 2/12**, **D 3/12** and **D 4/12** (see also **D 9/14**), the DBA concluded that the appellant possessed neither a university-level qualification meeting the above criteria (in particular because the required 80% of course hours in scientific and/or technical subjects was not met) nor sufficient professional experience to provide a basis for equivalent knowledge. However, while the appellants in cases **D 1/12** to **D 4/12** had started their practical training (see in this chapter V.2.1.2) after the amended REE entered into force on 1.1.2009, the respective appellants in **D 7/14** and **D 8/14** had already started it before then. In the latter two cases, the DBA held that, on the basis of the principles of good faith and equal treatment, the REE 1994 with its IPREE and Instructions should be applied, in accordance with the practice of the Examination Secretariat before 1.1.2009 (see e.g. **D 1/12**). Also taking into account the relevant jurisprudence (in particular **D 5/08**), the board was satisfied in both cases that the appellant was suitably qualified under the 1994 provisions.

Earlier decisions relating to the REE 1994 and its Instructions concerning the qualifications required for enrolment for the EQE are **D 15/04**, **D 17/04**, **D 18/04** and **D 8/04**, reported in the "Case Law of the Boards of Appeal", 5th ed. 2006, and also **D 5/08**, **D 10/08**.

### 2.1.2 Professional experience

A further requirement for enrolment is that at the date of the examination a candidate must normally have worked full-time for at least three years in the field of European patent applications and European patents in a contracting state, as set out in Art. 11(2) to (5) REE and R. 15 IPREE. For the pre-examination the period is reduced by one year (Art. 11(7) REE). The period may be reduced by six months for candidates who have successfully completed specialised studies of at least one academic year in the field of industrial property (R. 16(1) IPREE).

One way of acquiring this work experience is to complete a training period under the supervision of and as an assistant to one or more professional representatives before the EPO, in accordance with Art. 11(2)(a)(i) REE.

The following three cases, decided under the earlier law, remain of interest. According to **D 4/86** (OJ 1988, 26), for the condition stipulated in previous Art. 7(1)(b)(i) REE 1977, as amended, to be met, the trainee had to have completed his training period under conditions likely to ensure that he had actually assisted a professional representative by constantly taking part in activities pertaining to patent application procedures of which the representative was in fact in charge. **D 14/93** (OJ 1997, 561) ruled that the training period could not be served with a legal practitioner whose name did not appear on the list of professional representatives, even if the said practitioner was a patent attorney under national law (see Art. 134(7) EPC 1973, see now Art. 134(8) EPC). According to the board, the activities referred to in Art. 7(1)(b) REE 1991 presupposed the scientific or

technical knowledge required with a view to activities pertaining to European patent applications and patents; persons training EQE candidates needed to possess such knowledge, and legal practitioners did not normally do so. **D 25/96** (OJ 1998, 45) ruled that the period of professional activity required for the EQE enrolment could not be served with a self-employed German patent agent who was not on the list of professional representatives.

A candidate may alternatively complete the prescribed period of professional activities as an employee in accordance with the requirements of Art. 11(2)(a)(ii) REE. The relevant conditions are not met where the candidate's employer is not represented before the EPO by the candidate in accordance with Art. 133(3) EPC but by external patent attorneys, or where the candidate's main activity has been in the field of national or international applications and patents (**D 6/10**, with reference to **D 12/06** and **D 13/06**; see also **D 11/11**, with reference to **D 32/07**; furthermore **D 1/12** to **D 4/12**).

Given the tenor of Art. 11(2)(a)(ii) REE, (mere) professional activity and activities pertaining to patent law cannot be treated as two distinct requirements. Professional activity can be recognised only if and for such time as candidates were able to represent their employer before the EPO and in fact did so. They must have been authorised to act as representative by their employer, but formal authorisation is not enough by itself, as it does not show whether, as required, they have actually worked in that capacity (**D 1/13**).

In **D 16/04** the board confirmed the practice of the Examination Secretariat of allowing only periods of professional activity completed after the required degree was obtained as not being in conflict with Art. 10 REE 1994. Art. 10(1) REE 1994 mentioned the requirement of possessing a university-level scientific or technical or equivalent qualification first, followed by a reference to the conditions set out in paragraph 2, i.e. the three-year full-time training period to be completed by the date of the examination. The ordinary meaning to be given to this grammatical order reflected the common understanding that studies normally precede practical training. The required length of the training period was a consequence of the candidate's technical or scientific degree acquired before starting the training period rather than vice versa. See also **D 6/08**.

This is now a requirement under Art. 11(3) REE, which, in conjunction with R. 15(2) IPREE, also specifies how periods of professional activity may be aggregated to make up a full-time training period.

Art. 11(2)(b) REE allows candidates who at the date of the examination have performed full-time the duties of an examiner at the EPO for at least four years to enrol for the EQE without having previously worked in accordance with Art. 11(2)(a) REE. In **D 19/04** the appellant, an examiner of many years' standing at the German Patent and Trade Mark Office, had cited the corresponding Art. 10(2)(b) REE 1994 when submitting his candidature for the examination, without providing evidence that he had worked in accordance with Art. 10(2)(a) REE 1994. The board pointed out that Art. 10(2)(b) REE 1994 related to EPO examiners, who in view of their professional experience could be assumed to have a comprehensive knowledge of the European patent grant procedure. The professional experience of long-serving examiners in national offices could not be

equated with that of EPO examiners. Given the different professional circumstances of EPO examiners and those in national offices, the means represented by the provision were in reasonable proportion to the end it served.

According to R. 16(2) IPREE, the period of professional activity under Art. 11(2)(a) REE may be reduced by up to one year if a candidate has been a patent examiner at the EPO or the national patent office of a contracting state.

## 2.2. Examination conditions

In **D 2/95** the DBA found against an appellant alleging discrimination; the fact that certain other candidates had been allowed to use normal as opposed to copy paper for the examination was not in breach of the provisions governing its conduct. Some candidates might find copy paper more awkward, but others might well prefer it. Nor did other arguments along similar lines - e.g. that too little time was allowed for the papers, or that candidates whose mother tongue was not an EPO official language were at a disadvantage and should therefore be given more time than the others - convince the DBA that the relevant provisions had been infringed (**D 11/00**).

In **D 1/94** (OJ 1996, 468) the board did however rule that a translation error might constitute a violation of Art. 11(3) REE 1991 (cf. Art. 12(3) REE, R. 5 IPREE), since this provision assumed that the translation from the language selected by the candidate into one of the EPO official languages was totally correct. In its decision, the Examination Board therefore had to give reasons why the translation errors had not been found to be serious.

In **D 14/95** the appellant alleged infringement of the principle of equal treatment because he, as a specialist in biochemistry, had been placed at a disadvantage in Paper C (taken from mechanical engineering) compared with a specialist in that field. The board found against any breach of equal treatment; the appellant's position was no different from that of any other candidate whose specialist field did not happen to be used in the paper as set. True, the examination procedure did in effect involve a certain "inequality". The Examination Board set a limited number of papers, and therefore had to make a choice amongst the different technical fields. So there would always be candidates who happened to be more specialised than others in the particular field selected. This however was inherent in any general examination, and thus did not constitute arbitrary unequal treatment. Furthermore, Paper C was less concerned with testing specialist technical knowledge than the ability to draft a notice of opposition to a European patent.

In **D 9/96** a candidate alleged unequal treatment in connection with the language rules under Art. 15 REE 1994 (cf. Art. 12 REE). The board conceded that not all candidates were treated equally since not all of them received examination papers in their mother tongue. However, this differentiation was a direct consequence of the linguistic regime of the EPC 1973 itself. According to Art. 14(1) EPC 1973 the official languages of the EPO were English, French and German. Each professional representative was inevitably confronted with documents and notifications in one of the three official languages of the EPO. Thus, any professional representative had to be expected, in the public interest

and the interest of his clients, to understand at least one of the official languages and to be able to work on documents and notifications drafted in this language.

The background to several appeals (**D 10/97**, **D 15/97**, **D 17/97** and **D 5/97**) against Examination Board decisions failing candidates in Paper D of the 1996 EQE was that some (but not all) of the copies of the paper given to candidates did not contain Question 11. The Examination Board therefore automatically gave all candidates full marks for Question 11. On this point the DBA reaffirmed **D 14/95**, which had stated that equal treatment did not have to be absolute, provided the nature and extent of any unequal treatment was justifiable in the circumstances. It would be wrong in law, however, if the examination conditions put certain candidates at a disadvantage for no good reason. The Examination Board had compensated the affected candidates in a way which appeared entirely appropriate given the circumstances. This necessarily involved a certain unequal treatment, which however was limited in its extent and acceptable in this special situation. In particular, it ensured that no candidate was worse off than if his answer had been marked objectively. So, in the DBA's view, the way in which the Examination Board had corrected the error was appropriate to the circumstances and did not constitute unlawfully unequal treatment.

### **2.3. Marking the answer papers**

Art. 6(2)(c) REE requires the Examination Board to give the members of the examination committees instructions for marking candidates' answers consistently (cf. Art. 16 REE 1994).

Under Art. 8(1)(d) and (e) REE, the examination committees mark the answer papers, each paper being marked by two committee members (examiners) separately (cf. Art. 8(b) REE 1994).

In **D 4/99** the appellant's complaint concerned the fact that the two examiners had marked Paper D differently. The board stated that the appellant's starting point that in case of non-identical marks only one value could be the correct one was irreconcilable with the fact that marking was an individual assessment of the candidate's work. Rather, more or less strict standards were possible and different aspects might be considered essential or less important even within the general instructions to the examiner for marking the papers contained in the IPREE 1994. Examiners must have some latitude of evaluation when awarding marks and individual examiners might arrive at different marks, both results being justifiable. Therefore, differences in marking did not violate the REE 1994 and its Implementing provisions (**D 5/94**, **D 6/98**). In order to safeguard the principle of equal treatment, harmonisation of marking was provided for in the marking sheets. If the marking was different, the two examiners might revise their marks on the basis of a discussion between them. The examination committee recommended the grade, and the Examination Board adopted it or otherwise, in full knowledge of the different marks awarded by the two examiners. This system ensured uniformity of marking (Art. 16 REE 1994). See also in this chapter V.2.6.3.

In **D 6/99** the DBA confirmed that small differences in marking did not, as such, violate the REE 1994 and its Implementing provisions. They were an unavoidable consequence of the provision, in Art. 8(b) REE 1994, that each answer was marked separately by two examiners. The board was not aware of any provision supporting the appellant's submission that in such cases only the better mark awarded in each category of the paper should be counted.

In **D 10/02** (OJ 2003, 275) it was noted that neither the REE 1994 nor its Implementing provisions regulated the procedure to follow in the exceptional cases where a committee was unable to agree on the marking; nor did they provide for calling in a third or fourth examiner. The DBA pointed out that those were the very cases in which an express provision was needed in order for a candidate to satisfy himself that his paper had not been marked arbitrarily or the procedure influenced by irrelevant circumstances. Hence the appointment of a third examiner without any basis in the REE 1994 or its Implementing provisions had to be deemed a substantial procedural violation.

In **D 3/04** the appellant had complained about unsuitable conditions during the examination. The appealed decision, however, did not show that the appellant's complaint had been taken into consideration by the Examination Board. In the view of the DBA, where the Examination Board found the circumstances referred to in a complaint not to justify the allocation of additional marks, brief reasons should be given explaining why this was so.

In **D 7/05** (OJ 2007, 378), which concerned Paper D, the DBA deemed that details of the marking include sufficient sub-division of the maximum achievable mark and the candidate's overall mark into sub-marks, and an indication of the substantive and legal issues for which those sub-marks were awarded. In producing schedules of marks there had to be a trade-off between their purpose of ensuring uniform marking (Art. 16 REE 1994) and the need also to allow for fair marking of answers which deviated from the scheme but were at least reasonable and competently substantiated. The schedules therefore had to leave some room for manoeuvre and - merely - be sufficiently detailed to constitute details of the marking within the meaning of R. 6(1) IPREE 1994 (cf. now R. 4(1) IPREE) allowing candidates to verify, on the basis of the documents published or made accessible, whether the marking of their answers infringed marking principles the respect of which was subject to review by the DBA. See also in this chapter V.2.5 and decisions **D 11/07**, **D 23/08** and **D 8/12**.

#### **2.4. Grades / passing the examination**

To pass the examination, a candidate must have passed each paper or obtained the minimum grades as specified in the IPREE (Art. 14(1) REE, R. 6(1), (3) and (4) IPREE). The possibility of being awarded the grade "Compensable fail" in an individual paper (R. 6(3)(c) IPREE) is no longer restricted to first sitters. If, despite this compensatory measure, a candidate fails the examination, he must resit those papers which he did not pass (Art. 16(1) REE). Borderline case assessments of candidates' fitness to practise as professional representatives before the EPO are therefore not possible under the REE

and IPREE. For earlier decisions relating to this point, see "Case Law of the Boards of Appeal", 5<sup>th</sup> ed. 2006, V.2.4 "Borderline cases", and also **D 23/08**.

## **2.5. Substantiation of EQE decisions**

At issue in **D 12/97** (OJ 1999, 566) was whether EQE Examination Board decisions informing candidates that they have failed the examination have to be reasoned. The DBA pointed out that this was not required by the REE 1994. The board also found the appellant's constitutional arguments - that substantiation of such decisions was a generally recognised principle of procedural law within the meaning of Art. 125 EPC 1973 - to be unfounded. For this to be so, it had to be shown that substantiation of such decisions was required in the EPC contracting states.

In **D 3/03** the DBA confirmed its case law (**D 12/97**, OJ 1999, 566), whereby the REE 1994 neither required EQE decisions to be reasoned nor made reference to R. 68(2) EPC 1973 (cf. now R. 111(2) EPC), which therefore did not apply. The Guidelines for Examination were likewise not applicable for the same reasons. The REE and its Implementing provisions were *lex specialis* for the EPC. In other words, unless they expressly referred to the EPC, then only they and not the EPC applied. The subsidiary nature of these provisions was justified by the fact that they governed a particular matter unrelated to the EPC *stricto sensu*, since their purpose was to establish whether a candidate was considered fit to practise as a professional representative before the EPO. With regard to the review by the courts of decisions concerning the European qualifying examination for professional representatives before the EPO, the German Federal Constitutional Court had also held that the obligation to give reasons for examination decisions cannot be regarded as an expression of the structural elements of any protection of basic rights intended by the Basic Law (see decision 2 BvR 2368/99 of 4 April 2001).

This case law was again confirmed by the DBA in **D 7/05** (OJ 2007, 378). In its extensive reasoning the Board also held that, apart from the fact that the marking sheets under R. 6(1) IPREE 1994 already had a decision substantiation function, the extent to which the principles of rule-of-law process also demanded individual substantiation of examination decisions could not be assessed without consideration of the extent of the Board's powers of review under Art. 27(1) REE 1994. The absence of an obligation to provide individual substantiation was to be seen in connection with the fact that Examination Board decisions in EQE proceedings were subject to only limited judicial review (as to this see also chapters V.2.6.1 and V.2.6.3).

## **2.6. Appeals against decisions of the Examination Board and the Examination Secretariat**

### **2.6.1 Competence of the board of appeal**

Under Art. 24(1) REE (cf. Art. 27(1) REE 1994), an appeal lies from decisions of the Examination Board and the Secretariat only on grounds of infringement of the Regulation or of any provision relating to its application.

However, the board of appeal has only very limited scope for reviewing the legal validity of implementing provisions drawn up by the Administrative Council or, in the case of delegation, by the relevant subsidiary body.

In **D 3/89** (OJ 1991, 257) the board of appeal stated in justification of the limited scope of the examination that the relevant bodies had discretionary powers in drawing up such provisions. As long as the legislative organ and subsidiary bodies had not misused their discretionary powers, the DBA could apply the provisions concerning examinations only to the case in point (see also **D 1/81**, OJ 1982, 258, **D 5/89**, OJ 1991, 210, **D 14/96**, **D 11/99** and **D 7/05**, OJ 2007, 378). Concerning the Examination Secretariat's discretion to decide on the sufficiency of a candidate's professional experience, see e.g. **D 32/07** and **D 1/13**.

#### 2.6.2 Time limit for appeal / rectification of decisions

The notice of appeal, to be filed within one month from notification of the contested decision, must already include the statement setting out the grounds (cf. Art. 24(2) REE). Under Art. 24(3) REE, if the Examination Board or the Secretariat considers the appeal to be admissible and well-founded it must rectify its decision and order reimbursement of the appeal fee. If the appeal is not allowed within two months from notification of the decision, it is remitted to the DBA. The procedure according to Art. 27 REE 1994, which was the subject of the following two decisions, has therefore been streamlined.

In **D 38/05** of 17.1.2007 and **D 4/06** the DBA found that the provision for rectification of decisions of the Examination Board was modelled on Art. 109(1) EPC and designed to serve the same purpose in comparable situations. The aim, in either case, was that the department of first instance be able to set aside a decision of its own if it found an appeal against that decision, filed by the (sole) party, to be (admissible and) allowable. This was a quick and simple way of cancelling flawed decisions. Art. 27(3) REE 1994 (analogous to Art. 109(1) EPC) provided that the department whose decision was contested - in this case, the Examination Board - must rectify its decision if it considered the relevant requirements to be fulfilled. This also meant that the Examination Board was obliged to assess carefully whether or not these requirements were met before deciding to grant or refuse rectification and, in the latter case, referring the matter to the board of appeal. The two-month time limit for considering the appeal and deciding whether it must be allowed therefore only started to run on receipt of the statement of grounds for appeal, even though this was not expressly provided in Art. 27(3) REE 1994 - in contrast to Art. 109(2) EPC. See, however, the current provisions of Art. 24(2) and (3) REE, referred to in the previous paragraph. See also **D 3/14** in this chapter V.2.6.3, which concerned the pre-examination.

#### 2.6.3 Objective review of the marks awarded

In accordance with the DBA's consistent case law (in particular **D 1/92**, OJ 1993, 357, **D 6/92**, OJ 1993, 361, and **D 7/05**, OJ 2007, 378), decisions of the Examination Board may in principle only be reviewed for the purposes of establishing that they do not infringe the REE, the provisions relating to its application or higher-ranking law. In **D 1/92**



and **D 6/92**, the DBA therefore concluded that its functions did **not** include reconsidering the examination procedure **on its merits**. Accordingly, the Examination Board's value judgment concerning the number of marks that an examination paper deserved was not subject to review by the board. Only if the appellant could show that the contested decision was based on serious and obvious mistakes could the board take this into account. The alleged mistake must be so obvious that it could be established without re-opening the entire marking procedure, for instance if an examiner was alleged to have based his evaluation on a technically or legally incorrect premise on which the contested decision rested. Any further claims regarding alleged defects in the assessment of candidates' work fell outside the DBA's jurisdiction, since value judgments were not subject to judicial review. These findings were confirmed in **D 7/05** (OJ 2007, 378). See also, for example, **D 9/00**, **D 7/01**, **D 11/01**, **D 16/02**, **D 6/04**, **D 14/08**, **D 23/08**, **D 1/13** and **D 5/13**.

In **D 6/98**, the DBA added that these conditions were in line with those for correcting errors under R. 89 EPC 1973 (cf. now R. 140 EPC), particularly in the case of errors of transcription or calculation in the marking. Under Art. 27(1) REE 1994 (cf. Art. 24(1) REE), the DBA was not empowered to reopen the assessment procedure (**D 15/97**). The DBA was not intended to be a department of second instance empowered to examine whether the marks awarded for a candidate's examination were justified on their merits or correct, and thus to superimpose its own value judgment on that of the Examination Board (**D 20/96** and **D 6/02**).

In **D 13/02** the board stated that obvious mistakes as referred to above were those which could be identified without a re-evaluation of the examination paper. That would be the case, for instance, if one and the same paper had been marked **very** differently by the two examiners, since the marking discrepancy alone would indicate an infringement of the principle of uniform marking, irrespective of the level of the marks awarded. Another example of an obvious mistake would be a question whose wording was ambiguous or incomprehensible. That would be clear straight away, without any reference to marks awarded, from the meaning that common sense would ascribe to the wording of the question concerned.

**D 17/05** cited **D 13/02** to point out that the existence of a mistake within the meaning of **D 1/92** could not be deduced from a comparison of the candidate's answer with another answer. The board also cited the statement that the disclosure of marking instructions which may have been used by the examiner was not required for a decision on an appeal and that under the established case law no other entitlement existed to any such disclosure.

In **D 3/00** (OJ 2003, 365) the appellant claimed that for each question in paper D, parts 1 and 2, he should have been awarded the highest number of marks awarded by one of the two examiners who had marked his paper. In **D 12/00**, too, the appellant claimed that the higher number of marks should count. Any discrepancy between the markings of each examiner showed gross disregard for the principle of uniformity within the meaning of Art. 16 REE 1994 (Art. 6(2)(c) REE, English text, now provides for consistency of marking). The board confirmed its established case law, adding that differences of

opinion over the number of marks to be awarded for a given answer were a reflection of value judgments which were not, in principle, subject to judicial review. It had also already been explained in **D 4/99** (see point 2.3 above) that the marking of examination papers was an individual assessment and that, within the general instructions to the examiners for marking the papers (IPREE 1994), more or less strict standards were possible and different aspects might be considered essential or less important. Hence it was consistent with the ratio legis of Art. 8(b) REE 1994 (cf. Art. 8(1)(e) REE) that the examiners had some (limited) latitude of evaluation when awarding marks and might therefore arrive at different marks, both results being justifiable (**D 5/94** and **D 6/98**). The fact that two independent examiners had arrived at different marks was not per se a violation of the applicable provisions (**D 12/00**). In **D 3/00** the board drew attention to the fact that, with regard to the evaluation of the merits of a candidate's answer in an examination paper, a candidate was not per se entitled to claim the highest mark awarded by one of the examiners for each answer to a sub-question or sub-element whenever the two examiners who marked the paper in accordance with Art. 8(b) REE 1994 differed in their marking.

**D 6/07** and **D 7/07** were among a number of appeal decisions concerning the marking of paper C of the 2007 examination. A large number of candidates had taken as the starting point for their attack on the claims a document which the examination committee did not consider to represent the closest prior art and had been awarded no points in this regard. The Examination Board took the view that, in keeping with long-standing practice, some credit should be given for properly drafted problem and solution approaches even where the wrong starting document for assessing inventive step had been used. Given the lateness of the proceedings and the impossibility of re-marking all the papers, it decided, as an exceptional measure, that the fairest option would be to award ten additional points (being the maximum number possible) to all candidates having sat the paper. The DBA held first that the awarding of no points by the examination committee infringed the requirements of R. 4(2) and (3) IPREE 1994: the "fit to practise" criterion required the examiners in marking the individual parts of a candidate's answers not to disregard their merit in the context of the whole answer paper (**D 3/00**, OJ 2003, 365) and the need to allow for the fair marking of answers which, although deviating from the marking scheme, were nonetheless reasonable and competently substantiated (**D 7/05**, OJ 2007, 378). The board further ruled that, under Art. 7(3) REE 1994, it fell to the Examination Board to award the grades "pass", "fail", or "compensable fail" and formally to decide whether the whole examination had been passed or not. Its powers did not extend to the preceding marking of candidates' individual papers on a scale of zero to 100, and therefore the alteration of the marks awarded by the examination committee (in accordance with Art. 8(b) REE 1994 and R. 4(1) IPREE 1994) by the blanket addition of ten marks per paper had been ultra vires. The abstract awarding of marks without regard to the "fit to practise" criterion of R. 4 IPREE 1994 in the individual candidates' examination papers infringed the principle of objectivity as well as Art. 8(b) REE 1994 and R. 4 IPREE 1994. In conclusion the DBA ordered a new marking of paper C of each appellant in accordance with R. 4 IPREE 1994, with the ten additional points already awarded to be retained by the appellant.

In **D 3/14** the appellant had obtained the grade "fail" (with 68 marks) in the 2014 **pre-examination** for the European qualifying examination. She argued that the answer to statement 10.4 in the question paper should have been "false", rather than "true", as given in the Examiner's Report, and requested that the decision of the Examination Board be set aside and that she be awarded a "pass".

In accordance with the settled case law (e.g. **D 1/92**, see above), the board examined whether the alleged mistake was so obvious that it could be established without reopening the entire marking procedure. It found that statement 10.4 should have been formulated differently in order to express the aim intended. Candidates could not be expected to make an assumption in this respect (cf. R. 22(3) IPREE, providing that candidates must limit themselves to the facts given). The appellant's understanding of statement 10.4 was justified from an objective point of view. The answer to it was "false" and not "true" as indicated in the examiner's report. The examiners had based their evaluation on an incorrect premise and therefore the contested decision was based on serious and obvious mistakes which could be established without reopening the entire marking procedure. The decision had to be set aside and the appeal fee reimbursed (Art. 24(4) REE). Concerning the requested award of a "pass", the appeal board was not empowered by Art. 24(4), second sentence, REE to correct the decision, i.e. to review the marks and grade of an examination paper. It therefore considered whether special reasons provided a legal basis for not remitting the case to the Examination Board (cf. Art. 12 Additional Rules of Procedure of the DBA, Supplementary publication 1, OJ 2014, 54). Only in a few exceptional cases had the DBA found such special reasons (**D 5/86**, **D 11/91**, **D 8/08** and **D 9/08**), but in appeals against decisions of the Examination Board it had not made use of this power to review the contested decision on its merits (on the limits of the board's power see **D 7/05**). However, the pre-examination was a multiple choice paper. The marks were awarded according to a strict scheme not involving any discretion and the award of a "pass" or "fail" was merely the arithmetical outcome of the marks achieved. From a limited review, the board was able to establish the correct marks on the basis of the appellant's answer paper without interfering with any value judgment of the Examination Committee or Examination Board. Also taken into account were the matter's urgency, since a "pass" in the pre-examination was a precondition for the main examination, and the fact that the Examining Board, by not rectifying its decision, even though the discrepancy had been comprehensively substantiated, had burdened the appellant with appeal proceedings. With the correction, the total marks rose from 68 to 70 and a "pass" was therefore awarded.

#### 2.6.4 Legitimate interest

According to the established case law, a candidate who appealed against failing the EQE but resat and passed it before the appeal had been decided still retained a legitimate interest in pursuing the appeal. This was confirmed in **D 3/98**. Any other view would amount to denying him recourse to the law; legitimate interest would then depend on how long proceedings took. However, appellants could exert little influence over that, and should therefore not have to suffer the consequences. Whether there was a legitimate interest was to be determined with reference to the date the proceedings were initiated (in this case, on the day the appeal was filed).

## 2.6.5 Complaints about the conduct of the examination - duties of the Examination Board

In several decisions, the DBA pointed out that, under point 7 of the former Instructions to candidates (OJ 1995, 145) and point 7 of the former Instructions to invigilators (OJ 1995, 153), a timely and formally correct complaint about the conduct of the examination was to be submitted to the Examination Board, which was then supposed to issue a provisional opinion, together with an invitation to comment. Failure to do so put it in breach of generally recognised principles of procedural law (Art. 125 EPC), notably the right to be heard (Art. 113(1) EPC; see **D 17/96**, **D 2/97**, **D 2/99** and **D 3/99**).

The corresponding provisions of R. 19(3) and (4) IPREE were considered in case **D 3/10**, in which the appellant had raised a complaint about disturbances during the examination only with the appeal. The DBA held that it would be inadmissible to examine the alleged disturbances in the context of an appeal without any prior decision of the Examination Board in this regard. By not submitting a complaint immediately after the examination, as foreseen by R. 19(3) IPREE, the appellant had deprived the Examination Board of the opportunity to determine the exact circumstances involved and to react accordingly, if necessary with a decision pursuant to R. 19(4) IPREE, or to deal with the allegations in its decision on the result of the examination under Art. 6(5) REE (cf. **D 3/04**).

## 3. Disciplinary matters

The Regulation on Discipline for Professional Representatives (RDR) of 21.10.1977 (OJ 1978, 91), adopted by the Administrative Council in accordance with Art. 134(8)(c) EPC 1973 and amended by AC Decision of 14.12.2007 in accordance with Art. 134a(1)(c) EPC (OJ 2008, 14; also in Supplementary publication - OJ 1 of each year), contains not only provisions on general professional obligations, professional secrecy and conduct towards clients but also provisions relating to the disciplinary bodies responsible for imposing disciplinary measures (see also Additional Rules of Procedure of the Disciplinary Committee and of the Disciplinary Board, OJ 1980, 176, and 177 and 183, respectively; for amendments see OJ 2007, 552; Additional Rules of Procedure of the Disciplinary Board of Appeal, OJ 1980, 176 and 188; for amendments see OJ 2007, 548; for consolidated version, see Supplementary publication to OJ 1 of each year).

### 3.1. Disciplinary measures

According to **D 5/86** (OJ 1989, 210), an infringement of the rules of professional conduct must be established to the satisfaction of the disciplinary body before it can impose a disciplinary measure. Absolute certainty is not required, but a degree of probability which in human experience verges on certainty. A disciplinary measure cannot be imposed if there is reasonable doubt as to whether the infringement has occurred.

In **D 11/91** (OJ 1995, 721) the EPO Disciplinary Board had ordered the deletion of the appellant from the list of professional representatives for an indefinite period. In his appeal, the appellant contested the disciplinary measure and held that the procedure

before the DBA did not comply with the provisions of the European Convention for the Protection of Human Rights, in particular because the DBA had been established not by national law but by the Administrative Council of the EPO, the disciplinary bodies did not constitute an independent court, the DBA was not a national authority, and its decisions could not be referred to a higher court of appeal.

The DBA decided that the European Convention for the Protection of Human Rights contained provisions which expressed general principles of law common to the member states of the EPO. As such these provisions should be considered part of the legal system of this Organisation and should be observed by all its departments. This therefore applied to Art. 13 ECHR, which guaranteed the protection by the judiciary of the rights of the individual. The "national authority" mentioned in this article was clearly meant to be understood as a competent authority in accordance with the law of the state concerned. However, in ratifying the Munich Convention, the contracting states accepted a transfer of prerogatives whereby professional representatives before the EPO became subject to the same set of professional regulations, controlled by a central body whose decisions were open to effective remedy before a body of second instance whose independence was guaranteed by the rules governing its composition. The drafting of these regulations and the establishment of these bodies was thus consistent with general principles of law, in particular those enshrined in the European Convention for the Protection of Human Rights.

The board took the view that, in order to ensure that the penalty was proportionate to the seriousness of the charges and that the maxim whereby penalties should not be arbitrary but fixed or predetermined was respected, Art. 4(1)(e) RDR should be understood as meaning "for a period not defined by the text", that is for a discretionary period to be decided by the competent disciplinary body. In its decision, the latter should fix the said period and give reasons for its choice.

In **D 20/99** (OJ 2002, 19), appellant X filed an appeal against the EPO Disciplinary Board's decision to issue him with a reprimand. The DBA, reviewing the penalty imposed in respect of the first charge only, held that X's actions, for which he had been prosecuted in France, were in breach of Art. 1(1) and (2) RDR. It was clear that D had been involved in drawing up European patent applications in consultancy L, owned by the appellant, while being paid by company P. However, it was evident from the file that this contractual arrangement had never been the subject of invoicing.

That gave an advantage to consultancy L by cutting the cost of drawing up patent applications. As it inevitably entailed unfair distortion of competition in relation to other European patent attorneys, this was an undue advantage. The board concluded that the misuse of corporate assets was tantamount to unfair competition in relation to fellow European patent attorneys and thus represented a breach of the rules of professional conduct governing representatives before the EPO.

### **3.2. Appealability of decisions in disciplinary matters**

In **D 15/95** (OJ 1998, 297) the board ruled that a Disciplinary Committee decision dismissing a complaint was a decision in the legal sense only as regards the persons referred to in Art. 8(2) RDR, and only they could appeal against it. Thus the person who made the complaint had no right of appeal. Review on appeal was limited to safeguarding the rights of the "accused", i.e. the "professional representative concerned" within the meaning of the RDR (see also **D 1/98**). In **D 28/97** and **D 24/99** the DBA added that the purpose of disciplinary proceedings was not for individuals to pursue their interests vis-à-vis others (although these might be affected in individual cases) but rather to serve the public interest in orderly and proper exercise of professional representation before the EPO. Any claims by individuals arising from a representative's infringement of the rules of professional conduct were exclusively a matter for the competent (civil) courts (see also **D 25/05** and **D 3/13**).

## **4. Code of Professional Conduct**

The general principles are laid down in the current version (OJ 2003, 523; also published in Supplement to OJ 1 of each year). Point 1(a) of the Code refers in turn, as regards the general requirements for *epi* members, to the RDR (OJ 1978, 91, also OJ 2008, 14; also published in Supplementary publication - OJ 1 of each year).

### **4.1. General professional obligations**

In **D 16/95** the board ruled that, although drafting and filing translations and paying fees in the national phase in a contracting state were not directly related to grant, opposition or appeal proceedings, such activities were still covered by Art. 1 RDR. They were, after all, activities in connection with a European patent (see Art. 65 and 141 EPC 1973) and as such part of a professional representative's job. Regarding them as covered by Art. 1 RDR was also justified by the fact that it was difficult for outsiders (e.g. persons commissioned to translate patent specifications) to distinguish between those of a representative's activities which were directly related to grant, opposition or appeal proceedings and those which were not. Since national-phase-related activities were thus covered by Art. 1 RDR, reprehensible conduct in connection with them constituted a breach of a representative's general professional obligations under that provision (see also **D 25/05**).

### **4.2. Professional secrecy**

In **D 11/91** (OJ 1994, 401), the appellant had requested the removal of various documents placed on file by the complainant. The appellant argued that his request was justified because, inter alia, their inclusion contravened the rule of confidentiality to which professional representatives were subject. The documents were items of correspondence between the complainant and the disciplinary bodies and correspondence pertaining to an opposition case.

The board decided that the professional secrecy referred to in Art. 2 RDR set limits on the disciplinary bodies' powers of investigation and on the obligation under Art. 18 RDR for a professional representative before the EPO to supply all relevant information. However, the mere obligation of confidentiality deriving from the principle enshrined in Part I RDR could not be invoked to resist a request under Art. 18 RDR.

#### **4.3. Advertising**

The adoption of the Code of Conduct (current version, OJ 2003, 523; also published in Supplementary publication – OJ 1 of each year) entailed the rescindment of the ban contained in point 2(b)(1) on the comparison of the professional services of a member with those of another member, as laid down in the version published in OJ 1999, 537.

The original advertising ban had already been replaced in the previous version (OJ 1999, 537) by the new provision point 2(a), which states that advertising is generally permitted provided that it is true and objective.

#### **5. Appeals against decisions of the Disciplinary Board of Appeal**

In **D 5/82** (OJ 1983, 175) the DBA already noted that it has no power to refer questions to the Enlarged Board of Appeal. In **D 7/05** of 2.1.2007 and **D 2/06** of 31.8.2006 the DBA had to consider requests seeking a review of its final decisions. The board stated that decisions of the boards of appeal and the DBA became final when issued, and were no longer subject to appeal, nor could they be set aside by the board itself. It refused the requests as inadmissible, with reference to the principles set out by the Enlarged Board of Appeal in **G 1/97** (OJ 2000, 322), according to which the decision on inadmissibility is to be issued by the board of appeal which took the decision forming the subject of the request for revision. The decision on the request could be issued immediately and without further procedural formalities.





## VI. THE EPO ACTING AS A PCT AUTHORITY - EURO-PCT APPLICATIONS

1.	Introduction	1265
2.	Jurisdiction of the boards of appeal	1265
3.	Competence of the EPO acting as designated or elected Office	1266
4.	Language of the proceedings	1268

### 1. Introduction

The EPC provisions governing "international applications filed under the Patent Cooperation Treaty - Euro-PCT applications" are contained in Part X of the Convention (Art. 150 to 153 EPC) and Part IX of the Implementing Regulations (R. 157 to 165 EPC). Pursuant to Art. 150(2) EPC, international applications filed under the PCT may be the subject of proceedings before the EPO. In such proceedings, the provisions of the PCT and its Regulations apply, supplemented by the provisions of the EPC. In case of conflict, the provisions of the PCT or its Regulations prevail. An international application for which the EPO is a designated Office (or, optionally, an elected Office), and which has been accorded an international filing date, is equivalent to a regular European application ("Euro-PCT application", Art. 153(2) EPC).

The Guidelines for Search and Examination at the EPO as PCT authority (November 2015 edition) set out the practice and procedures to be followed for international applications before the EPO in the course of the international phase, while Chapter E-VIII of the Guidelines for Examination in the EPO (November 2015 edition) focuses on aspects particular to the handling of Euro-PCT applications in the European phase. Reference is also made to the comprehensive overview in the current "Euro-PCT Guide: PCT procedure at the EPO", Part A of which lists relevant official texts and further important sources of information.

### 2. Jurisdiction of the boards of appeal

The PCT does not expressly provide for appeal or petition during the international phase (cf. WIPO PCT Applicant's Guide – International Phase, para. 6.054). The sole exception under the EPC 1973 was the boards' competence to decide on protests against additional search or examination fees charged by the EPO acting as ISA (Art. 17(3)(a) PCT and Art. 154(3) EPC 1973) or IPEA (Art. 34(3)(a) PCT and Art. 155(3) EPC 1973) after a finding of lack of unity of invention. Thus, in **J 24/99** the Legal Board of Appeal confirmed that, apart from protest cases for which the boards' responsibility explicitly derived from Art. 154(3) and 155(3) EPC 1973, the jurisdiction of the boards was limited by the EPC, in particular Art. 21 and 106 EPC, which do not confer any jurisdiction on them to review actions taken by the EPO as IPEA (see also **J 15/91**, OJ 1994, 296).

Once the Euro-PCT application enters the regional phase before the EPO the appeal procedures provided for under the EPC supplement the provisions of the PCT (**J 20/89**, OJ 1991, 375; see also in this chapter VI.3.).

Board of Appeal decisions on protests according to the former procedure are to be found in Chapter II.B. "Unity of Invention". The current protest procedure under R. 158(3) EPC and preceding interim procedure are referred to in chapter II.B.1.

### 3. Competence of the EPO acting as designated or elected Office

In **J 26/87** (OJ 1989, 329) the board held that if, on the proper interpretation of the request for grant of an international application, an applicant designated an EPC contracting state for which the PCT was in force on the filing date of the international application, the EPO was bound by the provisions of Art. 153 EPC 1973 to act as the designated Office for that contracting state, even if the international application was published by the International Bureau without mentioning that contracting state as a designated state.

**J 19/93** also concerned the designation of EPC contracting states in an international application for the purpose of obtaining a European patent. The board pointed out that the EPO as elected or designated Office is fully competent to interpret applications appointing it to act in these capacities. The Office is not bound by the interpretation of the receiving Office or of the International Bureau (see also **J 4/94**, **J 26/87**).

In **J 7/93** the International Bureau did not inform the EPO of its election (in the demand for international preliminary examination) within the 21-month time limit under R. 104b(1) EPC 1973 (version valid prior to 1.3.2000). The EPO issued a communication pursuant to the then applicable R. 85a EPC 1973 concerning the grace period for late payment of the fees upon entry into the European phase and then a notification of loss of rights pursuant to R. 69(1) EPC 1973. The board pointed out that both referred to the 21-month period under R. 104b(1) EPC 1973, although, in the circumstances, the 31-month period was applicable. They were considered to be legally non-existent because they could not be based on any provision contained in the EPC or in the PCT. These communications, being legally non-existent, could not have any legal effect to the party's detriment.

In the PCT request in case **J 3/94** the applicant had **designated** a European patent under "Regional Patent" and five PCT contracting states including Germany and the United Kingdom under "National Patent". However, in the demand for international preliminary examination, filed with the EPO as IPEA, only the five PCT member states were **elected**; under "Regional Patent" there was no cross indicating the European patent. The applicant argued inter alia that the election of DE and GB made the EPO an elected Office by operation of law. However, the board held that the EPO did not become an elected Office in this case. One of the principles implemented by Art. 31(4)(a) PCT was that it was the applicant's choice for which office he intended to use the results of the international preliminary examination. Furthermore, it was not only a matter for the EPC to decide whether an election made for the national route was also valid for the

EPO. The validity of an election had to be decided during the international phase in order to give effect to the election. The IPEA had to examine the demand and the international authorities had to fulfil their obligations resulting from a valid election. The validity and scope of an election had to be clear not only for the applicant and the elected Office but also for the Authorities in the international phase. Its validity had to be assessed on a uniform basis by the Authorities concerned.

In **J 4/94** the board had to consider whether the EPO was competent to interpret the applicant's demand for international preliminary examination differently from the United Kingdom Patent Office acting as IPEA. The board conceded that the demand was addressed to the IPEA, the competent body to deal with it. However, **J 26/87** (OJ 1989, 329) had decided that the interpretation of the request for grant form by the receiving Office and the International Bureau was not binding on the EPO in its function as designated Office. The valid designation put the matter within the competence of the EPO as designated Office (Art. 2(xiii) PCT and Art. 153(1) EPC 1973). In the present case there was a defect in the demand, which the applicant should have been invited under R. 60 PCT to correct. A clear deviation by the IPEA from the intention expressed in the demand was not binding on the EPO. It was therefore possible for the EPO to regard itself as a validly elected Office. Consequently, under R. 104b(1) EPC 1973 (as in force prior to 1.3.2000) the time limit of 31 months applied.

A decision of an **examining division** of 5.6.1984 (OJ 1984, 565) pursuant to Art. 153(2) EPC 1973 (see now R. 159(2) EPC) in conjunction with Art. 25 PCT and Art. 24(2) PCT concerned the authority of a designated Office under Art. 24(2) PCT to maintain the effect of an international application. The applicant had missed the time limit for filing the representative's authorisation set by the Japanese Patent Office acting as receiving Office. The EPO, acting as designated Office, excused the non-observance of time limits which had been set by the receiving Office for the correction of formal deficiencies in accordance with Art. 14(1)(b) PCT in conjunction with R. 26.2 PCT (Art. 24(2) and 48(2)(a) PCT). The examining division found that the time limit under R. 26.2 PCT was comparable to time limits set by the EPO under Art. 121 EPC 1973 and granted re-establishment of rights according to Art. 122 EPC 1973 in respect of the time limit under Art. 121(2) EPC 1973.

**J 17/99** also concerned the application of Art. 24(2) PCT. The formerly applicable precautionary designation of EP in the international application was not confirmed within the prescribed period and was therefore regarded as withdrawn (former R. 4.9(b)(ii), (c) PCT, and Art. 24(1)(i) PCT), with the consequence that the effect of the international application under Art. 11(3) PCT - i.e. that of a European filing - ended on the same date. The board declined to exercise its discretion under Art. 24(2) PCT to maintain the effect provided for under Art. 11(3) PCT: when exercising that discretion as designated Office, the EPO had to apply the same rules and principles as for identical or comparable situations arising with direct European applications (here concerning correction of designations). This non-discriminatory approach was not only a fundamental principle of the PCT itself (see, for example, Art. 26 and 48(2)(a) PCT) but also a direct consequence of Art. 150(3) EPC 1973 (see now Art. 153(2) EPC; see also **J 3/81**, OJ 1982, 100; **J 8/01**, OJ 2003, 3).

The appeal in **J 3/00** concerned the question whether the Receiving Section should have rectified, under R. 82ter PCT, a purported error of the RO/EPO for the purposes of the regional phase before the EPO. The international application had been filed two days before expiry of the priority period with the description and claims in Swedish by mistake. The RO/EPO accorded as the international filing date the day of receipt of the corrected, i.e. English-language, documents (Art. 11(2)(b) PCT) and furthermore cancelled the priority claim. The applicant argued that the RO/EPO should have warned it of the deficiency. The board examined whether the filing date of the international application was incorrect due to an error made by the RO/EPO which was such that, had it been made by the EPO (as designated Office) itself, it would have to be rectified under the EPC (R. 82ter PCT). Thus, according to the constant jurisprudence of the boards of appeal concerning the protection of legitimate expectations, as confirmed in **G 2/97** (OJ 1999, 123), the EPO was required to warn the applicant of any loss of rights if such a warning could be expected in all good faith. The board found the relevant conditions to be met: the deficiency was immediately identifiable on the face of the application in the course of the Art. 11(1) PCT check and the applicant was in a position to correct it at very short notice. For a further case relating to R. 82ter PCT, see **J 10/04**.

In case **T 506/08** the EPO, acting as ISA, had issued a declaration of non-establishment of the ISR under Art. 17(2)(a) PCT. The examining division did not carry out a further search on the amended application, which it subsequently refused for lack of inventive step. At the appeal stage the applicant filed a request for a (partial) refund of the international search fee. However, the board declined jurisdiction to deal with the request. The guarantee of due process of law (cf. **G 3/08**, OJ 2011, 10), as invoked by the appellant, did not mean that each and every claim against the EPO was a matter for the boards (e.g. **J 14/87**, OJ 1988, 295; with reference to Art. 9 EPC 1973). Neither the PCT nor the Agreement between the European Patent Organisation and WIPO of 31 October 2001 provided for a refund in such a case.

#### **4. Language of the proceedings**

In decision **G 4/08** (OJ 2010, 572), the Enlarged Board of Appeal ruled on the first referred question that if an international application has been filed and published under the PCT in one official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into one of the other two EPO official languages, which would then become the language of the proceedings. Neither the EPC 1973 nor the EPC 2000 can be interpreted as allowing that. Nor is there any conflict between EPC and PCT provisions. On the second question, the Enlarged Board decided that EPO departments cannot use, in written proceedings on a European patent application or an international application in the regional phase, an EPO official language other than the language of proceedings used for the application under Art. 14(3) EPC.

## VII. INSTITUTIONAL MATTERS

1.	Legal status of the EPO boards of appeal	1269
1.1.	The judiciary of the European Patent Organisation	1269
1.2.	Boards of appeal as judicial authorities	1270
1.2.1	Courts of law under the EPC	1270
1.2.2	Tribunals under Article 6 of the European Convention on Human Rights	1270
1.2.3	Judicial or quasi-judicial authorities under the TRIPS Agreement	1271
1.2.4	Courts according to national case law	1272
1.3.	Not a court or tribunal of an EU Member State	1272
1.4.	Power to amend the RPBA under Article 23(4) EPC	1273
1.5.	Nature of the case law of the boards of appeal – no binding precedents	1274
2.	Extension agreements and ordinances	1274
2.1.	Legal nature	1274
2.2.	No jurisdiction of the boards of appeal	1275
2.3.	Non-applicability of Article 105(1)(a) EPC	1276
3.	Administrative agreements under Article 10(2)(a) EPC	1276

### 1. Legal status of the EPO boards of appeal

#### 1.1. The judiciary of the European Patent Organisation

In **G 3/08** (OJ 2011, 10) the Enlarged Board held that the European Patent Organisation is an international, intergovernmental organisation, based on the separation of powers principle, which the sovereign contracting states have entrusted with the exercise of some of their national powers in the field of patents. The EPC assigns executive power to the Office to grant patents and to its President to manage the Office in organisational respects (Art. 4(3) and 10 EPC), while to the Administrative Council it assigns limited legislative powers restricted to lower-ranking rules (Art. 33 EPC), along with financial and supervisory powers. The boards of appeal, which in their decisions are bound only by the EPC (Art. 23(3) EPC), are assigned the role of an independent judiciary in this patent system (Art. 21 to 23 EPC; see also **G 6/95**, OJ 1996, 649, points 2ff of the Reasons), even if for the present they are not an independent organ of the Organisation (Art. 4(2) EPC) but structurally integrated departments of the Office (Art. 15 EPC; see also **R 19/12** of 25 April 2014 and **R 2/14** of 17 February 2015). Like the judiciary of any democratic entity based on the separation of powers principle, the boards of appeal guarantee the due process of law within the Organisation. They are also assigned interpretative supremacy with regard to the EPC in terms of its scope of application (see Art. 23(3) EPC). Under Art. 21(1) EPC they are responsible for reviewing decisions taken by the Office in grant and opposition proceedings. Their interpretation of the EPC is the basis for the practice established by the Office for the examination of patent applications and oppositions to granted patents.

## 1.2. Boards of appeal as judicial authorities

### 1.2.1 Courts of law under the EPC

In **G 1/86** the Enlarged Board held that those EPC provisions governing the independence of members of the boards of appeal (Art. 23 EPC), their competence and method of work and the nature of the decisions they take, indicate that the boards act as courts with the task of ensuring that the law is respected when the EPC is applied. Moreover, there is no appeal against decisions of the boards. In the member states of the European Patent Organisation decisions by departments of last instance, i.e. those terminating proceedings concerned with checking the legality of administrative actions and the protection of the rights of the individual, can only be taken by courts of law.

In **T 1400/11** the board stated that according to the Enlarged Board in **G 7/91** and **G 8/91** (OJ 1993, 356, 346, point 7 of the Reasons), **G 9/91** and **G 10/91** (OJ 1993, 408, 420, point 18 of the Reasons) and **G 1/99** (OJ 2001, 381, point 6.6 of the Reasons), the appeal procedure is to be considered as a judicial procedure proper to an administrative court. See also Chapter IV.E.1 "Legal character of the appeal procedure". In **G 2301/15** the Enlarged Board stated that the board members' function as judges was generally recognised.

### 1.2.2 Tribunals under Article 6 of the European Convention on Human Rights

According to the first sentence of Art. 6(1) of the European Convention on Human Rights (ECHR), "[i]n the determination of his civil rights and obligations ... everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law."

In **R 8/13** of 20 March 2015 the Enlarged Board of Appeal stated that it was established case law of the Enlarged Board (**R 2/14** of 17 February 2015: and of the boards of appeal) that the EPC, which had been signed by contracting parties to the ECHR, must be applied in a way which supports the fundamental principles of Art. 6(1) ECHR (**G 1/05**, OJ 2007, 362, point 22 of the Reasons; **G 2/08** of 15 June 2009, point 3.3 of the Reasons). It further stated that the Enlarged Board fell within the definition laid down by the European Court of Human Rights (hereinafter "ECtHR") in *Campbell and Fell v. the United Kingdom* (28 June 1984, No 7819/77, paragraph 76): "the word 'Tribunal' in Article 6 paragraph 1 is not necessarily to be understood as signifying a court of law of the classic kind, integrated within the standard judicial machinery of the country". A tribunal may also be set up to deal with specific subject-matter which can be appropriately administered outside the ordinary court system. What is important, to ensure compliance with Art. 6(1) ECHR, are the guarantees, both substantive and procedural, which are in place (ECtHR, *Rolf Gustafson v. Sweden*, 1 July 1997, No. 23196/94, paragraph 45).

### 1.2.3 Judicial or quasi-judicial authorities under the TRIPS Agreement

As to the applicability of the TRIPS Agreement in proceedings before the EPO, see Chapter III.H.2 "Interpretation of the EPC affected by TRIPS Agreement".

Art. 62(5) TRIPS provides that final administrative decisions in procedures concerning the acquisition or maintenance of intellectual property rights and, where a member's law provides for such procedures, administrative revocation and inter partes procedures such as opposition, revocation and cancellation, must be subject to review by a **judicial or quasi-judicial** authority. Art. 32 TRIPS requires member countries to provide an opportunity for **judicial** review of any decision to revoke or forfeit a patent.

In **G 1/97** (OJ 2000, 322) the Enlarged Board of Appeal noted that boards of appeal may be seen as having the status of judicial authorities, since they embody all the features of such an authority: in their decisions, the members of the boards are not bound by any instructions and are obliged to comply only with the provisions of the EPC (Art. 23(3) EPC 1973; see also **R 19/12**, where the Enlarged Board stressed that the Service Regulations for EPO employees provide in Art. 1(4) that they only apply to board members in so far as they are not prejudicial to their independence); they are appointed for a fixed term, during which they may not be removed from office except if there are serious grounds for so doing (Art. 23(1) EPC 1973); the EPC contains provisions for safeguarding the impartiality of board members (Art. 24 EPC 1973); the boards always include at least one legally qualified member (Art. 21 EPC 1973); they have their own rules of procedure; and finally, they issue written decisions containing a statement of reasons (R. 66(2) EPC 1973). Regarding the judicial nature of the boards of appeal, reference was also made to the House of Lords' decision of 26 October 1995 in *Merrel Dow v. Norton*, [1996] R.P.C. 76, and to the decision of the United Kingdom High Court of Justice dated 20 December 1996, in the case of *Lenzing AG's European Patent (UK)*, [1997] R.P.C., 245). Even if the status of a judicial authority were to be contested, it would be clear that, in the light of the foregoing, the boards of appeal constitute at least a quasi-judicial authority as referred to in Art. 62(5) TRIPS. The Enlarged Board also examined the relationship between Art. 62(5) TRIPS and Art. 32 TRIPS. Art. 32 appears in Part II of TRIPS, which does not contain rules of procedure concerning the acquisition of patent rights but provisions concerning the exercise of rights conferred by a patent, together with certain rules on substantive patent law. By contrast, Part IV of TRIPS, containing Art. 62 as its sole provision, deals with the acquisition and maintenance of intellectual property rights, which include patent rights. Applying the principle of *lex specialis derogat legi generali*, the Enlarged Board held that this aspect was much more specific than the fact that Art. 32 TRIPS only concerns patents whereas Art. 62 TRIPS also deals with other types of intellectual property rights. The Enlarged Board concluded that Art. 62(5) TRIPS takes precedence over Art. 32 TRIPS in matters relating to the grant of European patents (see also **J 3/98**).

In **T 557/94** the appellant (patentee) referred to Art. 32 TRIPS, which guarantees an opportunity for judicial review of any decision to revoke a patent, and requested that the case be remitted to the department of first instance if the patent were revoked on the basis of a prior art document introduced during appeal proceedings. The board

investigated whether the basic principle of judicial review under Art. 32 TRIPS was satisfied by the EPC 1973. It found that, under Art. 111(1), second sentence, EPC 1973, the board of appeal was empowered either to decide on the merits of the case **or** to remit the case; it was not restricted to the latter alternative if the opposition division maintained the patent and the board was considering revoking the patent for the first time (see Chapter IV.E.7. "Remittal to the department of first instance"). Reading Art. 32 TRIPS in the context of the usual structure of judicial review in the EPC contracting states and the EPC 1973 itself, this provision guaranteed an instance for judicial review in revocation proceedings, but did not oblige the reviewing instance to remit the case to the department of first instance for continuation of proceedings when revocation was being considered by the judicial instance for the first time.

#### 1.2.4 Courts according to national case law

In **R 1/10** the Enlarged Board of Appeal confirmed that the EPO boards of appeal were set up as required by the rule of law. Several high-ranking national courts of EPC contracting states (in particular, the UK's Patents Court and Germany's Federal Court of Justice (Bundesgerichtshof) and Federal Constitutional Court (Bundesverfassungsgericht)) had declared the boards of appeal to be independent courts based on the rule of law (see also **R 19/12** of 25 April 2014) and recognised their decisions as those of such a court which they took into consideration when developing their case law.

In **J 3/95** (OJ 1997, 493) the Legal Board of Appeal stated that the status of the boards of appeal had been addressed by the High Court of Justice in the United Kingdom (Patents Court) in *R. v The Comptroller of Patents, Designs and Trade Marks ex parte Lenzing AG*. The High Court held that "the final arbiter of revocation under the new legal system [of the EPC] is to be the Board of Appeal of the EPO", and that "the UK and the other Member States have agreed at an international level via the EPC that the BoA is the final arbiter of oppositions. It is the agreed EPO equivalent of the House of Lords, Cour de Cassation or Bundesgerichtshof... Those who apply for patents in the EPO must accept the results of its findings and its methods of procedure". This decision also acknowledged that the boards of appeal constitute a specialised court exercising judicial authority within the meaning of Art. 32 TRIPS (see in this chapter VII.1.2.3).

#### 1.3. Not a court or tribunal of an EU Member State

In **T 276/99** the board noted that under the EC Treaty referrals to the Court of Justice of the European Communities (now Court of Justice of the European Union) were governed by Art. 234 ECT (now Art. 267 TFEU). The board pointed out that, *prima facie*, as the EPO boards of appeal were not a court or tribunal of an EU Member State, they did not have the status to refer a question to the Court of Justice of the European Communities.

The German Constitutional Court's decision of 4 April 2001 (2 BvR 2368/99, published in GRUR 2001, 728 - 730) referred to the delegation of powers to the EPO directly by the EPC contracting states who were also members of the EU, and not to any delegation from the EU itself. Since the European Patent Organisation was not part of the European



Union institutions, and since the delegation of powers by the non-EU contracting states was to the EPO but not to the European Union or its institutions, there was no obvious basis for referring a question to the Court of Justice of the European Communities from an EPO board of appeal.

In **G 2/06** (OJ 2009, 306) the appellant had requested a referral of questions to the Court of Justice of the European Union (CJEU) on the argument that, since R. 28(c) EPC repeats the wording of Art. 6(2)(c) of Directive 98/44/EC, the Enlarged Board of Appeal in interpreting R. 28(c) EPC was interpreting European Union law. The request was rejected as inadmissible. The Enlarged Board made it clear that neither the EPC nor the Implementing Regulations thereto contain any provision for a referral by any instance of the EPO of questions of law to the CJEU. The boards of appeal are a creation of the EPC, and their powers are limited to those given in the EPC. Art. 234 of the EC Treaty gives the CJEU jurisdiction to give preliminary rulings concerning the interpretation of acts of the institutions of the European Community, such as the Directive, but does not appear to provide any basis for a board of appeal of the EPO to request the CJEU to give a ruling on any questions before a board of appeal. Art. 234 ECT requires the question to be raised in a case pending before a court or tribunal of an EU member state. Whereas EPO boards of appeal have been recognised as courts or tribunals, they are not courts or tribunals of an EU member state but of an international organization whose contracting states are not all members of the EU. The seat of the boards of appeal in an EU member state, Germany, could not alter their status as part of an international organisation with jurisdiction conferred under the EPC. The boards of appeal are not and have never been treated as courts or tribunals of their host country.

In **R 1/10**, the Enlarged Board held that not even a CJEU finding that the boards of appeal lacked the independence required of a judicial body adhering to the rule of law (see opinion of the Advocate-General of 2 July 2010 and CJEU opinion of 8 March 2011 in Case 1/09) would be binding on the boards. The European Patent Organisation was an autonomous subject of international law and inherently independent of the EU.

#### **1.4. Power to amend the RPBA under Article 23(4) EPC**

The Rules of Procedure of the Boards of Appeal (RPBA) and of the Enlarged Board of Appeal (RPEBA) are adopted in accordance with the Implementing Regulations and subject to the approval of the Administrative Council (Art. 23(4) EPC; see OJ 2007, 536 and OJ 2007, 303). According to R. 12(3) EPC the Presidium of the Boards of Appeal adopts the RPBA. Pursuant to R. 13(2) EPC the members of the Enlarged Board of Appeal adopt the RPEBA. In **T 1400/11** the board stated that proceedings before the boards of appeal are governed by the RPBA in order to guarantee their judicial function.

In 1994 the Administrative Council adopted R. 71a EPC 1973 to the effect that a communication must be issued by the EPO at the same time as a summons to oral proceedings is issued (OJ 1995, 409). In contrast to this requirement, Art. 11(2) RPBA 1980 (Art. 15(1) RPBA 2007) leaves it to the discretion of the boards of appeal whether or not to send a communication with such a summons. In **G 6/95** (OJ 1996, 649) the Enlarged Board held that R. 71a(1) EPC 1973 did not apply to the boards of appeal. The

Enlarged Board pointed out that Art. 23(4) EPC 1973 states that the RPBA "shall be adopted in accordance with the provisions of the Implementing Regulations". In the view of the Enlarged Board this was clearly directed to the mechanism set out in R. 11 EPC 1973, which states that the authority referred to in R. 10(2) EPC 1973 (the "Presidium") "shall adopt" the RPBA. The Enlarged Board concluded that the power under Art. 23(4) EPC 1973 to amend the RPBA belonged to the Presidium of the boards of appeal, subject to the approval of the Administrative Council. The Enlarged Board further stated that, according to Art. 33(1)(b) EPC 1973, the Administrative Council was competent to amend the Implementing Regulations. However, the Administrative Council was not entitled to amend the Implementing Regulations in such a way that the effect of an amended rule would be in conflict with the EPC 1973 itself (Art. 164(2) EPC 1973). If R. 71a(1) EPC 1973 were to be interpreted as applying to all departments of the EPO, including the boards of appeal, its effect would be directly contradictory to and in conflict with the effect of Art. 11(2) RPBA 1980, which was adopted pursuant to Art. 23(4) EPC 1973 as the emanation of the independence of the boards of appeal. The Administrative Council must be presumed to know the limits of its own power. It was therefore reasonable to assume that the Administrative Council did not intend to amend R. 71 EPC 1973 so as to provide a conflict with a rule of procedure of the boards of appeal which it had itself previously approved.

### **1.5. Nature of the case law of the boards of appeal – no binding precedents**

In **R 14/11** the Enlarged Board stated that, like any other decisions of boards of appeal, its decisions in petition for review cases do not have the legal nature of creating a precedent in the sense that it would have to show in which respect a later decision differs from an earlier one in order for that later decision to be legally justified. Referring to **R 11/08** the Enlarged Board stated that such differences are normal and that the usefulness of case law is not confined to similar or identical facts but lies in the principles or guidance (such as interpretation of legislative provisions) which, whether the facts are similar or not, can be extracted from earlier cases.

## **2. Extension agreements and ordinances**

### **2.1. Legal nature**

An extension agreement is an international treaty between the European Patent Organisation and an extension state which the President of the EPO is authorised by the Administrative Council to conclude with the Council's approval (Art. 33(4) EPC). Such an agreement serves the interests not only of applicants, by providing a simple route to patent protection in the extension states, but also those of the extension state, by enabling it to offer patent protection for its territory by extending the effects of European and Euro-PCT applications and patents (**J 9/04**; see also **J 14/00**, OJ 2002, 432).

In **T 7/07** the board stated that the extension system largely corresponds to the EPC system operating in the EPC contracting states, except that it is not based on direct application of the EPC but on national law modelled on the EPC. The national law of the extension state governs the proceedings and the legal effects of the extension.

In **J 9/04** the board noted that, as a bilateral ordinance, the Extension Ordinances essentially deal - exhaustively and strictly separately from the Convention - with matters pertaining to the integration of extended European applications and protective rights into the respective national law and their relationship to national applications and rights. This includes, in particular, the conferral of the same effects on extended applications and patents as on national ones, the obligation to provide the national patent offices with a translation of the claims into the respective language, the national authentic text of extended applications and patents, their prior-art effect with respect to national applications and patents, and, finally, simultaneous protection. According to the board, none of these provisions give rise to any obligations on the part of the EPO. The EPO merely undertakes vis-à-vis the national patent authorities to assist with the administrative tasks associated with the extension of European patents, namely receiving requests for extension, levying extension fees and, after deducting an amount to cover its expenses, forwarding the remaining amount to the national patent offices. There is no right of recourse to the boards of appeal in respect of extensions of patent applications and patents to the extension states. Instead, the respective national jurisdiction is responsible. For example, Art. 6(2) of the Slovenian Law provides for appeals against decisions of the Slovenian Patent Office (see also **J 2/05**).

## **2.2. No jurisdiction of the boards of appeal**

In **J 22/10** the board stated that decisions taken by the EPO when carrying out its obligations under the co-operation agreements with certain states extending the protection conferred by European patents (extension agreements) were based not on the EPC itself but solely on the co-operation agreements between the European Patent Organisation and the extension states; it therefore rejected the respective appeals as inadmissible (see also **J 14/00**, OJ 2002, 432; **J 19/00**; **J 9/04** of 1 March 2005; **J 2/05**; **J 4/05**). Any decisions based on such international treaties did not fall within the scope of the EPC and, as a result of this, were not subject to the jurisdiction of the boards of appeal. The extension agreements made it absolutely clear that references to provisions of the EPC were exhaustive and, thus, that there could be no corresponding application of other provisions, including those of Art. 106 EPC concerning the appeals procedure. In other words, the Legal Board of Appeal was not competent to decide a case that was governed solely by a "foreign" legal system.

In **J 14/00** (OJ 2002, 432) the Legal Board of Appeal decided on the admissibility of an appeal directed against a letter issued by an EPO formalities officer applying the Extension Ordinance (OJ 1994, 75) associated with the Extension Agreement with the Republic of Slovenia. It held that, according to the exhaustive provision in Art. 106(1) EPC 1973, only those decisions of the EPO could be contested which were taken, within the framework of their duties under the EPC 1973, by the departments listed therein. This was not the case for decisions taken by the EPO when carrying out its obligations under the Extension Agreement. The Legal Board found that there was nothing in the structure or legal nature of the Extension Ordinance to support the appealability of the letter issued by an EPO formalities officer. The board held that the extension procedure generated legal effects exclusively on the basis of Slovenian national law. The Extension Ordinance thus made it absolutely clear that its references

to provisions of the EPC 1973 were exhaustive and that there could be no application of other provisions, including those of Art. 106 EPC 1973 on the appeals procedure.

### **2.3. Non-applicability of Article 105(1)(a) EPC**

In **T 1196/08** an assumed infringer intervened under Art. 105(1)(a) EPC and claimed that the Romanian patent resulting from the extension of a European patent had to be seen as a European patent granted under the EPC. The board did not agree. The term "the same patent" in Art. 105(1)(a) EPC meant a European patent within the meaning of Art. 2(1) EPC 1973. While there were certain parallels between the extension system and the European patent system, fundamental differences still existed. The extension system, including all the conditions and legal effects of extension, was based exclusively on the application of national law unless express reference was made to the EPC. By contrast, the European patent system and the effects of a European patent in the contracting states relied solely on the direct application of the EPC, even if certain provisions of the EPC referred to national law. According to the board, the extension of a European patent under the national law of the extension state meant that the European patent had the effect of a national patent, while designation under Art. 79 EPC 1973 meant that the patent was granted by the EPO on the basis of the EPC and with effect for the designated contracting state. The board concluded that a patent extended to the territory of an extension state was not a European patent within the meaning of Art. 2(1) EPC 1973. Furthermore, the Romanian extension ordinance did not refer to Art. 105 EPC. The references in the Romanian extension ordinance to the provisions of the EPC being exhaustive, there could be no question of applying Art. 105 EPC by analogy.

### **3. Administrative agreements under Article 10(2)(a) EPC**

According to Art. 10(1) EPC the European Patent Office is managed by the President, who is responsible for its activities to the Administrative Council. To this end, Art. 10(2)(a) EPC empowers and requires the President to "take all necessary steps to ensure the functioning of the European Patent Office".

On 29 June 1981 the Presidents of the German Patent Office (GPO) and the EPO entered into an Administrative Agreement concerning the filing of documents and payments (OJ 1981, 381). In **G 5/88**, **G 7/88** and **G 8/88** (OJ 1991, 137) the Enlarged Board of Appeal considered the validity of this Administrative Agreement. The primary object and purpose of the agreement was to provide a mechanism whereby documents which are sent to the EPO, but delivered by error to the GPO (and vice versa), should be marked with the date of receipt at the wrong office and treated accordingly by the office for which they are intended.

The Enlarged Board noted that the extent of the power given to the President under Art. 10(2)(a) EPC to "take all necessary steps to ensure the functioning of the European Patent Office" was not capable of exact definition. In each case it had to be considered how far a particular step was necessary for ensuring the functioning of the EPO. So far as the agreement was concerned with the problem of incorrect delivery of documents in

Munich (at the EPO and the GPO premises there), the conclusion of the agreement was a necessary step in order to avoid unjustified loss of rights to parties, and thus to ensure the proper functioning of the EPO. However, as far as the EPO sub-office in Berlin was concerned, there had been no basis for such an agreement until 1 July 1989. Before that date the sub-office in Berlin had not been a filing office, nor had a letterbox been installed. As far as documents and payments which reached the EPO via the GPO's office in Berlin were concerned, the administrative agreement was therefore invalid. The Enlarged Board applied, however, the principle of good faith and the protection of the legitimate expectations of users of the EPO in favour of the opponent, who had filed a notice of opposition against a European patent via the GPO's Berlin office, relying on the agreement published in the Official Journal.

In **T 485/89** (OJ 1993, 214), the board held that a notice of opposition filed by fax at the GPO in Munich on the last day of the opposition period and forwarded to the EPO the next day was admissible; the opposition fee had already been paid some days earlier. Oppositions filed within the prescribed time by fax at the GPO in Munich while intended for the EPO were covered by the Administrative Agreement of 29 June 1981 and should be treated by the EPO as if it had received them directly, irrespective of whether or not they had been wrongly delivered.

Following talks between the Presidents of the German Patent and Trademark Office (GPTO, formerly the GPO) and the EPO, both offices agreed, in the interests of legal certainty, that the Administrative Agreement dated 29 June 1981 concerning procedure on receipt of documents and payments would, with effect from 1 September 2005, no longer be applied (OJ 2005, 444).



## TABLE OF CASES

In the table of cases, the bibliographic data of all cited decisions are listed according to the reference number, giving details of the relevant board and the date of the decision. Board of appeal decisions published in the OJ include a reference to the year and page number of publication.

### Decisions of the Disciplinary Board

D	1/81	04.02.82	1982, 258	1256
D	5/82	15.12.82	1983, 175	1218, 1263
D	6/82	24.02.83	1983, 337	625
D	7/82	15.12.82	1983, 185	727, 1218
D	8/82	24.02.83	1983, 378	760
D	4/86	08.06.87	1988, 26	1250
D	5/86	29.02.88	1989, 210	691, 1259, 1260
D	3/89	05.03.89	1991, 257	1256
D	5/89	22.05.89	1991, 218	1256
D	9/91	23.11.92		1218
D	11/91	14.09.94	1995, 721	711, 724, 1259, 1260, 1262
D	1/92	30.07.92	1993, 357	1256, 1257, 1259
D	6/92	13.05.92	1993, 361	1256, 1257
D	14/93	05.06.96	1997, 561	800, 804, 805, 1250
D	1/94	17.05.95	1996, 468	1252
D	5/94	15.11.95		1253, 1258
D	2/95	22.04.96		1252
D	14/95	19.12.95		1252, 1253
D	15/95	09.06.97	1998, 297	1262
D	16/95	29.03.98		1262
D	9/96	09.03.98		1252
D	14/96	21.01.97		1256
D	17/96	03.12.96		1260
D	20/96	22.07.98		1257
D	25/96	17.03.97	1998, 45	1251
D	2/97	16.03.98		1260
D	5/97	08.12.98		1253
D	10/97	08.12.98		1253
D	12/97	25.06.98		1255
D	15/97	08.12.98		1253, 1257
D	17/97	08.12.98		1253
D	28/97	04.09.98		1262
D	1/98	21.07.98		1262
D	3/98	05.11.01		1259
D	6/98	20.04.99		1253, 1257, 1258
D	2/99	07.09.00		1260
D	3/99	29.09.00		1260
D	4/99	29.06.00		1253, 1258
D	6/99	06.07.01		1254
D	11/99	17.11.99		1256
D	20/99	06.03.01	2002, 19	1261
D	24/99	14.05.01		1262
D	3/00	03.05.02	2003, 365	1257, 1258
D	9/00	12.12.00		1257
D	11/00	09.05.01		1252
D	12/00	27.03.02		1257, 1258
D	7/01	07.11.02		1257
D	11/01	04.07.02		1257
D	6/02	02.10.02		1257
D	10/02	11.11.02	2003, 275	1254
D	13/02	11.11.02		1257
D	16/02	16.07.03		1257
D	3/03	23.04.04		1255
D	3/04	05.07.05		1254, 1260
D	6/04	30.08.04		1257
D	8/04	23.08.04		1250
D	15/04	14.02.05		1250
D	16/04	18.02.05		1251
D	17/04	11.02.05		1250
D	18/04	28.01.05		1250
D	19/04	28.02.05		1251
D	7/05	02.01.07		1254-1259, 1263
D	17/05	19.07.05		1257
D	25/05	15.11.06		1262
D	30/05	24.11.06		1218
D	38/05	03.04.07		1256
D	2/06	31.08.06		1263
D	4/06	29.11.06		1256
D	12/06	13.02.07		1251
D	13/06	13.02.07		1251
D	6/07	28.08.08		1258
D	7/07	17.09.08		1258
D	11/07	14.05.09		1254
D	32/07	15.02.08		1251, 1256
D	4/08	18.12.08		1249
D	5/08	15.01.09		1250

Table of cases

D	6/08	30.12.08	1251
D	7/08	02.02.09	1249
D	8/08	19.12.08	1259
D	9/08	19.12.08	1259
D	10/08	15.01.09	1250
D	12/08	02.02.09	1249
D	14/08	23.07.09	1257
D	23/08	03.06.09	1254, 1255, 1257
D	15/09	19.02.10	1249
D	3/10	22.09.11	1260
D	6/10	17.01.11	1251
D	11/11	20.01.12	1251
D	1/12	05.12.12	1250, 1251
D	2/12	05.12.12	1250
D	3/12	05.12.12	1250
D	4/12	05.12.12	1250, 1251
D	8/12	31.01.14	1254
D	1/13	10.03.14	1251, 1256, 1257
D	3/13	23.07.14	1262
D	5/13	19.09.14	1257
D	3/14	01.09.14	1256, 1259
D	7/14	14.01.15	1250
D	8/14	14.01.15	1250
D	9/14	30.01.15	1249, 1250
D	13/14	01.12.15	1249

### Decisions and opinions of the Enlarged Board of Appeal on referrals

G	1/83	05.12.84	1985, 60	51, 254, 706
G	5/83	05.12.84	1985, 64	2, 51, 57, 135, 137, 138, 141, 142, 144, 145, 147, 148, 156, 347, 474, 475, 704-706, 711, 713
G	6/83	05.12.84	1985, 67	51
G	1/84	24.07.85	1985, 299	528, 1006, 1008, 1009, 1038, 1043, 1224

G	1/86	24.06.87	1987, 447	603, 613, 645, 1065, 1084, 1085, 1183, 1270
G	1/88	27.01.89	1990, 469	709, 718, 1052, 1057, 1080, 1081
G	2/88	11.12.89	1990, 93	4, 12, 13, 108, 121, 139, 146-156, 204, 255, 262, 263, 297, 299, 347, 460, 462, 470, 472, 474, 475, 511, 512, 1218
G	4/88	24.04.89	1989, 480	959-963
G	5/88	16.11.90	1991, 137	514, 528, 1276
G	6/88	11.12.89	1990, 114	87, 146, 148-151, 153-156, 347, 1218
G	7/88	16.11.90	1991, 137	514, 1276
G	8/88	16.11.90	1991, 137	514, 1276
G	1/89	02.05.90	1991, 155	307, 308, 310, 313, 314, 319, 320, 326, 1219
G	2/89	02.05.90	1991, 166	308, 310, 313, 314
G	3/89	19.11.92	1993, 117	395, 401, 402, 405, 409, 427, 452, 457, 482-485, 656, 842, 844-846
G	1/90	05.03.91	1991, 275	607, 709, 743, 974, 1056, 1072, 1121
G	2/90	04.08.91	1992, 10	1074, 1221
G	1/91	09.12.91	1992, 253	177, 268, 311, 919, 1044, 1047
G	2/91	29.11.91	1992, 206	1065, 1084, 1085, 1167
G	3/91	07.09.92	1993, 8	605
G	4/91	03.11.92	1993, 707	750, 890, 968, 970
G	5/91	05.05.92	1992, 617	724, 726-728, 730-732, 734, 736, 746, 1071



## Table of cases

G	6/91	06.03.92	1992, 491	649, 651, 709, 1094	G	11/91	19.11.92	1993, 125	401, 402, 405, 427, 452,
G	7/91	05.11.92	1993, 356	978, 1007, 1029, 1065, 1167, 1168, 1270					482-485, 490, 656, 844
G	8/91	05.11.92	1993, 346, 478	566, 978, 1007, 1029, 1065, 1167, 1168, 1270	G	12/91	17.12.93	1994, 285	747, 750, 890, 899, 901, 911, 1167, 1226, 1243
G	9/91	31.03.93	1993, 408	549, 695, 721, 751, 754, 777, 781-783, 931, 933, 940, 956, 1006, 1007, 1014, 1017, 1027, 1028, 1031, 1032, 1035, 1042, 1046, 1047, 1065, 1066, 1085, 1099, 1103, 1115, 1119-1121, 1123, 1125, 1129, 1139, 1146, 1158, 1160, 1162, 1172, 1175, 1224, 1270	G	1/92	18.12.92	1993, 277	78, 83, 88, 89, 108, 109
					G	2/92	06.07.93	1993, 591	322, 323, 325, 832, 866, 918, 920, 921, 1007
					G	3/92	13.06.94	1994, 607	774, 791, 837
					G	4/92	29.10.93	1994, 149	531, 543, 548-551, 674, 938, 946, 1237
					G	5/92	27.09.93	1994, 22	605
					G	6/92	27.09.93	1994, 25	605
					G	8/92	05.03.93		1221
					G	9/92	14.07.94	1994, 875	528, 709, 1039, 1058, 1065, 1085, 1087, 1097, 1099, 1111, 1112, 1114-1117, 1162, 1219
					G	10/92	28.04.94	1994, 633	501, 527, 900
					G	1/93	02.02.94	1994, 541	401, 414, 427, 450, 459, 461, 463, 475-481, 493
G	10/91	31.03.93	1993, 420	781-783, 833, 931, 933, 983, 1006, 1007, 1014, 1027-1036, 1047, 1065, 1097, 1099, 1103-1105, 1115, 1123, 1125, 1129, 1139, 1146, 1160, 1172, 1200, 1224, 1270	G	2/93	21.12.94	1995, 275	328, 354, 355, 714
					G	3/93	16.08.94	1995, 18	367, 372, 392, 393, 1223
					G	4/93	14.07.94	1994, 875	528, 1007, 1039, 1065, 1085, 1087, 1097, 1099, 1111, 1114, 1116-1118, 1162
					G	5/93	18.01.94	1994, 447	528, 605

Table of cases

G	7/93	13.05.94	1994, 775	463, 553, 559, 578, 761, 872-874, 876, 877, 894-896, 898, 899, 935, 940, 1040, 1126, 1140, 1148, 1240	G	1/98	20.12.99	2000, 111	2, 37, 43-45, 50, 56, 707, 1219
G	8/93	13.06.94	1994, 887	978, 1065, 1124	G	2/98	31.05.01	2001, 413	367, 372-375, 378, 379, 381, 383, 384, 388, 389, 393-397, 410, 450, 458, 479
G	9/93	06.07.94	1994, 891	528, 1009-1011, 1224	G	3/98	12.07.00	2001, 62	73, 707, 709, 1218, 1219
G	10/93	30.11.94	1995, 172	900, 1123, 1124, 1130, 1150, 1171	G	4/98	27.11.00	2001, 131	505-507, 709, 852, 1223, 1224
G	1/94	11.05.94	1994, 787	970, 971, 973, 1065	G	1/99	02.04.01	2001, 381	1065, 1087, 1092, 1112, 1113, 1115-1118, 1168, 1229, 1270
G	2/94	19.02.96	1996, 401	740, 815, 817, 825, 826, 1203	G	2/99	12.07.00	2001, 83	73, 707, 1218-1220
G	1/95	19.07.96	1996, 615	4, 541, 833, 1018, 1023, 1030, 1034	G	3/99	18.02.02	2002, 347	802, 806, 807, 1012, 1013, 1077, 1221, 1234
G	2/95	14.05.96	1996, 555	457, 482, 838, 842, 845, 846	G	1/02	22.01.03	2003, 165	836, 1026, 1071
G	3/95	27.11.95	1996, 169	1223	G	2/02	26.04.04	2004, 483	368, 705, 706, 710, 711
G	4/95	19.02.96	1996, 412	531, 648, 669, 709, 814, 815, 817-824, 826, 1241	G	3/02	26.04.04	2004, 483	368, 705, 706, 710, 711
G	6/95	24.07.96	1996, 649	577, 580, 731, 1269, 1273	G	1/03	08.04.04	2004, 413	2, 56, 112, 237, 283, 330, 334, 338, 339, 348, 349, 351, 372, 373, 387, 390, 402, 425-436, 458, 478, 528, 709, 778
G	7/95	19.07.96	1996, 626	1030, 1031, 1036, 1219	G	2/03	08.04.04	2004, 448	56, 112, 237, 283, 372, 373, 425, 426, 428, 429, 431, 433, 434, 778, 1220
G	8/95	16.04.96	1996, 481	764, 766, 767, 1075, 1076	G	3/03	28.01.05	2005, 344	1074, 1110, 1206, 1207
G	1/97	10.12.99	2000, 322	710, 763, 766, 1073, 1182, 1226, 1263, 1271	G	1/04	16.12.05	2006, 334	2, 37, 51-54, 57, 62, 64, 65, 273, 274, 708, 1223
G	2/97	12.11.98	1999, 123	514, 517, 518, 521, 523, 525, 551, 1268					
G	3/97	21.01.99	1999, 245	654, 674-676, 681, 691, 959, 1008-1011, 1013					
G	4/97	21.01.99	1999, 270	674, 676, 691, 1008-1010					

G	2/04	25.05.05	2005, 549	959, 963, 1219, 1221
G	3/04	22.08.05	2006, 118	972, 1190
G	1/05	28.06.07	2008, 271	402, 449, 492-496, 508, 509, 511, 512, 879, 902, 1219
G	1/05	07.12.06	2007, 362	711, 724-728, 737, 1270
G	1/06	28.06.07	2008, 307	442, 492-494, 496, 500, 508, 509, 511, 512, 902, 1219
G	2/06	25.11.08	2009, 306	38-40, 46, 708, 710, 714, 1219, 1273
G	3/06	–		1220
G	1/07	15.02.10	2011, 134	51-57, 63, 274, 426, 435, 706-708
G	2/07	09.12.10	2012, 130	46, 47, 516, 529, 707, 713, 714, 1220
G	1/08	09.12.10	2012, 206	46, 48, 516, 529, 707
G	2/08	15.06.09		135, 137, 138, 140, 142, 143, 347, 529, 705, 706, 711, 723-726, 729, 737, 1066, 1218, 1270
G	2/08	19.02.10	2010, 456	135, 137, 138, 140, 142, 143, 347, 529, 705, 706, 1066, 1218
G	3/08	12.05.10	2011, 10	5-9, 11, 19-23, 25-27, 197, 200, 202, 204, 208, 216, 223, 531, 1066, 1074, 1217, 1223, 1227, 1268, 1269
G	3/08	16.10.09		725, 726, 737
G	4/08	16.02.10	2010, 572	647, 1268

G	1/09	27.09.10	2011, 336	499, 501, 502, 504, 604, 774, 1219
G	1/10	23.07.12	2013, 194	488, 489, 763-765, 1039, 1040, 1049, 1050
G	2/10	30.08.11	2012, 376	373, 401, 402, 405, 408, 412, 424-429, 431, 436, 440, 450, 479, 1218
G	1/11	19.03.14	2014, A122	1075
G	1/12	30.04.14	2014, A114	482, 654, 674, 676, 1016, 1017, 1077, 1089-1091, 1217, 1221, 1222
G	2/12	25.03.15	2016, A27	2, 10, 11, 48, 49, 704-709
G	1/13	25.11.14	2015, A42	1009, 1086, 1218, 1222
G	2/13	25.03.15	2016, A28	11, 48, 49, 704-709
G	1/14	19.11.15	2016, Axx	1220
G	2/14	–	2015, A13	1220
G	3/14	24.03.15	2015, A102	263, 356, 358, 832, 979, 1019, 1039, 1047, 1049, 1218, 1225
G	1/15	pending		397, 493, 1225
G	2301/15	17.09.15		1245, 1246, 1270
G	2302/15	11.02.16		1246

### Decisions of the Legal Board of Appeal

J	1/78 - 3.1.01	02.03.79	1979, 285	800
J	5/79 - 3.1.01	17.01.80	1980, 71	642, 771, 1080
J	6/79 - 3.1.01	13.06.80	1980, 225	605, 1191
J	1/80 - 3.1.01	17.07.80	1980, 289	606, 640, 644, 855
J	3/80 - 3.1.01	31.01.80	1980, 92	603, 837

Table of cases

J	5/80 - 3.1.01	07.07.81	1981, 343	617, 624, 626, 632, 633	
J	7/80 - 3.1.01	11.03.81	1981, 137	646, 651, 840	
J	8/80 - 3.1.01	18.07.80	1980, 293	841, 855, 856, 1090	
J	11/80 - 3.1.01	25.03.81	1981, 141	903, 904, 1169	
J	12/80 - 3.1.01	26.03.81	1981, 143	855, 856	
J	15/80 - 3.1.01	11.06.81	1981, 213	367, 370	
J	19/80 - 3.1.01	03.02.81	1981, 65	844	
J	21/80 - 3.1.01	26.02.81	1981, 101	1188	
J	1/81 - 3.1.01	24.11.82	1983, 53	593	
J	3/81 - 3.1.01	07.12.81	1982, 100	854, 855, 1267	
J	5/81 - 3.1.01	09.12.81	1982, 155	71, 768, 859, 1203, 1222	
J	8/81 - 3.1.01	30.11.81	1982, 10	749, 1070	
J	10/81 - 3.1.01	05.05.82		801	
J	1/82 - 3.1.01	07.04.82	1982, 293	845	
J	3/82 - 3.1.01	16.02.83	1983, 171	855, 856	
J	4/82 - 3.1.01	21.07.82	1982, 385	855, 856	
J	7/82 - 3.1.01	23.07.82	1982, 391	536, 538, 607, 609, 610, 644, 758, 880, 882, 1187, 1195	
J	8/82 - 3.1.01	08.11.83	1984, 155	707, 847, 850	
J	9/82 - 3.1.01	26.11.82	1983, 57	592	
J	10/82 - 3.1.01	21.12.82	1983, 94	1199	
J	12/82 - 3.1.01	11.03.83	1983, 221	863	
J	14/82 - 3.1.01	19.01.83	1983, 121	855, 856, 1195	
J	16/82 - 3.1.01	02.03.83	1983, 262	633, 636, 1188	
J	19/82 - 3.1.01	28.07.83	1984, 6	1164	
J	23/82 - 3.1.01	28.01.83	1983, 127	794, 795	
J	24/82 - 3.1.01	03.08.84	1984, 467	903	
J	25/82 - 3.1.01	03.08.84	1984, 467	903	
J	26/82 - 3.1.01	03.08.84	1984, 467	903	
J	3/83 - 3.1.01	02.11.83		604	
J	7/83 - 3.1.01	02.12.83	1984, 211	532, 600, 1191	
J	8/83 - 3.1.01	13.02.85	1985, 102	864	
J	9/83 - 3.1.01	13.02.85		864	
J	12/83 - 3.1.01	09.11.84	1985, 6	888, 1079	
J	13/83 - 3.1.01	03.12.84		1071	
J	9/84 - 3.1.01	30.04.85	1985, 233	300	
J	10/84 - 3.1.01	29.11.84	1985, 71	514	
J	12/84 - 3.1.01	25.01.85	1985, 108	518, 634, 743	
J	13/84 - 3.1.01	16.11.84	1985, 34	902	
J	16/84 - 3.1.01	06.08.85	1985, 357	794	
J	18/84 - 3.1.01	31.07.86	1987, 215	836, 1190	
J	19/84 - 3.1.01	12.11.84	1991, 473	553, 1195	
J	21/84 - 3.1.01	29.11.85	1986, 75	853-855	
J	4/85 - 3.1.01	28.02.86	1986, 205	841, 847, 1090, 1124	
J	11/85 - 3.1.01	23.10.85	1986, 1	796	
J	12/85 - 3.1.01	07.02.86	1986, 155	766, 1070, 1071, 1079	
J	15/85 - 3.1.01	10.07.86	1986, 395	494, 902	
J	18/85 - 3.1.01	04.11.86	1987, 356	795	
J	20/85 - 3.1.01	14.05.86	1987, 102	100, 531, 533, 534, 655, 670, 700, 879, 1084	
J	22/85 - 3.1.01	23.07.86	1987, 455	795, 1212	
J	900/85 - 3.1.01	01.03.85	1985, 159 (=J xx/xx)		560, 597
J	2/86 - 3.1.01	21.10.86	1987, 362	616, 617, 619	
J	3/86 - 3.1.01	21.10.86	1987, 362	617, 619	
J	6/86 - 3.1.01	28.01.87	1988, 124	904	
J	9/86 - 3.1.01	17.03.87		607, 609, 620, 639	
J	11/86 - 3.1.01	06.08.86		605	
J	12/86 - 3.1.01	06.02.87	1988, 83	1168, 1189	
J	14/86 - 3.1.01	28.04.87	1988, 85	591	
J	15/86 - 3.1.01	09.10.87	1988, 417	904, 908	
J	16/86 - 3.1.01	01.12.86		611	
J	18/86 - 3.1.01	27.04.87	1988, 165	838, 839	
J	22/86 - 3.1.01	07.02.87	1987, 280	639, 640, 1097, 1100, 1106, 1107	
J	25/86 - 3.1.01	14.11.86	1987, 475	840, 1088	
J	28/86 - 3.1.01	13.04.87	1988, 85	802	
J	29/86 - 3.1.01	12.06.87	1988, 84	607, 743	



Table of cases

J	6/91 - 3.1.01	01.12.92	1994, 349	856-858		
J	9/91 - 3.1.01	01.12.92		856		
J	10/91 - 3.1.01	11.12.92		699		
J	11/91 - 3.1.01	05.08.92	1994, 28	527, 528, 604, 714		
J	14/91 - 3.1.01	06.11.91	1993, 479	575, 768, 1222		
J	15/91 - 3.1.01	16.12.92	1994, 296	1265		
J	16/91 - 3.1.01	05.08.92	1994, 28	604, 714		
J	17/91 - 3.1.01	17.09.92	1994, 225	771		
J	19/91 - 3.1.01	17.09.92		771		
J	1/92 - 3.1.01	15.07.92		1076		
J	2/92 - 3.1.01	01.12.92	1994, 375	841, 856, 857, 1090		
J	7/92 - 3.1.01	17.02.94		743		
J	11/92 - 3.1.01	12.01.94	1995, 25	857		
J	12/92 - 3.1.01	30.04.93		605		
J	13/92 - 3.1.01	18.10.93		1070		
J	15/92 - 3.1.01	25.05.93		526		
J	16/92 - 3.1.01	25.04.94		596, 631		
J	17/92 - 3.1.01	22.11.96		866, 1205		
J	18/92 - 3.1.01	18.12.92		801		
J	19/92 - 3.1.01	11.10.93		788		
J	21/92 - 3.1.01	16.03.95		618		
J	22/92 - 3.1.01	13.12.94		610, 625, 642		
J	23/92 - 3.1.01	17.12.93		619		
J	24/92 - 3.1.01	16.03.95		618		
J	25/92 - 3.1.01	29.09.93		526		
J	26/92 - 3.1.01	23.08.94		620, 633, 634		
J	27/92 - 3.1.01	20.05.94	1995, 288	515, 517-519, 796		
J	28/92 - 3.1.01	11.05.94		630		
J	30/92 - 3.1.01	18.12.92		801		
J	31/92 - 3.1.01	18.12.92		801		
J	32/92 - 3.1.01	18.12.92		801		
J	33/92 - 3.1.01	18.12.92		801		
J	34/92 - 3.1.01	23.08.94		518, 522, 611, 615, 743		
J	35/92 - 3.1.01	17.03.94		806		
J	36/92 - 3.1.01	20.05.94		501		
J	38/92 - 3.1.01	16.03.95		772, 773, 1001		
J	39/92 - 3.1.01	16.03.95		772, 773, 1088		
J	41/92 - 3.1.01	27.10.93	1995, 93	525, 619, 623		
J	42/92 - 3.1.01	28.02.97		488, 748, 912, 1076		
J	43/92 - 3.1.01	28.11.95		742, 743, 749		
J	44/92 - 3.1.01	29.11.96		642, 643		
J	47/92 - 3.1.01	21.10.93	1995, 180	596		
J	48/92 - 3.1.01	29.11.96		642, 643		
J	49/92 - 3.1.01	29.05.95		597		
J	1/93 - 3.1.01	17.05.94		594		
J	2/93 - 3.1.01	07.02.94	1995, 675	1072		
J	3/93 - 3.1.01	22.02.94		625		
J	7/93 - 3.1.01	23.08.93		644, 1266		
J	8/93 - 3.1.01	19.03.97		699		
J	10/93 - 3.1.01	14.06.96	1997, 91	640, 772		
J	11/93 - 3.1.01	06.02.96		811		
J	16/93 - 3.1.01	20.06.95		607, 609, 625, 628		
J	18/93 - 3.1.01	02.09.94	1997, 326	840		
J	19/93 - 3.1.01	15.12.97		1266		
J	2/94 - 3.1.01	21.06.95		523, 615		
J	3/94 - 3.1.01	28.03.95		1266		
J	4/94 - 3.1.01	24.03.95		1266, 1267		
J	5/94 - 3.1.01	28.09.94		607, 616, 619, 623, 625		
J	7/94 - 3.1.01	18.01.95	1995, 817	857		
J	9/94 - 3.1.01	18.01.96		599, 600		
J	10/94 - 3.1.01	18.01.96		599, 600		
J	11/94 - 3.1.01	17.11.94	1995, 596	815, 824, 889		
J	12/94 - 3.1.01	16.02.96		514		
J	13/94 - 3.1.01	04.10.96		889		
J	14/94 - 3.1.01	15.12.94	1995, 825	519, 742		
J	16/94 - 3.1.01	10.06.96	1997, 331	1091, 1169, 1188		
J	21/94 - 3.1.01	12.04.95	1996, 16	846		
J	22/94 - 3.1.01	19.06.95		787		
J	27/94 - 3.1.01	27.02.95	1995, 831	501, 515, 519, 527, 528, 831, 889, 904, 907, 1183, 1200		

J	28/94 - 3.1.01	07.12.94	1995, 742	503, 773, 1066, 1084, 1166			
J	29/94 - 3.1.01	10.03.97	1998, 147	605, 858, 878, 1068			
J	30/94 - 3.1.01	09.10.95		766, 1075, 1189, 1213			
J	3/95 - 3.1.01	28.02.97	1997, 493	1272			
J	8/95 - 3.1.01	04.11.96		615, 715			
J	14/95 - 3.1.01	20.08.97		514			
J	15/95 - 3.1.01	20.08.97		514			
J	16/95 - 3.1.01	20.08.97		514			
J	17/95 - 3.1.01	20.08.97		514			
J	22/95 - 3.1.01	04.07.97	1998, 569	507, 852			
J	24/95 - 3.1.01	20.08.97		514			
J	25/95 - 3.1.01	20.08.97		514, 527, 528			
J	26/95 - 3.1.01	13.10.98	1999, 668	599, 600, 606, 611, 645, 772, 958			
J	27/95 - 3.1.01	09.04.97		804, 805			
J	29/95 - 3.1.01	30.01.96	1996, 489	889			
J	32/95 - 3.1.01	24.03.99	1999, 733	868, 1079, 1110, 1187, 1191, 1206, 1207			
J	33/95 - 3.1.01	31.08.98		773, 1084			
J	4/96 - 3.1.01	15.04.97		525			
J	7/96 - 3.1.01	20.01.98	1999, 443	773, 911, 912			
J	8/96 - 3.1.01	20.01.98		774			
J	9/96 - 3.1.01	21.11.97		786			
J	10/96 - 3.1.01	15.07.98		806			
J	16/96 - 3.1.01	14.07.97	1998, 347	713, 814, 815			
J	17/96 - 3.1.01	03.12.96		840			
J	18/96 - 3.1.01	01.10.97	1998, 403	519, 646, 1212			
J	19/96 - 3.1.01	23.04.99		507, 794, 795			
J	20/96 - 3.1.01	28.09.98		787, 1206			
J	21/96 - 3.1.01	06.05.98		501, 604			
J	23/96 - 3.1.01	28.08.97		640, 1201			
J	24/96 - 3.1.01	27.04.01	2001, 434	310, 831, 1204			
J	25/96 - 3.1.01	11.04.00		632, 636			
J	27/96 - 3.1.01	16.12.98			854, 1090		
J	29/96 - 3.1.01	03.09.97	1998, 582	501			
J	31/96 - 3.1.01	25.11.97		840			
J	4/97 - 3.1.01	09.07.97			903, 904, 907		
J	5/97 - 3.1.01	23.09.99			643		
J	7/97 - 3.1.01	11.12.97			526, 842		
J	17/97 - 3.1.01	14.02.02			507, 841		
J	18/97 - 3.1.01	14.02.02			507, 841		
J	22/97 - 3.1.01	10.11.99			607		
J	24/97 - 3.1.01	26.08.99			607		
J	27/97 - 3.1.01	26.10.98			786		
J	29/97 - 3.1.01	14.06.99			902		
J	32/97 - 3.1.01	20.07.98			786, 1206		
J	35/97 - 3.1.01	07.06.00			789		
J	36/97 - 3.1.01	25.05.99			773, 774		
J	38/97 - 3.1.01	22.06.99			514, 1072, 1189, 1213, 1214		
J	2/98 - 3.1.01	27.11.02			598		
J	3/98 - 3.1.01	25.09.00			1074, 1271		
J	5/98 - 3.1.01	07.04.00			572		
J	6/98 - 3.1.01	17.10.00			611		
J	10/98 - 3.1.01	02.12.02	2003, 184		705, 706, 710		
J	11/98 - 3.1.01	15.06.00			600, 613		
J	12/98 - 3.1.01	08.10.02			611		
J	15/98 - 3.1.01	31.10.00	2001, 183		646		
J	16/98 - 3.1.01	20.12.00			1074		
J	17/98 - 3.1.01	20.9.99	2000, 399		515, 787, 812		
J	18/98 - 3.1.01	16.01.04			614, 616, 617, 633		
J	21/98 - 3.1.01	25.10.99	2000, 406		651, 863, 1191		
J	22/98 - 3.1.01	25.10.99			652, 1191		
J	5/99 - 3.1.01	06.04.00			597, 598		
J	6/99 - 3.1.01	25.10.99			652, 1191		
J	7/99 - 3.1.01	17.05.00			597, 598, 607		
J	9/99 - 3.1.01	10.10.03	2004, 309		811		
J	10/99 - 3.1.01	20.12.99			611		
J	14/99 - 3.1.01	25.10.99			652, 1191		
J	15/99 - 3.1.01	25.10.99			652, 1191		
J	16/99 - 3.1.01	03.09.01			767		
J	17/99 - 3.1.01	04.07.00			854, 1267		
J	18/99 - 3.1.01	01.10.02			804		

Table of cases

J	20/99 - 3.1.01	08.05.00		752	
J	24/99 - 3.1.01	22.03.01		1265	
J	3/00 - 3.1.01	20.12.01		522, 843,	
				1268	
J	4/00 - 3.1.01	21.03.02		863	
J	7/00 - 3.1.01	12.07.02		774, 1078	
J	8/00 - 3.1.01	13.03.02		528	
J	12/00 - 3.1.01	24.01.02		772	
J	14/00 - 3.1.01	10.05.01	2002, 432	1070, 1274,	
				1275	
J	19/00 - 3.1.01	10.05.01		1070, 1275	
J	20/00 - 3.1.01	24.09.01		795	
J	2/01 - 3.1.01	04.02.04	2005, 88	369, 494,	
				499, 902	
J	3/01 - 3.1.01	17.06.02		854	
J	5/01 - 3.1.01	28.11.01		847, 850	
J	8/01 - 3.1.01	06.06.02	2003, 3	1267	
J	9/01 - 3.1.01	19.11.01		646	
J	10/01 - 3.1.01	15.10.02		501, 604	
J	15/01 - 3.1.01	15.11.01		1188	
J	18/01 - 3.1.01	02.05.02		646	
J	25/01 - 3.1.01	13.02.03		854	
J	27/01 - 3.1.01	11.03.04		607, 608,	
				625	
J	2/02 - 3.1.01	09.07.02		612, 625	
J	4/02 - 3.1.01	28.10.05		604	
J	5/02 - 3.1.01	30.07.02		515, 517	
J	6/02 - 3.1.01	13.05.04		854, 912,	
				1090	
J	10/02 - 3.1.01	22.02.05		773-775	
J	13/02 - 3.1.01	26.06.03		837	
J	16/02 - 3.1.01	10.02.04		560, 1194	
J	1/03 - 3.1.01	06.10.04		605, 631	
J	4/03 - 3.1.01	09.09.04		573, 574,	
				905	
J	6/03 - 3.1.01	29.09.04		774	
J	11/03 - 3.1.01	14.04.05		607, 611,	
				620, 622	
J	12/03 - 3.1.01	26.09.05		771, 905,	
				906	
J	13/03 - 3.1.01	23.02.04		514	
J	14/03 - 3.1.01	20.08.04		594	
J	17/03 - 3.1.01	18.06.04		560, 625	
J	18/03 - 3.1.01	03.09.04		607	
J	19/03 - 3.1.01	11.03.05		904, 905,	
				907, 1090	
J	22/03 - 3.1.01	22.06.04		646	
J	23/03 - 3.1.01	13.07.04		488, 912,	
				1090	
J	24/03 - 3.1.01	17.02.04	2004, 544	501, 604	
J	25/03 - 3.1.01	27.04.05	2006, 395	771, 905,	
				907, 908	
J	28/03 - 3.1.01	04.10.04	2005, 597	502, 503,	
				1066	
J	33/03 - 3.1.01	16.11.04		775	
J	34/03 - 3.1.01	14.10.05		514	
J	35/03 - 3.1.01	04.05.04		611	
J	36/03 - 3.1.01	22.02.05		652	
J	37/03 - 3.1.01	15.03.06		905	
J	38/03 - 3.1.01	15.03.06		904, 905	
J	40/03 - 3.1.01	18.08.04		507	
J	1/04 - 3.1.01	20.12.06		798, 812	
J	3/04 - 3.1.01	20.09.05		503, 604	
J	5/04 - 3.1.01	29.11.05		787	
J	7/04 - 3.1.01	09.11.04		502	
J	9/04 - 3.1.01	01.03.05		1070, 1274,	
				1275	
J	10/04 - 3.1.01	05.07.04		658, 662,	
				676, 693,	
				1268	
J	13/04 - 3.1.01	23.12.04		592, 850	
J	14/04 - 3.1.01	17.03.05		771, 905	
J	15/04 - 3.1.01	30.05.06		726, 728,	
				735	
J	16/04 - 3.1.01	28.04.05		534	
J	17/04 - 3.1.01	09.04.05		518, 526,	
				1080, 1081,	
				1206	
J	18/04 - 3.1.01	04.05.05	2006, 560	501, 591,	
				604	
J	19/04 - 3.1.01	14.07.05		607, 628	
J	1/05 - 3.1.01	30.09.05		507	
J	2/05 - 3.1.01	01.03.05		1070, 1275	
J	4/05 - 3.1.01	02.02.06		1070, 1275	
J	6/05 - 3.1.01	17.10.05		646	
J	7/05 - 3.1.01	12.07.07		501	
J	9/05 - 3.1.01	21.12.06		692, 693,	
				698, 790,	
				1197	
J	12/05 - 3.1.01	03.08.06		839	
J	13/05 - 3.1.01	03.08.06		594, 839	
J	18/05 - 3.1.01	21.12.06		692, 693,	
				698, 790,	
				1197	



Table of cases

J	19/05 - 3.1.01	24.11.06		614, 616	J	4/10 - 3.1.01	15.03.12		772
J	20/05 - 3.1.01	06.09.07		499, 774	J	6/10 - 3.1.01	13.11.12		773, 775
J	3/06 - 3.1.01	17.12.07	2009, 170	843	J	7/10 - 3.1.01	13.11.12		773, 775, 828
J	5/06 - 3.1.01	24.11.06		457, 846	J	8/10 - 3.1.01	05.10.11	2012, 472	798, 799, 803, 808, 814, 815
J	7/06 - 3.1.01	26.04.07		905	J	9/10 - 3.1.01	18.04.12		797, 865, 1209
J	9/06 - 3.1.01	24.11.07		774	J	12/10 - 3.1.01	16.06.11		627, 628
J	11/06 - 3.1.01	18.04.07		618, 627	J	13/10 - 3.1.01	27.05.11		531
J	15/06 - 3.1.01	30.11.07		773	J	15/10 - 3.1.01	08.11.10		551, 614, 616
J	18/06 - 3.1.01	30.11.07		773	J	18/10 - 3.1.01	02.12.11		906
J	1/07 - 3.1.01	25.07.07		617, 621, 624, 625, 627, 628, 637	J	19/10 - 3.1.01	17.05.11		516, 604
J	4/07 - 3.1.01	07.07.08		618, 627, 628, 632	J	21/10 - 3.1.01	22.12.11		607, 608
J	5/07 - 3.1.01	26.02.08		505, 517, 878	J	22/10 - 3.1.01	12.12.11		1070, 1275
J	6/07 - 3.1.01	10.12.07		625	J	23/10 - 3.1.01	12.07.11		518, 769, 770
J	7/07 - 3.1.01	12.12.07		593, 792, 1207	J	24/10 - 3.1.01	15.04.11		502
J	8/07 - 3.1.01	08.12.08	2009, 216	1218	J	25/10 - 3.1.01	21.07.11	2011, 624	797, 865
J	9/07 - 3.1.01	30.06.08		367, 605, 712	J	27/10 - 3.1.01	09.12.11		843, 844
J	10/07 - 3.1.01	31.03.08	2008, 567	1069, 1070, 1187, 1205	J	28/10 - 3.1.01	28.02.13		788
J	12/07 - 3.1.01	15.04.08		593	J	29/10 - 3.1.01	18.11.11		501, 593, 596, 832
J	13/07 - 3.1.01	10.07.08		619, 621	J	1/11 - 3.1.01	28.06.11		504, 903, 906, 907
J	14/07 - 3.1.01	02.04.09		749, 760, 797	J	4/11 - 3.1.01	25.11.11	2012, 516	503, 504
J	1/08 - 3.1.01	28.09.09		519	J	5/11 - 3.1.01	06.06.12		616, 931, 949
J	2/08 - 3.1.01	27.05.09	2010, 100	525	J	7/11 - 3.1.01	24.01.12		353
J	3/08 - 3.1.01	02.10.08		632	J	8/11 - 3.1.01	30.01.13		353
J	5/08 - 3.1.01	09.07.09		503	J	9/11 - 3.1.01	30.03.12		1070
J	6/08 - 3.1.01	27.05.09		522, 526, 611	J	10/11 - 3.1.01	03.12.12		1097
J	7/08 - 3.1.01	08.12.10		795, 1071	J	13/11 - 3.1.01	22.06.12		521, 522, 643
J	10/08 - 3.1.01	16.11.09		908	J	16/11 - 3.1.01	07.12.12		616
J	15/08 - 3.1.01	18.08.09		625	J	1/12 - 3.1.01	23.10.13		837, 839
J	16/08 - 3.1.01	31.08.09		854	J	2/12 - 3.1.01	07.08.13		844
J	18/08 - 3.1.01	03.04.09		849, 1067	J	3/12 - 3.1.01	05.12.12		617, 619
J	1/09 - 3.1.01	06.10.09		797	J	4/12 - 3.1.01	05.12.12		617, 619
J	3/09 - 3.1.01	28.05.10		301, 324	J	5/12 - 3.1.01	05.07.13		847
J	4/09 - 3.1.01	28.07.09		851, 1212	J	6/12 - 3.1.01	29.01.13		898
J	8/09 - 3.1.01	23.08.10		625, 643	J	7/12 - 3.1.01	25.01.13		625, 631
J	11/09 - 3.1.01	23.08.10		613, 617	J	9/12 - 3.1.01	28.06.13		499, 774
J	18/09 - 3.1.01	01.09.10	2011, 480	502	J	10/12 - 3.1.01	13.05.14		501, 591, 604
J	1/10 - 3.1.01	30.07.10		850					

Table of cases

J	13/12 - 3.1.01	17.06.13	775
J	14/12 - 3.1.01	12.12.13	793, 1197
J	15/12 - 3.1.01	18.02.13	844
J	17/12 - 3.1.01	13.11.13	772
J	18/12 - 3.1.01	15.05.13	599, 1188
J	20/12 - 3.1.01	18.03.13	504
J	22/12 - 3.1.01	07.11.13	998, 1072
J	25/12 - 3.1.01	22.07.14	795, 796
J	1/13 - 3.1.01	27.11.13	607, 609, 625, 1190
J	3/13 - 3.1.01	05.11.14	617
J	5/13 - 3.1.01	17.01.14	624, 627, 628
J	6/13 - 3.1.01	23.07.13	903, 905
J	7/13 - 3.1.01	07.10.15	508
J	8/13 - 3.1.01	13.04.15	1197
J	9/13 - 3.1.01	24.07.13	801
J	15/13 - 3.1.01	09.05.14	774, 775
J	16/13 - 3.1.01	22.05.14	402, 457, 488, 846, 1075
J	22/13 - 3.1.01	01.09.15	503
J	23/13 - 3.1.01	30.03.15	503
J	1/14 - 3.1.01	17.09.14	1108
J	3/14 - 3.1.01	08.09.14	698
J	6/14 - 3.1.01	02.06.15	613, 616, 931
J	12/14 - 3.1.01	27.03.15	844, 847
J	14/14 - 3.1.01	23.03.15	789
J	15/14 - 3.1.01	18.06.15	627
J	17/14 - 3.1.01	15.06.15	773
J	2/15 - 3.1.01	20.07.15	771, 903, 904, 906, 907

**Decisions of the Enlarged Board of Appeal on petitions for review**

R	1/08	15.07.08	1226-1229, 1231, 1235-1237
R	2/08	11.09.08	824, 1226, 1227, 1230-1233, 1236, 1237
R	3/08	25.09.08	649, 663, 818, 824, 1231, 1241

R	4/08	20.03.09	1230, 1231, 1237
R	5/08	05.02.09	1226, 1232-1234
R	7/08	22.06.09	1218, 1230, 1231
R	8/08	19.05.09	1230
R	9/08	21.01.09	1229, 1231
R	10/08	13.03.09	1228, 1232, 1240, 1243
R	11/08	06.04.09	586, 587, 718, 1235, 1236, 1239, 1243, 1274
R	2/09	29.07.09	793
R	3/09	03.04.09	1228, 1231, 1239
R	4/09	30.04.10	514, 515, 525, 1228, 1229, 1231, 1234, 1236, 1239
R	6/09	03.06.09	1232
R	7/09	22.07.09	1226, 1231, 1241
R	8/09	23.09.09	1229, 1237
R	9/09	22.03.10	1230, 1231
R	10/09	22.06.10	1139, 1149, 1227-1229
R	11/09	22.11.00	1231, 1235
R	12/09	03.12.09	730-732, 737, 738, 1066, 1217, 1229, 1236, 1237, 1239
R	13/09	22.10.09	1228, 1235, 1236
R	14/09	22.12.09	584, 1227
R	15/09	05.07.10	1232, 1234, 1236, 1237, 1243
R	16/09	19.05.10	1151, 1227, 1232, 1239, 1240, 1242
R	17/09	01.10.10	515, 583, 736, 1227, 1235, 1239

R	18/09	27.09.10	659, 802, 807, 1077, 1227, 1232-1234, 1236	R	5/11	22.08.11	1127, 1240
R	19/09	24.03.10	1235	R	6/11	04.11.11	1227, 1229, 1237-1239
R	20/09	07.09.10	723, 1227, 1232, 1234	R	7/11	05.10.11	663, 1230, 1231
R	21/09	19.03.10	655, 663, 672, 674, 678, 713, 1229, 1230, 1240	R	8/11	29.11.11	1228, 1231, 1238, 1239
R	1/10	22.02.11	801, 1230, 1272, 1273	R	9/11	07.12.12	1131, 1228, 1236
R	2/10	03.11.10	1232, 1244	R	10/11	09.11.11	1228, 1229
R	3/10	29.09.11	541, 662, 1226, 1231, 1234, 1236-1238, 1241	R	11/11	14.11.11	940, 1139, 1140, 1142, 1149, 1228, 1229, 1240
R	6/10	28.07.10	1232	R	13/11	20.04.12	514, 1140, 1144, 1227, 1229, 1236, 1237, 1239
R	9/10	10.09.10	1228, 1229, 1232, 1239	R	14/11	05.07.12	1230, 1231, 1274
R	12/10	14.12.11	1233, 1238	R	15/11	13.05.13	726, 1226, 1234, 1237, 1241, 1244
R	13/10	24.03.11	1228	R	16/11	23.03.12	1232
R	14/10	26.01.11	527, 553, 716, 870, 909, 1238, 1239, 1243	R	17/11	19.03.12	542, 1228, 1229, 1231, 1236, 1238, 1242
R	15/10	25.11.10	1229, 1236	R	18/11	22.11.12	776, 1226
R	16/10	20.12.10	735, 1234	R	19/11	02.10.12	1227, 1228, 1236
R	17/10	15.06.11	584, 1230, 1231	R	20/11	23.10.12	1227
R	18/10	25.03.11	592	R	21/11	15.06.12	1226, 1230, 1231, 1234, 1236, 1242-1244
R	19/10	16.03.11	880, 881, 1229, 1231, 1238, 1242	R	2/12	26.09.12	584, 725, 738, 1226-1228, 1231, 1232, 1238, 1242
R	20/10	25.08.11	1226-1228, 1232	R	3/12	29.08.12	1228, 1239
R	21/10	16.03.11	655, 702, 1227, 1237, 1238, 1242	R	4/12	20.12.12	1233, 1238, 1240
R	22/10	07.03.11	1235-1237	R	5/12	20.12.12	1230
R	23/10	15.07.11	1226, 1238	R	6/12	18.01.13	655, 658, 672, 1230, 1236, 1238
R	1/11	27.06.11	1218, 1226, 1229, 1231	R	7/12	06.12.13	1218, 1237
R	2/11	23.11.11	1231				
R	3/11	16.12.11	1226, 1230, 1231				
R	4/11	16.04.12	1229, 1236, 1237				

Table of cases

R	11/12	19.07.13	571, 1234, 1237
R	12/12	14.01.13	1236
R	13/12	14.11.12	1228, 1238
R	14/12	25.10.13	1239
R	15/12	11.03.13	1236, 1238
R	16/12	15.11.13	1226, 1230, 1232, 1233, 1240
R	17/12	08.07.13	1236, 1237
R	18/12	10.12.13	1227, 1230, 1236, 1237
R	19/12	12.04.16	711, 724-726, 729, 738, 739, 1217, 1228, 1238, 1244, 1269, 1271, 1272
R	1/13	17.06.13	1131, 1151, 1229, 1232, 1236, 1237
R	2/13	10.06.13	1236-1238
R	3/13	30.01.14	1236, 1237
R	4/13	25.07.13	1140, 1227, 1229, 1232, 1233, 1236
R	5/13	10.02.14	163, 1227-1229, 1231, 1236
R	6/13	22.11.13	1228, 1231, 1235
R	8/13	20.03.15	724, 725, 739, 1237, 1238, 1241, 1270
R	9/13	10.02.14	163
R	10/13	10.02.14	163
R	11/13	10.02.14	163
R	12/13	10.02.14	163
R	13/13	10.02.14	163
R	14/13	25.02.15	1229, 1231
R	15/13	18.10.13	1232-1234, 1236
R	16/13	08.12.14	958, 1226, 1236, 1237, 1241, 1244
R	17/13	13.09.13	1232, 1236, 1240, 1243
R	18/13	17.03.14	619, 620, 638
R	1/14	21.01.15	1230

R	2/14	17.02.15	531, 729, 738, 739, 1217, 1269, 1270
R	3/14	07.07.14	1226, 1230-1232, 1242
R	5/14	04.03.15	1226-1228, 1231, 1232
R	6/14	28.05.15	587, 1234, 1243
R	7/14	18.02.16	1227, 1228, 1232, 1233, 1236, 1238, 1243
R	8/14	28.07.15	1226, 1237
R	9/14	24.02.15	162, 680, 1226-1228, 1236, 1237, 1239
R	10/14	29.05.15	1228, 1229, 1231
R	13/14	15.01.16	581, 1229, 1243
R	17/14	15.12.15	1229, 1230, 1232, 1235, 1239
R	18/14	22.05.15	1231
R	2/15	21.10.15	728
R	6/15	25.04.16	1227, 1229, 1240

## Decisions of the technical boards of appeal

### 1980

T	1/80 - 3.3.01	06.04.81	1981, 206	162, 172, 229
T	2/80 - 3.3.01	05.06.81	1981, 431	270, 294, 450
T	4/80 - 3.3.01	07.09.81	1982, 149	426
T	6/80 - 3.3.02	13.05.81	1981, 434	106

### 1981

T	1/81 - 3.2.02	04.05.81	1981, 439	240
T	2/81 - 3.3.01	01.07.82	1982, 394	415, 694
T	5/81 - 3.2.02	04.03.82	1982, 249	173, 184, 869, 909, 1071, 1191
T	6/81 - 3.2.02	17.09.81	1982, 183	265
T	7/81 - 3.3.01	14.12.82	1983, 98	1092, 1093

T	9/81 - 3.3.01	25.01.83	1983, 372	136
T	12/81 - 3.3.01	09.02.82	1982, 296	69, 107, 110, 116, 122-124, 129, 423
T	15/81 - 3.4.01	28.07.81	1982, 2	234
T	18/81 - 3.3.01	01.03.85	1985, 166	535, 1084
T	19/81 - 3.2.02	29.07.81	1982, 51	244
T	20/81 - 3.3.01	10.02.82	1982, 217	162, 172, 175, 177, 251
T	21/81 - 3.5.01	10.09.82	1983, 15	227, 250
T	24/81 - 3.3.01	13.10.82	1983, 133	162, 164, 172, 184, 229, 243, 245
T	26/81 - 3.2.02	28.10.81	1982, 211	172
T	28/81 - 3.3.01	11.06.85		1171
T	32/81 - 3.2.01	05.03.82	1982, 225	189, 225, 1092, 1093
<b>1982</b>				
T	10/82 - 3.3.01	15.03.83	1983, 407	983, 991, 994, 1010, 1073
T	11/82 - 3.5.01	15.04.83	1983, 479	446, 447, 909
T	13/82 - 3.5.01	03.03.83	1983, 411	614, 684, 1096, 1188
T	21/82 - 3.2.01	30.11.83		1168
T	22/82 - 3.3.01	22.06.82	1982, 341	232
T	32/82 - 3.5.01	14.03.84	1984, 354	272, 360, 553, 891, 1195
T	36/82 - 3.5.01	25.10.82	1983, 269	237
T	37/82 - 3.5.01	29.07.83	1984, 71	227, 446
T	39/82 - 3.2.02	30.07.82	1982, 419	235
T	41/82 - 3.3.01	30.03.82	1982, 256	1168, 1188, 1189
T	43/82 - 3.3.01	16.04.04		136
T	52/82 - 3.2.01	18.03.83	1983, 416	439
T	53/82 - 3.3.01	28.06.82		415
T	54/82 - 3.3.01	16.05.83	1983, 446	403
T	57/82 - 3.3.01	29.04.82	1982, 306	306
T	60/82 - 3.2.01	25.10.83		244
T	62/82 - 3.4.01	23.06.83		244
T	65/82 - 3.3.01	20.04.83	1983, 327	232, 238
T	79/82 - 3.5.01	06.10.83		246

T	84/82 - 3.3.01	18.03.83	1983, 451	541, 867, 869, 871
T	94/82 - 3.2.01	22.07.83	1984, 75	278, 356
T	109/82 - 3.5.01	15.05.84	1984, 473	234, 247
T	110/82 - 3.3.01	08.03.83	1983, 274	306
T	113/82 - 3.2.01	22.06.83	1984, 10	249
T	114/82 - 3.3.01	01.03.83	1983, 323	1079, 1199
T	115/82 - 3.3.01	01.03.83	1983, 323	1079
T	119/82 - 3.3.01	12.12.83	1984, 217	153, 227, 238, 239, 244, 315
T	123/82 - 3.3.01	30.08.85		70
T	128/82 - 3.3.01	12.01.84	1984, 164	135, 706, 707
T	130/82 - 3.2.01	26.08.83	1984, 172	796
T	146/82 - 3.5.01	29.05.85	1985, 267	773-775
T	150/82 - 3.3.01	07.02.84	1984, 309	269, 296, 298
T	152/82 - 3.3.01	05.09.83	1984, 301	644, 793, 797, 1166
T	161/82 - 3.5.01	26.06.84	1984, 551	113, 867-869, 884, 1051
T	162/82 - 3.5.01	20.06.87	1987, 533	264, 828, 830, 867, 884, 1196
T	172/82 - 3.4.01	19.05.83	1983, 493	450
T	181/82 - 3.3.01	28.02.84	1984, 401	124, 125, 129, 160, 175, 250, 251, 1220
T	184/82 - 3.3.01	04.01.84	1984, 261	177-179
T	191/82 - 3.2.01	16.04.85	1985, 189	607-610, 633, 634, 639
T	192/82 - 3.3.01	22.03.84	1984, 415	228, 250
<b>1983</b>				
T	2/83 - 3.3.01	15.03.84	1984, 265	173, 183, 185, 223, 226, 234, 235, 238, 315
T	4/83 - 3.3.01	16.03.83	1983, 498	116, 235
T	13/83 - 3.3.01	13.04.84	1984, 428	452
T	14/83 - 3.3.01	07.06.83	1984, 105	329, 340, 342
T	17/83 - 3.3.01	20.09.83	1984, 307	793

Table of cases

T	20/83 - 3.3.01	17.03.83	1983, 419	250, 869			
T	36/83 - 3.3.01	14.05.85	1986, 295	61, 135, 136, 156, 257			
T	49/83 - 3.3.01	26.07.83	1984, 112	37, 43			
T	66/83 - 3.5.01	06.06.89		869			
T	69/83 - 3.3.01	05.04.84	1984, 357	244, 250			
T	84/83 - 3.2.01	29.09.83		86, 91			
T	95/83 - 3.2.01	09.10.84	1985, 75	1128			
T	104/83 - 3.3.01	09.05.84		244			
T	115/83 - 3.3.01	08.11.83		272			
T	130/83 - 3.3.01	05.07.84		619			
T	140/83 - 3.2.01	24.10.83		305			
T	144/83 - 3.3.01	27.03.86	1986, 301	37, 57, 60, 61, 254, 256, 257			
T	160/83 - 3.2.01	19.03.84		470			
T	164/83 - 3.3.02	17.07.86	1987, 149	160, 253			
T	169/83 - 3.2.01	25.03.85	1985, 193	109, 178, 329, 374, 453			
T	170/83 - 3.3.01	12.09.84	1984, 605	650, 793, 997			
T	173/83 - 3.5.01	10.10.89	1987, 465	73, 93			
T	201/83 - 3.3.01	09.05.84	1984, 481	379, 412, 415-418			
T	202/83 - 3.3.01	06.03.84		304, 329			
T	204/83 - 3.3.01	24.06.85	1985, 310	109			
T	205/83 - 3.3.01	25.06.85	1985, 363	297, 389, 465, 696			
T	206/83 - 3.3.01	26.03.86	1987, 5	76, 113, 331, 696			
T	211/83 - 3.2.01	18.05.84	1986, 328	332, 447			
T	219/83 - 3.3.01	26.11.85	19 86, 211	296, 690, 694, 1052			
T	220/83 - 3.3.01	14.01.86	1986, 249	1097, 1098, 1100-1102, 1106			
<b>1984</b>							
T	6/84 - 3.3.01	21.02.85	1985, 238	332, 404			
T	13/84 - 3.5.01	15.05.86	1986, 253	173, 177, 178, 264, 265, 458			
T	32/84 - 3.5.01	06.08.85	1986, 9	329			
T	38/84 - 3.3.01	05.04.84	1984, 368	238			
T	42/84 - 3.4.01	23.03.87	1988, 251	750, 830, 831, 884, 1204			
T	57/84 - 3.3.01	12.08.86	1987, 53	236			
T	73/84 - 3.2.01	26.04.85	1985, 241	553, 974, 980, 1120			
T	81/84 - 3.3.02	15.05.87	1988, 207	58			
T	85/84 - 3.4.01	14.01.86		998, 1000, 1168			
T	87/84 - 3.2.01	06.02.86		280			
T	89/84 - 3.2.01	03.07.84	1984, 562	1124, 1188			
T	90/84 - 3.3.01	02.04.85		183			
T	92/84 - 3.4.01	05.03.87		280			
T	94/84 - 3.3.01	20.06.86	1986, 337	538, 539, 882, 1084			
T	106/84 - 3.2.01	25.02.85	1985, 132	249			
T	122/84 - 3.3.01	29.07.86	1987, 177	930			
T	124/84 - 3.3.01	16.01.86		175			
T	136/84 - 3.3.01	06.03.85		280			
T	142/84 - 3.2.01	08.07.86	1987, 112	235			
T	147/84 - 3.2.01	04.03.87		566, 1171			
T	156/84 - 3.4.01	09.04.87	1988, 372	777, 931, 935, 977			
T	163/84 - 3.3.02	21.08.86	1987, 301	232			
T	165/84 - 3.2.02	29.01.87		270			
T	166/84 - 3.3.01	22.08.84	1984, 489	1204, 1225			
T	167/84 - 3.2.02	20.01.87	1987, 369	102, 105, 108, 233, 996, 1001			
T	170/84 - 3.2.01	07.07.86	1986, 400	264			
T	171/84 - 3.3.01	24.10.85	1986, 95	76, 331			
T	175/84 - 3.5.01	22.09.87	1989, 71	224, 461			
T	176/84 - 3.2.01	22.11.85	1986, 50	193, 194			
T	178/84 - 3.5.01	07.12.87	1989, 157	310, 322			
T	184/84 - 3.3.01	04.04.86		373, 388			
T	185/84 - 3.2.01	08.04.86	1986, 373	1052			
T	186/84 - 3.3.01	18.12.85	1986, 79	980, 1120			
T	192/84 - 3.4.01	09.11.84	1985, 39	641			
T	193/84 - 3.3.01	22.01.85		100			
T	194/84 - 3.4.01	22.09.88	1990, 59	413			
T	195/84 - 3.2.01	10.10.85	1986, 121	193, 234, 546			
T	198/84 - 3.3.01	28.02.85	1985, 209	69, 116, 129-131, 134			

T 208/84 - 3.5.01	15.07.86	1987, 14	12, 13, 17, 19, 22, 24, 198, 200, 254, 255
T 215/84 - 3.3.01	10.09.84		157
T 225/84 - 3.2.01	16.07.86		234
T 237/84 - 3.5.01	31.07.86	1987, 309	269
T 249/84 - 3.2.01	21.01.85		784
T 258/84 - 3.2.01	18.07.86	1987, 119	933, 1170
T 264/84 - 3.4.01	07.04.88		980
T 269/84 - 3.4.01	07.04.87		264
T 270/84 - 3.3.01	01.09.87		248
T 271/84 - 3.3.01	18.03.86	1987, 405	247, 450, 477
T 273/84 - 3.3.01	21.03.86	1986, 346	931, 1170
T 279/84 - 3.3.02	29.06.87		297, 696
T 287/84 - 3.4.01	11.06.85	1985, 333	607, 613, 615, 617
T 288/84 - 3.3.01	07.02.86	1986, 128	332
<b>1985</b>			
T 17/85 - 3.3.01	06.06.86	1986, 406	129
T 22/85 - 3.5.01	05.10.88	1990, 12	3, 12, 30
T 25/85 - 3.3.01	18.12.85	1986, 81	1010, 1015, 1016
T 26/85 - 3.5.01	20.09.88	1990, 22	113, 131
T 32/85 - 3.3.01	05.06.86		331, 340
T 35/85 - 3.3.02	16.12.86		252
T 37/85 - 3.2.01	13.01.87	1988, 86	223
T 48/85 - 3.3.02	18.11.86		340
T 49/85 - 3.3.02	13.11.86		942
T 52/85 - 3.5.01	16.03.89		21
T 61/85 - 3.3.02	03.09.87		380, 381, 463
T 64/85 - 3.4.01	19.01.88		1122
T 66/85 - 3.5.01	09.12.87	1989, 167	448, 449
T 68/85 - 3.3.01	27.11.86	1987, 228	263, 271, 275, 286, 342
T 73/85 - 3.3.01	14.01.88		237
T 89/85 - 3.2.01	07.12.87		1162
T 98/85 - 3.3.01	01.09.87		474
T 99/85 - 3.4.01	23.10.86	1987, 413	176, 264
T 105/85 - 3.3.01	05.02.87		633, 636
T 110/85 - 3.2.02	26.11.87	1987, 157	633
T 115/85 - 3.5.01	05.09.88	1990, 30	17, 22, 33, 213, 219, 220
T 116/85 - 3.3.01	14.10.87	1989, 13	59, 254
T 121/85 - 3.5.01	14.03.89		5, 31
T 123/85 - 3.3.02	23.02.88	1989, 336	358, 974, 1039, 1120-1122, 1161
T 124/85 - 3.2.01	14.12.87		281, 358
T 127/85 - 3.3.02	01.02.88	1989, 271	356, 1045
T 133/85 - 3.2.01	25.08.87	1988, 441	284, 411, 413, 449
T 139/85 - 3.3.01	23.12.86		263, 276
T 144/85 - 3.2.01	25.06.87		226
T 149/85 - 3.3.01	14.01.86	1986, 103	649, 1094
T 152/85 - 3.2.01	28.05.86	1987, 191	793, 1014
T 153/85 - 3.3.01	11.12.86	1988, 1	115, 716, 1105, 1128, 1129, 1152
T 155/85 - 3.3.02	28.07.87	1988, 87	180, 236, 238, 239
T 157/85 - 3.2.01	12.05.86		980
T 163/85 - 3.5.01	14.03.89	1990, 379	19, 21, 31-33
T 168/85 - 3.4.01	27.04.87		264
T 171/85 - 3.2.01	30.07.86	1987, 160	897, 900
T 172/85 - 3.3.01	19.04.88		942
T 213/85 - 3.3.01	16.12.86	1987, 482	1097, 1098, 1100, 1102
T 219/85 - 3.2.01	14.07.86	1986, 376	333
T 222/85 - 3.3.02	21.01.87	1988, 128	749, 1019, 1020, 1027, 1071
T 226/85 - 3.3.02	17.03.87	1988, 336	329, 331, 334, 340
T 229/85 - 3.3.01	27.10.86	1987, 237	176, 249
T 231/85 - 3.3.01	08.12.86	1989, 74	149, 1201
T 235/85 - 3.3.01	22.11.88		886
T 244/85 - 3.3.02	23.01.87	1988, 216	1078, 1079
T 247/85 - 3.2.01	16.09.86		1073
T 248/85 - 3.3.01	21.01.86	1986, 261	116, 162, 229, 296
T 251/85 - 3.3.02	19.05.87		297
T 253/85 - 3.3.02	10.02.87		1172
T 260/85 - 3.5.01	09.12.87	1989, 105	402, 410
T 271/85 - 3.3.01	22.03.89	1988, 341	1187, 1222
T 284/85 - 3.5.01	24.11.89		495
T 291/85 - 3.3.01	23.07.87	1988, 302	115

Table of cases

T 292/85 - 3.3.02 27.01.88 1989, 275	276, 334, 338, 345, 356
T 293/85 - 3.3.02 27.01.88	276
<b>1986</b>	
T 6/86 - 3.3.01 23.12.87	1023
T 7/86 - 3.3.01 16.09.87 1988, 381	124, 125, 183
T 9/86 - 3.3.01 06.11.86 1988, 12	249
T 10/86 - 3.4.01 01.09.88	333
T 16/86 - 3.2.02 04.02.88 1989, 415	470
T 17/86 - 3.2.01 26.10.87 1989, 297	412
T 19/86 - 3.3.01 15.10.87 1989, 25	57, 141, 142
T 23/86 - 3.4.01 25.08.86 1987, 316	289-291, 1045
T 26/86 - 3.4.01 21.05.87 1988, 19	16, 199, 205
T 38/86 - 3.5.01 14.02.89 1990, 384	5, 8, 15, 29, 30, 202
T 48/86 - 3.4.01 12.01.88	244
T 49/86 - 3.2.02 17.09.87	996, 1000
T 55/86 - 3.2.01 15.03.88	243
T 57/86 - 3.3.01 19.05.88	190
T 58/86 - 3.2.01 26.04.89	509
T 63/86 - 3.2.01 10.08.87 1988, 224	1174
T 65/86 - 3.5.01 22.06.89	15
T 69/86 - 3.2.01 15.09.87	683, 692
T 73/86 - 3.2.02 07.12.88	100, 779
T 95/86 - 3.5.01 23.10.90	5, 30, 31, 211
T 109/86 - 3.5.01 20.07.87	796, 1166
T 113/86 - 3.3.01 28.10.87	489, 490, 1045
T 114/86 - 3.4.01 29.10.86 1987, 485	116
T 117/86 - 3.3.01 01.08.88 1989, 401	656, 934, 941, 982-984, 1001, 1003, 1168
T 120/86 - 3.2.02 12.07.88	264
T 137/86 - 3.4.01 08.02.88	264
T 162/86 - 3.3.02 07.07.87 1988, 452	177, 178
T 166/86 - 3.3.02 25.09.86 1987, 372	874, 876, 897
T 170/86 - 3.5.01 02.03.89	1171
T 175/86 - 3.3.02 06.11.90	124, 1046
T 177/86 - 3.2.01 09.12.87	413
T 186/86 - 3.5.01 05.12.89	30, 31
T 194/86 - 3.2.01 17.05.88	1024
T 197/86 - 3.3.02 04.02.88 1989, 371	178, 251, 679
T 200/86 - 3.3.02 29.09.87	304, 1174
T 219/86 - 3.2.02 03.07.87 1988, 254	1016
T 222/86 - 3.4.01 22.09.87	190
T 234/86 - 3.4.01 23.11.87 1989, 79	716, 718, 720, 721, 892, 1021, 1078, 1082, 1197, 1201
T 237/86 - 3.2.01 11.06.87 1988, 261	980, 981
T 243/86 - 3.2.01 09.12.86	684, 692
T 246/86 - 3.4.01 11.01.88 1989, 199	402
T 254/86 - 3.3.02 05.11.87 1989, 115	168, 236
T 263/86 - 3.4.01 08.12.87	237
T 275/86 - 3.3.01 03.10.90	1095
T 278/86 - 3.2.02 17.02.87	264
T 281/86 - 3.3.02 27.01.88 1989, 202	338, 344
T 283/86 - 3.3.02 17.03.89	355
T 287/86 - 3.4.01 28.03.88	79, 157
T 290/86 - 3.3.01 13.11.90 1992, 414	57, 59, 60, 110, 141, 142, 144
T 293/86 - 3.3.02 05.07.88	909
T 296/86 - 3.3.02 08.06.89	1174
T 299/86 - 3.3.02 23.09.87 1988, 88	276, 338, 344, 560, 562, 886
T 300/86 - 3.5.01 28.08.89	91, 97
T 303/86 - 3.3.01 08.11.88	110, 996
T 305/86 - 3.2.01 22.11.88	996
T 307/86 - 3.3.02 02.05.88	340
T 313/86 - 3.3.01 12.01.88	428
T 317/86 - 3.2.01 15.04.88 1989, 378	1017
T 322/86 - 3.3.01 11.02.88	176
T 329/86 - 3.2.01 02.02.89	1023
T 336/86 - 3.3.01 28.09.88	986
T 341/86 - 3.2.01 19.10.87	1174
T 345/86 - 3.3.02 17.10.89	695
T 349/86 - 3.2.01 29.04.88 1988, 345	960, 961
T 355/86 - 3.2.02 14.04.87	1102
T 365/86 - 3.2.02 26.01.89	250
T 378/86 - 3.2.02 21.10.87 1988, 386	474
T 385/86 - 3.4.01 25.09.87 1988, 308	37, 63



T 389/86 - 3.2.01	31.03.87	1988, 87	225, 1094	T 128/87 - 3.2.01	03.06.88	1989, 406	603, 683, 692, 700
T 390/86 - 3.3.01	17.11.87	1989, 30	744-746, 748, 749, 759, 760, 1057, 1200	T 133/87 - 3.4.01	23.06.88		1173, 1176, 1180
T 398/86 - 3.2.01	16.03.87		909	T 139/87 - 3.2.01	09.01.89	1990, 68	1110, 1151
T 406/86 - 3.3.01	02.03.88	1989, 302	89, 721, 1045, 1128	T 141/87 - 3.4.01	29.09.88		189-191, 226
T 416/86 - 3.4.01	29.10.87	1989, 309	437	T 145/87 - 3.2.01	28.02.90		454
T 420/86 - 3.3.02	12.01.89		463, 474	T 148/87 - 3.3.02	24.11.89		299
T 424/86 - 3.3.01	11.08.88		110	T 154/87 - 3.2.01	29.06.89		251
<b>1987</b>				T 155/87 - 3.2.01	07.02.90		933
T 4/87 - 3.2.01	19.05.88		264	T 162/87 - 3.5.01	08.06.89		100, 676
T 9/87 - 3.3.01	18.08.88	1989, 438	1054	T 166/87 - 3.3.01	16.05.88		620, 622, 623
T 11/87 - 3.3.01	14.04.88		633	T 170/87 - 3.3.01	05.07.88	1989, 441	112, 428, 455
T 16/87 - 3.4.01	24.07.90	1992, 212	289-291, 373, 695, 1045	T 172/87 - 3.2.01	12.01.89		358
T 19/87 - 3.4.01	16.04.87	1988, 268	558, 560, 561, 886, 1194, 1196	T 179/87 - 3.2.02	16.01.90		329
T 28/87 - 3.2.01	29.04.88	1989, 383	195	T 181/87 - 3.3.02	29.08.89		338, 355
T 29/87 - 3.3.02	19.09.90		249	T 193/87 - 3.2.01	13.06.91	1993, 207	649, 1000, 1025
T 35/87 - 3.3.02	27.04.87	1988, 134	306	T 198/87 - 3.3.02	21.06.88		1171
T 38/87 - 3.4.01	30.06.88		237	T 205/87 - 3.2.02	14.06.88		1171
T 44/87 - 3.2.01	23.05.89		249	T 213/87 - 3.2.02	08.07.90		228
T 51/87 - 3.3.02	08.12.88	1991, 177	76, 331	T 219/87 - 3.3.01	11.03.88		183
T 54/87 - 3.4.01	10.10.88		237	T 230/87 - 3.4.01	15.12.88		358
T 56/87 - 3.4.01	20.09.88	1990, 188	101, 109, 116, 226	T 239/87 - 3.3.02	11.02.88		355
T 59/87 - 3.3.01	14.08.90	1991, 561	108, 149, 236, 459	T 243/87 - 3.3.02	30.08.89		745, 759, 760, 1198
T 62/87 - 3.3.01	08.04.88		78	T 245/87 - 3.4.01	25.09.87	1989, 171	51, 56
T 65/87 - 3.2.02	18.09.90		227	T 256/87 - 3.3.02	26.07.88		336, 341, 358, 359, 362
T 77/87 - 3.3.01	16.03.89	1990, 280	111	T 261/87 - 3.3.01	16.12.86		228
T 81/87 - 3.3.02	24.01.89	1990, 250	334, 373, 375, 385, 386	T 262/87 - 3.5.01	06.04.89		244
T 85/87 - 3.3.01	21.07.88		125	T 269/87 - 3.3.02	24.01.89		272, 375
T 88/87 - 3.2.02	18.04.89		280, 562	T 293/87 - 3.3.01	23.02.89		100, 694
T 89/87 - 3.2.02	20.12.89		111	T 295/87 - 3.3.01	06.12.88	1990, 470	380, 1051, 1084, 1128
T 101/87 - 3.2.01	25.01.90		941-943, 982, 983	T 296/87 - 3.3.01	30.08.88	1990, 195	127, 240, 1039, 1120, 1161, 1162
T 105/87 - 3.3.01	25.02.88		1105, 1107	T 301/87 - 3.3.02	16.02.89	1990, 335	263, 334, 346, 356, 367, 375, 386, 392, 445, 1048
T 124/87 - 3.3.01	09.08.88	1989, 491	110, 115, 125, 126, 696				

Table of cases

T 302/87 - 3.3.02 30.01.90	236
T 305/87 - 3.2.02 01.09.89 1991, 429	104
T 315/87 - 3.2.01 14.02.89	249, 596, 598, 641, 1166
T 320/87 - 3.3.02 10.11.88 1990, 71	37, 43, 298
T 321/87 - 3.3.01 26.01.89	244
T 322/87 - 3.3.03 25.04.90	276
T 323/87 - 3.3.02 24.03.88 1989, 343	603, 649, 650, 1026, 1094, 1189
T 326/87 - 3.3.03 28.08.90 1992, 522	939, 983, 986, 1001, 1170, 1172
T 327/87 - 3.2.01 12.01.90	289, 291
T 328/87 - 3.2.01 04.04.91 1992, 701	1024, 1027, 1124
T 330/87 - 3.3.01 24.02.88	249
T 331/87 - 3.2.02 06.07.89 1991, 22	410, 411, 438, 448, 829
T 332/87 - 3.3.01 23.11.90	104, 116, 681
T 350/87 - 3.4.01 15.06.89	250
T 365/87 - 3.3.02 14.09.89	194
T 381/87 - 3.3.01 10.11.88 1990, 213	78, 100, 683, 694, 1128
T 383/87 - 3.3.02 26.04.89	559, 996
T 387/87 - 3.2.02 14.09.89	225
T 389/87 - 3.3.01 10.05.88	334
T 397/87 - 3.3.01 31.01.89	196
T 409/87 - 3.4.01 03.05.88	886
T 410/87 - 3.4.01 13.07.89	237, 244
T 415/87 - 3.3.01 27.06.88	980
T 416/87 - 3.3.01 29.06.89 1990, 415	293, 656, 982-984, 1001, 1170
T 417/87 - 3.2.01 17.08.89	485
T 433/87 - 3.3.01 17.08.89	562
T 434/87 - 3.2.02 05.09.89	297
T 438/87 - 3.2.01 09.05.89	1014
T 453/87 - 3.3.01 18.05.89	1020
T 454/87 - 3.4.01 02.08.89	194
T 459/87 - 3.3.01 18.11.88	694
T 460/87 - 3.3.01 20.06.89	190

**1988**

T 1/88 - 3.3.01 26.01.89	1028, 1093, 1098, 1100
T 3/88 - 3.3.02 06.05.88	486
T 7/88 - 3.2.02 08.09.89	998
T 18/88 - 3.3.02 25.01.90 1992, 107	232
T 22/88 - 3.5.01 22.11.91 1993, 143	1098
T 24/88 - 3.2.04 30.11.90	1045
T 26/88 - 3.3.01 07.07.89 1991, 30	639, 939, 1056, 1072, 1170, 1222
T 39/88 - 3.3.02 15.11.88 1989, 499	355
T 61/88 - 3.4.01 05.06.89	241
T 62/88 - 3.5.01 02.07.90	1045
T 73/88 - 3.3.01 07.11.89 1992, 557	373, 375, 1080, 1084
T 79/88 - 3.3.03 25.07.91	994
T 85/88 - 3.3.01 31.08.89	1093
T 87/88 - 3.2.01 29.11.91 1993, 430	310, 322, 1197
T 90/88 - 3.3.02 25.11.88	355
T 92/88 - 3.3.01 19.07.91	980
T 93/88 - 3.3.01 11.08.88	558, 1194
T 98/88 - 3.4.01 15.01.90	559, 869, 871, 886, 909, 1174
T 106/88 - 3.3.02 15.11.88	355
T 117/88 - 3.2.02 09.10.90	909
T 118/88 - 3.5.01 14.11.89	407
T 119/88 - 3.5.01 25.04.89 1990, 395	15, 204, 218
T 120/88 - 3.2.03 25.09.90	224
T 124/88 - 3.5.02 19.12.90	657, 676
T 129/88 - 3.3.03 10.02.92 1993, 598	280, 299, 1025, 1124
T 134/88 - 3.3.01 18.12.89	1022
T 136/88 - 3.2.02 11.10.89	412
T 140/88 - 3.4.01 13.02.90	1102
T 145/88 - 3.2.01 27.10.89 1991, 251	1096, 1098, 1102, 1106
T 153/88 - 3.3.03 09.01.91	81
T 155/88 - 3.3.01 14.07.89	721, 1039, 1201
T 158/88 - 3.4.01 12.12.89 1991, 566	205
T 162/88 - 3.2.02 09.07.90	909
T 171/88 - 3.2.02 07.05.90	297

T 182/88 - 3.3.01 03.11.88	1990, 287	761, 873, 876, 897, 1126		T 310/88 - 3.3.03 23.07.90	114
T 185/88 - 3.3.01 22.06.89	1990, 451	1022		T 312/88 - 3.3.01 29.01.91	341, 342
T 194/88 - 3.2.02 30.11.92		974, 975		T 315/88 - 3.4.01 11.10.89	225
T 197/88 - 3.3.02 02.08.88	1989, 412	533, 977, 1195		T 317/88 - 3.3.01 13.06.91	160
T 198/88 - 3.3.01 03.08.89	1991, 254	933, 1006, 1008		T 329/88 - 3.2.05 22.06.93	974
T 204/88 - 3.2.01 03.04.90		681		T 330/88 - 3.2.01 22.03.90	543, 952, 986
T 208/88 - 3.3.01 20.07.88	1992, 22	87, 149, 1197, 1224		T 344/88 - 3.3.03 16.05.91	560, 565, 1021
T 209/88 - 3.2.01 20.12.89		542, 543, 552, 1193, 1194		T 346/88 - 3.3.01 24.04.89	1187
T 212/88 - 3.3.01 08.05.90	1992, 28	331, 334, 338, 379, 764, 983, 1000, 1166		T 358/88 - 3.3.02 21.09.90	358
T 215/88 - 3.3.01 09.10.90		1170		T 361/88 - 3.2.01 21.06.90	276
T 223/88 - 3.5.01 06.07.90		620		T 365/88 - 3.3.02 05.08.91	485
T 225/88 - 3.3.01 10.08.90		1039		T 371/88 - 3.2.01 29.05.90	1992, 157 451, 467, 477
T 226/88 - 3.4.01 11.10.89		250		T 383/88 - 3.3.01 01.12.92	409, 414, 489, 694
T 227/88 - 3.3.02 15.12.88	1990, 292	1033, 1046, 1048		T 390/88 - 3.3.02 20.02.90	88, 89, 252
T 238/88 - 3.3.03 25.04.91	1992, 709	274, 289, 294, 334		T 392/88 - 3.3.01 06.03.90	244
T 241/88 - 3.2.01 20.02.90		109		T 416/88 - 3.5.01 31.05.90	289
T 245/88 - 3.2.01 12.03.91		87, 100		T 423/88 - 3.2.01 20.11.90	1174
T 248/88 - 3.4.01 14.11.89		1221		T 424/88 - 3.4.01 11.05.89	1052
T 249/88 - 3.3.01 14.02.89		185		T 426/88 - 3.2.02 09.11.90	1992, 427 195
T 251/88 - 3.3.01 14.11.89		732, 745, 746, 1177		T 429/88 - 3.2.03 25.09.90	264
T 254/88 - 3.3.01 10.10.89		1102		T 432/88 - 3.5.01 15.06.89	1102
T 261/88 - 3.5.02 16.02.93		733, 734, 736		T 444/88 - 3.3.03 09.05.90	78
T 265/88 - 3.4.01 07.11.89		437		T 446/88 - 3.2.02 28.11.90	233
T 271/88 - 3.3.02 06.06.89		269		T 451/88 - 3.2.01 15.01.90	109
T 274/88 - 3.2.01 06.06.89		1179		T 459/88 - 3.3.01 13.02.89	1990, 425 980, 1108
T 279/88 - 3.3.01 25.01.90		1020		T 461/88 - 3.2.03 17.04.91	1993, 295 89, 997
T 283/88 - 3.3.02 26.11.90		558, 560-562, 886, 1193		T 465/88 - 3.2.03 19.03.90	453
T 293/88 - 3.2.02 23.03.90	1992, 220	1054		T 466/88 - 3.3.02 12.02.91	238
T 295/88 - 3.3.01 12.06.89		191		T 472/88 - 3.3.03 10.10.90	458, 1046, 1048
T 297/88 - 3.3.01 05.12.89		1224		T 475/88 - 3.3.01 23.11.89	76, 77, 331, 341, 959, 960
T 309/88 - 3.3.01 28.02.90		619, 634		T 484/88 - 3.3.01 01.02.89	716, 721, 891, 1201
				T 493/88 - 3.4.01 13.12.89	1991, 380 754, 1196
				T 500/88 - 3.4.02 12.07.90	244
				T 501/88 - 3.2.02 30.11.89	1174
				T 508/88 - 3.4.01 20.07.89	249
				T 514/88 - 3.2.02 10.10.89	1992, 570 408
				T 522/88 - 3.3.01 19.12.89	640, 644
				T 523/88 - 3.2.01 26.02.91	453
				T 525/88 - 3.2.01 15.11.90	986, 998

Table of cases

T 527/88 - 3.2.01 11.12.90	408		
T 532/88 - 3.3.01 16.05.90	234		
T 536/88 - 3.2.01 14.01.91	1992, 638	933	
T 544/88 - 3.4.01 17.04.89	1990, 429	310	
T 547/88 - 3.2.02 19.11.93		563, 696	
T 550/88 - 3.3.01 27.03.90	1992, 117	72, 1023, 1040	
T 560/88 - 3.2.01 19.02.90		558, 1194	
T 572/88 - 3.3.01 27.02.91		107	
T 574/88 - 3.3.01 06.12.89		165	
T 580/88 - 3.4.01 25.01.90		331	
T 582/88 - 3.3.02 17.05.90		149, 987	
T 591/88 - 3.5.01 12.12.89		992	
T 598/88 - 3.3.01 07.08.89		542, 558, 560, 1187, 1193, 1201	
T 601/88 - 3.3.03 14.03.91		244	
T 609/88 - 3.3.03 10.07.90		897	
T 619/88 - 3.3.03 01.03.90		474	
T 626/88 - 3.2.02 16.05.90		1170	
T 627/88 - 3.3.03 04.07.90		676	
T 632/88 - 3.2.02 21.11.89		992	
T 635/88 - 3.2.03 28.02.92	1993, 608	1008, 1010	
T 640/88 - 3.3.03 14.12.90		485	
T 648/88 - 3.3.01 23.11.89	1991, 292	232	
<b>1989</b>			
T 2/89 - 3.3.02 03.07.89	1991, 51	1020	
T 3/89 - 3.3.02 14.02.90		123	
T 5/89 - 3.4.02 06.07.90	1992, 348	720, 1180	
T 14/89 - 3.3.02 12.06.89	1990, 432	522, 523, 526, 615, 617, 627	
T 16/89 - 3.3.02 24.01.90		367	
T 18/89 - 3.2.03 25.03.91		342	
T 21/89 - 3.3.01 27.06.90		1184, 1186	
T 38/89 - 3.3.03 21.08.90		1153	
T 40/89 - 3.3.03 05.05.93		252	
T 49/89 - 3.4.01 10.07.90		459, 470, 1172	
T 60/89 - 3.3.02 31.08.90	1992, 268	185, 191, 195, 330, 334, 1125	
T 65/89 - 3.2.04 05.12.90		264	
T 73/89 - 3.5.01 07.08.89		622	
T 76/89 - 3.3.02 10.10.89		875, 897	
T 78/89 - 3.4.01 23.01.90		1184	
T 79/89 - 3.2.01 09.07.90	1992, 283	716, 719, 901, 1186, 1218, 1221	
T 89/89 - 3.4.02 27.03.90		289, 1045	
T 93/89 - 3.3.03 15.11.90	1992, 718	78, 1024	
T 96/89 - 3.2.03 17.01.91		470	
T 99/89 - 3.2.01 05.03.91		190	
T 110/89 - 3.2.01 25.02.91		952	
T 112/89 - 3.2.04 04.10.90		626	
T 115/89 - 3.2.02 24.07.90		181	
T 118/89 - 3.2.03 19.09.90		413, 1220	
T 121/89 - 3.2.03 25.06.91		289, 291, 293	
T 122/89 - 3.4.01 05.02.91		358	
T 125/89 - 3.2.03 10.01.91		559, 996	
T 130/89 - 3.2.02 07.02.90	1991, 514	225, 228	
T 150/89 - 3.2.02 29.04.91		765, 766	
T 153/89 - 3.3.01 17.11.92		754, 909	
T 158/89 - 3.3.02 20.11.90		486	
T 160/89 - 3.4.01 13.11.90		1163	
T 164/89 - 3.4.02 03.04.90		933	
T 169/89 - 3.3.03 23.10.90		1099	
T 176/89 - 3.3.03 27.06.90		165	
T 182/89 - 3.3.01 14.12.89	1991, 391	334, 338, 362, 683, 695, 702, 1022, 1125	
T 183/89 - 3.2.01 30.07.90		761	
T 184/89 - 3.3.02 25.02.92		176	
T 194/89 - 3.5.02 04.12.90		289	
T 200/89 - 3.3.01 07.12.89	1992, 46	486	
T 205/89 - 3.2.02 21.08.91		1201	
T 210/89 - 3.5.01 20.10.89	1991, 433	603	
T 213/89 - 3.5.01 10.04.90		800	
T 227/89 - 3.3.03 25.09.91		179, 250	
T 228/89 - 3.2.01 25.11.91		870, 909	
T 231/89 - 3.3.02 14.06.91	1993, 13	476, 477	
T 232/89 - 3.2.03 03.12.91		1024	
T 237/89 - 3.2.03 02.05.91		941	
T 243/89 - 3.2.02 02.07.91		446, 867, 884	
T 249/89 - 3.2.02 15.07.91		305	
T 250/89 - 3.2.01 06.11.90	1992, 355	612, 1098	
T 253/89 - 3.2.04 07.02.91		909	
T 264/89 - 3.2.01 25.02.92		289	
T 268/89 - 3.2.02 06.02.92	1994, 50	173	

T 275/89 - 3.2.01 03.05.90	1992, 126	570, 991, 993, 1051, 1053		T 457/89 - 3.2.04 21.03.91	1080
T 279/89 - 3.3.03 03.07.91		129-131		T 472/89 - 3.2.03 25.06.91	289
T 288/89 - 3.2.04 15.01.92		441		T 476/89 - 3.2.01 10.09.91	289-291
T 291/89 - 3.3.02 14.05.91		933		T 482/89 - 3.5.02 11.12.90	1992, 646 90, 654, 657, 662, 663, 674, 676, 682, 1016
T 294/89 - 3.4.01 25.10.90		227		T 484/89 - 3.2.03 08.12.92	545, 933
T 299/89 - 3.3.03 31.01.91		1082		T 485/89 - 3.2.02 14.08.91	1993, 214 1277
T 300/89 - 3.3.01 11.04.90	1991, 480	297, 541, 831, 833, 867, 869, 871, 875, 876, 885, 1194		T 487/89 - 3.3.03 17.07.91	280, 356
T 323/89 - 3.3.02 24.09.90	1992, 169	656, 982, 983, 1001, 1003, 1168		T 488/89 - 3.2.01 21.06.91	485
T 324/89 - 3.3.02 13.06.91		1045		T 495/89 - 3.3.02 09.01.91	354
T 331/89 - 3.3.03 13.02.92		1161		T 496/89 - 3.3.01 21.02.91	953
T 338/89 - 3.2.03 10.12.90		779		T 500/89 - 3.3.01 26.03.91	119, 238
T 344/89 - 3.3.02 19.12.91		178-180		T 506/89 - 3.2.01 12.07.90	998
T 345/89 - 3.4.01 27.05.91		265		T 507/89 - 3.3.03 31.01.91	991, 992
T 352/89 - 3.3.03 15.01.91		560		T 516/89 - 3.3.02 19.12.90	1992, 436 770
T 365/89 - 3.3.01 10.04.91		173		T 519/89 - 3.3.03 05.05.92	244
T 366/89 - 3.2.02 12.02.92		228		T 520/89 - 3.2.01 19.02.90	645
T 386/89 - 3.2.01 24.03.92		177-179		T 523/89 - 3.2.01 01.08.90	157, 832, 1000
T 387/89 - 3.4.01 18.02.91	1992, 583	934		T 528/89 - 3.5.02 17.09.90	249
T 388/89 - 3.3.01 26.02.91		224		T 534/89 - 3.2.02 02.02.93	1994, 464 932, 952, 955, 986, 1065, 1102
T 392/89 - 3.2.01 03.07.90		1180		T 538/89 - 3.2.01 02.01.91	1024, 1025, 1051, 1197
T 396/89 - 3.3.03 08.08.91		584, 695, 1120		T 544/89 - 3.2.03 27.06.91	289, 290, 293
T 397/89 - 3.2.03 08.03.91		437		T 551/89 - 3.4.01 20.03.90	251
T 402/89 - 3.3.01 12.08.91		459, 472		T 552/89 - 3.4.01 27.08.91	229
T 404/89 - 3.2.01 09.04.91		1000		T 560/89 - 3.3.02 24.04.91	1992, 725 193, 933
T 411/89 - 3.3.02 20.12.90		299		T 561/89 - 3.2.04 29.04.91	942, 1052
T 418/89 - 3.3.02 08.01.91	1993, 20	276, 354		T 563/89 - 3.2.01 03.09.91	297, 959
T 423/89 - 3.3.01 10.06.92		299, 472		T 564/89 - 3.3.01 10.02.93	162, 179, 183, 184
T 424/89 - 3.2.01 22.08.91		249		T 565/89 - 3.2.03 26.09.90	289-291, 1045, 1172
T 426/89 - 3.4.01 28.06.90	1992, 172	282, 473, 474		T 571/89 - 3.2.02 22.05.90	415
T 430/89 - 3.3.01 17.07.91		289, 953, 957		T 580/89 - 3.3.03 29.08.91	1993, 218 777, 781, 782
T 435/89 - 3.3.02 10.06.92		329		T 588/89 - 3.2.03 15.01.92	934
T 448/89 - 3.4.01 30.10.90	1992, 361	1020		T 595/89 - 3.2.01 10.07.91	681
T 450/89 - 3.3.03 15.10.91		102, 104		T 596/89 - 3.4.01 15.12.92	982, 983
T 451/89 - 3.2.04 01.04.93		671, 800		T 603/89 - 3.4.01 03.07.90	1992, 230 5, 30, 33, 205
T 454/89 - 3.5.01 11.03.91		294			

Table of cases

T 604/89 - 3.4.02 14.01.92	1992, 240	189
T 606/89 - 3.3.01 18.09.90		165
T 611/89 - 3.3.01 10.10.91		332
T 614/89 - 3.2.03 11.06.92		577, 996-998, 1168
T 622/89 - 3.3.03 17.09.92		983
T 631/89 - 3.2.02 10.04.92		244
T 638/89 - 3.4.02 09.11.90		987, 1172
T 641/89 - 3.3.01 24.09.91		170, 171
T 665/89 - 3.2.03 17.07.91		802, 807, 1012, 1087
T 666/89 - 3.3.01 10.09.91	1993, 495	106, 110, 126, 131-133
T 668/89 - 3.3.03 19.06.90		560, 561, 1193
T 673/89 - 3.2.01 08.09.92		437, 467, 477
T 680/89 - 3.4.02 08.05.90		1197
T 682/89 - 3.5.01 17.08.93		1050, 1051
T 695/89 - 3.2.02 09.09.91	1993, 152	1007
T 702/89 - 3.2.01 26.03.92	1994, 472	603
T 707/89 - 3.3.01 15.04.91		276
T 716/89 - 3.3.02 22.02.90	1992, 132	1084, 1195
T 721/89 - 3.2.01 08.11.91		341
T 725/89 - 3.3.02 20.05.92		681, 1103
T 732/89 - 3.3.03 07.10.92		179, 250
T 735/89 - 3.5.02 09.01.92		264
T 737/89 - 3.2.04 07.12.92		986
T 743/89 - 3.3.03 27.01.92		79, 687, 688
T 754/89 - 3.2.03 24.04.91		243, 1024
T 760/89 - 3.2.02 06.09.93	1994, 797	663, 671, 674, 678, 771
T 762/89 - 3.2.01 28.09.92		974
T 763/89 - 3.3.01 10.07.91		107, 134
T 765/89 - 3.2.01 08.07.93		982, 987, 1000, 1001, 1168
T 767/89 - 3.2.03 16.04.91		194
T 772/89 - 3.3.02 18.10.91		76, 331
T 774/89 - 3.3.02 02.06.92		57, 62, 246
T 780/89 - 3.3.02 12.08.91	1993, 440	59
T 783/89 - 3.4.02 19.02.91		544, 545
T 784/89 - 3.4.02 06.11.90	1992, 438	438

T 789/89 - 3.2.01 11.01.93	1994, 482	977, 978, 1001
<b>1990</b>		
T 3/90 - 3.4.01 24.04.91	1992, 737	562, 565
T 5/90 - 3.3.03 27.11.92		473
T 12/90 - 3.3.01 23.08.90		110, 125
T 19/90 - 3.3.02 03.10.90	1990, 476	37, 40, 41, 45, 46, 258, 334, 335, 338, 346, 347, 362, 386, 702
T 23/90 - 3.3.01 18.09.91		114
T 30/90 - 3.3.03 13.06.91		617, 619
T 34/90 - 3.3.01 15.10.91	1992, 454	566, 616, 648, 751, 1065
T 37/90 - 3.2.02 01.10.92		472
T 42/90 - 3.2.01 25.02.91		565
T 47/90 - 3.3.01 20.02.90	1991, 486	1110, 1174
T 50/90 - 3.2.02 14.05.91		292, 1045
T 51/90 - 3.4.01 08.08.91		1157
T 54/90 - 3.3.03 16.06.93		472
T 55/90 - 3.2.01 05.05.92		1184, 1185
T 60/90 - 3.3.03 11.12.92		450
T 61/90 - 3.2.03 22.06.93		184
T 65/90 - 3.2.02 05.03.92		225
T 68/90 - 3.5.02 28.11.91		980
T 74/90 - 3.2.01 01.10.91		244
T 75/90 - 3.2.04 03.05.93		472, 1052
T 78/90 - 3.2.01 07.12.93		1023, 1024
T 82/90 - 3.3.02 23.07.92		100, 329
T 89/90 - 3.5.01 27.11.90	1992, 456	910, 1058, 1073
T 90/90 - 3.2.03 25.06.92		1102
T 95/90 - 3.3.01 30.10.92		226
T 97/90 - 3.3.01 13.11.91	1993, 719	939, 983, 1170, 1172-1174
T 110/90 - 3.5.01 15.04.93	1994, 557	16, 31
T 114/90 - 3.3.01 26.02.92		78
T 116/90 - 3.3.01 18.12.91		750, 764
T 130/90 - 3.3.02 28.02.91		298
T 132/90 - 3.2.03 21.02.94		371, 392
T 137/90 - 3.3.01 26.04.91		1180
T 144/90 - 3.2.02 03.12.91		227

T 154/90 - 3.2.04 19.12.91	1993, 505	994, 1003, 1102	T 332/90 - 3.4.01 08.10.91	235, 238
T 156/90 - 3.2.01 09.09.91		1082	T 338/90 - 3.3.03 21.10.93	991
T 157/90 - 3.3.02 12.09.91		437	T 343/90 - 3.3.01 26.05.92	419
T 166/90 - 3.2.02 11.08.92		476, 477, 490	T 345/90 - 3.2.04 26.02.92	225
T 172/90 - 3.3.02 06.06.91		253	T 347/90 - 3.2.04 19.02.93	980, 981
T 182/90 - 3.2.02 30.07.93	1994, 641	53, 54, 831, 1194	T 358/90 - 3.2.03 27.01.92	194
T 190/90 - 3.2.04 16.01.92		1050	T 362/90 - 3.2.01 13.10.92	213, 219
T 191/90 - 3.3.03 30.10.91		472	T 363/90 - 3.2.02 25.02.92	87, 676
T 194/90 - 3.3.01 27.11.92		978, 1093	T 366/90 - 3.3.01 17.06.92	131
T 195/90 - 3.4.02 20.06.90		1108	T 372/90 - 3.2.04 20.05.94	454
T 204/90 - 3.2.02 30.07.91		276	T 375/90 - 3.2.02 21.05.92	895, 897
T 210/90 - 3.2.04 25.05.93		1052	T 376/90 - 3.3.03 08.09.93	1994, 906
T 211/90 - 3.2.05 01.07.93		955, 956	T 390/90 - 3.3.01 15.12.92	1994, 808
T 217/90 - 3.3.01 21.11.91		1039	T 394/90 - 3.2.01 20.03.91	249
T 219/90 - 3.3.01 08.05.91		248	T 398/90 - 3.2.04 27.10.92	91
T 229/90 - 3.3.01 10.10.91		75, 939	T 400/90 - 3.4.02 03.07.91	388
T 231/90 - 3.2.04 25.03.93		986	T 401/90 - 3.3.02 04.02.92	157
T 233/90 - 3.3.02 08.07.92		103, 115	T 404/90 - 3.4.02 16.12.93	228
T 234/90 - 3.2.01 22.07.92		934	T 409/90 - 3.4.01 29.01.91	1993, 40
T 270/90 - 3.3.03 21.03.91	1993, 725	100, 669, 683, 684, 694, 700, 953, 955, 1152, 1157	T 424/90 - 3.4.01 11.12.91	190
T 273/90 - 3.3.01 10.06.91		1082	T 441/90 - 3.3.03 15.09.92	564
T 277/90 - 3.2.03 12.03.92		194	T 443/90 - 3.2.03 16.09.92	194
T 282/90 - 3.3.02 14.01.93		168	T 449/90 - 3.3.02 05.12.91	345, 358, 386
T 287/90 - 3.2.01 25.09.91		1102	T 453/90 - 3.2.03 26.01.93	282
T 288/90 - 3.3.03 01.12.92		116	T 456/90 - 3.5.02 25.11.91	200, 1165
T 290/90 - 3.4.01 09.10.90	1992, 368	796, 1055	T 469/90 - 3.4.01 06.02.91	178
T 292/90 - 3.3.02 16.11.92		751, 754	T 470/90 - 3.3.01 19.05.92	236
T 294/90 - 3.2.04 28.01.92		225	T 472/90 - 3.3.02 10.02.93	987
T 297/90 - 3.2.04 03.12.91		280, 356	T 483/90 - 3.2.03 14.10.92	1088, 1089
T 300/90 - 3.3.02 16.04.91		934	T 484/90 - 3.2.01 21.10.91	1993, 448
T 301/90 - 3.4.01 23.07.90		235	T 490/90 - 3.4.02 12.03.91	301, 903
T 303/90 - 3.3.02 04.02.92		157	T 493/90 - 3.3.02 10.12.91	297, 485
T 308/90 - 3.2.01 03.09.91		329, 453	T 494/90 - 3.3.02 14.06.91	560, 561
T 314/90 - 3.3.03 15.11.91		656, 663	T 496/90 - 3.2.01 10.12.92	410
T 315/90 - 3.4.02 18.03.91		607	T 503/90 - 3.3.03 13.10.93	983
T 317/90 - 3.3.03 23.04.92		1042	T 513/90 - 3.2.02 19.12.91	1994, 154
T 323/90 - 3.2.04 04.06.92		388	T 517/90 - 3.2.04 13.05.92	105, 108, 233
T 324/90 - 3.3.03 13.03.91	1993, 33	615, 616, 619, 623, 1188	T 522/90 - 3.4.02 08.09.93	1196
			T 525/90 - 3.3.02 17.06.92	700
			T 530/90 - 3.2.02 23.04.92	178, 458
			T 537/90 - 3.2.02 20.04.93	76, 77, 196
			T 547/90 - 3.5.01 17.01.91	178, 458
			T 553/90 - 3.2.03 15.06.92	1993, 666
			T 556/90 - 3.2.02 11.02.93	771, 958
				986, 987

Table of cases

T 562/90 - 3.2.02 30.10.92	110	T 717/90 - 3.2.01 10.07.91	224
T 565/90 - 3.3.01 15.09.92	116, 131	T 729/90 - 3.3.03 29.10.93	250, 1101, 1107, 1108
T 572/90 - 3.3.02 24.06.92	269	T 737/90 - 3.3.01 09.09.93	332, 333
T 582/90 - 3.2.01 11.12.92	658, 663, 678, 983, 1010	T 740/90 - 3.3.02 02.10.91	334, 364, 694
T 590/90 - 3.3.01 24.03.93	235	T 752/90 - 3.2.03 08.12.92	276
T 591/90 - 3.2.01 12.11.91	111	T 755/90 - 3.3.03 01.09.92	563, 983
T 594/90 - 3.2.01 07.06.95	392	T 760/90 - 3.4.02 24.11.92	295
T 595/90 - 3.2.02 24.05.93 1994, 695	76, 239, 748, 1165	T 762/90 - 3.4.02 29.11.91	271, 435, 472, 748, 1073, 1165
T 600/90 - 3.3.01 18.02.92	1024	T 766/90 - 3.3.02 15.07.92	558, 563, 1193
T 606/90 - 3.2.05 29.01.93	486	T 768/90 - 3.2.04 14.11.94	226
T 611/90 - 3.3.03 21.02.91 1993, 50	933, 939, 983, 986, 1002, 1103, 1104, 1170, 1172-1174	T 770/90 - 3.5.01 17.04.91	420
T 612/90 - 3.3.02 07.12.93	619	T 775/90 - 3.4.02 24.06.92	240
T 614/90 - 3.3.03 25.02.94	564	T 776/90 - 3.4.01 28.08.91	1000
T 621/90 - 3.5.01 22.07.91	1170	T 811/90 - 3.2.04 02.04.92 1993, 728	770, 779, 780, 1083
T 622/90 - 3.4.02 13.11.91	272	T 815/90 - 3.3.04 20.10.97	355
T 626/90 - 3.3.02 02.12.93	175, 180, 1154, 1163	T 816/90 - 3.3.02 07.09.93	186, 269, 355
T 628/90 - 3.5.01 25.11.91	957	T 830/90 - 3.2.01 23.07.93 1994, 713	92-94, 657, 676, 1025, 1124, 1163
T 629/90 - 3.5.02 04.04.91 1992, 654	978	T 833/90 - 3.3.03 19.05.94	1082
T 650/90 - 3.2.02 23.07.93	245	T 842/90 - 3.2.01 20.08.93	795
T 654/90 - 3.3.01 08.05.91	76, 331	T 850/90 - 3.2.01 10.06.92	265
T 656/90 - 3.4.01 13.11.91	167	T 852/90 - 3.3.01 02.06.92	1172
T 663/90 - 3.3.01 13.08.91	558, 562, 1193	T 853/90 - 3.5.01 11.09.91	629, 630
T 664/90 - 3.2.02 09.07.91	297	T 854/90 - 3.4.01 19.03.92 1993, 669	4, 12, 28, 255
T 665/90 - 3.3.02 23.09.92	364	T 855/90 - 3.2.03 16.05.95	875
T 666/90 - 3.3.02 28.02.94	555, 751, 1195	T 859/90 - 3.3.01 05.11.92	683
T 669/90 - 3.4.01 14.08.91 1992, 739	531, 533, 880, 1050	T 869/90 - 3.4.01 01.07.92	619, 642
T 676/90 - 3.2.04 14.07.93	403, 454	T 872/90 - 3.2.01 27.06.91	560, 877, 889, 1202
T 685/90 - 3.2.02 30.01.92	408, 437	T 876/90 - 3.5.02 05.12.91	986
T 686/90 - 3.2.03 21.06.93	14	T 877/90 - 3.3.02 28.07.92	81, 90, 91, 1024
T 689/90 - 3.4.01 21.01.92 1993, 616	404, 405	T 883/90 - 3.2.04 01.04.93	671, 800
T 690/90 - 3.2.03 15.05.92	1110	T 887/90 - 3.2.04 06.10.93	95, 1025, 1124
T 692/90 - 3.2.02 28.09.93	563	T 893/90 - 3.3.02 22.07.93	141-143, 276, 277, 1210, 1211
T 695/90 - 3.2.01 31.03.92	244		
T 705/90 - 3.2.01 15.07.91	936, 942, 1000		
T 711/90 - 3.3.02 15.09.93	288		



T 895/90 - 3.2.04 23.09.93	1052	T 126/91 - 3.2.01 12.05.92	329
T 896/90 - 3.2.03 22.04.94	1119	T 143/91 - 3.2.03 24.09.92	733
T 897/90 - 3.3.02 07.05.91	265	T 148/91 - 3.3.01 01.09.92	358
T 900/90 - 3.2.03 18.05.94	605, 607	T 153/91 - 3.2.01 09.09.93	472
T 901/90 - 3.3.02 23.09.93	1994, 556	T 158/91 - 3.3.02 30.07.91	346
T 905/90 - 3.3.01 13.11.92	1994, 306	T 166/91 - 3.2.04 15.06.93	565, 1170
	514, 528,	T 176/91 - 3.3.03 08.04.91	358, 633,
	651, 796,		784
	830	T 184/91 - 3.3.02 11.06.93	1174, 1218,
T 909/90 - 3.5.02 03.06.92	991		1224
T 910/90 - 3.2.04 14.04.93	172, 176	T 187/91 - 3.4.01 11.03.93	1994, 572
T 936/90 - 3.2.05 15.06.94	639		413, 415
T 938/90 - 3.3.03 25.03.92	472, 477	T 196/91 - 3.1.01 05.12.91	974
T 939/90 - 3.3.03 16.12.93	955	T 197/91 - 3.2.04 18.01.93	1195
T 952/90 - 3.2.02 23.11.92	289-291	T 204/91 - 3.3.01 22.06.92	1020
T 953/90 - 3.4.01 12.05.92	89, 90, 668	T 205/91 - 3.2.02 16.06.92	70
T 955/90 - 3.4.01 21.11.91	193	T 206/91 - 3.3.02 08.04.92	227
T 958/90 - 3.3.01 04.12.92	154	T 209/91 - 3.2.03 23.05.91	199
T 961/90 - 3.2.01 07.06.95	392	T 212/91 - 3.3.02 16.05.95	933, 944
T 969/90 - 3.4.01 12.05.92	89, 90	T 214/91 - 3.2.04 23.06.92	477
		T 221/91 - 3.2.01 08.12.92	96
<b>1991</b>		T 227/91 - 3.2.02 15.12.92	1994, 491
T 5/91 - 3.2.03 24.06.93	248		144, 146,
T 10/91 - 3.3.03 08.01.92	477		280
T 15/91 - 3.2.05 22.06.93	157	T 228/91 - 3.2.01 27.08.92	91
T 17/91 - 3.2.02 26.08.92	932, 955	T 234/91 - 3.3.02 25.06.93	196, 249
T 24/91 - 3.2.02 05.05.94	1995, 512	T 236/91 - 3.5.01 16.04.93	5
T 25/91 - 3.5.01 02.06.92	563, 1157	T 243/91 - 3.2.04 24.07.91	276
T 28/91 - 3.3.03 20.12.92	986	T 244/91 - 3.2.03 01.10.93	194
T 47/91 - 3.2.03 30.06.92	194	T 245/91 - 3.3.03 21.06.94	132
T 48/91 - 3.3.02 18.11.93	1157	T 246/91 - 3.3.01 14.09.93	176, 268
T 55/91 - 3.3.02 11.07.94	551	T 247/91 - 3.3.01 30.03.82	110, 130
T 60/91 - 3.2.01 05.10.92	1993, 551	T 248/91 - 3.3.02 20.06.91	630
T 71/91 - 3.5.01 21.09.93	5, 31	T 252/91 - 3.2.02 04.04.95	1209
T 75/91 - 3.2.03 11.01.93	1196	T 255/91 - 3.4.02 12.09.91	1993, 318
T 79/91 - 3.4.02 21.02.92	268, 869,		114, 132,
	1206		373
T 94/91 - 3.4.02 09.09.91	310, 317	T 257/91 - 3.4.01 17.11.92	248
T 102/91 - 3.5.02 11.10.91	1098	T 258/91 - 3.3.01 19.02.93	125
T 106/91 - 3.3.03 10.02.94	178	T 263/91 - 3.2.01 04.12.92	561, 562
T 107/91 - 3.2.05 06.12.93	340	T 267/91 - 3.3.02 28.04.93	96, 332,
T 108/91 - 3.2.01 17.09.92	1994, 228		358
T 109/91 - 3.3.02 15.01.92	683, 700	T 270/91 - 3.2.01 01.12.92	611
T 110/91 - 3.3.01 24.04.92	983	T 285/91 - 3.4.01 15.06.93	227
T 118/91 - 3.2.01 28.07.92	497, 509,	T 289/91 - 3.3.01 10.03.93	1994, 649
	903		176, 1009,
T 119/91 - 3.4.02 28.07.92	831, 1194		1010, 1026,
T 122/91 - 3.3.02 09.07.91	623		1108
T 125/91 - 3.2.04 03.02.92	1176	T 297/91 - 3.2.04 16.06.94	994
		T 304/91 - 3.2.02 15.12.93	869
		T 318/91 - 3.5.01 18.08.92	998

Table of cases

T 322/91 - 3.2.05 14.10.93	980	T 453/91 - 3.5.01 31.05.94	7, 30
T 327/91 - 3.5.01 19.11.93	90, 563, 657, 661, 676	T 455/91 - 3.3.02 20.06.94 1995, 684	188, 191, 192, 241
T 334/91 - 3.2.01 09.02.93	987	T 456/91 - 3.3.03 03.11.93	275, 289, 294, 334, 357
T 349/91 - 3.4.02 10.03.93	350	T 459/91 - 3.2.03 06.06.95	1153
T 360/91 - 3.3.03 01.06.93	1196	T 462/91 - 3.2.02 05.07.94	90
T 367/91 - 3.5.01 14.12.92	1196	T 470/91 - 3.3.01 11.05.92 1993, 680	306
T 369/91 - 3.3.01 15.05.92 1993, 561	132, 618, 1039, 1166	T 473/91 - 3.5.01 09.04.92 1993, 630	639, 743, 1109, 1111
T 375/91 - 3.3.03 17.11.94	955	T 478/91 - 3.2.01 02.06.93	246, 248
T 384/91 - 3.4.02 27.09.94 1995, 745	475, 479, 480	T 485/91 - 3.2.04 25.04.94	235
T 388/91 - 3.4.01 12.10.93	276	T 487/91 - 3.5.01 22.01.93	340
T 391/91 - 3.3.02 22.11.93	272, 276, 277, 329	T 492/91 - 3.3.01 04.01.94	305
T 392/91 - 3.2.05 24.06.93	1078, 1196	T 495/91 - 3.3.01 20.07.93	165, 166, 176, 181
T 393/91 - 3.3.02 12.10.94	275, 423	T 497/91 - 3.2.02 30.06.92	373
T 395/91 - 3.3.04 07.12.95	660	T 500/91 - 3.3.02 21.10.92	188, 191
T 406/91 - 3.3.01 22.10.92	363, 364	T 506/91 - 3.3.02 03.04.92	717, 1065, 1078
T 407/91 - 3.3.01 15.04.93	226	T 508/91 - 3.2.04 28.01.93	120
T 408/91 - 3.3.02 23.11.93	1000	T 515/91 - 3.2.03 23.04.93	244
T 409/91 - 3.3.01 18.03.93 1994, 653	160, 272, 273, 284-286, 334, 335, 344, 356, 357, 683	T 516/91 - 3.3.03 14.01.92	630
T 410/91 - 3.2.03 13.10.93	225, 455	T 518/91 - 3.4.01 29.09.92	107
T 411/91 - 3.3.02 10.11.93	1165	T 522/91 - 3.3.03 18.11.93	288
T 412/91 - 3.2.02 27.02.96	102, 111	T 523/91 - 3.3.03 29.03.93	275, 831, 1194
T 413/91 - 3.3.02 25.06.92	612	T 525/91 - 3.2.01 25.03.92	618
T 415/91 - 3.5.02 13.05.92	402, 410	T 532/91 - 3.5.01 05.07.93	534, 1050, 1051
T 418/91 - 3.3.02 23.08.94	335, 357, 363	T 545/91 - 3.5.01 28.04.93	1020
T 420/91 - 3.2.05 17.03.93	1124	T 548/91 - 3.3.02 07.02.94	230, 335, 357, 363, 1010
T 435/91 - 3.3.01 09.03.94 1995, 188	160, 284, 285, 335, 343, 356, 357	T 552/91 - 3.3.01 03.03.94 1995, 100	297, 298, 452
T 438/91 - 3.3.04 17.10.94	57, 60	T 555/91 - 3.3.02 05.05.93	247
T 439/91 - 3.2.02 21.07.91	1050	T 563/91 - 3.2.01 01.03.93	1101, 1105, 1107
T 440/91 - 3.3.01 22.03.94	173, 179	T 566/91 - 3.3.02 18.05.94	234, 545
T 441/91 - 3.4.01 18.08.92	116, 392, 1024, 1125	T 570/91 - 3.2.04 26.11.93	165, 166, 168, 1052
T 442/91 - 3.3.02 23.06.94	116, 295	T 574/91 - 3.3.02 03.08.93	1101, 1107
T 452/91 - 3.3.03 05.07.95	278, 712	T 576/91 - 3.3.02 18.05.93	89
		T 581/91 - 3.3.03 04.08.93	489, 490
		T 582/91 - 3.2.01 11.11.92	373, 441

T 601/91 - 3.3.01 27.07.93	695	T 729/91 - 3.2.04 21.11.94	92, 100
T 602/91 - 3.3.02 13.09.94	96, 97, 1024	T 731/91 - 3.2.03 03.05.95	176
T 605/91 - 3.2.03 20.07.93	247	T 734/91 - 3.5.01 07.04.92	883, 1195
T 606/91 - 3.2.03 27.07.93	289	T 740/91 - 3.3.03 15.12.93	452
T 613/91 - 3.2.03 05.10.93	1088	T 741/91 - 3.3.01 22.09.93	175, 176, 953
T 617/91 - 3.2.02 22.01.97	246	T 746/91 - 3.5.01 20.10.93	1174
T 621/91 - 3.2.03 28.09.94	1020, 1027, 1051, 1196	T 748/91 - 3.2.01 23.08.93	110, 455, 563
T 622/91 - 3.4.02 01.02.94	72	T 757/91 - 3.2.03 10.03.92	1184, 1185
T 623/91 - 3.3.01 16.02.93	271	T 759/91 - 3.3.03 18.11.93	288
T 624/91 - 3.2.02 16.06.93	107	T 766/91 - 3.3.02 29.09.93	75, 77, 195, 331
T 628/91 - 3.5.02 14.09.92	410, 411	T 769/91 - 3.2.01 29.03.94	1054, 1176
T 631/91 - 3.4.01 27.01.93	1093	T 770/91 - 3.3.02 29.04.92	662, 700
T 632/91 - 3.3.01 01.02.94	196, 1093	T 773/91 - 3.2.05 25.03.92	1168, 1189
T 634/91 - 3.2.02 31.05.94	94, 1025, 1124	T 784/91 - 3.5.01 22.09.93	1165
T 640/91 - 3.4.01 29.09.93	1994, 918 762, 871, 874, 935, 1126, 1195	T 785/91 - 3.3.03 05.03.93	720
T 643/91 - 3.3.03 18.09.96	1084	T 795/91 - 3.5.01 02.11.92	558, 563, 1193
T 645/91 - 3.3.01 13.07.93	115	T 796/91 - 3.3.03 27.01.93	283
T 651/91 - 3.2.01 18.02.93	120, 832	T 799/91 - 3.2.01 03.02.94	94
T 653/91 - 3.4.01 24.09.92	567	T 800/91 - 3.3.04 20.07.95	176
T 656/91 - 3.3.02 27.09.94	252	T 810/91 - 3.3.01 04.09.92	276
T 658/91 - 3.3.01 14.05.93	110, 125	T 822/91 - 3.4.02 19.01.93	276
T 660/91 - 3.4.01 23.07.93	237	T 830/91 - 3.3.02 15.09.94	1994, 728 869
T 674/91 - 3.2.03 30.11.94	658, 661, 685	T 833/91 - 3.5.01 16.04.93	5, 20, 33
T 677/91 - 3.4.01 03.11.92	102, 104, 105, 248	T 834/91 - 3.3.03 31.08.93	165
T 682/91 - 3.4.02 22.09.92	533, 975, 1191	T 842/91 - 3.2.03 11.05.93	80, 92
T 685/91 - 3.3.03 05.01.93	955, 986	T 843/91 - 3.3.01 17.03.93	1994, 818 693, 736, 826, 827, 1165, 1166, 1185, 1186
T 686/91 - 3.3.01 30.06.94	165, 166	T 852/91 - 3.3.01 06.06.94	230
T 688/91 - 3.5.01 21.04.93	265, 275, 282	T 856/91 - 3.4.02 08.10.92	752-754
T 690/91 - 3.3.04 10.01.96	1184	T 857/91 - 3.2.03 16.11.93	109
T 691/91 - 3.2.02 29.07.92	1209	T 862/91 - 3.2.04 17.03.93	244
T 697/91 - 3.3.01 20.04.94	358	T 867/91 - 3.3.01 12.10.93	1088
T 699/91 - 3.2.04 21.05.93	247	T 869/91 - 3.5.02 06.08.92	1103
T 701/91 - 3.2.02 04.10.93	225	T 875/91 - 3.5.02 10.03.93	986, 987
T 706/91 - 3.2.01 15.12.92	647, 1098	T 879/91 - 3.3.03 08.12.93	472
T 715/91 - 3.5.01 24.03.92	619, 633, 635	T 880/91 - 3.4.02 26.04.93	1195
T 716/91 - 3.2.04 15.05.95	528	T 881/91 - 3.2.01 04.02.93	1172
T 727/91 - 3.3.01 11.08.93	1093	T 882/91 - 3.2.01 04.01.93	986
		T 886/91 - 3.3.02 16.06.94	188, 191, 265
		T 891/91 - 3.4.02 16.03.93	194

Table of cases

T 894/91 - 3.3.01 16.06.92	276
T 898/91 - 3.3.04 18.07.97	1084, 1113
T 904/91 - 3.3.01 18.01.95	115
T 905/91 - 3.4.02 05.10.93	996
T 907/91 - 3.2.03 08.10.93	882
T 908/91 - 3.2.02 16.11.93	871, 1212
T 912/91 - 3.3.02 25.10.94	471, 549
T 919/91 - 3.4.01 15.02.93	1174
T 924/91 - 3.2.04 04.08.93	565
T 925/91 - 3.4.02 26.04.94	1995, 469 1020, 1027, 1092, 1093, 1200
T 931/91 - 3.3.03 20.04.93	340
T 934/91 - 3.3.01 04.08.92	1994, 184 1003, 1071, 1183
T 938/91 - 3.2.03 21.09.93	1103
T 939/91 - 3.3.04 05.12.94	732, 745, 746, 1177, 1201
T 942/91 - 3.3.02 09.02.94	115
T 951/91 - 3.3.03 10.03.94	1995, 202 734, 780, 782, 932, 941, 942, 953, 1152
T 955/91 - 3.4.01 04.02.93	1152
T 957/91 - 3.3.03 29.09.94	379
T 958/91 - 3.3.02 25.03.84	93
T 962/91 - 3.5.02 21.04.93	15
T 968/91 - 3.3.03 12.01.94	695
T 985/91 - 3.2.04 23.03.94	955
T 986/91 - 3.2.03 06.11.95	113
T 988/91 - 3.2.01 29.06.93	1024
T 990/91 - 3.3.01 25.05.92	485, 533, 1191
<b>1992</b>	
T 1/92 - 3.3.02 27.04.92	1993, 685 889, 1066, 1079
T 3/92 - 3.2.03 03.06.94	1103
T 6/92 - 3.3.01 26.10.93	1168, 1169
T 18/92 - 3.5.02 30.04.93	981
T 26/92 - 3.2.02 27.01.94	982, 996
T 27/92 - 3.2.01 25.07.94	1994, 853 971
T 28/92 - 3.3.02 09.06.94	472, 1160
T 35/92 - 3.2.01 28.10.92	563, 1193
T 42/92 - 3.4.01 29.11.94	105
T 44/92 - 3.2.02 15.04.94	590
T 62/92 - 3.2.04 20.06.94	296
T 65/92 - 3.3.02 13.06.93	375, 379
T 77/92 - 3.2.02 13.10.95	5
T 81/92 - 3.5.02 05.07.93	987, 996
T 92/92 - 3.2.01 21.09.93	181, 938
T 104/92 - 3.3.04 06.08.96	241
T 110/92 - 3.2.03 12.10.94	247
T 111/92 - 3.5.01 27.07.94	619, 642
T 112/92 - 3.3.02 04.08.92	1994, 192 236
T 113/92 - 3.3.01 17.12.92	875, 1184, 1185
T 117/92 - 3.2.01 02.12.93	943
T 127/92 - 3.2.01 14.12.94	375, 392
T 128/92 - 3.3.04 30.11.94	89
T 131/92 - 3.3.03 03.03.94	379
T 132/92 - 3.3.02 06.08.96	1041
T 133/92 - 3.3.01 18.10.94	125, 126, 549
T 148/92 - 3.2.03 13.09.94	1163
T 160/92 - 3.4.02 27.01.94	1995, 387 81, 514, 520, 693, 878, 885
T 164/92 - 3.5.01 29.04.93	1995, 305 101, 190
T 182/92 - 3.3.03 06.04.93	1197
T 188/92 - 3.3.02 15.12.92	1102
T 189/92 - 3.2.04 07.10.92	194, 779
T 196/92 - 3.3.01 15.11.94	405
T 199/92 - 3.3.01 11.01.94	1009, 1020
T 201/92 - 3.3.03 18.07.95	935, 942
T 202/92 - 3.3.01 19.07.94	550
T 219/92 - 3.5.01 18.11.93	1103
T 223/92 - 3.3.02 20.07.93	186, 188, 191, 352, 354
T 227/92 - 3.4.02 01.07.93	813
T 229/92 - 3.2.04 23.08.94	1103
T 230/92 - 3.2.02 16.05.93	660, 695
T 234/92 - 3.2.03 12.01.95	1157
T 238/92 - 3.2.01 13.05.93	935, 943
T 239/92 - 3.2.05 23.02.95	700, 1188
T 242/92 - 3.3.02 26.05.93	334, 357
T 248/92 - 3.5.02 31.05.93	546
T 253/92 - 3.5.02 22.10.93	241, 1165
T 255/92 - 3.5.02 09.09.92	1183
T 266/92 - 3.5.01 17.10.94	1082
T 267/92 - 3.3.03 04.06.96	88, 932, 983
T 272/92 - 3.2.01 16.08.95	109

## Table of cases

T 273/92 - 3.3.03 18.08.93	165, 246, 1093	T 461/92 - 3.4.02 05.07.94	244
T 281/92 - 3.4.02 06.11.92	276	T 465/92 - 3.2.02 14.10.94 1996, 32	101, 105, 163
T 288/92 - 3.3.01 18.11.93	409, 414, 445, 1183	T 469/92 - 3.2.02 09.09.94	373, 374, 1193, 1219
T 292/92 - 3.3.02 06.09.96	252	T 472/92 - 3.3.03 20.11.96 1998, 161	80, 88, 98, 100, 655, 683-685, 687, 695
T 304/92 - 3.5.01 23.06.93	1166	T 473/92 - 3.5.01 10.03.95	590
T 315/92 - 3.5.01 27.04.93	952	T 482/92 - 3.3.01 23.01.97	165
T 321/92 - 3.5.02 13.01.93	189	T 484/92 - 3.3.03 30.12.93	286, 357
T 327/92 - 3.3.04 22.04.97	165, 546, 1112, 1125	T 492/92 - 3.3.01 18.01.96	338, 342
T 330/92 - 3.2.04 10.02.94	245, 246	T 494/92 - 3.3.03 13.06.93	565
T 334/92 - 3.3.01 23.03.94	171, 176	T 501/92 - 3.4.01 01.06.95 1996, 261	550, 1065
T 340/92 - 3.2.01 05.10.94	1076	T 503/92 - 3.3.03 17.03.94	358
T 341/92 - 3.3.01 30.08.94 1995, 373	549	T 506/92 - 3.4.01 03.08.95	250, 251
T 347/92 - 3.3.02 23.09.94	245	T 511/92 - 3.2.02 27.05.93	101, 102, 104, 105
T 359/92 - 3.2.01 25.03.93	373	T 526/92 - 3.3.01 25.10.94	418
T 366/92 - 3.5.02 18.02.93	831, 886, 1183, 1194	T 527/92 - 3.5.01 24.01.94	756
T 367/92 - 3.3.03 22.08.96	444	T 536/92 - 3.2.04 29.11.93	1206, 1207
T 371/92 - 3.3.03 02.12.93 1995, 324	750, 890, 1071, 1095, 1188	T 540/92 - 3.3.03 01.03.95	246
T 378/92 - 3.2.01 13.01.94	265	T 541/92 - 3.2.01 25.01.94	95, 1009, 1024
T 382/92 - 3.2.04 26.11.92	732, 745, 746, 1072, 1177, 1200	T 543/92 - 3.3.03 13.06.94	555, 1194, 1195
T 392/92 - 3.5.02 21.01.93	1195	T 555/92 - 3.3.02 15.11.95	297
T 398/92 - 3.3.02 12.11.96	454	T 574/92 - 3.4.01 17.03.95	227
T 406/92 - 3.3.02 18.01.95	1024	T 578/92 - 3.4.01 02.02.94	234
T 410/92 - 3.5.02 20.09.93	228	T 585/92 - 3.3.02 09.02.95 1996, 129	73, 74, 700, 703
T 418/92 - 3.2.03 10.03.92	282	T 588/92 - 3.4.01 18.03.94	1196
T 422/92 - 3.4.02 21.02.95	115	T 597/92 - 3.3.01 01.03.95 1996, 135	373
T 426/92 - 3.4.01 03.03.94	251	T 598/92 - 3.4.01 07.12.93	1166
T 432/92 - 3.2.01 28.01.94	982, 994	T 599/92 - 3.4.01 25.04.94	875, 1174
T 436/92 - 3.3.02 20.03.95	74	T 601/92 - 3.2.04 20.04.95	472, 1210
T 439/92 - 3.2.04 16.05.94	165, 168, 169, 289, 291, 296	T 605/92 - 3.2.01 25.04.94	998
T 441/92 - 3.5.01 10.03.95	493, 495, 497, 879	T 612/92 - 3.3.04 28.02.96	335, 345, 346, 352
T 446/92 - 3.3.01 28.03.95	1052	T 627/92 - 3.5.02 30.03.93	978
T 447/92 - 3.5.02 07.07.93	71, 104, 114, 115	T 630/92 - 3.3.02 22.02.94	234
T 453/92 - 3.3.01 20.12.94	244	T 631/92 - 3.3.03 11.05.95	132
T 455/92 - 3.2.04 05.10.93	281	T 637/92 - 3.2.02 21.11.95	157
T 457/92 - 3.5.01 26.09.94	1170	T 645/92 - 3.3.01 12.04.94	162, 184
		T 646/92 - 3.3.02 13.09.94	1102
		T 654/92 - 3.5.01 03.05.94	74

Table of cases

T 656/92 - 3.3.01 04.05.95	415	T 832/92 - 3.5.01 23.06.94	1054
T 657/92 - 3.3.04 06.09.94	116	T 838/92 - 3.2.01 10.01.95	586, 587, 656, 658, 672, 674, 676, 700, 993, 1072, 1084
T 659/92 - 3.2.02 24.10.94 1995, 519	959, 960, 962, 963, 1168	T 856/92 - 3.4.02 08.02.95	550, 1114
T 667/92 - 3.3.02 10.03.94	615, 617, 638, 782	T 861/92 - 3.3.02 01.02.93	304, 316
T 675/92 - 3.4.01 10.11.93	194	T 867/92 - 3.5.02 13.04.94 1995, 126	983, 984
T 684/92 - 3.2.01 25.07.95	971	T 870/92 - 3.2.05 20.07.99	958, 964, 1015, 1016
T 686/92 - 3.5.01 28.10.93	563, 1193	T 879/92 - 3.5.01 16.03.94	562, 563
T 694/92 - 3.3.04 08.05.96 1997, 408	176, 186, 187, 195, 231, 272, 330, 334, 335, 345-347, 352	T 881/92 - 3.3.03 22.04.96	176
T 697/92 - 3.2.02 15.06.94	233	T 882/92 - 3.3.03 22.04.96	176
T 703/92 - 3.2.04 14.09.95	788	T 884/92 - 3.3.03 22.04.96	176
T 712/92 - 3.3.04 19.06.95	248, 249	T 887/92 - 3.5.01 19.04.94	213
T 714/92 - 3.2.04 18.09.92	744	T 890/92 - 3.2.01 12.07.94	550
T 715/92 - 3.3.02 10.02.94	1039	T 892/92 - 3.3.01 24.06.93 1994, 664	533, 540, 566, 880, 1054, 1195
T 720/92 - 3.3.03 31.05.94	276	T 896/92 - 3.2.01 28.04.94	109, 1000
T 737/92 - 3.3.03 12.06.95	781, 1027, 1029, 1119	T 910/92 - 3.4.02 17.05.95	902
T 739/92 - 3.3.03 16.07.96	97	T 917/92 - 3.3.01 06.05.93	358
T 741/92 - 3.2.02 21.06.94	235	T 918/92 - 3.2.02 08.12.94	996
T 745/92 - 3.4.01 08.06.94	228, 229	T 920/92 - 3.4.02 19.10.95	332
T 753/92 - 3.2.03 04.04.95	1000, 1004	T 923/92 - 3.3.04 08.11.95 1996, 564	186, 335, 346, 375, 382, 383
T 758/92 - 3.2.01 20.05.94	450	T 930/92 - 3.4.01 19.10.94 1996, 191	567, 990, 1001, 1003
T 766/92 - 3.4.01 14.05.96	250	T 931/92 - 3.3.03 10.08.93	104
T 769/92 - 3.5.01 31.05.94 1995, 525	5, 6, 8, 9, 20, 21, 199	T 933/92 - 3.4.01 06.12.93 1994, 740	1123
T 771/92 - 3.3.01 19.07.95	549	T 939/92 - 3.3.01 12.09.95 1996, 309	75, 77, 160, 161, 175, 176, 181, 183, 196, 231, 239, 241, 242, 252, 271, 284, 285, 330, 339, 683, 916
T 782/92 - 3.2.01 22.06.94	92, 96, 684, 687	T 943/92 - 3.2.04 10.04.95	244
T 785/92 - 3.3.02 14.12.95	281		
T 790/92 - 3.5.01 29.10.93	22, 33		
T 792/92 - 3.4.01 29.11.93	718		
T 793/92 - 3.2.04 16.07.93	867		
T 795/92 - 3.3.02 23.04.96	490		
T 798/92 - 3.4.01 28.07.94	234		
T 802/92 - 3.4.01 22.07.94 1995, 379	450		
T 804/92 - 3.5.02 08.09.93 1994, 862	677		
T 812/92 - 3.2.01 21.11.95	249		
T 820/92 - 3.3.02 11.01.94 1995, 113	52, 57-60		
T 831/92 - 3.4.01 13.12.94	1128, 1136		

T 951/92 - 3.4.01 15.02.95 1996, 53	534, 751, 871, 881, 883, 1036, 1195
T 952/92 - 3.4.01 17.08.94 1995, 755	83, 88, 89, 109
T 955/92 - 3.3.02 26.09.95	486
T 957/92 - 3.3.01 21.12.93	176, 246
T 964/92 - 3.3.01 23.08.94	171
T 965/92 - 3.3.02 08.08.95	75
T 968/92 - 3.2.03 28.07.94	1120
T 969/92 - 3.2.02 31.03.95	103
T 971/92 - 3.3.01 07.09.94	234
T 973/92 - 3.2.01 06.12.93	980
T 986/92 - 3.2.01 28.09.94	246
T 996/92 - 3.3.01 23.03.93	1082
T 1000/92 - 3.3.01 11.05.94	171
T 1002/92 - 3.4.01 06.07.94 1995, 605	931-933, 935, 942, 944, 956, 983, 1035
T 1011/92 - 3.2.03 16.09.94	971
T 1014/92 - 3.3.01 10.01.95	247
T 1019/92 - 3.2.01 09.06.94	932, 952, 1019, 1028
T 1032/92 - 3.4.01 23.08.94	1174
T 1037/92 - 3.4.01 29.08.96	194
T 1042/92 - 3.2.04 28.10.93	1110
T 1045/92 - 3.3.03 21.10.93	289, 1195
T 1048/92 - 3.3.01 05.12.94	127
T 1049/92 - 3.2.03 10.11.94	1196
T 1050/92 - 3.2.02 20.11.95	385
T 1051/92 - 3.2.01 26.04.94	1200
T 1054/92 - 3.2.02 20.06.96	97, 376, 683
T 1055/92 - 3.5.01 31.03.94 1995, 214	272, 273, 284, 360
T 1059/92 - 3.5.01 21.09.93	1153
T 1063/92 - 3.3.03 15.10.93	1184, 1185
T 1066/92 - 3.3.02 05.07.95	1028
T 1067/92 - 3.4.01 16.07.94	1174
T 1072/92 - 3.2.03 28.06.94	243
T 1077/92 - 3.2.02 05.12.95	246
T 1085/92 - 3.5.02 10.11.94	91, 93
T 1096/92 - 3.3.03 16.05.94	235
T 1097/92 - 3.3.03 27.09.93	1110
T 1101/92 - 3.3.02 13.06.96	1195, 1210
T 1105/92 - 3.2.04 21.01.94	169
<b>1993</b>	
T 15/93 - 3.3.01 07.11.95	161
T 26/93 - 3.5.02 16.12.94	1184
T 28/93 - 3.2.03 07.07.94	1025, 1108
T 33/93 - 3.3.01 05.05.93	534, 909
T 39/93 - 3.3.03 14.02.96 1997, 134	162, 173, 177, 178, 188, 577, 666, 713
T 51/93 - 3.3.04 08.06.94	141, 144
T 55/93 - 3.2.02 15.03.95	224
T 63/93 - 3.2.02 28.07.93	869
T 68/93 - 3.3.01 24.01.95	110
T 71/93 - 3.4.02 01.06.93	107, 108
T 74/93 - 3.3.01 09.11.94 1995, 712	58, 256
T 81/93 - 3.2.04 12.04.95	720
T 82/93 - 3.4.01 15.05.95 1996, 274	56, 474, 1224
T 83/93 - 3.4.01 02.04.97	984, 1003
T 85/93 - 3.4.01 17.10.96 1998, 183	944
T 89/93 - 3.2.01 16.05.94	871
T 92/93 - 3.4.01 31.07.95	1152
T 96/93 - 3.2.04 23.01.95	1174
T 105/93 - 3.3.01 22.05.95	534, 1036
T 124/93 - 3.3.02 10.08.95	521, 1094
T 125/93 - 3.3.03 04.12.96	1000, 1172
T 134/93 - 3.4.02 16.11.95	244
T 141/93 - 3.3.03 15.03.96	120
T 149/93 - 3.3.02 23.03.95	185
T 150/93 - 3.2.04 06.03.95	957
T 152/93 - 3.3.01 21.03.95	175, 244
T 153/93 - 3.3.01 21.02.94	1184-1186
T 157/93 - 3.2.03 25.07.95	265
T 165/93 - 3.2.01 12.07.94	1051
T 167/93 - 3.3.01 03.05.96 1997, 229	497, 498, 1184
T 169/93 - 3.3.01 10.07.96	1115
T 186/93 - 3.2.04 22.05.95	1174
T 187/93 - 3.3.04 05.03.97	186, 330, 335, 346, 347, 351
T 191/93 - 3.4.02 07.06.94	454
T 193/93 - 3.5.01 06.08.93	886
T 195/93 - 3.3.04 04.05.95	968, 1168
T 203/93 - 3.4.01 01.09.94	184, 246
T 204/93 - 3.5.01 29.10.93	16, 20, 255

Table of cases

T 206/93 - 3.3.03 30.10.96	1129	T 381/93 - 3.5.01 12.08.94	609, 617, 625, 638
T 210/93 - 3.3.03 12.07.94	153	T 382/93 - 3.3.01 19.09.96	695
T 211/93 - 3.3.02 11.07.95	124	T 404/93 - 3.5.02 28.09.94	72
T 219/93 - 3.3.03 16.09.93	1110, 1192, 1211	T 410/93 - 3.3.03 16.07.96	166
T 220/93 - 3.3.03 30.11.93	533, 1195	T 412/93 - 3.3.04 21.11.94	188, 192, 330, 342, 352, 354
T 225/93 - 3.3.03 13.05.97	337, 342, 358, 361	T 419/93 - 3.3.03 19.07.95	176
T 229/93 - 3.3.01 21.02.97	875	T 420/93 - 3.4.01 03.06.97	934
T 233/93 - 3.2.05 28.10.96	239, 1084, 1119	T 422/93 - 3.3.01 21.09.95	1997, 24 176, 189
T 234/93 - 3.3.04 15.05.97	75, 195	T 431/93 - 3.2.01 17.11.94	250
T 238/93 - 3.2.02 10.05.94	235	T 433/93 - 3.4.01 06.12.96	1997, 509 726, 728, 733, 1034, 1036, 1037
T 240/93 - 3.4.01 17.10.94	251	T 441/93 - 3.3.04 27.03.96	191, 192, 393, 394
T 249/93 - 3.3.03 27.05.98	1180, 1181	T 443/93 - 3.5.02 22.03.95	657, 660, 662, 1028
T 252/93 - 3.2.02 07.02.95	1025, 1124	T 454/93 - 3.3.02 06.11.95	562
T 254/93 - 3.3.02 14.05.97	1998, 285 146, 155	T 467/93 - 3.2.04 13.06.95	971
T 255/93 - 3.4.01 27.09.94	932	T 469/93 - 3.4.02 09.06.94	618
T 263/93 - 3.3.01 12.01.94	1053, 1054	T 471/93 - 3.2.03 05.12.95	971
T 279/93 - 3.3.01 12.12.96	154, 155, 474	T 473/93 - 3.3.02 01.02.94	677
T 286/93 - 3.3.01 22.11.96	238	T 487/93 - 3.3.04 06.02.96	881, 882
T 291/93 - 3.2.05 22.06.95	1203	T 493/93 - 3.3.04 30.01.97	477
T 292/93 - 3.2.05 13.02.97	91, 95	T 505/93 - 3.2.02 10.11.95	1125
T 296/93 - 3.3.04 28.07.94	1995, 627 100, 186, 373, 375, 386, 683, 971, 1165	T 516/93 - 3.3.02 02.04.97	867
T 298/93 - 3.3.01 19.12.96	165	T 527/93 - 3.2.02 20.01.95	1170
T 306/93 - 3.3.02 30.07.96	1000	T 528/93 - 3.4.01 23.10.96	1078, 1079, 1121, 1122, 1145, 1162
T 311/93 - 3.3.01 16.01.97	101, 292, 372	T 533/93 - 3.2.03 24.10.95	1093
T 321/93 - 3.2.04 15.03.95	1112	T 540/93 - 3.2.04 08.02.94	234
T 322/93 - 3.3.03 02.04.97	284, 334	T 556/93 - 3.3.03 19.02.97	284
T 325/93 - 3.3.03 11.09.97	166	T 576/93 - 3.2.02 02.09.93	1188
T 326/93 - 3.5.01 29.11.94	683	T 582/93 - 3.5.01 23.06.94	101, 883
T 333/93 - 3.4.01 10.03.97	298	T 583/93 - 3.3.03 04.01.96	1996, 496 175, 176, 231, 284, 412, 1163
T 339/93 - 3.3.04 18.04.96	1010	T 588/93 - 3.3.02 31.01.96	181, 363
T 350/93 - 3.4.02 20.01.94	264	T 589/93 - 3.2.01 15.06.94	1995, 387 886
T 351/93 - 3.2.03 01.03.95	243, 248	T 590/93 - 3.3.01 10.05.94	1995, 337 1008, 1010
T 352/93 - 3.3.01 04.04.95	123	T 597/93 - 3.2.02 17.02.97	225
T 356/93 - 3.3.04 21.02.95	1995, 545 37, 41-43, 50	T 599/93 - 3.4.01 04.10.96	32
T 374/93 - 3.3.01 04.03.97	411	T 601/93 - 3.3.01 13.09.94	626
T 375/93 - 3.2.03 02.09.94	178	T 605/93 - 3.5.01 20.01.95	73, 404
T 378/93 - 3.4.01 06.12.95	196		
T 380/93 - 3.3.03 10.02.94	176		



T 607/93 - 3.4.02 14.02.96	110	T 817/93 - 3.4.02 30.11.94	1037
T 616/93 - 3.2.04 27.06.95	172	T 818/93 - 3.2.02 02.04.96	93, 95, 99, 162, 178, 234, 235, 329, 453, 454
T 623/93 - 3.5.02 19.10.95	72, 1035	T 822/93 - 3.3.02 23.05.95	613
T 630/93 - 3.5.01 27.10.93	272, 275	T 823/93 - 3.2.04 18.10.96	95
T 647/93 - 3.5.02 06.04.94 1995, 132	531, 553, 753, 830, 880, 890, 891, 1110, 1195, 1204, 1207, 1208	T 825/93 - 3.4.01 14.01.97	191
T 653/93 - 3.3.01 21.10.96	133	T 828/93 - 3.4.02 07.05.96	392, 393
T 655/93 - 3.2.03 25.10.94	237	T 829/93 - 3.4.02 24.05.96	1042
T 656/93 - 3.2.02 12.03.96	223	T 840/93 - 3.3.02 11.07.95 1996, 335	1121, 1129, 1160, 1162
T 659/93 - 3.3.03 07.09.94	284, 285, 335	T 847/93 - 3.4.02 31.01.95	983, 989, 1002, 1103, 1172
T 660/93 - 3.4.02 19.07.96	132	T 848/93 - 3.4.01 03.02.98	150, 152
T 666/93 - 3.2.03 13.12.94	223	T 860/93 - 3.3.03 29.12.93 1995, 47	281, 289, 290, 294, 358, 1196, 1197
T 669/93 - 3.2.03 13.02.95	373	T 861/93 - 3.3.03 29.04.94	938
T 690/93 - 3.3.02 11.10.94	525	T 863/93 - 3.5.01 17.02.94	1196
T 702/93 - 3.4.01 10.02.94	304	T 866/93 - 3.3.01 08.09.97	115
T 703/93 - 3.4.01 17.12.96	250	T 870/93 - 3.4.01 18.02.98	560, 565
T 712/93 - 3.2.02 14.04.97	56	T 884/93 - 3.3.03 05.09.96	294
T 713/93 - 3.2.02 12.02.96	223	T 885/93 - 3.3.03 15.02.96	577, 713
T 719/93 - 3.4.02 22.09.94	982, 983	T 889/93 - 3.5.02 10.02.95	447
T 720/93 - 3.4.02 19.09.95	1185	T 915/93 - 3.3.04 22.04.94	188
T 723/93 - 3.3.04 12.07.96	265	T 919/93 - 3.3.04 18.11.98	386
T 726/93 - 3.2.05 01.07.94 1995, 478	845, 846	T 926/93 - 3.4.01 01.10.96 1997, 447	1018
T 731/93 - 3.3.01 01.12.94	564, 1194	T 928/93 - 3.4.02 23.01.97	102, 109
T 739/93 - 3.2.03 06.04.95	104	T 932/93 - 3.2.01 31.01.95	1092
T 740/93 - 3.2.04 10.01.96	536, 751, 752, 756	T 937/93 - 3.2.04 04.03.97	657, 676
T 748/93 - 3.3.03 19.04.94	603	T 943/93 - 3.4.01 03.08.94	103
T 752/93 - 3.2.04 16.07.96	1039, 1114	T 951/93 - 3.3.04 17.09.97	780
T 767/93 - 3.3.04 13.11.96	386	T 954/93 - 3.3.03 06.02.97	568, 702
T 790/93 - 3.5.02 15.07.94	1199	T 961/93 - 3.2.04 14.01.94	1108
T 793/93 - 3.3.03 27.09.95	106, 685	T 970/93 - 3.2.01 15.03.96	370, 662, 676, 983
T 795/93 - 3.3.01 29.10.96	160, 162, 184, 246, 663	T 972/93 - 3.4.02 16.06.94	857
T 798/93 - 3.2.01 20.06.96 1997, 363	655, 661, 664, 977, 1008, 1010	T 973/93 - 3.4.02 15.06.94	857
T 803/93 - 3.4.01 19.07.95 1996, 204	815, 1224	T 977/93 - 3.3.04 30.03.99	108
T 805/93 - 3.3.03 20.02.97	336, 338, 362	T 986/93 - 3.2.01 25.04.95 1996, 215	1034, 1126
T 813/93 - 3.3.01 17.10.94	176	T 988/93 - 3.4.01 04.07.96	1025
T 815/93 - 3.3.03 19.06.96	120	T 989/93 - 3.3.01 16.04.97	165, 231

Table of cases

T 999/93 - 3.4.02 09.03.95	749, 759, 897	T 207/94 - 3.3.04 08.04.97	1999, 273	186, 187, 191, 386
T 1016/93 - 3.2.01 23.03.95	933, 983	T 212/94 - 3.5.02 11.10.96		13
T 1022/93 - 3.3.01 05.10.95	996	T 223/94 - 3.2.04 16.02.96		223, 226
T 1039/93 - 3.5.02 08.02.96	447	T 226/94 - 3.4.01 20.03.96		227
T 1040/93 - 3.2.04 16.05.95	168	T 238/94 - 3.2.01 11.06.97		536
T 1043/93 - 3.2.04 22.11.01	678	T 239/94 - 3.5.01 15.09.95		115
T 1049/93 - 3.3.01 03.08.99	550	T 259/94 - 3.3.01 11.08.98		943
T 1052/93 - 3.3.01 10.01.96	376	T 270/94 - 3.3.01 22.01.98		1012, 1036
T 1053/93 - 3.3.01 26.08.97	185	T 284/94 - 3.4.01 25.11.98	1999, 464	437, 440
T 1056/93 - 3.2.01 16.01.96	373	T 295/94 - 3.2.04 26.07.94		246
T 1062/93 - 3.3.02 30.04.97	179	T 301/94 - 3.3.02 28.11.96		89, 90
T 1072/93 - 3.3.03 18.09.97	1085	T 305/94 - 3.3.03 20.06.96		70, 955
T 1074/93 - 3.3.04 15.12.98	181	T 309/94 - 3.3.03 19.03.97		540
T 1076/93 - 3.4.02 16.02.95	95, 98	T 311/94 - 3.3.01 28.06.94		909
T 1077/93 - 3.3.02 30.05.96	59, 60	T 312/94 - 3.4.01 04.09.97		101, 102
T 1082/93 - 3.3.03 14.11.97	385	T 323/94 - 3.2.04 26.09.96		1119
<b>1994</b>		T 324/94 - 3.4.01 07.05.96		225, 228
T 2/94 - 3.4.01 04.02.98	191	T 332/94 - 3.3.01 18.02.98		285
T 20/94 - 3.3.01 04.11.98	300, 473	T 334/94 - 3.3.03 25.09.97		817, 818
T 27/94 - 3.2.01 14.05.96	1186	T 341/94 - 3.3.02 13.07.95		244
T 34/94 - 3.4.02 22.03.94	1025, 1124	T 348/94 - 3.2.02 21.10.98		82
T 45/94 - 3.2.01 02.11.94	795	T 356/94 - 3.2.01 30.06.95		543, 781, 955
T 47/94 - 3.4.02 16.01.95	565	T 363/94 - 3.2.03 22.11.95		225
T 51/94 - 3.5.02 08.06.94	830, 831, 1204	T 372/94 - 3.3.01 14.08.96		1092
T 61/94 - 3.5.01 12.10.95	272, 273	T 373/94 - 3.3.02 31.07.98		171, 195, 248
T 63/94 - 3.3.04 18.01.95	188	T 382/94 - 3.4.02 17.04.97	1998, 24	404, 647, 839, 842
T 68/94 - 3.3.04 11.08.99	535	T 385/94 - 3.3.04 24.06.97		160
T 69/94 - 3.3.02 18.06.96	172	T 386/94 - 3.3.04 11.01.96	1996, 658	186, 345
T 77/94 - 3.2.03 28.04.98	78, 79	T 387/94 - 3.3.04 07.03.97		191
T 86/94 - 3.3.03 08.07.97	1126	T 397/94 - 3.4.02 05.04.95		831, 1194
T 89/94 - 3.3.03 05.07.94	555, 1195	T 401/94 - 3.3.03 18.08.94		124
T 97/94 - 3.3.03 15.07.97	1998, 467	T 405/94 - 3.4.02 12.07.95		533
	100, 580, 684, 685, 958	T 406/94 - 3.3.05 17.12.97		130
T 118/94 - 3.4.01 12.02.98	237	T 412/94 - 3.3.01 05.06.96		252
T 125/94 - 3.3.02 29.05.96	1174	T 414/94 - 3.4.02 14.05.98		550
T 134/94 - 3.3.02 12.11.96	384, 385	T 432/94 - 3.3.01 19.06.97		1126
T 135/94 - 3.5.01 12.06.95	234	T 455/94 - 3.2.04 10.12.96		183
T 143/94 - 3.3.02 06.10.95	1996, 430	T 462/94 - 3.5.01 10.01.96		1174
T 144/94 - 3.3.06 12.10.99	1196	T 464/94 - 3.3.04 21.05.97		103, 386, 685
T 164/94 - 3.3.01 11.11.96	251	T 467/94 - 3.3.01 04.11.99		230
T 189/94 - 3.2.01 12.01.95	410	T 469/94 - 3.3.02 01.07.97		58, 61, 150
T 190/94 - 3.5.01 26.10.95	19	T 479/94 - 3.5.01 31.07.95		1195
T 200/94 - 3.3.01 23.10.97	183, 694			

T 488/94 - 3.4.02 02.07.97	719, 1201	T 712/94 - 3.2.03 14.11.96	987
T 490/94 - 3.4.02 11.12.97	276	T 715/94 - 3.4.02 13.11.97	1125
T 498/94 - 3.3.04 22.06.98	354	T 731/94 - 3.2.01 15.02.96	224
T 501/94 - 3.5.02 10.07.96 1997, 376	934	T 740/94 - 3.2.03 09.05.96	1047, 1199
T 510/94 - 3.3.04 21.04.98	350	T 750/94 - 3.4.01 01.04.97 1998, 32	100, 678, 683-685,
T 513/94 - 3.3.04 23.04.98	350		689, 694, 700, 881, 882
T 515/94 - 3.3.04 29.10.97	1166	T 751/94 - 3.4.03 12.05.99	132
T 520/94 - 3.4.01 07.07.94	881, 882	T 752/94 - 3.3.01 24.05.00	269
T 522/94 - 3.2.05 22.09.97 1998, 421	1009, 1026, 1108	T 772/94 - 3.5.01 20.03.96	164
T 529/94 - 3.3.02 09.10.97	564, 875	T 780/94 - 3.5.01 24.10.96	181
T 530/94 - 3.3.10 20.04.98	275	T 792/94 - 3.2.05 11.10.00	447
T 533/94 - 3.3.01 23.03.95	1024	T 794/94 - 3.3.04 17.09.98	1042, 1154, 1158
T 534/94 - 3.3.01 23.03.95	1024	T 796/94 - 3.5.02 27.11.95	857
T 542/94 - 3.2.01 07.05.96	493	T 804/94 - 3.2.01 10.07.95	370, 541, 1198
T 544/94 - 3.3.02 22.01.97	236, 991, 992	T 808/94 - 3.4.02 26.01.95	558, 565, 887, 1176, 1207
T 552/94 - 3.3.01 04.12.98	385	T 817/94 - 3.2.04 30.07.96	168, 241
T 557/94 - 3.2.05 12.12.96	1180, 1182, 1271	T 825/94 - 3.3.01 25.02.00	284
T 561/94 - 3.3.01 06.12.96	251	T 826/94 - 3.4.02 30.11.95	117
T 568/94 - 3.3.01 23.07.99	472	T 828/94 - 3.5.01 18.10.96	620, 636
T 575/94 - 3.2.01 11.07.96	657, 662, 1163	T 833/94 - 3.5.01 20.08.98	693, 975
T 586/94 - 3.3.06 29.09.99	361	T 840/94 - 3.3.01 26.03.96 1996, 680	607, 609
T 590/94 - 3.3.03 03.05.96	75, 195, 404, 971, 1009, 1015	T 848/94 - 3.3.03 03.06.97	251, 684
T 602/94 - 3.3.04 03.03.98	635	T 856/94 - 3.3.04 05.06.97	188
T 609/94 - 3.4.02 27.02.97	1186	T 859/94 - 3.3.06 21.09.99	421
T 610/94 - 3.4.02 20.06.96	1154	T 861/94 - 3.2.02 19.09.95	525
T 620/94 - 3.5.02 13.06.95	373, 393	T 871/94 - 3.2.04 24.10.96	167
T 631/94 - 3.2.05 28.03.95 1996, 67	748, 970	T 873/94 - 3.4.01 10.07.96 1997, 456	414, 493, 495
T 635/94 - 3.2.03 25.04.95	642	T 882/94 - 3.3.03 07.08.97	251
T 641/94 - 3.2.01 01.02.96	991	T 892/94 - 3.3.02 19.01.99 2000, 1	155, 550
T 645/94 - 3.3.05 22.10.97	243	T 900/94 - 3.3.02 09.09.98	1161
T 648/94 - 3.3.01 26.10.94	1110	T 905/94 - 3.2.03 11.06.96	677, 682
T 650/94 - 3.4.02 11.03.99	562	T 912/94 - 3.4.01 06.05.97	175, 227
T 667/94 - 3.3.02 16.10.97	700, 703	T 917/94 - 3.3.06 28.10.99	116, 406, 448
T 668/94 - 3.3.01 20.10.98	231	T 921/94 - 3.3.01 30.10.98	538
T 671/94 - 3.3.01 11.06.96	75, 195	T 922/94 - 3.3.03 30.10.97	1033, 1046
T 676/94 - 3.2.01 06.02.96	76, 331	T 929/94 - 3.4.01 07.07.98	700, 784
T 681/94 - 3.2.01 18.06.96	250	T 930/94 - 3.3.01 15.10.97	160, 230
T 687/94 - 3.2.02 23.04.96	178, 225	T 938/94 - 3.3.04 23.06.99	1089
T 691/94 - 3.5.02 13.05.96	74		
T 697/94 - 3.4.01 28.04.97	246		
T 698/94 - 3.3.03 17.02.97	751, 754		

Table of cases

T 949/94 - 3.5.02 24.03.95	607, 633, 634, 639, 743	T 223/95 - 3.5.02 04.03.97	1002, 1029, 1170
T 953/94 - 3.5.01 15.07.96	4, 13, 24, 33, 255	T 227/95 - 3.5.01 11.4.96	756, 1203
T 960/94 - 3.3.04 13.09.00	552, 745, 746, 1201	T 236/95 - 3.2.01 16.07.96	411
T 975/94 - 3.3.04 06.11.96	458	T 240/95 - 3.3.06 06.07.99	132
T 977/94 - 3.2.01 18.12.97	286, 1180	T 241/95 - 3.3.02 14.06.00 2001, 103	58, 147, 277, 348
<b>1995</b>		T 252/95 - 3.3.02 21.08.98	1104, 1105
T 3/95 - 3.2.04 24.09.97	1020, 1107	T 253/95 - 3.3.03 17.12.97	1066, 1085
T 9/95 - 3.2.03 09.04.97	983	T 272/95 - 3.3.04 15.04.99 1999, 590	38
T 27/95 - 3.2.03 25.06.96	1033	T 274/95 - 3.4.01 02.02.96 1997, 99	1029
T 32/95 - 3.5.02 28.10.96	694, 833	T 277/95 - 3.3.04 16.04.99	376
T 35/95 - 3.2.04 01.10.96	168	T 280/95 - 3.5.02 23.10.96	184
T 68/95 - 3.3.01 23.09.97	176	T 281/95 - 3.5.02 24.09.96	1093
T 70/95 - 3.3.04 12.01.99	168	T 301/95 - 3.2.05 28.03.00	779, 782
T 72/95 - 3.3.05 18.03.98	200, 227, 239	T 311/95 - 3.3.05 16.06.99	242
T 73/95 - 3.3.03 18.03.99	249	T 317/95 - 3.3.02 26.02.99	143
T 86/95 - 3.2.02 09.09.97	81	T 321/95 - 3.4.02 06.11.96	517
T 104/95 - 3.3.04 16.09.97	228	T 322/95 - 3.3.03 10.08.99	246, 931
T 111/95 - 3.3.02 13.03.96	575, 576	T 325/95 - 3.4.02 18.11.97	460
T 112/95 - 3.2.01 19.02.98	479	T 333/95 - 3.5.01 05.03.97	210, 216
T 114/95 - 3.2.01 08.04.97	1018, 1028	T 337/95 - 3.3.01 30.01.96 1996, 628	262
T 121/95 - 3.4.01 03.02.98	881, 882, 891	T 343/95 - 3.3.04 17.11.97	514, 517, 683
T 134/95 - 3.2.01 22.10.96	471	T 349/95 - 3.2.04 14.02.97	249
T 136/95 - 3.2.01 25.02.97 1998, 480	374	T 353/95 - 3.3.02 25.07.00	1008, 1084
T 141/95 - 3.2.03 30.09.99	1093	T 364/95 - 3.2.04 20.11.96	373
T 142/95 - 3.2.03 04.05.98	1196	T 373/95 - 3.3.02 06.12.96	110
T 144/95 - 3.2.04 26.02.99	971	T 389/95 - 3.5.02 15.10.97	935, 1104, 1105
T 151/95 - 3.3.02 18.06.98	297	T 396/95 - 3.3.02 17.09.96	411
T 152/95 - 3.5.02 03.07.96	1166	T 401/95 - 3.3.01 28.01.99	472, 1112, 1152
T 154/95 - 3.2.01 27.01.98	1035	T 402/95 - 3.4.01 06.10.99	191
T 156/95 - 3.3.01 30.03.98	230	T 433/95 - 3.3.01 08.08.00	161
T 172/95 - 3.3.03 05.03.98	377	T 434/95 - 3.2.03 17.06.97	224, 990, 991
T 180/95 - 3.3.01 02.12.96	1110	T 436/95 - 3.4.02 29.09.00	1183, 1184
T 181/95 - 3.5.02 12.09.96	264, 265, 871	T 442/95 - 3.3.04 26.09.96	923, 925, 926
T 183/95 - 3.5.01 25.06.96	1207	T 446/95 - 3.2.02 23.03.99	780, 968, 969
T 187/95 - 3.4.02 03.02.97	534, 882	T 460/95 - 3.5.01 20.10.97 1998, 587	514, 517, 524, 630, 1091, 1188
T 188/95 - 3.3.02 04.12.97	535	T 463/95 - 3.5.02 29.01.97	932, 1042
T 189/95 - 3.3.02 29.02.00	155		
T 193/95 - 3.4.01 26.11.98	386		
T 211/95 - 3.5.02 09.07.97	412, 494		

T 476/95 - 3.2.01 20.06.96	732, 745, 746, 1177	T 727/95 - 3.3.04 21.05.99	2001, 1	351
T 480/95 - 3.4.02 05.11.96	95	T 736/95 - 3.3.04 09.10.00	2001, 191	833, 1033
T 481/95 - 3.4.02 15.05.97	1123	T 737/95 - 3.2.03 21.11.97		367
T 482/95 - 3.3.03 28.08.95	284	T 738/95 - 3.2.03 19.09.07		467
T 487/95 - 3.2.04 07.08.97	165, 169	T 739/95 - 3.2.04 26.06.97		168
T 493/95 - 3.2.04 22.10.96	611, 629, 1098	T 749/95 - 3.4.02 16.07.97		298
T 494/95 - 3.2.04 30.06.97	1053	T 752/95 - 3.2.03 22.06.99		1025
T 506/95 - 3.5.02 05.02.97	165	T 767/95 - 3.3.04 05.09.00		123
T 530/95 - 3.3.04 10.06.97	191	T 772/95 - 3.2.01 30.09.97		997, 998
T 531/95 - 3.2.01 26.08.97	244	T 786/95 - 3.2.04 13.10.97		1024
T 532/95 - 3.3.01 04.03.99	935	T 789/95 - 3.4.02 13.03.97		1205
T 536/95 - 3.3.01 03.06.97	105	T 792/95 - 3.2.01 05.08.97		1045
T 543/95 - 3.2.03 10.11.97	654, 657	T 794/95 - 3.4.02 07.07.97		1110, 1208
T 556/95 - 3.5.01 08.08.96	1997, 205	T 795/95 - 3.2.01 06.10.98		467
T 558/95 - 3.2.01 10.02.97	370, 657, 661, 662, 977, 1054	T 798/95 - 3.3.01 06.12.95		748, 901
T 576/95 - 3.2.03 15.04.97	172	T 804/95 - 3.3.01 04.12.97		642
T 582/95 - 3.2.01 28.01.97	1052	T 809/95 - 3.2.01 29.04.97		90, 97, 383, 384
T 583/95 - 3.2.03 22.12.97	1112	T 838/95 - 3.3.02 09.12.99		194
T 585/95 - 3.2.01 10.12.96	987	T 839/95 - 3.3.05 23.06.98		720, 833, 909
T 589/95 - 3.3.03 05.11.98	227	T 841/95 - 3.4.02 13.06.96		283
T 592/95 - 3.4.01 09.09.98	299	T 849/95 - 3.2.02 15.12.98		993
T 609/95 - 3.3.02 27.08.98	451	T 850/95 - 3.3.02 12.07.96	1997, 152	751, 763
T 610/95 - 3.3.02 21.07.99	105, 234, 1043	T 860/95 - 3.3.05 27.10.99		281
T 611/95 - 3.2.05 13.07.99	80	T 870/95 - 3.4.02 14.07.98		117
T 615/95 - 3.3.01 16.12.97	421, 756, 1110	T 881/95 - 3.2.01 25.06.97		339, 574
T 616/95 - 3.3.06 17.02.99	284	T 897/95 - 3.4.03 22.02.00		224
T 628/95 - 3.4.01 13.05.96	733	T 899/95 - 3.5.01 21.11.96		1088
T 632/95 - 3.2.03 22.10.96	697	T 900/95 - 3.5.02 05.11.97		244
T 639/95 - 3.3.04 21.01.98	346, 351	T 901/95 - 3.5.02 29.10.98		87
T 665/95 - 3.2.03 01.03.99	663, 678	T 908/95 - 3.2.01 21.07.97		779
T 670/95 - 3.3.05 09.06.98	959, 963, 966	T 909/95 - 3.4.01 02.10.98		886
T 671/95 - 3.3.03 15.01.96	1193	T 917/95 - 3.2.04 01.08.01		554, 567
T 693/95 - 3.2.03 23.10.00	558, 572, 991	T 919/95 - 3.2.02 16.01.97		1110, 1111
T 696/95 - 3.2.03 16.11.95	1188	T 923/95 - 3.2.02 12.11.96		514, 523
T 706/95 - 3.3.05 22.05.00	155	T 931/95 - 3.5.01 08.09.00	2001, 441	3, 5, 6, 8-11, 22, 28, 198, 200, 202-204
T 708/95 - 3.4.02 16.12.96	1103	T 938/95 - 3.2.01 06.03.97		441
T 715/95 - 3.3.06 19.12.00	1002, 1003	T 939/95 - 3.5.01 23.01.98	1998, 481	1111, 1206
T 717/95 - 3.2.04 23.04.98	998	T 960/95 - 3.3.03 31.03.99		251, 1026
		T 971/95 - 3.4.03 15.09.00		164
		T 980/95 - 3.3.03 18.02.98		265
		T 988/95 - 3.2.04 11.02.97		102, 115

Table of cases

T 989/95 - 3.3.04 06.05.99	280	T 237/96 - 3.4.02 22.04.98	554, 873,
T 994/95 - 3.3.04 18.02.99	344		880, 890,
T 1001/95 - 3.3.01 20.01.00	619		892, 897,
T 1002/95 - 3.2.01 10.02.98	1114		1126
T 1007/95 - 3.3.03 17.11.98	1999, 733	T 239/96 - 3.5.01 23.10.98	1118
<b>1996</b>		T 243/96 - 3.2.02 25.05.98	81
T 24/96 - 3.2.04 04.03.99	1042	T 276/96 - 3.4.02 17.06.97	474
T 29/96 - 3.2.04 16.09.97	988, 995	T 281/96 - 3.2.02 19.02.97	619
T 37/96 - 3.3.06 07.02.00	78	T 284/96 - 3.3.01 20.07.99	175, 243
T 43/96 - 3.5.02 05.07.96	633	T 296/96 - 3.3.01 12.01.00	419, 420,
T 48/96 - 3.5.01 25.08.98	682		523, 538
T 59/96 - 3.3.01 07.04.99	165, 166	T 319/96 - 3.2.03 11.12.98	322, 921,
T 64/96 - 3.2.01 30.09.97	402, 479		924
T 65/96 - 3.3.03 18.03.98	133, 1107	T 339/96 - 3.5.02 21.10.98	178
T 79/96 - 3.3.05 20.10.98	102, 117	T 349/96 - 3.2.05 22.09.98	196
T 80/96 - 3.3.02 16.06.99	2000, 50	T 363/96 - 3.2.06 24.05.00	683, 684
T 92/96 - 3.5.02 12.09.97	884	T 366/96 - 3.3.06 17.02.00	124
T 107/96 - 3.2.05 25.11.98	389	T 367/96 - 3.4.02 21.06.01	763, 1048
T 113/96 - 3.2.04 19.12.97	945, 1173	T 373/96 - 3.2.02 25.05.00	1162
T 115/96 - 3.2.04 25.02.97	226	T 379/96 - 3.3.02 13.01.99	193
T 120/96 - 3.2.03 06.02.97	540, 1054,	T 382/96 - 3.3.03 07.07.99	717, 1069,
	1176		1108, 1155
T 135/96 - 3.2.01 20.01.97	538, 671,	T 395/96 - 3.3.06 11.06.99	237
	754, 1176,	T 405/96 - 3.2.01 08.11.96	1193
	1192	T 410/96 - 3.5.01 25.07.97	282
T 142/96 - 3.2.02 14.04.99	1079, 1111,	T 429/96 - 3.3.04 31.05.01	332
	1209	T 431/96 - 3.3.04 23.02.99	349, 354
T 158/96 - 3.3.02 28.10.98	103, 147,	T 452/96 - 3.3.02 05.04.00	244, 577
	348	T 458/96 - 3.4.02 07.10.98	289, 291,
T 161/96 - 3.3.04 03.11.97	1999, 331		292
	514, 524,	T 462/96 - 3.4.02 04.02.98	81
	525, 742	T 475/96 - 3.3.03 15.06.99	931
T 165/96 - 3.3.06 30.05.00	91	T 476/96 - 3.3.03 29.04.99	577
T 167/96 - 3.5.02 16.05.97	1212	T 477/96 - 3.4.03 25.07.00	197
T 169/96 - 3.3.01 30.07.96	304, 320,	T 481/96 - 3.4.02 16.09.96	981
	716, 718,	T 488/96 - 3.3.01 07.12.99	272
	719, 891	T 496/96 - 3.2.01 13.02.98	105
T 181/96 - 3.4.02 12.02.97	276	T 503/96 - 3.5.02 12.01.99	1046
T 191/96 - 3.2.01 02.04.98	1103	T 505/96 - 3.5.01 15.12.98	241
T 194/96 - 3.3.02 10.10.96	564	T 522/96 - 3.2.01 07.05.98	415
T 218/96 - 3.2.03 15.09.98	237	T 525/96 - 3.3.02 11.08.00	1028
T 223/96 - 3.3.04 29.01.99	296	T 528/96 - 3.5.01 18.11.98	561, 562
T 225/96 - 3.2.03 03.04.98	759, 760,	T 541/96 - 3.4.01 07.03.01	254, 258,
	1199		364
T 233/96 - 3.3.02 04.05.00	141	T 542/96 - 3.3.02 11.05.00	142
T 234/96 - 3.2.05 04.12.97	196, 240	T 549/96 - 3.3.01 09.03.99	554, 719,
			720

T 556/96 - 3.2.02 24.03.00	996	T 946/96 - 3.3.01 23.06.97	833, 880, 890
T 561/96 - 3.4.02 16.01.97	334	T 947/96 - 3.4.03 07.12.99	415
T 574/96 - 3.3.01 30.07.99	271	T 955/96 - 3.3.02 19.04.01	175
T 596/96 - 3.3.02 14.12.99	102, 117	T 957/96 - 3.3.01 28.01.97	318
T 608/96 - 3.3.01 11.07.00	112	T 961/96 - 3.3.01 10.02.00	170
T 610/96 - 3.5.02 10.11.98	130	T 986/96 - 3.4.01 10.08.00	176, 190, 191
T 624/96 - 3.4.02 06.02.97	629, 639	T 989/96 - 3.2.06 05.07.01	971
T 626/96 - 3.2.01 10.01.97	246, 248	T 990/96 - 3.3.01 12.02.98 1998, 489	127, 128
T 637/96 - 3.2.04 27.11.97	1114	T 1003/96 - 3.2.03 06.02.01	695
T 643/96 - 3.3.01 14.10.96	230, 392, 535	T 1004/96 - 3.2.04 17.10.97	537
T 648/96 - 3.5.02 16.03.98	1041, 1047, 1153, 1196	T 1008/96 - 3.2.03 25.06.03	368, 369, 691
T 656/96 - 3.2.03 21.06.99	1036	T 1018/96 - 3.2.03 28.10.98	223
T 674/96 - 3.3.02 29.04.99	341, 1042	T 1028/96 - 3.2.01 15.09.99 2000, 475	730, 731, 735, 736
T 686/96 - 3.3.05 06.05.99	118	T 1029/96 - 3.3.01 21.08.01	102
T 697/96 - 3.3.02 07.10.99	232	T 1032/96 - 3.3.03 26.05.00	1164
T 708/96 - 3.5.01 14.11.97	166	T 1037/96 - 3.2.04 04.06.98	1039
T 711/96 - 3.2.04 17.06.98	225	T 1046/96 - 3.3.04 19.01.98	489
T 717/96 - 3.2.04 10.07.97	226	T 1060/96 - 3.2.03 26.01.99	1172
T 718/96 - 3.2.01 30.06.98	257	T 1062/96 - 3.3.01 11.12.97	634
T 730/96 - 3.3.01 19.10.99	162, 165, 253	T 1066/96 - 3.4.02 08.07.99	897
T 737/96 - 3.3.04 09.03.00	187	T 1069/96 - 3.2.01 10.05.00	1020
T 740/96 - 3.2.06 26.10.00	116, 296	T 1070/96 - 3.2.02 13.01.00	1171
T 750/96 - 3.4.03 27.11.01	276	T 1073/96 - 3.3.02 01.09.99	155
T 755/96 - 3.3.01 06.08.99 2000, 174	578	T 1105/96 - 3.4.01 09.07.97 1998, 249	718, 719, 877, 1201
T 784/96 - 3.3.02 15.07.99	452	T 1109/96 - 3.3.03 18.02.99	323
T 785/96 - 3.3.03 18.04.00	958	<b>1997</b>	
T 789/96 - 3.4.01 23.08.01 2002, 364	56	T 1/97 - 3.2.01 30.03.99	1088
T 791/96 - 3.3.04 15.11.99	191	T 10/97 - 3.4.02 07.10.99	423, 424
T 809/96 - 3.2.05 20.07.01	974	T 15/97 - 3.3.01 08.11.00	227
T 811/96 - 3.3.06 09.03.00	420	T 17/97 - 3.3.01 14.11.00	1196
T 819/96 - 3.3.01 02.02.99	252, 587	T 19/97 - 3.3.04 31.07.01	958-960, 964, 966
T 821/96 - 3.3.01 25.04.01	869	T 25/97 - 3.2.01 19.07.00	235
T 823/96 - 3.3.01 28.01.97	106, 381, 406, 407	T 27/97 - 3.5.01 30.05.00	14, 200, 209, 210
T 850/96 - 3.2.03 14.01.98	808, 809	T 36/97 - 3.2.03 23.10.01	621
T 855/96 - 3.3.05 10.11.99	942, 1125	T 37/97 - 3.3.05 22.11.99	572
T 867/96 - 3.3.02 21.06.00	766	T 40/97 - 3.2.01 01.12.98	437
T 869/96 - 3.2.03 10.11.98	224	T 41/97 - 3.2.01 15.04.98	1210
T 870/96 - 3.4.02 16.07.98	168, 169	T 43/97 - 3.4.01 10.10.01	234
T 886/96 - 3.2.06 06.07.01	971	T 56/97 - 3.3.02 30.08.01	143
T 898/96 - 3.4.01 10.01.97	1207, 1208	T 59/97 - 3.2.04 24.07.98	297
T 917/96 - 3.3.01 27.04.99	161		
T 936/96 - 3.3.05 11.06.99	250		

Table of cases

T 63/97 - 3.2.04 01.12.97	184	T 298/97 - 3.3.06 28.05.01	2002, 83	563, 798,
T 65/97 - 3.2.04 15.06.00	1162			959, 961,
T 66/97 - 3.4.02 09.01.98	168			963, 1076,
T 77/97 - 3.3.01 03.07.97	372, 374,			1078
	380	T 299/97 - 3.3.06 06.06.01		358
T 78/97 - 3.3.06 03.05.01	472	T 308/97 - 3.3.05 10.11.98		1093
T 83/97 - 3.3.04 16.03.99	1180, 1181	T 313/97 - 3.3.01 17.02.00		176
T 95/97 - 3.2.01 18.03.99	105	T 315/97 - 3.4.02 21.06.02		243, 1116
T 100/97 - 3.2.05 16.06.00	666, 676	T 323/97 - 3.3.06 17.09.01	2002, 476	428
T 106/97 - 3.2.03 16.09.99	942, 944	T 325/97 - 3.3.02 10.02.00		171, 175
T 123/97 - 3.2.01 10.09.98	246	T 355/97 - 3.3.01 05.07.00		100, 175,
T 142/97 - 3.4.01 02.12.99	2000, 358			230, 252,
	547, 654,			694
	664, 666,	T 378/97 - 3.3.06 06.06.00		358, 361
	671	T 382/97 - 3.3.06 28.09.00		1041, 1163
T 153/97 - 3.3.02 02.12.98	172	T 385/97 - 3.3.02 11.10.00		1125
T 157/97 - 3.3.05 18.03.98	200, 227	T 392/97 - 3.2.01 20.04.99		574, 969,
T 158/97 - 3.3.05 04.04.00	200, 227			973
T 162/97 - 3.2.04 30.06.99	1096, 1097,	T 396/97 - 3.3.02 15.11.00		1129
	1101, 1107	T 409/97 - 3.2.04 25.11.98		288
T 167/97 - 3.2.02 16.11.98	1999, 488	T 425/97 - 3.3.02 08.05.98		555, 751,
T 170/97 - 3.2.04 23.02.98	184			763, 764,
T 176/97 - 3.3.05 18.03.98	200, 227			1199
T 177/97 - 3.2.01 08.06.99	1097	T 426/97 - 3.3.05 14.12.99		945
T 188/97 - 3.3.04 08.02.01	375, 386,	T 438/97 - 3.2.03 09.02.99		75, 77, 195,
	518, 968			196
T 191/97 - 3.3.03 03.02.99	252	T 443/97 - 3.2.04 17.09.99		919
T 202/97 - 3.5.02 10.02.99	98	T 445/97 - 3.3.01 01.04.98		1039
T 212/97 - 3.5.02 08.06.99	584, 587,	T 450/97 - 3.3.02 05.02.98	1999, 67	447
	678, 764,	T 465/97 - 3.3.07 14.03.01		363
	766, 1019	T 468/97 - 3.3.01 11.04.00		472
T 223/97 - 3.2.01 03.11.98	268, 1043	T 475/97 - 3.2.05 18.10.01		1085
T 227/97 - 3.3.04 09.10.98	1999, 495	T 479/97 - 3.3.04 06.09.01		375, 376
	355, 605,	T 497/97 - 3.2.02 25.07.97		455
	606	T 500/97 - 3.2.02 15.01.01		1098
T 231/97 - 3.3.01 21.03.00	230, 250	T 517/97 - 3.2.05 25.10.99	2000, 515	971
T 255/97 - 3.3.05 12.05.00	246	T 524/97 - 3.3.01 16.05.00		251
T 258/97 - 3.5.01 08.02.02	200, 209,	T 541/97 - 3.2.04 21.04.99		278, 356
	210	T 550/97 - 3.5.01 21.09.99		245
T 265/97 - 3.4.01 04.05.01	276	T 552/97 - 3.5.02 04.11.97		555, 1190,
T 266/97 - 3.2.03 22.06.98	645, 1071			1195
T 270/97 - 3.3.02 20.12.99	106, 107	T 568/97 - 3.3.02 21.02.02		276, 286
T 276/97 - 3.5.02 26.02.99	493	T 577/97 - 3.3.05 05.04.00		1155, 1156,
T 283/97 - 3.5.01 19.10.00	1098			1173
T 287/97 - 3.3.03 12.09.00	289, 294	T 584/97 - 3.3.02 05.12.01		143
T 291/97 - 3.3.04 08.05.01	691	T 586/97 - 3.3.01 14.09.00		262, 270,
				280, 284



T 594/97 - 3.2.04 12.10.01	1117	T 885/97 - 3.2.04 03.12.98	183
T 596/97 - 3.2.04 10.06.98	268	T 887/97 - 3.3.02 28.11.00	451
T 613/97 - 3.3.01 26.05.98	1078	T 899/97 - 3.3.05 28.11.01	818
T 623/97 - 3.5.01 11.04.02	242	T 903/97 - 3.4.02 31.01.01	380
T 631/97 - 3.4.03 17.02.00	2001, 13 323, 832, 921, 924	T 906/97 - 3.4.02 10.06.99	455
T 633/97 - 3.4.02 19.07.00	98, 941, 942	T 909/97 - 3.3.07 13.06.02	380
T 636/97 - 3.3.04 26.03.98	347, 1186	T 919/97 - 3.3.01 29.01.98	77
T 641/97 - 3.3.01 17.10.00	230	T 920/97 - 3.3.04 19.12.00	1076
T 642/97 - 3.3.07 15.02.01	583, 586, 1194, 1195	T 931/97 - 3.2.06 08.01.01	987
T 644/97 - 3.3.03 22.04.99	166, 168, 176, 1107	T 935/97 - 3.5.01 04.02.99	3, 16-18, 198, 206
T 647/97 - 3.3.02 01.02.01	377, 378	T 937/97 - 3.5.01 28.10.98	830, 1204
T 649/97 - 3.2.05 08.12.00	281	T 948/97 - 3.4.01 09.01.02	372
T 652/97 - 3.2.03 16.06.99	752, 754, 755	T 950/97 - 3.4.03 26.03.02	274, 275, 298
T 659/97 - 3.3.05 22.08.01	421	T 951/97 - 3.4.01 05.12.97	1998, 440 544, 579, 761, 875
T 666/97 - 3.3.03 01.10.99	464	T 967/97 - 3.5.01 25.10.01	162, 163
T 677/97 - 3.5.02 26.04.99	869, 871, 881	T 970/97 - 3.3.05 20.09.00	246
T 679/97 - 3.2.03 04.01.99	1176, 1179	T 976/97 - 3.3.03 16.08.00	554, 720, 772
T 686/97 - 3.3.03 12.05.98	621	T 986/97 - 3.2.04 25.02.00	269
T 701/97 - 3.3.05 23.08.01	441, 493	T 994/97 - 3.3.06 24.08.01	1117
T 710/97 - 3.4.02 25.10.00	165	T 998/97 - 3.3.02 11.07.01	363
T 712/97 - 3.3.01 27.01.00	579, 670, 1192	T 1046/97 - 3.3.01 02.12.99	127
T 713/97 - 3.3.01 18.02.98	170	T 1051/97 - 3.3.02 19.05.98	175
T 714/97 - 3.3.03 27.06.00	160	T 1067/97 - 3.4.02 04.10.00	417, 439
T 743/97 - 3.3.04 26.07.00	344, 345	T 1070/97 - 3.3.05 04.03.99	643
T 747/97 - 3.3.03 01.02.00	176	T 1071/97 - 3.3.02 17.08.00	112
T 774/97 - 3.2.04 17.11.98	1051, 1069, 1108	T 1074/97 - 3.3.01 20.03.03	298, 452
T 775/97 - 3.2.02 03.04.01	144	T 1100/97 - 3.2.05 08.05.98	1071
T 777/97 - 3.2.02 16.03.98	748, 760	T 1126/97 - 3.4.01 13.12.01	1128, 1134
T 784/97 - 3.2.03 16.06.00	411	T 1129/97 - 3.3.01 26.10.00	2001, 273 270, 295
T 792/97 - 3.3.03 09.09.99	166	T 1137/97 - 3.3.04 14.10.02	92, 960, 964, 990
T 793/97 - 3.3.01 01.03.00	171, 244	T 1148/97 - 3.2.01 09.12.99	1154
T 799/97 - 3.2.03 04.07.01	962	T 1149/97 - 3.4.02 07.05.99	2000, 259 459, 462, 463, 1037, 1046, 1180
T 802/97 - 3.4.02 24.07.98	833, 870, 881	T 1164/97 - 3.3.02 22.03.01	297
T 805/97 - 3.2.04 13.01.00	234	T 1165/97 - 3.2.06 15.02.00	256
T 838/97 - 3.3.04 14.11.00	81, 93, 98	T 1167/97 - 3.2.01 17.11.99	272
T 859/97 - 3.4.03 02.03.01	1204	T 1171/97 - 3.5.01 17.09.99	988
T 861/97 - 3.4.02 22.06.99	720		
T 864/97 - 3.5.01 14.06.00	931		

Table of cases

T 1173/97 - 3.5.01 01.07.98	1999, 609	3, 5, 6, 9, 16-18, 20, 21, 24, 26, 27, 32, 198, 202, 206, 217, 705, 706, 710, 711, 1223		T 238/98 - 3.3.05 07.05.03	297
T 1177/97 - 3.5.01 09.07.02		20, 21, 201, 212		T 241/98 - 3.2.04 22.03.99	725, 736
T 1180/97 - 3.2.01 19.10.99		1018		T 245/98 - 3.3.02 11.10.01	361
T 1191/97 - 3.2.04 10.04.00		677		T 247/98 - 3.3.05 17.06.99	693, 698, 788, 790
T 1194/97 - 3.5.02 15.03.00	2000, 525	21, 25, 32, 212-214, 218		T 249/98 - 3.2.01 11.01.00	1025
T 1198/97 - 3.3.05 05.03.01		545, 587, 1068, 1210		T 254/98 - 3.2.06 26.09.00	695
T 1203/97 - 3.2.03 09.05.00		165		T 260/98 - 3.3.07 23.01.03	330
T 1208/97 - 3.3.04 03.11.00		116, 290, 293		T 268/98 - 3.3.05 16.05.01	239
T 1212/97 - 3.3.04 14.05.01		82, 688		T 274/98 - 3.3.01 05.02.02	270
T 1213/97 - 3.5.02 16.11.01		975		T 287/98 - 3.3.06 05.12.00	404
T 1221/97 - 3.4.02 13.10.98		495		T 319/98 - 3.3.01 19.02.02	155
<b>1998</b>				T 338/98 - 3.4.02 02.03.99	629
T 4/98 - 3.3.02 09.08.01	2002, 139	143, 1211		T 342/98 - 3.3.04 20.11.01	375, 954
T 26/98 - 3.4.01 30.04.02		189, 194		T 351/98 - 3.3.04 15.01.02	89
T 27/98 - 3.4.01 07.05.99		642		T 376/98 - 3.2.01 09.03.99	543, 545
T 37/98 - 3.2.06 17.05.01		92, 96		T 400/98 - 3.3.06 19.09.02	176, 241
T 45/98 - 3.2.02 06.06.00		1003		T 406/98 - 3.2.03 26.09.00	223, 224
T 50/98 - 3.3.06 13.06.02		1134		T 411/98 - 3.2.04 11.01.00	101
T 51/98 - 3.3.01 24.07.01		232		T 414/98 - 3.2.04 30.11.99	183, 184, 226
T 71/98 - 3.3.05 21.12.99		243		T 425/98 - 3.3.01 12.03.02	270
T 74/98 - 3.3.03 19.10.00		117, 118		T 428/98 - 3.3.05 23.02.01	2001, 494
T 80/98 - 3.2.04 26.09.00		509			514, 520, 607, 610, 617, 619, 621, 622, 675
T 91/98 - 3.3.04 29.05.01		188, 680		T 432/98 - 3.3.02 28.11.01	240
T 97/98 - 3.3.05 21.05.01	2002, 183	1089, 1090		T 437/98 - 3.3.08 29.01.03	262, 278, 287, 1083, 1195
T 111/98 - 3.3.05 10.07.01		1171-1173, 1175		T 438/98 - 3.3.03 12.10.00	477
T 135/98 - 3.3.02 20.11.02		953		T 439/98 - 3.3.06 17.10.02	358, 361
T 191/98 - 3.2.06 04.03.03		551		T 445/98 - 3.2.01 10.07.00	524, 525, 1095, 1188
T 201/98 - 3.5.01 27.07.99		541, 869, 871		T 464/98 - 3.3.05 12.09.00	169
T 203/98 - 3.5.01 27.07.99		272		T 471/98 - 3.4.01 02.07.02	227
T 209/98 - 3.3.01 26.06.01		230		T 473/98 - 3.5.02 05.09.00	2001, 231
T 210/98 - 3.3.03 19.12.00		996			753, 1083, 1181, 1192
T 226/98 - 3.3.01 07.02.01		270		T 480/98 - 3.2.04 28.04.99	271
T 228/98 - 3.3.03 04.04.01		449		T 484/98 - 3.3.04 13.09.99	276
				T 502/98 - 3.3.06 07.06.02	935, 942
				T 517/98 - 3.3.05 17.01.02	2003, 385
				T 534/98 - 3.2.03 01.07.99	1020, 1022
				T 541/98 - 3.5.01 10.02.00	933
				T 552/98 - 3.3.03 07.11.00	958
				T 554/98 - 3.2.04 05.10.99	472

T 564/98 - 3.2.01 06.06.00	1162
T 587/98 - 3.5.02 12.05.00 2000, 497	505, 508-511, 832
T 590/98 - 3.3.02 30.04.03	1117
T 592/98 - 3.2.02 05.10.01	674
T 598/98 - 3.3.05 16.10.01	975
T 619/98 - 3.5.01 23.04.99	34, 204, 213
T 621/98 - 3.5.01 18.06.99	819
T 646/98 - 3.4.02 20.09.01	472
T 656/98 - 3.3.04 18.05.01	815, 958, 959, 1077
T 685/98 - 3.5.02 21.09.98 1999, 346	541, 878, 879, 1207, 1208
T 687/98 - 3.3.03 11.01.01	284
T 690/98 - 3.2.01 22.06.99	777, 1124
T 693/98 - 3.2.01 25.04.02	1033
T 713/98 - 3.3.03 17.01.02	357, 361
T 717/98 - 3.3.06 04.11.02	289-291, 294
T 718/98 - 3.3.06 26.11.02	953
T 728/98 - 3.3.01 12.05.00 2001, 319	127, 262, 270, 279, 281, 297, 410
T 733/98 - 3.4.03 14.12.99	630, 1101
T 740/98 - 3.3.01 09.11.04	429, 528, 828
T 748/98 - 3.3.04 23.05.01	297
T 777/98 - 3.3.07 30.03.01 2001, 509	638
T 778/98 - 3.3.03 07.08.00	536, 1195
T 828/98 - 3.2.04 28.03.00	1015
T 862/98 - 3.4.02 17.08.99	542, 552, 746
T 869/98 - 3.3.06 09.05.00	1180
T 872/98 - 3.2.01 26.10.99	245
T 875/98 - 3.3.03 26.10.01	1197
T 877/98 - 3.2.03 05.10.00	80
T 881/98 - 3.4.01 23.05.00	629, 630
T 887/98 - 3.2.04 19.07.00	1181
T 892/98 - 3.5.01 23.03.00	931
T 910/98 - 3.2.02 30.10.01	151
T 911/98 - 3.5.01 09.04.03	242
T 914/98 - 3.2.01 22.09.00	1053, 1178
T 915/98 - 3.5.01 17.05.00	1181
T 925/98 - 3.2.03 13.03.01	414
T 927/98 - 3.2.04 09.07.99	1024
T 928/98 - 3.2.06 08.11.00	584, 586
T 939/98 - 3.3.03 17.01.02	281
T 942/98 - 3.3.01 13.02.01	231, 421
T 954/98 - 3.5.01 09.12.99	592, 725, 726, 736
T 959/98 - 3.3.06 22.10.02	121
T 960/98 - 3.3.07 09.04.03	358, 359, 361
T 962/98 - 3.3.01 15.01.04	408, 438, 439, 444
T 965/98 - 3.3.04 26.08.99	763
T 985/98 - 3.2.04 21.10.04	250
T 1001/98 - 3.4.02 10.09.03	74
T 1017/98 - 3.2.06 18.06.01	283
T 1020/98 - 3.3.01 27.06.03 2003, 533	269, 271
T 1022/98 - 3.3.05 10.11.99	540
T 1041/98 - 3.2.02 22.10.01	281
T 1043/98 - 3.2.01 11.05.00	196, 197
T 1048/98 - 3.3.01 04.06.02	277
T 1053/98 - 3.5.01 22.10.99	208
T 1055/98 - 3.3.05 04.04.01	356
T 1056/98 - 3.2.01 02.02.00	1054
T 1059/98 - 3.2.01 19.02.02	1001
T 1062/98 - 3.2.06 17.01.02	337, 358, 364
T 1063/98 - 3.3.03 03.07.01	1104
T 1072/98 - 3.3.01 03.06.03	1147
T 1097/98 - 3.2.01 02.02.00	1020
T 1105/98 - 3.2.01 19.09.00	579, 580, 1135, 1157
T 1130/98 - 3.2.01 12.07.99	795
<b>1999</b>	
T 5/99 - 3.2.01 16.05.00	356
T 35/99 - 3.2.02 29.09.99 2000, 447	53
T 37/99 - 3.4.02 09.11.00	1046
T 42/99 - 3.4.01 21.01.04	995
T 49/99 - 3.5.01 05.03.02	221, 295, 1093
T 52/99 - 3.3.02 22.08.00	1128
T 68/99 - 3.3.07 12.06.03	419, 424
T 71/99 - 3.4.02 20.06.01	663, 732
T 72/99 - 3.4.03 26.06.02	619
T 76/99 - 3.4.02 09.10.01	1117
T 79/99 - 3.3.02 03.12.99	593
T 91/99 - 3.3.02 24.01.03	991, 994

Table of cases

T 131/99 - 3.4.02 19.07.01	392	T 596/99 - 3.3.03 05.12.01	695
T 151/99 - 3.5.01 24.10.01	99, 689, 700	T 598/99 - 3.4.03 17.12.02	1114
T 172/99 - 3.3.03 07.03.02	335, 336	T 605/99 - 3.2.06 25.04.02	931
T 190/99 - 3.2.04 06.03.01	287, 451, 464	T 609/99 - 3.5.02 13.11.01	942
T 201/99 - 3.3.06 10.09.04	379, 431, 434	T 613/99 - 3.2.01 30.08.99	920
T 212/99 - 3.5.02 12.09.01	89	T 620/99 - 3.3.04 08.05.03	297, 1012
T 231/99 - 3.2.04 31.08.99	584, 586, 587, 750, 1072, 1194	T 647/99 - 3.3.02 04.04.00	1193
T 240/99 - 3.2.03 12.12.02	1118	T 652/99 - 3.2.06 22.02.01	933
T 241/99 - 3.5.02 06.12.01	1024, 1025	T 653/99 - 3.3.04 18.09.02	1019
T 263/99 - 3.2.02 20.06.00	165	T 663/99 - 3.2.01 06.02.01	541, 1198
T 264/99 - 3.2.01 14.11.00	97, 455	T 668/99 - 3.2.03 14.09.04	1003, 1004
T 274/99 - 3.3.06 16.05.01	944	T 686/99 - 3.3.01 22.01.03	419, 421, 422, 425
T 275/99 - 3.3.02 25.07.00	882, 1181	T 702/99 - 3.3.02 03.12.03	252, 678
T 276/99 - 3.5.01 26.09.01	332, 1272	T 710/99 - 3.4.03 11.02.03	1154
T 304/99 - 3.2.01 07.05.01	1168, 1169	T 711/99 - 3.3.07 21.10.03 2004, 550	962, 963
T 308/99 - 3.3.02 02.06.03	240	T 717/99 - 3.3.03 18.11.04	430
T 314/99 - 3.3.03 21.06.01	92, 177, 680, 783	T 724/99 - 3.3.02 24.10.01	1117
T 320/99 - 3.4.03 26.09.02	1201	T 736/99 - 3.5.02 20.06.02	944, 957
T 323/99 - 3.3.01 17.10.01	243	T 744/99 - 3.5.01 15.01.02	375, 381
T 329/99 - 3.3.06 05.04.01	407	T 758/99 - 3.5.01 25.01.01	1002
T 363/99 - 3.3.02 19.04.04	271	T 806/99 - 3.4.02 21.10.00	793
T 372/99 - 3.2.05 17.11.00	1188, 1189	T 809/99 - 3.2.06 22.10.02	1117
T 410/99 - 3.3.06 20.01.03	102	T 827/99 - 3.5.01 14.07.04	658
T 413/99 - 3.3.06 21.02.02	358	T 832/99 - 3.2.05 17.09.04	607, 636
T 427/99 - 3.3.01 15.11.01	1094, 1129	T 833/99 - 3.2.03 17.04.02	246, 678, 687
T 438/99 - 3.5.02 24.01.02	486	T 877/99 - 3.3.01 31.07.01	243, 262
T 451/99 - 3.3.04 14.03.03 2003, 334	112	T 898/99 - 3.2.06 05.11.02	586
T 468/99 - 3.3.06 16.05.03	584, 586, 935, 1128	T 930/99 - 3.2.07 01.08.02	342, 358, 361
T 473/99 - 3.2.05 22.10.02	1039	T 932/99 - 3.3.07 03.08.04	293, 1104
T 478/99 - 3.2.04 07.12.00	94	T 934/99 - 3.2.02 18.04.01	1020
T 481/99 - 3.2.06 21.06.02	956	T 945/99 - 3.3.02 17.12.04	293
T 484/99 - 3.3.03 25.07.00	579	T 947/99 - 3.3.02 27.11.03	89, 957
T 491/99 - 3.2.01 24.10.00	113, 114	T 950/99 - 3.3.08 11.11.02	1100
T 494/99 - 3.3.02 19.02.03	253	T 952/99 - 3.3.03 10.12.02	155, 283, 1156
T 507/99 - 3.3.05 20.12.02 2003, 225	112	T 957/99 - 3.2.06 12.12.02	584, 586
T 525/99 - 3.3.01 12.09.02	105	T 958/99 - 3.2.06 23.05.01	871
T 543/99 - 3.3.06 24.10.00	1188, 1189	T 966/99 - 3.2.06 03.12.02	586
T 553/99 - 3.2.01 21.02.01	477	T 971/99 - 3.3.04 19.04.00	643
T 588/99 - 3.3.06 27.03.03	241	T 989/99 - 3.3.03 14.12.00	897
T 592/99 - 3.3.02 01.08.02	480	T 998/99 - 3.3.02 15.09.03 2005, 229	371, 1222
		T 1001/99 - 3.2.03 27.06.02	5
		T 1008/99 - 3.4.02 04.05.00	483, 495, 508

T 1019/99 - 3.5.01 16.06.04	171, 176
T 1022/99 - 3.2.01 10.04.01	90, 1024
T 1049/99 - 3.3.02 09.11.04	110, 120, 150, 151, 430
T 1050/99 - 3.3.08 25.01.05	426, 428, 431
T 1062/99 - 3.2.01 04.05.00	1026, 1071
T 1065/99 - 3.3.02 19.09.01	535, 1176
T 1080/99 - 3.5.01 31.10.01 2002, 568	81, 569, 572, 573
T 1086/99 - 3.3.02 10.11.04	431
T 1097/99 - 3.3.04 28.05.03	1154
T 1101/99 - 3.3.07 10.04.01	769
<b>2000</b>	
T 4/00 - 3.2.06 17.01.03	104, 586
T 9/00 - 3.3.02 18.12.01 2002, 275	512, 961, 1011
T 12/00 - 3.4.02 07.11.02	684, 1098
T 13/00 - 3.3.02 27.06.03	380
T 36/00 - 3.3.08 02.10.03	346
T 41/00 - 3.4.02 19.12.01	784
T 43/00 - 3.3.02 09.05.03	370
T 48/00 - 3.3.02 12.06.02	1002, 1177
T 54/00 - 3.5.02 19.12.00	1078
T 55/00 - 3.5.01 10.10.00	765
T 60/00 - 3.4.01 03.07.03	904, 1169
T 65/00 - 3.3.07 10.10.01	1019
T 74/00 - 3.4.02 15.03.05	659, 682, 693, 966
T 89/00 - 3.2.03 14.03.02	402
T 97/00 - 3.3.01 25.09.03	252, 696
T 98/00 - 3.3.01 18.03.03	1175
T 100/00 - 3.3.03 07.03.03	128
T 103/00 - 3.3.01 01.04.03	274
T 111/00 - 3.3.04 14.02.02	188
T 112/00 - 3.4.02 26.06.02	128
T 113/00 - 3.5.02 17.09.02	172
T 120/00 - 3.3.04 18.02.03	954
T 134/00 - 3.3.06 05.09.03	180
T 140/00 - 3.3.01 27.06.02	934
T 141/00 - 3.3.05 30.09.02	272
T 149/00 - 3.4.02 30.01.02	169
T 165/00 - 3.2.01 30.11.00	1096, 1102
T 188/00 - 3.4.03 05.05.03	311
T 196/00 - 3.3.01 11.07.02	1129
T 204/00 - 3.4.02 13.11.02	695
T 208/00 - 3.2.01 06.10.00	1197
T 218/00 - 3.2.04 21.03.01	102
T 222/00 - 3.3.08 15.01.03	344
T 244/00 - 3.5.01 15.11.01	32, 211, 212
T 248/00 - 3.3.07 17.02.04	1197
T 250/00 - 3.3.06 24.03.03	289
T 263/00 - 3.2.03 25.05.00	1007, 1070, 1071
T 264/00 - 3.2.04 28.05.01	770
T 268/00 - 3.3.01 16.12.03	231, 883
T 269/00 - 3.5.01 16.03.05	547
T 270/00 - 3.5.01 18.09.01	794
T 278/00 - 3.3.01 11.02.03 2003, 546	751-753, 755, 757, 758, 1196
T 281/00 - 3.5.02 20.08.02	935
T 285/00 - 3.3.06 22.10.04	431
T 289/00 - 3.2.03 20.06.01	374
T 335/00 - 3.2.06 08.10.02	1017
T 336/00 - 3.2.06 08.10.02	1017
T 338/00 - 3.3.08 06.11.02	12, 256, 259
T 349/00 - 3.5.01 05.04.01	1102
T 361/00 - 3.3.05 16.06.04	658, 665, 673, 677
T 375/00 - 3.2.07 07.05.02	534, 660
T 380/00 - 3.4.02 07.05.02	956
T 395/00 - 3.3.04 22.04.04	228
T 402/00 - 3.3.01 05.05.04	494, 495
T 405/00 - 3.3.06 14.10.04	289
T 416/00 - 3.3.07 24.01.06	985, 1172
T 417/00 - 3.2.03 28.01.02	560
T 426/00 - 3.2.04 20.10.04	1225
T 434/00 - 3.3.02 29.06.01	1078
T 446/00 - 3.3.02 03.07.03	717, 953, 1155, 1156
T 451/00 - 3.2.01 21.03.02	99
T 479/00 - 3.3.05 15.02.02	172
T 481/00 - 3.3.02 13.08.04	932, 955
T 485/00 - 3.3.05 22.09.04	337, 364
T 499/00 - 3.3.06 28.01.03	363, 703
T 500/00 - 3.3.07 17.06.04	429, 430, 527, 528, 828, 830
T 508/00 - 3.2.07 29.06.04	658, 670, 956

Table of cases

T 515/00 - 3.2.05 25.06.03	339, 374, 384	T 786/00 - 3.3.03 19.12.01	75, 128, 1088
T 521/00 - 3.2.03 10.04.03	1022	T 787/00 - 3.3.04 26.06.03	942
T 523/00 - 3.2.03 10.07.03	101, 294	T 792/00 - 3.3.04 02.07.02	335, 340, 345, 349, 363, 697, 701
T 530/00 - 3.2.03 11.06.01	934	T 801/00 - 3.4.02 25.06.03	1104
T 532/00 - 3.3.09 01.06.05	180	T 818/00 - 3.3.06 18.07.03	381
T 552/00 - 3.3.04 30.10.03	287	T 824/00 - 3.5.02 24.03.03 2004, 5	907, 1080, 1081
T 558/00 - 3.5.01 18.02.04	162, 242	T 827/00 - 3.3.03 19.06.02	166
T 561/00 - 3.3.05 17.07.02	495	T 835/00 - 3.3.03 07.11.02	166
T 594/00 - 3.3.04 06.05.04	533, 1176, 1195	T 848/00 - 3.3.02 13.11.02	721, 1078
T 607/00 - 3.3.09 21.02.05	975	T 860/00 - 3.3.06 28.09.04	405, 406
T 611/00 - 3.3.06 18.09.01	1170	T 861/00 - 3.5.02 24.06.03	194
T 619/00 - 3.4.02 11.09.03	341, 358, 359, 361	T 862/00 - 3.5.03 29.04.04	1152
T 631/00 - 2.4.02 05.05.04	161, 162	T 866/00 - 3.3.01 30.09.03	339
T 641/00 - 3.5.01 26.09.02 2003, 352	13, 19, 173, 188, 192, 198-210, 214	T 890/00 - 3.3.02 28.10.02	1002
T 643/00 - 3.5.01 16.10.03	209-212, 214, 216, 219	T 915/00 - 3.4.02 19.06.02	243
T 659/00 - 3.5.02 01.07.03	240	T 920/00 - 3.2.06 16.06.03	287
T 660/00 - 3.4.02 17.04.02	237	T 923/00 - 3.3.02 01.08.06	373
T 664/00 - 3.3.02 28.11.02	572	T 926/00 - 3.3.02 26.02.04	240
T 665/00 - 3.3.07 13.04.05	394	T 931/00 - 3.3.05 19.05.03	417, 418
T 681/00 - 3.3.01 26.03.03	1048	T 937/00 - 3.4.02 12.06.03	990, 1044
T 692/00 - 3.3.06 13.05.03	567	T 943/00 - 3.3.03 31.07.03	341, 358, 359
T 699/00 - 3.3.07 25.04.05	1120, 1161	T 946/00 - 3.3.01 24.11.04	176
T 706/00 - 3.2.03 15.05.03	549, 551, 554	T 952/00 - 3.2.03 27.11.02	999, 1001
T 708/00 - 3.5.01 05.12.03 2004, 160	323, 325, 920-922, 924, 926, 927	T 959/00 - 3.3.03 21.01.05	547, 1191
T 714/00 - 3.3.03 06.08.02	417, 439, 440	T 961/00 - 3.3.05 09.12.02	718, 1081, 1201
T 722/00 - 3.2.04 31.10.01	115	T 966/00 - 3.3.03 06.03.03	155
T 725/00 - 3.2.04 16.06.04	554	T 970/00 - 3.4.02 15.09.04	162, 184
T 727/00 - 3.3.06 22.06.01	420, 422	T 979/00 - 3.3.03 20.03.03	166
T 737/00 - 3.3.04 21.05.03	70	T 984/00 - 3.3.04 18.06.02	345, 363
T 740/00 - 3.2.06 10.10.01	587, 751	T 986/00 - 3.5.02 25.02.03 2003, 554	552, 1138
T 747/00 - 3.3.01 01.03.05	431	T 1016/00 - 3.2.07 12.04.02	1196
T 751/00 - 3.3.08 21.05.03	363	T 1023/00 - 3.4.03 17.09.03	364
T 778/00 - 3.2.04 06.07.01 2001, 554	515, 525, 1095, 1188	T 1029/00 - 3.3.02 29.05.01	526
		T 1031/00 - 3.3.02 23.05.02	136
		T 1038/00 - 3.3.04 26.03.02	971
		T 1039/00 - 3.2.04 15.01.01	536, 1195
		T 1048/00 - 3.2.03 18.06.03	558
		T 1050/00 - 3.5.01 07.08.03	941
		T 1074/00 - 3.3.04 13.05.04	262, 277

T 1076/00 - 3.3.04 05.08.03	284, 942, 944	T 260/01 - 3.2.03 22.01.02	272
T 1084/00 - 3.3.08 11.04.03	279, 287	T 283/01 - 3.3.05 03.09.02	621
T 1102/00 - 3.3.08 01.06.04	191, 428	T 295/01 - 3.3.04 07.09.01	2002, 251 1026, 1071
T 1105/00 - 3.3.06 21.10.03	684	T 311/01 - 3.2.03 04.11.01	659, 660
T 1127/00 - 3.3.08 16.12.03	395	T 314/01 - 3.5.01 18.12.03	603
T 1143/00 - 3.2.03 07.11.02	971	T 318/01 - 3.4.02 18.11.04	751, 1119
T 1164/00 - 3.3.06 02.09.03	1036	T 320/01 - 3.3.01 12.03.04	231
T 1172/00 - 3.5.02 05.09.01	621	T 343/01 - 3.3.04 12.05.05	533, 1176
T 1173/00 - 3.5.02 05.06.03	2004, 16 339	T 344/01 - 3.3.02 15.03.05	358
T 1176/00 - 3.5.02 23.07.03	505, 1094	T 351/01 - 3.3.08 02.07.03	346, 382, 383
T 1177/00 - 3.5.02 24.07.03	505	T 360/01 - 3.3.03 21.10.03	1156
T 1188/00 - 3.3.03 30.04.03	178, 180, 231	T 373/01 - 3.5.03 14.10.04	293
T 1195/00 - 3.2.02 24.05.04	239	T 377/01 - 3.5.01 14.10.03	922, 926
T 1201/00 - 3.2.01 07.11.02	1174	T 379/01 - 3.5.01 24.03.04	769
T 1204/00 - 3.2.06 20.05.03	120	T 380/01 - 3.3.06 28.05.04	288
<b>2001</b>		T 386/01 - 3.4.02 24.07.03	938, 980, 1121
T 6/01 - 3.3.04 02.12.03	270	T 387/01 - 3.2.06 13.01.04	341, 358
T 10/01 - 3.3.08 09.03.05	432	T 393/01 - 3.3.02 13.07.04	240
T 12/01 - 3.3.08 02.12.03	689	T 396/01 - 3.5.01 25.05.04	293, 403
T 14/01 - 3.3.06 03.11.04	430	T 397/01 - 3.3.06 14.12.04	1128, 1131, 1153
T 15/01 - 3.3.04 17.06.04	2006, 153 367, 371, 959, 1016, 1040, 1089, 1109, 1221	T 402/01 - 3.5.01 21.02.05	1173, 1180
T 30/01 - 3.4.02 29.06.04	380, 784	T 423/01 - 3.3.04 25.03.04	161, 379
T 34/01 - 3.2.01 18.02.03	941	T 459/01 - 3.2.06 06.11.03	586
T 55/01 - 3.5.01 11.02.03	80, 100, 655	T 475/01 - 3.3.08 15.06.04	42, 44, 818, 820
T 56/01 - 3.5.01 21.01.04	266, 267	T 486/01 - 3.3.04 03.09.03	147
T 79/01 - 3.3.04 25.03.03	1188	T 493/01 - 3.3.08 04.06.03	192
T 83/01 - 3.3.02 10.08.04	336, 337	T 500/01 - 3.3.04 12.11.03	287, 289, 292, 456, 1156
T 87/01 - 3.5.02 11.09.03	74	T 508/01 - 3.5.02 09.10.01	758
T 125/01 - 3.5.01 11.12.02	19	T 514/01 - 3.2.07 11.09.03	984, 1000
T 129/01 - 3.2.06 25.06.03	1190	T 520/01 - 3.2.07 29.10.03	1034, 1219
T 131/01 - 3.2.01 18.07.02	2003, 115 578, 938, 1032	T 524/01 - 3.3.08 21.10.05	334
T 133/01 - 3.3.01 30.09.03	252	T 540/01 - 3.3.01 05.11.03	1147
T 134/01 - 3.3.01 27.01.05	112, 431	T 545/01 - 3.2.01 16.09.03	281
T 135/01 - 3.5.02 21.01.04	394, 1031	T 554/01 - 3.3.09 20.10.05	988
T 136/01 - 3.4.03 30.11.05	380	T 579/01 - 3.3.04 30.06.04	459, 467, 468, 470
T 151/01 - 3.3.02 09.02.06	278	T 580/01 - 3.3.02 29.11.05	431
T 193/01 - 3.4.02 04.06.04	278, 281	T 583/01 - 3.3.02 26.07.05	107
T 211/01 - 3.3.06 01.12.03	169	T 584/01 - 3.3.02 21.04.05	431
T 214/01 - 3.5.01 07.03.03	176, 936	T 591/01 - 3.3.02 16.03.05	1085
T 230/01 - 3.3.02 26.04.05	111	T 594/01 - 3.3.01 30.03.04	132

Table of cases

T 604/01 - 3.5.03 12.08.04	459, 938, 1190, 1196	T 922/01 - 3.4.02 09.07.03	978
T 611/01 - 3.3.02 23.08.04	540, 733	T 933/01 - 3.2.06 28.06.04	298
T 622/01 - 3.2.02 08.05.02	621	T 942/01 - 3.3.06 12.08.04	478
T 638/01 - 3.5.02 12.09.01	1110	T 948/01 - 3.3.01 08.04.04	170, 188
T 639/01 - 3.3.01 09.02.05	431	T 981/01 - 3.4.03 24.11.04	1083
T 642/01 - 3.4.01 23.05.05	1172	T 985/01 - x.x.xx 18.03.05	725, 729, 736
T 643/01 - 3.4.03 07.07.04	805	T 991/01 - 3.4.02 14.10.03	1172
T 650/01 - 3.4.01 14.10.04	165	T 1001/01 - 3.3.02 11.10.07	444
T 652/01 - 3.4.02 12.09.02	109	T 1003/01 - 3.2.01 08.12.03	981, 1169
T 655/01 - 3.4.03 25.05.03	553, 980	T 1004/01 - 3.3.07 01.09.04	418, 444, 480, 1152, 1153
T 667/01 - 3.5.03 15.02.06	83, 689	T 1011/01 - 3.5.01 16.11.04	329
T 669/01 - 3.3.04 22.05.02	147	T 1017/01 - 3.5.03 30.11.04	78
T 681/01 - 3.3.07 28.11.06	97, 292, 357	T 1021/01 - x.x.xx 18.03.05	724
T 694/01 - 3.3.04 04.07.02 2003, 250	970, 973	T 1034/01 - 3.4.03 29.01.04	945
T 708/01 - 3.5.03 17.03.05	976	T 1052/01 - 3.2.01 01.07.03	465
T 713/01 - 3.3.03 07.10.03	696	T 1056/01 - 3.2.02 04.06.03	368, 369, 388, 690
T 715/01 - 3.3.04 24.09.02	1089	T 1064/01 - 3.3.01 25.03.04	231
T 716/01 - 3.3.08 10.11.04	350	T 1069/01 - 3.2.01 12.08.02	272
T 717/01 - 3.2.01 14.01.03	1105, 1107	T 1081/01 - 3.3.01 27.09.04	90-92
T 730/01 - 3.3.01 03.02.04	132	T 1092/01 - 3.3.04 26.04.05	152
T 736/01 - 3.3.09 04.08.05	1170	T 1098/01 - 3.3.02 13.04.05	1120
T 739/01 - 3.3.02 06.10.05	431	T 1122/01 - 3.4.02 06.05.04	582
T 749/01 - 3.2.05 23.08.02	974	T 1146/01 - 3.3.03 02.09.04	417, 418, 431
T 785/01 - 3.2.01 30.09.03	617, 621	T 1147/01 - 3.3.04 16.06.04	1083
T 788/01 - 3.3.03 13.06.03	380, 381	T 1156/01 - 3.3.09 21.06.05	269, 278, 279
T 794/01 - 3.3.03 28.08.03	250	T 1157/01 - 3.3.06 01.09.04	718, 800, 1201
T 796/01 - 3.3.05 09.01.06	269	T 1174/01 - 3.2.03 12.12.02	554
T 803/01 - 3.3.03 09.09.03	128, 239, 297	T 1182/01 - 3.3.03 14.06.05	932, 941, 952, 985, 1002
T 808/01 - 3.2.01 11.05.04	1100	T 1186/01 - 3.3.07 19.07.06	276
T 811/01 - 3.3.04 06.08.04	345	T 1190/01 - 3.2.02 22.07.03	270
T 836/01 - 3.3.04 07.10.03	142, 144	T 1195/01 - 3.4.01 16.12.05	403
T 837/01 - 3.2.03 08.09.03	552, 761	T 1200/01 - 3.5.02 06.11.02	692, 698, 699
T 846/01 - 3.5.01 17.09.02	1074, 1100	T 1206/01 - 3.3.01 23.09.04	419, 422, 473
T 866/01 - 3.3.02 11.05.05	37, 779, 1013, 1088	T 1212/01 - 3.3.02 03.02.05	164, 244, 245, 248
T 872/01 - 3.3.03 14.07.04	1156	T 1228/01 - 3.3.04 23.04.03	375, 445
T 880/01 - 3.5.01 09.06.05	1039, 1161		
T 881/01 - 3.3.04 19.03.04	292		
T 892/01 - 3.3.02 07.11.05	76		
T 906/01 - 3.2.02 28.09.04	99		
T 913/01 - 3.3.06 11.10.04	92, 97		
T 914/01 - 3.3.03 02.12.03	336		
T 917/01 - 3.2.03 17.06.03	976		
T 918/01 - 3.3.04 06.10.04	185-187		



T 1239/01 - 3.3.01 07.01.04	232	T 295/02 - 3.3.03 01.12.03	276, 286
T 1250/01 - 3.3.05 14.05.03	337, 340	T 302/02 - 3.3.04 12.03.04	229, 817, 821
T 1277/01 - 3.3.09 25.11.04	226	T 315/02 - 3.2.02 12.09.03	81
T 1281/01 - 3.5.02 23.01.03	787, 788, 1094	T 318/02 - 3.3.01 21.09.04	185
T 1285/01 - 3.3.01 06.07.04	170	T 326/02 - 3.3.03 11.05.04	155, 1048
<b>2002</b>		T 329/02 - 3.5.03 03.08.05	655, 661, 665, 683
T 6/02 - 3.3.07 03.02.05	246	T 343/02 - 3.5.01 20.01.03	796
T 14/02 - 3.2.07 05.11.03	1136, 1157	T 357/02 - 3.3.03 30.07.04	180
T 21/02 - 3.3.01 20.02.06	1207	T 362/02 - 3.3.02 26.06.02	1196, 1205
T 23/02 - 3.3.03 19.07.05	403	T 369/02 - 3.3.07 07.07.05	252
T 30/02 - 3.3.08 09.10.06	382, 383	T 370/02 - 3.3.07 14.12.06	89
T 36/02 - 3.3.10 20.03.06	1120	T 374/02 - 3.2.07 13.10.05	657
T 41/02 - 3.3.03 19.01.06	691	T 378/02 - 3.3.04 12.10.05	281
T 50/02 - 3.3.01 29.06.04	1129	T 381/02 - 3.3.03 26.08.04	1048
T 64/02 - 3.2.06 19.01.05	579	T 396/02 - 3.3.07 02.08.05	341, 359, 361
T 67/02 - 3.3.02 14.05.04	434	T 397/02 - 3.3.08 10.10.03	340, 363
T 68/02 - 3.2.07 24.06.04	586, 937	T 401/02 - 3.5.01 15.01.04	580
T 70/02 - 3.2.04 15.03.02	537, 751, 753	T 407/02 - 3.4.03 12.11.03	1093, 1121
T 84/02 - 3.2.06 27.09.02	1078	T 408/02 - 3.5.01 07.04.05	996
T 107/02 - 3.3.06 15.06.05	241	T 411/02 - 3.3.04 07.11.06	470, 1128
T 109/02 - 3.2.02 20.01.05	567, 1138	T 412/02 - 3.3.03 16.06.04	278, 279, 295
T 117/02 - 3.3.03 07.11.05	934	T 413/02 - 3.5.01 05.05.04	964
T 127/02 - 3.3.08 16.09.03	284	T 425/02 - 3.2.06 21.10.04	472
T 133/02 - 3.5.01 27.09.05	267	T 435/02 - 3.2.01 01.04.04	992
T 138/02 - 3.3.05 27.06.06	144, 146	T 441/02 - 3.3.03 19.05.04	239
T 143/02 - 3.2.05 08.01.04	342	T 442/02 - 3.3.01 26.10.04	227
T 147/02 - 3.3.05 27.04.05	190	T 454/02 - 3.3.10 08.02.06	933
T 149/02 - 3.4.03 25.07.03	1112	T 457/02 - 3.3.09 16.11.05	288
T 161/02 - 3.3.08 13.09.04	433	T 462/02 - 3.5.01 11.02.03	619
T 174/02 - 3.4.01 25.11.04	281	T 475/02 - 3.3.07 21.12.06	496
T 181/02 - 3.2.04 13.10.03	567, 1043, 1138	T 482/02 - 3.5.01 09.02.05	209, 1013, 1016
T 186/02 - 3.4.03 29.06.04	532	T 496/02 - 3.3.03 11.01.05	166, 252
T 210/02 - 3.3.02 01.10.04	181	T 497/02 - 3.3.04 27.05.04	884
T 226/02 - 3.2.07 13.07.04	767	T 499/02 - 3.3.07 24.06.05	276
T 241/02 - 3.2.07 24.09.04	463	T 502/02 - 3.5.01 17.01.03	1106, 1169
T 250/02 - 3.3.04 28.04.05	380, 470	T 506/02 - 3.3.08 18.01.05	431
T 252/02 - 3.2.06 07.12.04	341, 358	T 511/02 - 3.2.03 17.02.04	1024
T 268/02 - 3.3.02 31.01.03	1075	T 552/02 - 3.2.04 15.10.03	640, 829
T 269/02 - 3.3.02 20.07.05	999	T 553/02 - 3.3.06 14.07.04	5, 121
T 273/02 - 3.5.01 27.04.05	966	T 556/02 - 3.2.04 19.02.03	290, 291
T 283/02 - 3.2.04 09.04.03	781, 977, 1204	T 558/02 - 3.2.04 23.07.03	619
T 287/02 - 3.2.03 03.09.04	265	T 563/02 - 3.3.06 31.05.05	358, 662
T 288/02 - 3.4.03 22.04.04	299		

Table of cases

T 564/02 - 3.3.03 30.09.04	297, 298	T 838/02 - 3.3.07 29.01.03	732, 746, 747, 1177
T 567/02 - 3.3.03 14.10.04	955	T 844/02 - 3.2.01 06.02.04	272
T 569/02 - 3.2.07 02.06.04	954	T 845/02 - 3.2.02 07.06.05	178, 180
T 574/02 - 3.3.09 26.04.05	667, 935, 983	T 850/02 - 3.2.05 05.04.05	160
T 576/02 - 3.2.04 27.03.03	384	T 854/02 - 3.3.02 14.10.02	1083, 1169
T 587/02 - 3.5.01 12.09.02	535, 870, 883	T 858/02 - 3.5.03 12.08.05	32
T 609/02 - 3.3.08 27.10.04	115, 181, 344, 347, 348, 352	T 861/02 - 3.5.01 25.06.04	757
T 611/02 - 3.2.06 09.11.04	341, 358	T 864/02 - 3.3.06 19.05.05	1085
T 619/02 - 3.4.02 22.03.06 2007, 63	3, 5, 7, 10, 29, 198, 200, 205, 208	T 885/02 - 3.3.01 15.12.04	657, 659, 663, 678
T 646/02 - 3.2.03 21.09.04	1119	T 889/02 - 3.3.04 22.03.05	187
T 653/02 - 3.3.03 09.07.04	781, 1119	T 890/02 - 3.3.08 10.10.04 2005, 497	76, 77, 362, 702
T 663/02 - 3.4.01 17.03.11	54	T 893/02 - 3.3.08 26.05.04	182
T 668/02 - 3.3.01 08.03.05	252	T 900/02 - 3.3.08 28.04.04	725, 734, 746, 1198, 1202
T 671/02 - 3.3.06 10.08.04	625	T 910/02 - 3.4.03 22.06.04	563
T 674/02 - 3.3.10 23.02.06	472	T 914/02 - 3.4.01 12.07.05	3, 6, 7, 11, 20, 24, 29, 30, 198, 273
T 677/02 - 3.2.05 22.04.04	624	T 922/02 - 3.2.03 10.03.04	540, 1176
T 681/02 - 3.4.02 05.06.03	580, 1135, 1155	T 924/02 - 3.3.01 04.11.04	231
T 684/02 - 3.3.03 12.10.07	151, 153, 1046	T 929/02 - 3.4.02 09.12.04	234
T 696/02 - 3.4.02 02.11.04	562, 1084	T 934/02 - 3.2.01 29.04.04	1039, 1105, 1107, 1120, 1122, 1161
T 713/02 - 3.3.01 12.04.05 2006, 267	749, 858, 1070, 1071	T 948/02 - 3.3.03 05.04.05	421
T 718/02 - 3.2.02 22.02.05	107	T 953/02 - 3.3.03 08.06.05	783
T 723/02 - 3.3.05 13.05.05	489	T 963/02 - 3.4.03 29.09.04	751, 755
T 749/02 - 3.4.03 20.01.04	761, 1179, 1196, 1199	T 966/02 - 3.2.04 01.12.04	540, 1012
T 750/02 - 3.2.01 27.05.04	467	T 972/02 - 3.2.06 08.07.05	92, 674
T 764/02 - 3.5.01 20.09.05	208	T 977/02 - 3.5.02 16.06.04	156, 472
T 767/02 - 3.4.03 01.06.05	178	T 979/02 - 3.4.02 08.10.03	862, 1138
T 779/02 - 3.4.02 24.11.04	245	T 982/02 - 3.3.03 11.05.05	932
T 794/02 - 3.2.03 07.06.05	1039, 1120, 1161	T 988/02 - 3.3.03 30.10.03	269, 278
T 796/02 - 3.3.08 01.04.04	1162	T 991/02 - 3.2.01 26.09.03	1200
T 799/02 - 3.2.04 27.07.04	176	T 992/02 - 3.3.01 22.11.05	279, 295
T 806/02 - 3.3.05 28.11.06	124	T 1018/02 - 3.5.01 09.12.03	290, 293, 402, 477, 1121, 1161
T 830/02 - 3.5.01 11.10.05	329	T 1023/02 - 3.3.04 19.05.07	287, 289, 290, 292, 348
T 833/02 - 3.3.01 16.11.04	170	T 1024/02 - 3.2.05 12.05.04	619
T 836/02 - 3.3.01 01.06.05	100		

T 1028/02 - 3.2.04 07.12.04	237	T 172/03 - 3.5.01 27.11.03	20, 162,
T 1033/02 - 3.3.10 26.04.06	341, 358, 359		164, 193, 199, 205
T 1045/02 - 3.5.02 13.11.03	1098, 1100, 1101	T 175/03 - 3.3.03 03.11.05	373
T 1063/02 - 3.5.02 16.06.04	587	T 178/03 - 3.3.01 11.04.06	573
T 1067/02 - 3.3.08 30.11.04	447	T 190/03 - x.x.xx 18.03.05 2006, 502	241, 724, 725, 736
T 1081/02 - 3.5.01 13.01.04	520, 541, 750, 890	T 207/03 - 3.3.10 08.03.07	983
T 1090/02 - 3.3.04 30.09.04	155	T 208/03 - 3.2.05 20.04.05	358
T 1091/02 - 3.3.04 23.07.04 2005, 14	959, 960, 963, 964	T 215/03 - 3.3.06 18.11.05	954
T 1109/02 - 3.5.03 07.09.05	559	T 217/03 - 3.3.06 02.03.05	430
T 1121/02 - 3.2.04 24.11.03	200, 204	T 225/03 - 3.2.01 22.06.07	658, 686
T 1147/02 - 3.3.04 31.05.06	697	T 234/03 - 3.3.01 18.05.06	251, 253
T 1151/02 - 3.2.02 04.11.03	294	T 237/03 - 3.4.02 09.11.0	933
T 1170/02 - 3.3.09 01.03.06	415	T 255/03 - 3.2.04 31.08.04	168
T 1175/02 - 3.3.07 16.03.05	240	T 257/03 - 3.3.06 15.03.04	1106
T 1183/02 - 3.5.02 17.02.03 2003, 404	1194	T 258/03 - 3.5.01 21.04.04 2004, 575	3-10, 13, 19, 21-29, 198, 200, 203, 204
T 1193/02 - x.x.xx 18.03.05	724, 726, 728	T 261/03 - 3.3.03 24.11.05	964, 966
T 1197/02 - 3.2.02 12.07.06	64	T 265/03 - 3.3.02 27.04.07	758
T 1202/02 - 3.2.07 09.12.04	194, 1152	T 267/03 - 3.4.02 28.09.05	80, 936
T 1212/02 - 3.4.02 12.04.05	818, 820	T 274/03 - 3.2.01 08.07.04	919, 922, 925, 926
T 1216/02 - 3.5.02 24.02.03	1212	T 278/03 - 3.3.08 18.01.05	185
<b>2003</b>		T 281/03 - x.x.xx 18.03.05	540, 541, 585, 724, 732, 1209, 1213
T 3/03 - 3.3.06 19.10.04	439	T 283/03 - x.x.xx 18.03.05	724, 726, 728, 736
T 12/03 - 3.2.05 03.02.04	1191, 1196	T 285/03 - 3.4.03 10.05.05	433
T 23/03 - 3.3.06 31.01.05	1096, 1106	T 307/03 - 3.3.07 03.07.07 2009, 422	508, 510, 511
T 25/03 - 3.2.06 08.02.05	439, 441	T 309/03 - 3.3.07 30.07.03 2004, 91	1168
T 30/03 - 3.2.06 12.05.05	1154	T 315/03 - 3.3.08 06.07.04 2006, 15	37, 38, 40-42, 45, 46, 1013, 1198
T 45/03 - 3.3.03 19.01.05	1156	T 323/03 - 3.3.06 26.11.04	162, 181
T 53/03 - 3.4.02 10.11.03	981	T 335/03 - 3.4.02 26.07.05	477
T 60/03 - 3.2.03 13.07.05	412	T 339/03 - 3.3.10 11.11.05	170
T 61/03 - 3.3.04 12.04.05	294	T 353/03 - 3.4.02 25.08.03	923
T 64/03 - 3.3.03 01.02.05	295, 490	T 354/03 - 3.3.01 07.12.04	170
T 81/03 - 3.5.01 12.02.04	462, 1128, 1131, 1133, 1152	T 355/03 - 3.3.01 30.10.03	555
T 86/03 - 3.3.06 28.06.04	933	T 361/03 - 3.4.03 21.06.05	1170
T 90/03 - 3.3.08 17.03.05	123		
T 131/03 - 3.4.02 22.12.04	701		
T 132/03 - 3.5.01 05.03.04	1106		
T 152/03 - 3.2.02 22.04.04	99		
T 157/03 - 3.3.04 04.01.05	344, 954		
T 163/03 - 3.2.06 05.02.07	98		
T 168/03 - 3.3.02 07.03.03	1109		

Table of cases

T 373/03 - 3.4.01 02.09.05	86	T 664/03 - 3.3.09 20.10.04	484	
T 378/03 - 3.3.01 04.07.06	175, 251	T 668/03 - 3.2.04 06.12.07	997	
T 382/03 - 3.5.01 20.07.04	813	T 671/03 - 3.2.04 20.07.06	932, 952, 985	
T 383/03 - 3.2.02 01.10.04	2005, 159	53	T 674/03 - 3.2.03 19.12.05	998
T 394/03 - 3.4.02 04.03.05	297, 1085, 1086	T 715/03 - 3.3.02 16.01.06	103	
T 397/03 - 3.5.02 10.01.06	585	T 719/03 - 3.2.03 14.10.04	636, 637	
T 404/03 - 3.5.01 12.07.06	410, 411, 442	T 745/03 - 3.4.02 22.09.05	717, 873	
T 407/03 - 3.2.02 15.11.05	97	T 749/03 - 3.4.02 15.09.05	287, 451, 467	
T 412/03 - 3.3.01 16.06.05	294	T 759/03 - 3.3.04 17.08.06	187	
T 420/03 - 3.2.04 10.05.05	1004, 1093	T 764/03 - 3.4.03 10.02.05	1130, 1163	
T 423/03 - 3.3.03 10.10.03	494, 495	T 772/03 - 3.5.03 22.04.04	576	
T 424/03 - 3.5.01 23.02.06	6, 7, 9, 16, 19, 23, 25-27, 200, 213, 1223	T 794/03 - 3.2.01 22.03.05	472	
T 427/03 - 3.3.02 13.10.04	1196	T 803/03 - 3.3.03 21.04.04	802	
T 431/03 - 3.3.03 03.05.06	290	T 806/03 - 3.3.03 13.09.06	496	
T 449/03 - 3.4.01 28.11.03	869	T 808/03 - 3.5.02 12.02.04	620, 624, 639, 743, 1109	
T 455/03 - 3.3.01 05.07.05	1129	T 813/03 - 3.5.02 07.01.04	272	
T 466/03 - 3.5.02 21.09.04	521	T 818/03 - 3.4.03 06.07.05	272	
T 469/03 - 3.5.01 24.02.06	511	T 823/03 - 3.2.07 10.02.05	172	
T 492/03 - 3.3.08 11.03.05	544	T 826/03 - 3.4.01 16.03.07	690	
T 494/03 - 3.3.08 18.05.05	380	T 830/03 - 3.5.02 21.09.04	521, 750, 890, 1094	
T 497/03 - 3.3.01 08.08.06	761	T 843/03 - 3.3.04 25.10.04	386	
T 507/03 - 3.5.02 07.10.05	989	T 849/03 - 3.5.03 19.08.04	540	
T 525/03 - 3.4.02 27.09.05	266	T 853/03 - 3.3.01 12.10.05	230	
T 531/03 - 3.4.03 17.03.05	193, 199, 200, 203, 208	T 859/03 - 3.3.06 06.07.05	165, 287	
T 537/03 - 3.2.03 10.11.05	380	T 861/03 - 3.3.02 28.11.03	879, 1207	
T 542/03 - 3.3.04 14.07.05	187	T 874/03 - 3.2.04 28.06.05	932, 940, 986	
T 548/03 - 3.2.03 28.03.06	166	T 882/03 - 3.3.09 11.04.06	338, 358, 361	
T 558/03 - 3.3.04 02.06.05	405	T 883/03 - 3.3.04 07.09.05	245	
T 571/03 - 3.5.01 22.03.06	1196	T 897/03 - 3.3.08 16.03.04	751, 755, 757, 1196	
T 572/03 - 3.x.0x 18.03.05	724, 736	T 900/03 - 3.2.01 18.10.05	978	
T 599/03 - 3.3.03 06.09.05	166	T 907/03 - 3.2.05 11.10.05	1028	
T 602/03 - 3.5.01 25.04.06	1137	T 909/03 - 3.2.05 01.02.05	548, 672	
T 621/03 - 3.3.09 23.05.06	270	T 910/03 - 3.2.05 07.07.05	373, 410, 442, 448	
T 637/03 - 3.5.01 21.07.05	284	T 913/03 - 3.5.02 16.06.05	1135	
T 651/03 - 3.3.10 10.05.07	1129, 1131, 1156	T 922/03 - 3.2.01 11.05.05	1152	
T 653/03 - 3.2.04 08.04.05	438	T 924/03 - 3.4.02 27.09.05	76	
T 655/03 - 3.2.04 17.06.05	1105			
T 658/03 - 3.3.03 07.10.04	405			
T 659/03 - 3.2.01 04.10.04	266			

T 928/03 - 3.5.01 02.06.06	201, 206, 207, 210, 216	T 20/04 - 3.3.08 16.03.05	386
T 956/03 - 3.3.08 19.07.06	964, 965	T 23/04 - 3.3.03 05.04.06	1115
T 958/03 - 3.5.01 17.01.07	209	T 24/04 - 3.2.03 01.07.05	607
T 975/03 - 3.3.04 24.07.07	463	T 32/04 - 3.2.03 27.10.05	609, 610
T 984/03 - 3.3.10 25.07.08	252	T 49/04 - 3.4.03 18.10.05	214-216
T 989/03 - 3.3.02 23.10.07	1128	T 56/04 - 3.4.03 21.09.05	295
T 992/03 - 3.4.01 20.10.06	54, 55	T 70/04 - 3.2.07 25.08.06	1153
T 1000/03 - 3.5.02 03.08.05	552	T 72/04 - 3.3.06 23.03.06	363
T 1002/03 - 3.5.04 17.01.07	541, 869, 872	T 89/04 - 3.5.04 05.07.07	817, 819
T 1012/03 - 3.3.05 01.12.06	580, 581, 836	T 95/04 - 3.4.03 29.09.04	560, 561, 726, 728, 869
T 1020/03 - 3.3.04 29.10.04 2007, 204	144, 148, 284, 1219	T 111/04 - 3.2.07 28.06.06	933
T 1026/03 - 3.5.04 25.01.08	494, 1134	T 125/04 - 3.5.01 10.05.05	32, 34, 211, 214, 219
T 1027/03 - 3.2.01 10.01.05	562, 932	T 126/04 - 3.2.01 29.06.04	650, 1094, 1189
T 1054/03 - 3.2.02 05.07.04	612	T 127/04 - 3.5.03 11.10.06	270
T 1063/03 - 3.3.04 16.12.04	610	T 133/04 - 3.3.03 26.04.06	1134
T 1067/03 - 3.5.01 04.05.05	570, 573, 1136	T 141/04 - 3.4.03 09.11.05	921, 922, 926
T 1102/03 - 3.5.01 28.05.08	568, 569, 571	T 143/04 - 3.2.02 12.09.06	65
T 1110/03 - 3.5.02 04.10.04 2005, 302	77, 538, 582, 654, 671, 675	T 154/04 - 3.5.01 15.11.06 2008, 46	2-4, 10, 11, 15, 34, 121, 173, 197-199, 204, 205, 208-211, 218, 705, 712, 1219, 1221
T 1121/03 - 3.3.10 20.04.06	335	T 162/04 - 3.3.09 28.03.07	999
T 1165/03 - 3.3.08 03.05.07	1015, 1026	T 165/04 - 3.5.01 13.05.05	619
T 1172/03 - 3.2.02 04.05.05	53, 57	T 166/04 - 3.5.01 18.07.07	444, 542
T 1173/03 - 3.3.01 29.06.06	274, 276	T 169/04 - 3.2.03 09.06.05	953
T 1184/03 - 3.5.02 23.06.05	500	T 170/04 - 3.2.03 01.07.05	607
T 1197/03 - 3.3.01 14.06.05	1105	T 172/04 - 3.2.06 13.12.05	788
T 1198/03 - 3.3.02 23.01.07	641, 642, 644	T 176/04 - 3.3.10 30.11.05	100
T 1200/03 - 3.3.07 15.06.05	157	T 188/04 - 3.3.04 31.05.05	308, 312
T 1213/03 - 3.3.06 24.05.05	175, 252	T 191/04 - 3.2.04 13.09.05	444
T 1231/03 - 3.2.01 17.07.06	752	T 200/04 - 3.3.01 24.10.06	444
T 1236/03 - 3.3.03 08.03.06	234	T 201/04 - 3.3.03 29.06.05	974, 975
T 1239/03 - 3.3.03 02.11.06	456, 457, 489	T 215/04 - 3.3.03 26.10.06	161
T 1241/03 - 3.3.04 01.09.05	187, 287, 345, 422	T 221/04 - 3.2.03 05.05.04	619, 633
T 1247/03 - 3.3.03 03.05.05	297	T 234/04 - 3.2.07 10.01.07	175
<b>2004</b>		T 235/04 - 3.3.10 29.06.06	180
T 5/04 - 3.2.02 17.01.06	54		
T 6/04 - 3.4.01 21.07.06	120		

Table of cases

T 240/04 - 3.5.01 13.12.07	873, 1129, 1139, 1142, 1155	T 604/04 - 3.3.08 16.03.06	259, 344, 348
T 242/04 - 3.3.06 13.06.06	989	T 624/04 - 3.4.02 08.11.06	578, 951
T 276/04 - 3.3.08 24.06.04	757	T 658/04 - 3.3.01 01.02.07	331, 659, 684
T 295/04 - 3.2.02 13.07.04	1106	T 667/04 - 3.3.09 23.01.07	1136
T 300/04 - 3.5.01 21.04.05	286, 573	T 696/04 - 3.3.03 15.09.05	1156
T 306/04 - 3.5.01 02.03.07	7	T 707/04 - 3.5.02 04.04.06	1089
T 311/04 - 3.2.01 09.10.07	444	T 711/04 - 3.4.03 12.07.05	1042, 1120
T 313/04 - 3.2.01 19.12.06	662	T 717/04 - 3.2.04 28.02.07	800
T 326/04 - 3.3.06 12.12.06	340	T 726/04 - 3.2.01 29.05.06	867
T 328/04 - 3.3.04 27.11.07	355	T 735/04 - 3.3.07 13.09.07	778, 779
T 329/04 - 3.3.04 04.08.05	75, 77, 196	T 738/04 - 3.4.01 11.12.08	79, 655, 685, 688
T 341/04 - 3.2.05 26.05.06	333	T 742/04 - 3.3.05 14.07.05	566, 1176, 1180
T 347/04 - 3.2.07 06.11.06	870	T 762/04 - 3.3.10 15.11.07	695
T 352/04 - 3.3.07 11.10.07	468	T 763/04 - 3.2.04 22.06.07	536, 537, 751, 758, 880, 882, 884
T 358/04 - 3.3.01 06.12.06	230	T 781/04 - 3.5.03 30.11.05	524, 1086
T 386/04 - 3.2.03 09.01.07	1121, 1161, 1162	T 812/04 - 3.5.01 18.11.05	610, 787
T 388/04 - 3.5.02 22.03.06 2007, 16	3, 5, 7, 29, 30, 198, 199	T 823/04 - 3.5.03 05.08.05	551
T 399/04 - 3.2.02 16.06.05	1180	T 846/04 - 3.4.01 04.07.07	1128
T 431/04 - 3.3.08 13.09.04	1074	T 864/04 - 3.3.09 03.04.07	1022
T 440/04 - 3.3.05 26.11.08	133, 433	T 868/04 - 3.3.10 10.05.06	458
T 441/04 - 3.2.07 07.05.08	686	T 870/04 - 3.3.08 11.05.05	256, 258-260, 344
T 449/04 - 3.2.02 25.02.06	389	T 887/04 - 3.2.01 14.11.06	780, 969
T 452/04 - 3.3.03 12.01.06	341, 358, 359	T 899/04 - 3.5.04 02.04.08	381
T 453/04 - 3.3.03 01.02.07	679, 702	T 902/04 - 3.4.02 07.06.06	565, 1086
T 470/04 - 3.3.06 12.06.07	1138	T 903/04 - 3.3.06 12.09.06	165
T 474/04 - 3.3.07 30.06.05 2006, 129	547, 654, 655, 658, 661, 662, 671, 675	T 908/04 - 3.3.03 15.02.06	278, 295
T 479/04 - 3.3.03 20.10.05	732	T 911/04 - 3.2.02 10.02.05	558
T 489/04 - 3.5.02 08.09.05	618	T 927/04 - 3.3.03 10.05.06	932, 936, 941, 943
T 494/04 - 3.4.01 25.09.07	580, 1135, 1158	T 933/04 - 3.3.07 06.12.07	1145, 1161, 1162
T 505/04 - 3.3.08 07.10.05	289	T 934/04 - 3.4.01 17.06.05	155
T 509/04 - 3.3.04 05.07.05	142	T 936/04 - 3.3.07 24.04.08	512
T 514/04 - 3.3.09 12.09.06	1032, 1033	T 937/04 - 3.3.06 21.02.06	991
T 522/04 - 3.3.08 28.05.09	39	T 941/04 - 3.4.01 26.02.08	77, 196
T 550/04 - 3.3.01 02.04.08	584, 586	T 953/04 - 3.5.01 17.10.07	14, 209
T 562/04 - 3.3.04 14.02.06	473	T 956/04 - 3.3.07 17.01.08	296, 297
T 583/04 - 3.4.03 06.06.06	758, 833	T 978/04 - 3.4.03 08.08.06	1211
T 593/04 - 3.2.07 20.10.05	958		

T 991/04 - 3.3.05 22.11.05	524, 713, 1086	T 1321/04 - 3.2.04 28.02.05	101, 289, 292
T 998/04 - 3.3.01 13.03.07	175, 660, 694	T 1329/04 - 3.3.08 28.06.05	181, 182, 344
T 1033/04 - 3.4.02 21.09.06	1166, 1167	T 1336/04 - 3.3.08 09.03.06	123, 182
T 1040/04 - 3.2.03 23.03.06 2006, 597	1220	T 1341/04 - 3.3.09 10.05.07	1083, 1115
T 1044/04 - 3.5.04 29.01.07	942	T 1343/04 - 3.3.09 11.12.07	150, 153
T 1057/04 - 3.3.10 14.03.07	180	T 1351/04 - 3.5.01 18.04.07	22, 23
T 1059/04 - 3.5.03 17.06.05	551	T 1355/04 - 3.5.04 07.11.08	1120
T 1060/04 - 3.4.02 29.11.07	1158	T 1359/04 - 3.4.01 26.04.05	585
T 1064/04 - 3.3.07 27.06.08	894-896	T 1366/04 - 3.3.10 16.04.08	807, 1069
T 1105/04 - 3.3.09 24.04.08	293, 944	T 1374/04 - 3.3.08 07.04.06 2007, 313	37
T 1123/04 - 3.4.02 25.08.06	752, 758, 833	T 1380/04 - 3.2.06 26.09.06	943, 1115
T 1124/04 - 3.3.03 17.01.07	1155	T 1382/04 - 3.5.01 30.07.09	566
T 1142/04 - 3.4.02 04.03.05	1169	T 1394/04 - 3.2.01 04.05.06	925
T 1154/04 - 3.3.08 21.04.05	534, 538	T 1399/04 - 3.3.04 25.10.06	141, 1176, 1177
T 1161/04 - 3.5.01 06.12.06	13, 33	T 1400/04 - 3.5.04 28.02.08	1154
T 1164/04 - 3.2.06 04.04.06	444	T 1408/04 - 3.2.06 17.11.06	171, 287, 439, 441, 454
T 1177/04 - 3.2.02 14.03.06	945	T 1409/04 - 3.5.04 14.06.07	696
T 1178/04 - 3.3.09 27.02.07 2008, 80	960, 966, 1002, 1009, 1082, 1100, 1113, 1202	T 1416/04 - 3.2.06 14.12.06	1044
T 1181/04 - 3.3.06 31.01.05 2005, 312	891, 893, 894	T 1418/04 - 3.2.05 22.11.07	287
T 1182/04 - 3.2.03 10.07.07	1072	T 1440/04 - 3.2.03 06.02.07	79
T 1187/04 - 3.5.02 06.12.06	1100	<b>2005</b>	
T 1191/04 - 3.5.01 22.11.07	331	T 1/05 - 3.3.03 20.04.07	1044
T 1212/04 - 3.4.02 12.07.06	570	T 4/05 - 3.3.10 03.03.09	1016
T 1216/04 - 3.2.04 22.04.05	1189	T 5/05 - 3.3.01 09.11.05	372, 390, 391
T 1222/04 - 3.5.01 12.04.06	1206	T 6/05 - 3.3.10 09.10.07	960, 964, 965
T 1242/04 - 3.5.01 20.10.06 2007, 421	77, 913, 914, 916, 917, 1218, 1222	T 19/05 - 3.3.05 15.02.12	78, 689
T 1253/04 - 3.3.08 07.06.05	75, 195, 331	T 21/05 - 3.3.04 13.07.06	346
T 1255/04 - 3.3.01 16.03.05 2005, 424	891, 894	T 29/05 - 3.3.08 13.03.06	123, 275, 277, 279
T 1262/04 - 3.3.04 13.07.12	40, 41, 344	T 39/05 - 3.3.06 22.11.06	1222
T 1273/04 - 3.4.03 16.11.07	1134, 1156	T 62/05 - 3.3.03 14.11.06	368, 369, 690
T 1279/04 - 3.4.03 25.09.07	291	T 65/05 - 3.3.05 17.04.08	990, 992
T 1284/04 - 3.5.01 07.03.07	208, 209	T 70/05 - 3.3.08 07.02.06	381-383
T 1306/04 - 3.3.08 08.12.05	182	T 80/05 - 3.3.04 19.11.08	383, 1224
T 1315/04 - 3.2.07 18.04.05	1207	T 83/05 - 3.3.04 10.09.15	46, 49, 713, 714, 1224
T 1316/04 - 3.3.03 25.11.05	358	T 87/05 - 3.3.10 04.09.07	940, 1127, 1152
T 1319/04 - 3.3.02 22.04.08 2009, 36	143		

Table of cases

T 94/05 - 3.2.04 12.07.07	225, 284, 285	T 369/05 - 3.3.10 27.06.07	335
T 97/05 - 3.3.03 31.05.07	457	T 373/05 - 3.2.07 27.03.07	583
T 98/05 - 3.4.03 08.11.07	444	T 382/05 - 3.3.06 18.12.06	1130
T 99/05 - 3.3.03 29.08.06	995	T 383/05 - 3.5.02 01.08.07	994
T 107/05 - 3.5.03 12.06.07	1192, 1196	T 407/05 - 3.4.02 03.07.08	1158
T 123/05 - 3.5.02 24.05.07	990, 991	T 425/05 - 3.3.02 23.05.06	809, 960, 965
T 127/05 - 3.2.01 31.08.06	1168	T 427/05 - 3.2.03 12.06.07	574
T 142/05 - 3.2.01 13.06.06	465	T 433/05 - 3.3.04 14.06.07	182, 347, 348
T 148/05 - 3.3.03 11.10.06	1155, 1156	T 452/05 - 3.2.04 30.08.06	76, 101, 117, 971
T 151/05 - 3.2.04 22.11.07	76, 932, 952	T 461/05 - 3.4.03 10.07.07	439, 442, 443
T 179/05 - 3.3.03 30.11.06	336	T 464/05 - 3.2.06 14.05.07	341, 358
T 184/05 - 3.2.07 05.02.08	417	T 466/05 - 3.3.03 19.12.06	338, 341, 358, 359
T 188/05 - 3.2.05 18.06.07	940, 948	T 471/05 - 3.4.02 06.02.07	7, 20, 29
T 190/05 - 3.2.01 23.07.08	658, 662, 670, 671, 676, 1023	T 474/05 - 3.3.10 19.06.07	405
T 211/05 - 3.5.04 30.07.09	759, 1200	T 490/05 - 3.4.03 21.08.07	995, 998
T 214/05 - 3.3.06 19.01.07	1130	T 514/05 - 3.4.03 08.09.05 2006, 526	524, 1086, 1095
T 222/05 - 3.5.04 12.12.08	489	T 515/05 - 3.3.09 02.08.07	547, 1178
T 223/05 - 3.3.01 24.04.07	116, 290, 292, 1126	T 537/05 - 3.3.03 29.03.07	1080
T 233/05 - 3.5.04 09.01.09	1136	T 555/05 - 3.3.03 24.05.07	278
T 242/05 - 3.2.03 20.09.06	1207	T 570/05 - 3.3.05 07.03.08	417
T 245/05 - 3.2.06 25.05.05	1207	T 591/05 - 3.4.02 11.05.06	500, 506, 1067, 1081
T 248/05 - 3.3.08 25.04.06	1000	T 601/05 - 3.3.04 02.12.09	349, 351, 588
T 250/05 - 3.3.02 04.03.08	475, 478	T 607/05 - 3.3.04 10.09.08	1154
T 255/05 - 3.3.08 18.10.05	554, 892	T 619/05 - 3.5.01 28.02.08	414
T 258/05 - 3.3.07 21.06.07	779	T 629/05 - 3.5.01 06.07.07	330
T 259/05 - 3.3.10 26.03.09	180	T 633/05 - 3.5.02 28.03.07	987
T 263/05 - 3.2.06 28.06.07 2008, 329	268, 584, 586, 1043, 1044, 1125	T 641/05 - 3.3.08 09.11.06	260, 344
T 265/05 - 3.5.01 18.01.08	496, 1182	T 642/05 - 3.3.10 20.03.07	270, 1105
T 272/05 - 3.2.03 08.05.07	1211	T 646/05 - 3.5.02 26.10.07	118
T 297/05 - 3.3.08 02.02.06	284	T 651/05 - 3.3.06 17.05.06	270
T 307/05 - 3.3.03 27.02.07	477, 489, 490	T 666/05 - 3.3.04 13.11.08	383
T 308/05 - 3.5.03 27.02.06	1189, 1213	T 687/05 - 3.2.06 28.09.07	496, 1197
T 313/05 - 3.3.04 06.07.06	91	T 689/05 - 3.5.04 07.09.10	532, 581, 1192
T 316/05 - 3.3.10 19.12.07	751, 753, 1196	T 693/05 - 3.4.02 06.03.07	1078
T 323/05 - 3.3.01 09.08.07	1038	T 700/05 - 3.3.07 18.09.08	650
T 339/05 - 3.3.01 10.04.08	343	T 704/05 - 3.4.03 31.07.07	1110, 1208
T 340/05 - 3.2.01 06.06.07	978	T 708/05 - 3.3.09 14.02.07	118, 132, 1153
T 365/05 - 3.5.01 19.06.07	1218		



T 710/05 - 3.3.08 22.02.07	182	T 998/05 - 3.2.07 22.03.07	884
T 717/05 - 3.4.03 07.09.06	33	T 1007/05 - 3.5.04 18.06.09	1149, 1171, 1182
T 725/05 - 3.3.04 14.10.09	1192	T 1008/05 - 3.3.03 17.01.08	955
T 730/05 - 3.5.03 10.07.07	74	T 1018/05 - 3.2.06 25.09.07	280, 356
T 739/05 - 3.3.06 03.11.05	528	T 1029/05 - 3.3.03 12.03.08	941, 952, 1104
T 743/05 - 3.2.07 12.10.06	617, 693, 788	T 1046/05 - 3.5.02 20.02.08	282
T 752/05 - 3.5.01 31.01.06	1188	T 1048/05 - 3.3.04 05.12.07	284
T 760/05 - 3.2.07 03.06.08	954	T 1053/05 - 3.3.04 22.02.07	781, 1033
T 774/05 - 3.2.07 08.11.07	648, 826, 1011, 1012, 1089	T 1054/05 - 3.5.01 28.05.08	224
T 776/05 - 3.4.03 27.04.06	1138	T 1055/05 - 3.4.03 07.12.06	543, 588, 734
T 783/05 - 3.3.05 08.07.08	282	T 1074/05 - 3.5.04 08.09.09	1022
T 788/05 - 3.2.02 08.05.07	390, 391, 436	T 1082/05 - 3.3.01 26.09.07	1104
T 798/05 - 3.2.02 30.07.07	577, 579, 934	T 1093/05 - 3.5.01 13.06.07 2008, 430	750, 764, 890
T 804/05 - 3.2.03 16.10.07	79, 687, 688	T 1109/05 - 3.2.06 10.04.08	1128
T 824/05 - 3.3.03 28.09.07	167, 168, 181	T 1119/05 - 3.3.03 08.01.08	1126
T 829/05 - 3.2.01 18.07.07	484	T 1120/05 - 3.2.04 21.02.08	420, 455
T 839/05 - 3.2.06 05.10.06	1180, 1181	T 1123/05 - 3.2.04 28.10.08	1158
T 844/05 - 3.5.04 06.10.09	1092	T 1126/05 - 3.3.03 07.11.07	117
T 856/05 - 3.4.03 26.07.07	910	T 1127/05 - 3.3.04 15.01.08	139
T 876/05 - 3.4.01 07.11.07	444, 950	T 1131/05 - 3.3.03 19.02.08	239
T 892/05 - 3.4.03 17.10.07	103	T 1147/05 - 3.5.01 12.03.08	24
T 894/05 - 3.3.10 11.11.08	421	T 1152/05 - 3.3.03 08.04.08	522, 649, 1094, 1189
T 895/05 - 3.2.02 24.01.08	267	T 1170/05 - 3.5.02 27.10.06	760
T 898/05 - 3.3.08 07.07.06	256-260, 344	T 1174/05 - 3.2.04 24.01.08	120
T 902/05 - 3.2.03 27.03.06	624	T 1180/05 - 3.2.02 02.08.07	478
T 903/05 - 3.3.04 30.08.07	381, 387	T 1182/05 - 3.2.01 19.02.08	751, 752, 757, 758
T 906/05 - 3.3.08 25.01.07	287	T 1186/05 - 3.3.09 06.12.07	117, 118, 419
T 912/05 - 3.5.02 15.04.08	203	T 1187/05 - 3.2.06 12.07.07	980
T 916/05 - 3.5.02 10.05.07	999	T 1196/05 - 3.3.03 30.04.08	133
T 922/05 - 3.2.04 07.03.07	1096, 1100, 1101, 1103, 1107	T 1209/05 - 3.3.01 17.12.07	935
T 930/05 - 3.5.01 10.11.06	7, 10, 30	T 1210/05 - 3.3.01 24.01.08	658, 676, 686, 700, 1180
T 942/05 - 3.3.02 13.03.08	1131, 1152	T 1213/05 - 3.3.04 27.09.07	38, 42, 382, 941, 1039, 1224
T 947/05 - 3.3.10 27.11.07	406	T 1216/05 - 3.2.04 10.06.08	228
T 954/05 - 3.3.02 03.05.07	342	T 1217/05 - 3.2.04 08.05.07	284
T 972/05 - 3.3.05 17.03.09	521	T 1220/05 - 3.5.03 08.05.07	720
T 978/05 - 3.3.09 15.07.08	1131		
T 987/05 - 3.3.05 14.10.09	268		

Table of cases

T 1227/05 - 3.5.01 13.12.06 2007, 574	14, 23, 24, 198, 222	T 1464/05 - 3.4.02 14.05.09	91, 97, 164, 189, 451, 684
T 1233/05 - 3.3.10 24.04.08	131, 382	T 1466/05 - 3.3.08 27.07.07	346, 350
T 1237/05 - 3.2.03 15.03.07	1000, 1003	T 1481/05 - 3.2.04 06.03.07	462
T 1252/05 - 3.2.04 25.09.07	1173, 1180	T 1482/05 - 3.2.04 08.02.08	562, 563
T 1267/05 - 3.2.07 21.06.07	945	T 1494/05 - 3.4.01 03.04.06	900, 1176
T 1276/05 - 3.2.07 07.02.08	1106, 1120, 1161, 1162	T 1505/05 - 3.5.01 25.07.08	205
T 1279/05 - 3.4.02 15.07.08	1022	T 1514/05 - 3.3.09 01.07.09	242
T 1282/05 - 3.5.05 20.05.08	1161, 1164	T 1537/05 - 3.2.04 23.11.07	287
T 1305/05 - 3.5.02 25.06.08	1134	T 1538/05 - 3.2.04 28.08.06	12
T 1309/05 - 3.4.02 10.10.06	757, 758, 833	T 1554/05 - 3.5.03 05.07.07	74
T 1311/05 - 3.4.03 11.12.07	1134	T 1557/05 - 3.4.03 04.05.07	933, 1099
T 1314/05 - 3.4.01 15.04.08	137	T 1561/05 - 3.2.03 17.10.06	620, 637, 640, 643, 828
T 1333/05 - 3.3.05 18.06.08	1129, 1136	T 1567/05 - 3.5.01 30.04.08	33, 209, 211, 218
T 1335/05 - 3.3.04 23.01.08	91	T 1578/05 - 3.5.03 26.04.07	871
T 1356/05 - 3.4.03 16.02.06	757, 758, 828, 833	T 1585/05 - 3.3.07 17.11.10	1164
T 1360/05 - 3.4.03 16.02.06	757, 758, 828	T 1586/05 - 3.3.03 06.02.08	358, 359
T 1366/05 - 3.3.10 18.10.07	751, 754, 1196	<b>2006</b>	
T 1378/05 - 3.4.03 09.10.07	813	T 3/06 - 3.4.01 03.05.07	419, 1010
T 1379/05 - 3.3.08 20.02.06	1207	T 33/06 - 3.3.06 18.09.07	857
T 1387/05 - 3.5.04 24.04.08	442, 493	T 53/06 - 3.4.02 21.02.08	991
T 1394/05 - 3.3.05 04.04.08	1039	T 63/06 - 3.2.04 24.06.08	363, 701
T 1401/05 - 3.4.02 20.09.06	588, 619, 623, 627, 632, 769	T 71/06 - 3.2.07 15.10.08	584, 586
T 1404/05 - 3.3.07 24.05.07	271, 290, 357	T 104/06 - 3.2.05 20.07.07	1019
T 1407/05 - 3.3.05 19.01.10	465	T 106/06 - 3.3.04 21.06.07	319
T 1409/05 - 3.4.03 30.03.06 2007, 113	841	T 116/06 - 3.5.01 22.10.08	198
T 1417/05 - 3.5.05 04.12.08	234	T 121/06 - 3.5.01 25.01.07	265, 898, 1202
T 1421/05 - 3.3.09 18.01.11	962, 964, 1082, 1090	T 123/06 - 3.3.10 10.01.08	343
T 1425/05 - 3.3.04 18.08.06	566, 1176, 1180	T 133/06 - 3.3.09 29.05.08	982, 986, 1002
T 1433/05 - 3.2.04 28.11.07	289	T 142/06 - 3.3.03 11.03.08	128
T 1439/05 - 3.4.01 19.08.08	555, 717, 892, 1195	T 143/06 - 3.3.05 20.12.10	278
T 1443/05 - 3.3.01 04.07.08	378, 394, 395, 1134	T 148/06 - 3.2.04 08.01.08	718
T 1449/05 - 3.4.03 26.09.06	74, 1131	T 170/06 - 3.2.04 04.03.08	250
T 1459/05 - 3.2.03 21.02.08	1039, 1048	T 189/06 - 3.5.04 12.10.10	558
		T 190/06 - 3.3.09 18.11.08	992
		T 192/06 - 3.3.08 06.03.07	185
		T 204/06 - 3.5.01 21.01.09	226
		T 211/06 - 3.3.07 25.04.07	74, 170
		T 221/06 - 3.4.02 24.07.08	717
		T 229/06 - 3.2.02 09.12.08	90
		T 250/06 - 3.3.08 11.10.07	378, 383

T 252/06 - 3.4.02 06.05.08	249	T 578/06 - 3.3.04 29.06.11	181, 182, 680, 694
T 253/06 - 3.2.05 24.06.08	1133	T 580/06 - 3.4.01 01.07.08	620, 699, 786, 789
T 267/06 - 3.2.07 13.04.07	658, 666, 672	T 585/06 - 3.4.02 29.07.08	740, 825, 1202
T 276/06 - 3.3.10 25.09.08	179	T 601/06 - 3.5.05 05.05.09	569, 576
T 286/06 - 3.3.06 09.11.07	434	T 606/06 - 3.2.03 23.04.08	402
T 289/06 - 3.5.03 17.12.07	974	T 635/06 - 3.3.10 02.07.07	1032
T 300/06 - 3.2.06 13.11.07	444	T 671/06 - 3.4.03 02.08.07	267
T 307/06 - 3.3.01 16.09.08	279	T 673/06 - 3.3.01 01.04.09	550
T 309/06 - 3.3.08 25.10.07	345, 346	T 678/06 - 3.3.06 10.10.07	1050
T 314/06 - 3.5.04 26.10.10	494	T 683/06 - 3.5.02 25.11.09	848
T 321/06 - 3.4.01 05.03.08	384	T 690/06 - 3.5.01 24.04.07	77, 196, 914, 916, 1191, 1203
T 332/06 - 3.4.02 20.02.08	1081	T 699/06 - 3.3.04 29.06.10	348, 572, 573
T 333/06 - 3.2.06 13.03.07	989	T 704/06 - 3.3.08 15.03.07	938, 946
T 335/06 - 3.2.02 07.12.07	603, 634	T 716/06 - 3.2.04 17.06.08	548, 658, 665
T 339/06 - 3.2.01 05.12.07	939, 1129, 1139, 1142	T 750/06 - 3.5.02 08.03.07	758
T 341/06 - 3.2.01 31.01.08	412	T 756/06 - 3.5.01 18.04.08	33, 201, 203, 211, 219
T 353/06 - 3.2.05 16.07.08	1021	T 765/06 - 3.2.03 11.12.06	577, 579
T 364/06 - 3.3.04 22.03.07	345, 347	T 777/06 - 3.2.04 05.12.06	560
T 385/06 - 3.5.04 06.03.08	1154	T 778/06 - 3.2.04 20.09.06	1109
T 392/06 - 3.3.01 22.10.08	127, 660	T 784/06 - 3.3.08 23.06.10	204
T 394/06 - 3.3.04 28.07.09	362	T 787/06 - 3.5.01 18.11.08	1219, 1226
T 404/06 - 3.4.02 17.04.08	276	T 791/06 - 3.2.07 30.09.08	970, 1190
T 405/06 - 3.3.08 06.12.07	287, 350	T 801/06 - 3.3.04 04.03.09	347
T 406/06 - 3.3.04 16.01.08	139	T 809/06 - 3.5.01 27.06.07	1098
T 438/06 - 3.2.04 16.12.08	240	T 811/06 - 3.5.04 11.05.10	77
T 439/06 - 3.5.01 31.01.07 2007, 491	635, 637, 643	T 824/06 - 3.3.09 09.12.08	408
T 450/06 - 3.2.04 18.10.07	225	T 848/06 - 3.2.07 07.03.07	784
T 451/06 - 3.2.06 04.10.07	541	T 850/06 - 3.2.07 13.02.08	240
T 455/06 - 3.2.06 02.09.08	1134	T 857/06 - 3.3.04 05.06.08	589, 1073, 1235
T 462/06 - 3.3.01 01.07.09	577	T 859/06 - 3.3.03 21.05.08	358, 361
T 477/06 - 3.5.01 20.02.09	388	T 860/06 - 3.3.06 02.10.07	102
T 478/06 - 3.5.01 30.06.09	220	T 869/06 - 3.5.05 05.06.09	576
T 479/06 - 3.3.10 10.06.08	174, 253, 679	T 875/06 - 3.2.01 12.03.08	945, 1076, 1089
T 482/06 - 3.5.02 18.05.06	720	T 876/06 - 3.3.09 08.05.07	416
T 493/06 - 3.3.08 18.09.07	369, 370, 690, 691	T 877/06 - 3.3.05 02.12.09	508, 511
T 495/06 - 3.4.03 04.11.08	407	T 884/06 - 3.3.08 07.11.07	346
T 506/06 - 3.5.05 22.09.09	209		
T 515/06 - 3.3.04 18.01.07	1128		
T 516/06 - 3.3.08 23.05.07	1154, 1159		
T 552/06 - 3.5.04 18.08.10	558, 559		
T 555/06 - 3.2.01 22.11.07	582		

Table of cases

T 910/06 - 3.3.03 10.12.08	489	T 1146/06 - 3.5.04 21.01.11	943
T 911/06 - 3.5.02 11.11.09	444, 716, 721	T 1154/06 - 3.2.03 09.12.08	807, 1077
T 931/06 - 3.4.01 21.11.08	933, 939, 940, 944	T 1165/06 - 3.3.08 19.07.07	344
T 971/06 - 3.3.08 21.03.07	644, 750, 889, 890, 1207	T 1167/06 - 3.3.05 26.07.07	988
T 980/06 - 3.5.01 26.05.09	1199	T 1171/06 - 3.5.06 03.11.10	221
T 985/06 - 3.3.06 16.07.08	419	T 1172/06 - 3.3.04 15.10.08	403
T 990/06 - 3.2.07 08.06.09	552, 564, 727, 746, 1178	T 1183/06 - 3.2.07 06.05.09	161, 247
T 993/06 - 3.3.06 21.11.07	521, 750, 1094	T 1186/06 - 3.3.06 23.10.09	1145
T 1015/06 - 3.3.01 30.04.09	341, 359	T 1188/06 - 3.3.08 18.10.07	346
T 1020/06 - 3.x.xx 28.11.08	725, 731, 735	T 1194/06 - 3.3.01 06.08.09	1113
T 1023/06 - 3.2.04 07.12.06	206	T 1204/06 - 3.3.01 08.04.08	287
T 1026/06 - 3.5.01 26.09.07	607, 608, 612, 645	T 1207/06 - 3.4.02 07.05.08	818, 821
T 1029/06 - 3.5.01 22.04.09	24	T 1208/06 - 3.2.02 03.07.08	817, 819
T 1030/06 - 3.5.01 17.12.08	189	T 1242/06 - 3.3.04 31.05.12 2013, 42	44, 46, 268
T 1053/06 - 3.4.02 01.07.08	569, 574	T 1247/06 - 3.5.03 18.06.08	74
T 1063/06 - 3.3.10 03.02.09 2009, 516	339, 343	T 1250/06 - 3.2.06 16.10.07	444
T 1071/06 - 3.5.02 08.12.09	985, 990	T 1254/06 - 3.5.03 08.03.07	497, 505
T 1073/06 - 3.5.06 23.11.10	33, 216	T 1269/06 - 3.4.02 20.09.07	409
T 1074/06 - 3.3.04 09.08.07	144	T 1271/06 - 3.2.06 15.04.08	1025
T 1075/06 - 3.2.02 17.05.11	54, 59	T 1300/06 - 3.3.08 08.04.08	1175
T 1077/06 - 3.3.04 19.02.09	543, 1176	T 1324/06 - 3.2.04 14.07.08	811, 1078
T 1081/06 - 3.3.03 10.10.08	814, 967	T 1326/06 - 3.5.06 30.11.10	13, 14
T 1085/06 - 3.4.02 18.11.08	1192	T 1351/06 - 3.5.04 10.06.08	555, 719, 1080
T 1088/06 - 3.2.05 20.04.07	453	T 1387/06 - 3.3.03 20.01.10	102, 109
T 1095/06 - 3.3.07 07.05.08	619, 637	T 1396/06 - 3.3.04 31.05.07	182, 187, 348
T 1099/06 - 3.3.08 30.01.08	1184	T 1407/06 - 3.3.06 09.12.08	444
T 1107/06 - 3.3.04 03.12.08	406, 415	T 1420/06 - 3.2.02 05.06.09	1161, 1164
T 1113/06 - 3.2.02 17.02.09	1207	T 1441/06 - 3.3.07 01.07.10	992
T 1127/06 - 3.3.04 13.08.08	185	T 1452/06 - 3.3.08 10.05.07	258, 260, 344
T 1134/06 - 3.2.04 16.01.07	84, 100, 101, 681, 683, 689	T 1456/06 - 3.3.08 31.03.11	352, 459
T 1139/06 - 3.3.02 19.02.09	472	T 1474/06 - 3.4.01 10.01.08	1152
T 1140/06 - 3.3.03 13.05.09	343	T 1491/06 - 3.5.04 20.12.11	508, 511
T 1143/06 - 3.5.01 01.04.09	32, 34, 204, 210, 211, 213, 215, 216, 221	T 1493/06 - 3.5.03 02.04.09	1173, 1175
		T 1497/06 - 3.3.08 16.11.07	405
		T 1505/06 - 3.2.07 18.09.07	570, 1176, 1194
		T 1510/06 - 3.2.04 25.09.08	90, 97
		T 1511/06 - 3.2.04 25.09.08	92, 659, 942
		T 1512/06 - 3.2.04 25.09.08	93
		T 1514/06 - 3.3.05 05.10.11	965
		T 1526/06 - 3.3.04 11.07.08	553, 980

T 1543/06 - 3.2.04 29.06.07	3, 4, 198-202, 205, 206	T 1784/06 - 3.5.01 21.09.12	14, 199, 200, 202, 203, 207, 222, 223
T 1553/06 - 3.5.04 12.03.12	83, 99, 100, 681, 1007, 1011	T 1785/06 - 3.4.01 02.06.08	364, 1093
T 1556/06 - 3.2.06 24.06.08	583	T 1790/06 - 3.3.08 09.12.08	1135
T 1562/06 - 3.5.02 22.09.09	372	T 1808/06 - 3.3.09 14.02.08	287, 291
T 1590/06 - 3.5.05 23.09.09	751	T 1829/06 - 3.4.03 10.11.09	90
T 1599/06 - 3.3.04 13.09.07	137, 139, 187, 288	T 1841/06 - 3.5.01 21.01.11	209, 219
T 1600/06 - 3.5.03 10.10.08	932, 1173	T 1842/06 - 3.4.01 01.09.09	697, 702
T 1619/06 - 3.3.01 28.11.08	98	T 1855/06 - 3.3.07 18.06.09	155
T 1621/06 - 3.3.03 27.11.08	161	T 1859/06 - 3.2.06 26.02.08	1153
T 1625/06 - 3.5.05 17.06.10	77, 551	T 1873/06 - 3.5.01 13.09.07	1124
T 1629/06 - 3.3.06 16.01.08	1165	T 1875/06 - 3.3.04 08.01.08	84, 100, 683, 689
T 1632/06 - 3.3.01 02.09.09	1017	T 1886/06 - 3.3.06 23.10.09	341, 362
T 1634/06 - 3.5.04 04.03.11	165	T 1898/06 - 3.3.01 12.08.09	278
T 1640/06 - 3.2.07 15.06.07	1110	T 1903/06 - 3.4.01 27.05.09	552
T 1642/06 - 3.3.02 23.08.07	142	T 1913/06 - 3.2.04 30.09.08	1171, 1180
T 1652/06 - 3.3.02 12.03.08	446	T 1923/06 - 3.2.04 24.04.09	570
T 1658/06 - 3.5.06 14.01.11	7	<b>2007</b>	
T 1664/06 - 3.2.01 07.02.08	109	T 7/07 - 3.3.02 07.07.11	96, 780, 968, 1274
T 1698/06 - 3.5.03 24.05.07	751	T 8/07 - 3.3.03 07.05.09	431
T 1704/06 - 3.5.01 14.12.07	33, 551, 1137, 1138	T 26/07 - 3.5.02 18.12.09	561
T 1706/06 - 3.2.01 04.03.08	817, 821	T 33/07 - 3.2.06 17.07.08	1131, 1152
T 1708/06 - 3.4.03 28.09.10	511	T 46/07 - 3.2.04 26.06.07	645
T 1709/06 - 3.5.03 30.05.08	536, 537, 752, 757, 833	T 61/07 - 3.2.07 19.08.08	586, 677
T 1726/06 - 3.5.03 20.02.09	448	T 69/07 - 3.2.07 10.03.09	568, 991
T 1729/06 - 3.3.04 17.09.14	47	T 79/07 - 3.2.01 24.06.08	1075
T 1731/06 - 3.2.06 23.09.08	1131	T 82/07 - 3.5.04 23.01.08	694
T 1740/06 - 3.5.01 20.01.10	1191	T 95/07 - 3.3.03 29.05.09	671, 685
T 1747/06 - 3.5.03 16.06.08	753-755	T 100/07 - 3.2.01 09.07.09	931
T 1749/06 - 3.4.03 24.02.10	32, 214	T 110/07 - 3.3.05 30.11.11	380, 381
T 1753/06 - 3.3.01 06.05.09	713	T 114/07 - 3.2.06 09.12.08	1022
T 1757/06 - 3.2.03 18.11.08	953	T 131/07 - 3.3.09 24.03.09	590, 648, 649
T 1763/06 - 3.4.02 15.09.09	660, 1069, 1097, 1108	T 146/07 - 3.3.08 13.12.11	778, 779
T 1764/06 - 3.3.07 24.06.10	119	T 149/07 - 3.4.01 20.11.09	77
T 1771/06 - 3.3.08 07.02.08	287	T 150/07 - 3.3.06 27.10.09	413
T 1772/06 - 3.3.08 16.10.07	406	T 157/07 - 3.5.05 24.04.08	1088
		T 165/07 - 3.5.03 23.11.07	749, 1072
		T 172/07 - 3.3.07 22.03.11	469
		T 178/07 - 3.2.06 02.10.08	622
		T 193/07 - 3.3.05 11.05.11	1083
		T 212/07 - 3.2.03 18.11.09	990, 992, 1001

Table of cases

T 230/07 - 3.3.05 05.05.10	130, 131, 382	T 512/07 - 3.5.05 22.01.10	329
T 257/07 - 3.2.04 13.03.08	616, 620, 621, 1189	T 517/07 - 3.3.10 20.05.10	416
T 261/07 - 3.3.08 27.09.07	607, 615, 616, 621, 788	T 519/07 - 3.3.10 04.09.08	162, 174, 339
T 263/07 - 3.5.06 18.01.11	558, 559	T 520/07 - 3.2.01 18.02.09	817, 822
T 266/07 - 3.4.01 25.06.10	184	T 528/07 - 3.5.01 27.04.10	19, 33, 202
T 273/07 - 3.2.02 08.01.09	991, 993	T 534/07 - 3.3.08 25.11.08	811
T 274/07 - 3.5.03 16.04.07	925	T 546/07 - 3.2.04 14.02.08	102
T 276/07 - 3.2.07 20.03.09	447, 655, 659, 663, 678	T 552/07 - 3.5.04 17.10.07	1189
T 285/07 - 3.2.01 02.12.09	439	T 565/07 - 3.2.03 10.09.09	1155
T 293/07 - 3.3.04 24.07.08	187	T 597/07 - 3.3.06 12.08.09	1032
T 305/07 - 3.3.04 20.05.11	951	T 608/07 - 3.3.03 27.04.09	77, 359
T 314/07 - 3.3.10 16.04.09	448	T 613/07 - 3.3.03 29.02.08	1096
T 321/07 - 3.2.06 23.10.08	1131, 1152	T 617/07 - 3.3.04 04.08.09	334, 346, 350
T 330/07 - 3.2.04 20.01.09	228	T 628/07 - 3.5.05 06.07.10	74, 551
T 336/07 - 3.2.04 11.10.07	200, 205, 206	T 641/07 - 3.3.05 06.07.10	337
T 354/07 - 3.5.01 27.01.10	221	T 653/07 - 3.3.05 21.12.10	252
T 355/07 - 3.2.05 28.11.08	81	T 656/07 - 3.2.02 06.05.09	1039, 1048
T 382/07 - 3.3.04 26.09.08	370, 391	T 659/07 - 3.2.04 28.05.09	1114
T 384/07 - 3.4.03 08.09.09	29	T 694/07 - 3.2.07 25.11.08	437
T 385/07 - 3.3.04 05.10.07	103, 139, 147	T 708/07 - 3.2.02 14.04.10	410
T 390/07 - 3.3.08 20.11.08	672, 781, 1145, 1146	T 716/07 - 3.3.01 05.05.10	178
T 395/07 - 3.2.05 21.06.07	524	T 726/07 - 3.5.01 05.10.10	211, 219
T 416/07 - 3.3.04 27.03.08	1139	T 730/07 - 3.3.06 15.04.10	942
T 418/07 - 3.3.04 04.05.11	648, 807	T 762/07 - 3.3.08 24.02.09	954
T 431/07 - 3.3.01 21.01.09	362	T 763/07 - 3.3.03 24.06.09	104
T 433/07 - 3.3.04 11.01.11	350	T 764/07 - 3.5.03 14.05.09	1158, 1171, 1180
T 435/07 - 3.3.07 10.09.12	533, 534, 542	T 773/07 - 3.3.10 06.11.08	794
T 448/07 - 3.2.07 09.09.09	666	T 775/07 - 3.2.04 07.04.09	410
T 458/07 - 3.3.04 23.09.09	784	T 776/07 - 3.2.04 02.04.09	120
T 461/07 - 3.3.10 27.11.08	152	T 777/07 - 3.3.05 25.02.11	456
T 473/07 - 3.5.01 30.11.07	624, 637	T 782/07 - 3.3.08 04.02.09	185, 378
T 475/07 - 3.3.01 08.09.10	1001	T 788/07 - 3.3.04 07.01.08	43
T 484/07 - 3.3.05 15.03.13	1133	T 789/07 - 3.5.06 14.04.11	921, 922
T 494/07 - 3.4.03 13.05.11	1197, 1200	T 809/07 - 3.3.01 15.04.10	343
T 509/07 - 3.5.04 30.09.09	208, 1069, 1092, 1097, 1108	T 815/07 - 3.2.06 15.07.08	336, 337, 359
		T 823/07 - 3.5.01 18.02.11	210, 211
		T 824/07 - 3.3.03 05.10.07	161, 180, 1152
		T 837/07 - 3.3.08 06.10.10	1156
		T 840/07 - 3.3.04 14.09.11	1211
		T 847/07 - 3.3.04 13.01.10	187
		T 859/07 - 3.2.04 27.11.07	198, 200, 201, 206

T 868/07 - 3.5.04 16.03.10	438	T 1235/07 - 3.5.01 17.03.11	215
T 870/07 - 3.3.01 06.10.09	1157	T 1237/07 - 3.5.05 12.02.08	211, 542, 884
T 871/07 - 3.3.01 11.11.10	562	T 1266/07 - 3.5.03 26.11.09	581, 582
T 883/07 - 3.4.03 22.11.07	717, 1201	T 1287/07 - 3.2.08 11.05.10	498
T 888/07 - 3.5.05 19.04.11	272, 892	T 1304/07 - 3.2.06 02.04.09	790
T 893/07 - 3.4.01 11.02.10	1175	T 1309/07 - 3.2.04 23.06.09	90, 93
T 897/07 - 3.3.05 03.05.11	90	T 1329/07 - 3.4.02 11.11.10	364
T 898/07 - 3.5.03 30.04.09	969	T 1374/07 - 3.3.02 13.01.09	412, 420
T 908/07 - 3.2.04 16.05.08	1175	T 1391/07 - 3.4.02 07.11.08	508, 510, 511
T 919/07 - 3.3.01 13.01.09	818, 822	T 1395/07 - 3.3.10 07.07.09	290
T 926/07 - 3.2.04 14.05.08	578, 938	T 1397/07 - 3.3.10 06.05.10	172
T 937/07 - 3.3.05 28.08.09	586	T 1403/07 - 3.5.04 24.05.11	1137, 1138
T 952/07 - 3.2.02 06.09.10	757	T 1410/07 - 3.5.01 27.04.12	7
T 979/07 - 3.4.02 15.10.09	1158	T 1411/07 - 3.3.10 29.06.10	537
T 990/07 - 3.4.01 23.02.10	334	T 1415/07 - 3.5.01 17.11.11	405
T 991/07 - 3.4.01 30.03.10	551, 1137	T 1423/07 - 3.3.02 19.04.10	508, 510, 910
T 993/07 - 3.5.03 20.05.10	268, 1038	T 1426/07 - 3.2.03 26.09.08	558
T 1010/07 - 3.2.04 06.11.08	73	T 1437/07 - 3.3.04 26.10.09	113, 114, 362
T 1014/07 - 3.3.04 02.07.12	183, 226	T 1440/07 - 3.3.08 23.09.09	340
T 1041/07 - 3.3.10 01.10.09	406, 422	T 1450/07 - 3.3.08 11.02.09	257, 259
T 1042/07 - 3.4.01 22.08.08	563	T 1465/07 - 3.4.02 09.05.08	617, 620, 621, 633, 635, 643
T 1044/07 - 3.5.01 19.12.08	209, 1219, 1226	T 1469/07 - 3.3.02 03.02.09	1173
T 1068/07 - 3.3.08 07.03.12	427	T 1484/07 - 3.3.10 13.04.10	1048
T 1072/07 - 3.2.07 19.12.08	242	T 1500/07 - 3.2.04 06.05.08	443, 494
T 1078/07 - 3.2.02 18.09.09	1196	T 1501/07 - 3.2.04 06.05.08	443, 494
T 1079/07 - 3.4.01 13.05.09	991	T 1502/07 - 3.2.04 06.05.08	443, 494
T 1086/07 - 3.5.01 22.03.11	33	T 1511/07 - 3.3.09 31.07.09	420
T 1098/07 - 3.2.04 26.02.09	538, 539, 671	T 1515/07 - 3.5.01 03.07.08	914, 1203
T 1100/07 - 3.2.03 25.07.08	548, 658, 665, 668, 676	T 1523/07 - 3.3.10 24.11.09	106
T 1125/07 - 3.3.10 07.10.09	406, 1094	T 1533/07 - 3.2.01 06.10.09	599, 976
T 1162/07 - 3.3.01 06.10.10	70, 695, 700	T 1544/07 - 3.3.10 19.08.10	459, 1115
T 1170/07 - 3.3.02 13.03.12	458, 880	T 1549/07 - 3.3.03 13.12.10	1030
T 1179/07 - 3.3.03 10.03.09	150-152	T 1553/07 - 3.2.01 08.06.10	938, 939, 1024, 1025
T 1192/07 - 3.3.05 29.05.09	1189	T 1557/07 - 3.4.01 09.07.08	176, 536, 880, 881, 883
T 1194/07 - 3.2.04 30.04.09	1021	T 1575/07 - 3.5.01 12.01.12	210, 211
T 1202/07 - 3.5.03 07.04.11	403, 477, 478	T 1585/07 - 3.2.04 01.10.09	225
T 1205/07 - 3.3.08 20.09.11	344	T 1587/07 - 3.4.03 10.10.10	1137, 1138, 1145
T 1206/07 - 3.3.03 05.05.10	419, 420		
T 1225/07 - 3.3.06 29.05.09	357		
T 1226/07 - 3.3.02 25.03.10	894, 1072		
T 1232/07 - 3.4.03 27.09.07	267		

Table of cases

T 1606/07 - 3.5.05 09.09.08	561	T 1900/07 - 3.3.04 24.03.10	1018
T 1610/07 - 3.3.04 14.04.11	980	T 1905/07 - 3.5.04 21.12.10	885
T 1612/07 - 3.4.01 05.05.09	751, 757, 1196	T 1918/07 - 3.4.02 11.05.10	334
T 1630/07 - 3.3.06 28.05.10	105	T 1924/07 - 3.5.01 22.06.12	915, 1203
T 1639/07 - 3.5.01 17.02.12	173	T 1969/07 - 3.5.01 02.10.12	536, 869, 872, 880
T 1640/07 - 3.2.01 10.12.09	925	T 1982/07 - 3.3.08 26.02.08	872, 1208
T 1659/07 - 3.5.03 21.01.10	972, 980	T 1984/07 - 3.4.01 14.12.11	559
T 1667/07 - 3.3.08 02.03.10	782	T 1988/07 - 3.3.01 08.10.10	104
T 1668/07 - 3.5.04 27.10.11	1109	T 1990/07 - 3.5.01 13.06.12	1131
T 1670/07 - 3.5.01 11.07.13	205, 207, 217, 220, 223	T 1993/07 - 3.3.05 13.10.11	1134, 1135
T 1673/07 - 3.5.03 30.10.09	903, 904, 908	T 1998/07 - 3.2.08 15.07.09	270
T 1685/07 - 3.2.03 04.08.10	873, 941, 1129, 1152, 1155	T 2003/07 - 3.2.01 05.10.10	452
T 1695/07 - 3.3.07 28.09.11	55, 56, 434	T 2017/07 - 3.3.10 26.11.09	469
T 1705/07 - 3.3.10 16.06.10	1129, 1139, 1143	T 2043/07 - 3.3.03 13.01.10	684
T 1707/07 - 3.5.04 10.05.11	1106, 1126	T 2044/07 - 3.4.03 15.02.11	420
T 1721/07 - 3.3.04 29.03.12	587	T 2049/07 - 3.2.07 08.09.09	293
T 1728/07 - 3.3.01 11.10.10	452, 487	T 2050/07 - 3.3.08 19.02.13	121, 204
T 1751/07 - 3.3.02 26.04.12	772	<b>2008</b>	
T 1755/07 - 3.3.09 04.12.09	167	T 9/08 - 3.3.10 01.10.10	1092, 1093
T 1758/07 - 3.3.09 07.06.10	138	T 18/08 - 3.3.02 17.08.10	358
T 1761/07 - 3.3.01 14.01.11	175	T 21/08 - 3.2.07 02.09.10	162
T 1774/07 - 3.3.06 23.09.09	940, 948	T 25/08 - 3.2.04 29.04.10	666, 1024
T 1785/07 - 3.2.06 21.10.08	1152	T 31/08 - 3.2.01 24.11.09	781, 1028
T 1793/07 - 3.2.04 02.07.08	206	T 37/08 - 3.5.01 09.02.11	581
T 1796/07 - 3.4.01 27.11.09	364	T 51/08 - 3.5.05 07.05.09	497, 498, 1185
T 1808/07 - 3.5.01 09.07.10	290	T 53/08 - 3.3.01 01.11.10	168
T 1814/07 - 3.5.05 02.09.08	9, 13	T 56/08 - 3.3.01 03.03.11	458
T 1819/07 - 3.3.01 15.03.11	279	T 70/08 - 3.4.02 09.09.10	1207
T 1835/07 - 3.3.07 03.02.11	178	T 79/08 - 3.3.03 28.10.10	330
T 1837/07 - 3.2.02 03.05.11	761	T 85/08 - 3.2.07 03.09.09	268
T 1855/07 - 3.2.01 07.09.10	1045, 1048	T 87/08 - 3.3.10 11.02.10	174, 181, 756, 1196
T 1863/07 - 3.2.02 11.01.08	1207	T 99/08 - 3.2.03 20.02.09	1194
T 1865/07 - 3.2.04 29.01.09	813	T 102/08 - 3.5.04 08.11.11	225
T 1867/07 - 3.2.04 14.10.08	1137, 1138	T 109/08 - 3.3.02 27.01.12	762, 1126
T 1870/07 - 3.2.02 20.03.09	751, 883, 1196	T 120/08 - 3.3.09 14.10.10	336
T 1875/07 - 3.5.01 05.11.08	1193, 1225	T 123/08 - 3.5.04 08.06.11	941
T 1891/07 - 3.2.01 13.03.09	1210, 1211	T 124/08 - 3.3.09 22.06.10	980
T 1898/07 - 3.3.04 17.06.10	166, 459, 468, 470	T 138/08 - 3.2.02 13.07.10	1205
		T 144/08 - 3.2.02 22.10.09	439
		T 155/08 - 3.3.08 14.06.12	343
		T 177/08 - 3.3.02 08.04.11	460
		T 197/08 - 3.3.02 11.01.12	422
		T 229/08 - 3.2.01 26.01.10	951
		T 232/08 - 3.3.04 07.05.10	946, 948



T 235/08 - 3.3.07 08.04.09	550	T 534/08 - 3.3.01 26.09.11	754
T 236/08 - 3.3.02 10.05.12	424	T 535/08 - 3.3.01 12.01.12	370, 662
T 246/08 - 3.4.03 14.08.08	536, 537, 752, 758, 831, 876, 880, 882, 890, 896, 1148, 1202	T 546/08 - 3.4.03 24.01.12	1137
T 267/08 - 3.4.01 29.11.11	515, 525, 799, 809	T 547/08 - 3.2.02 10.03.11	460, 468, 1219
T 304/08 - 3.3.10 26.08.09	150, 151	T 555/08 - 3.5.05 04.06.13	625, 633, 635, 639
T 305/08 - 3.2.06 18.02.10	967, 969	T 567/08 - 3.2.04 28.09.09	478
T 320/08 - 3.3.06 10.01.11	935, 942	T 569/08 - 3.5.04 29.10.12	1159
T 331/08 - 3.3.03 25.09.10	524, 1086	T 570/08 - 3.3.06 17.02.12	701
T 339/08 - 3.3.03 03.03.10	942	T 571/08 - 3.2.07 11.04.11	957
T 343/08 - 3.4.02 07.01.09	577, 1194	T 582/08 - 3.2.06 16.06.09	444
T 356/08 - 3.2.04 07.07.09	1129, 1152, 1163	T 585/08 - 3.5.04 20.10.09	526, 614-616
T 358/08 - 3.2.06 09.07.09	1092, 1096	T 600/08 - 3.4.03 17.11.11	500, 1019
T 361/08 - 3.3.08 03.12.09	1145, 1146	T 608/08 - 3.2.01 22.07.10	545, 583
T 364/08 - 3.2.07 16.11.09	586	T 615/08 - 3.3.10 14.12.10	1152
T 369/08 - 3.3.03 28.04.10	941, 1002	T 616/08 - 3.3.04 23.03.09	1070, 1082, 1177
T 378/08 - 3.2.06 24.11.09	817, 823	T 619/08 - 3.2.07 27.01.10	225
T 384/08 - 3.3.04 26.06.09	962, 1009, 1113	T 620/08 - 3.3.01 04.05.11	1034
T 386/08 - 3.3.04 22.11.10	351	T 621/08 - 3.4.03 02.02.12	818
T 390/08 - 3.3.05 29.06.11	270	T 623/08 - 3.3.08 18.09.09	340
T 407/08 - 3.2.04 12.10.09	663, 678	T 646/08 - 3.3.02 14.04.11	979, 980
T 413/08 - 3.2.05 08.12.09	74	T 651/08 - 3.2.08 06.10.11	1138
T 423/08 - 3.3.01 13.09.11	487	T 653/08 - 3.5.06 22.02.12	558, 559
T 426/08 - 3.4.02 01.12.08	1021	T 667/08 - 3.4.01 20.04.12	406
T 428/08 - 3.2.01 09.10.08	964	T 671/08 - 3.4.03 18.09.12	74, 164, 946, 1161
T 433/08 - 3.3.05 04.08.11	1195, 1211	T 677/08 - 3.5.01 28.06.11	581, 1192
T 445/08 - 3.3.07 26.03.15	1091	T 680/08 - 3.2.05 15.04.10	373, 379
T 454/08 - 3.3.02 08.11.12	147	T 683/08 - 3.2.07 01.12.08	1190
T 467/08 - 3.2.07 07.06.11	935	T 707/08 - 3.2.04 08.02.11	1156
T 477/08 - 3.5.01 28.09.12	205	T 708/08 - 3.3.07 03.12.10	639
T 491/08 - 3.3.04 21.10.10	114, 348, 363	T 714/08 - 3.3.10 04.03.10	438
T 493/08 - 3.4.02 29.09.09	488, 607, 608, 612, 625, 630, 750	T 716/08 - 3.3.04 19.08.10	181
T 506/08 - 3.5.01 16.08.12	1070, 1268	T 724/08 - 3.4.03 16.11.12	950
T 508/08 - 3.3.08 08.10.09	587	T 725/08 - 3.3.01 16.07.10	458
T 518/08 - 3.3.05 19.08.11	1133	T 739/08 - 3.3.10 09.06.11	241, 1033
T 532/08 - 3.3.01 19.12.11	466, 1135	T 754/08 - 3.2.08 21.09.10	818, 820
		T 760/08 - 3.2.04 19.01.10	1098, 1101, 1105, 1106
		T 761/08 - 3.2.03 18.11.10	436
		T 765/08 - 3.4.03 04.02.09	837, 1086
		T 768/08 - 3.3.07 21.03.12	296
		T 777/08 - 3.3.01 24.05.11 2011, 633	77, 233
		T 778/08 - 3.3.09 07.12.10	182

Table of cases

T 781/08 - 3.5.03 17.08.11	1051	T 1199/08 - 3.3.08 03.05.12	46
T 783/08 - 3.3.03 15.07.09	1094	T 1212/08 - 3.2.02 13.01.12	1149, 1150
T 815/08 - 3.4.01 18.08.11	883	T 1228/08 - 3.4.01 26.11.12	169
T 824/08 - 3.3.08 20.11.12	467	T 1238/08 - 3.3.01 06.10.11	439
T 825/08 - 3.2.01 08.05.09	746, 1201	T 1239/08 - 3.3.01 30.06.11	105, 419
T 830/08 - 3.3.04 11.10.10	277	T 1244/08 - 3.3.10 07.07.11	553, 981, 1169
T 832/08 - 3.3.06 24.03.10	469, 955	T 1248/08 - 3.3.05 16.02.12	489, 490, 680
T 836/08 - 3.2.02 12.05.11	55, 274	T 1250/08 - 3.3.03 16.03.11	341, 359
T 863/08 - 3.3.07 24.10.11	1190	T 1251/08 - 3.5.06 29.06.12	558, 559
T 871/08 - 3.3.05 08.12.11	118, 458, 794	T 1257/08 - 3.2.04 07.07.10	750
T 888/08 - 3.3.01 03.08.10	251, 421	T 1282/08 - 3.3.04 22.06.11	1002
T 892/08 - 3.3.06 15.09.10	242	T 1287/08 - 3.2.08 31.07.09	980
T 912/08 - 3.5.02 25.05.11	446, 1093	T 1312/08 - 3.3.06 30.04.10	375, 469
T 916/08 - 3.3.05 06.03.12	466	T 1315/08 - 3.4.03 31.05.12	1130, 1134
T 922/08 - 3.2.02 13.10.11	1150	T 1317/08 - 3.4.03 15.05.12	184
T 923/08 - 3.2.08 02.08.11	55, 56, 274	T 1345/08 - 3.3.07 01.02.11	275
T 959/08 - 3.3.03 10.11.09	276	T 1364/08 - 3.3.04 10.11.10	187, 348, 352
T 960/08 - 3.4.01 01.12.11	964	T 1378/08 - 3.3.05 29.04.11	405
T 967/08 - 3.3.01 30.05.11	279	T 1382/08 - 3.4.01 30.03.09	1068, 1075
T 971/08 - 3.2.07 10.01.12	381	T 1397/08 - 3.3.10 08.07.10	178
T 980/08 - 3.5.06 14.03.12	1130, 1155	T 1407/08 - 3.2.02 20.03.13	56
T 982/08 - 3.5.06 07.11.12	649	T 1411/08 - 3.5.01 06.06.11	914-916, 1203
T 1005/08 - 3.2.07 27.01.11	586	T 1414/08 - 3.3.06 05.04.11	360
T 1027/08 - 3.4.01 03.12.10	175	T 1440/08 - 3.2.08 05.08.10	1048
T 1033/08 - 3.2.02 20.07.11	1117	T 1457/08 - 3.2.01 17.01.11	1164
T 1034/08 - 3.3.02 29.03.12	1015	T 1462/08 - 3.3.03 17.01.13	1102
T 1045/08 - 3.2.07 10.03.11	942, 1136	T 1465/08 - 3.5.03 27.07.09	614, 1189
T 1049/08 - 3.2.08 06.12.11	429	T 1469/08 - 3.3.10 27.10.11	685, 694
T 1067/08 - 3.3.09 10.02.11	1129, 1141, 1143, 1145, 1147, 1162	T 1472/08 - 3.3.01 08.02.12	1149
T 1069/08 - 3.3.08 08.09.11	946, 947	T 1485/08 - 3.3.01 20.12.12	935, 937
T 1079/08 - 3.3.10 19.04.10	174, 330, 338	T 1488/08 - 3.2.01 14.10.11	941, 945
T 1090/08 - 3.3.08 30.03.09	1087	T 1495/08 - 3.3.06 10.10.08	1190
T 1096/08 - 3.2.03 11.10.11	658, 667	T 1497/08 - 3.3.09 03.05.11	278, 489
T 1133/08 - 3.4.02 12.07.11	340, 342	T 1508/08 - 3.3.09 28.06.11	487
T 1168/08 - 3.3.07 10.06.11	1152, 1160	T 1536/08 - 3.2.04 12.08.10	538, 671
T 1169/08 - 3.4.01 11.08.11	334	T 1544/08 - 3.5.02 16.11.12	456, 945, 1230
T 1171/08 - 3.3.06 08.02.11	406, 407	T 1545/08 - 3.3.04 21.03.12	181, 187, 188, 1184
T 1172/08 - 3.3.08 07.10.11	460	T 1547/08 - 3.4.02 04.04.11	344
T 1178/08 - 3.5.04 09.05.12	862, 1148	T 1548/08 - 3.2.02 08.04.10	660
T 1188/08 - 3.5.06 28.03.12	1099	T 1579/08 - 3.3.06 23.07.10	375
T 1194/08 - 3.2.07 22.06.11	937, 1138	T 1581/08 - 3.2.07 03.04.09	1096
T 1196/08 - 3.3.02 10.11.10	780, 968, 1222, 1276		

T 1582/08 - 3.3.04 07.04.13	444	T 1841/08 - 3.3.02 09.10.12	1150
T 1589/08 - 3.5.05 15.03.12	1155	T 1849/08 - 3.4.03 01.03.12	102
T 1607/08 - 3.5.04 13.06.12	521, 831, 1193	T 1854/08 - 3.5.02 15.09.09	880
T 1610/08 - 3.2.02 21.09.11	571, 573	T 1859/08 - 3.3.04 05.06.12	103
T 1613/08 - 3.2.01 21.04.09	1190	T 1866/08 - 3.5.06 11.01.13	566
T 1617/08 - 3.3.08 20.12.12	1135	T 1870/08 - 3.4.03 13.03.12	425, 428
T 1628/08 - 3.5.03 30.11.10	1174	T 1872/08 - 3.3.01 20.10.11	673, 679
T 1650/08 - 3.3.08 02.10.12	1131, 1152, 1153	T 1877/08 - 3.3.10 23.02.10	185, 394, 395
T 1652/08 - 3.3.10 12.04.11	170, 746, 935, 936	T 1900/08 - 3.5.02 19.04.12	331
T 1668/08 - 3.2.07 18.08.09	977	T 1911/08 - 3.3.01 31.01.12	112, 431
T 1676/08 - 3.3.02 09.03.12	428, 659, 660, 669, 814, 817, 821, 1066, 1072, 1102, 1219, 1222	T 1914/08 - 3.2.07 13.10.11	686, 956
T 1687/08 - 3.5.02 09.11.11	818, 822	T 1926/08 - 3.3.07 03.05.11	70
T 1688/08 - 3.4.02 17.07.12	195	T 1935/08 - 3.3.07 17.12.10	639
T 1690/08 - 3.2.07 07.09.11	1155	T 1954/08 - 3.5.01 06.03.13	23
T 1698/08 - 3.3.02 28.11.12	656, 664, 666, 681	T 1962/08 - 3.4.02 12.12.10	612, 620-622, 1189
T 1708/08 - 3.3.10 10.03.11	1105	T 1967/08 - 3.2.02 21.01.11	226
T 1724/08 - 3.5.04 14.09.11	409, 450	T 1969/08 - 3.5.05 07.06.11	873, 1148, 1151, 1155
T 1726/08 - 3.3.04 06.10.09	621, 622	T 1976/08 - 3.4.02 05.12.08	560, 561
T 1735/08 - 3.3.03 27.09.12	585	T 1989/08 - 3.2.04 21.07.10	244
T 1741/08 - 3.5.06 02.08.12	32, 34, 210, 211, 213, 215-218, 220, 221, 829, 834	T 1990/08 - 3.4.03 06.03.12	1211
T 1748/08 - 3.2.02 11.06.12	1133, 1163	T 1997/08 - 3.2.04 01.07.09	537, 751, 752
T 1750/08 - 3.5.02 16.02.12	1155	T 2003/08 - 3.3.04 30.03.12	82, 144-146, 658, 661, 665, 670, 673, 688
T 1764/08 - 3.5.04 02.12.10	522, 524, 615, 620, 635	T 2006/08 - 3.3.08 18.10.11	351, 1199
T 1771/08 - 3.4.02 10.02.11	982	T 2009/08 - 3.2.03 26.10.10	586
T 1790/08 - 3.2.08 29.07.09	1078	T 2010/08 - 3.2.03 14.01.11	685
T 1791/08 - 3.3.08 11.03.10	181	T 2013/08 - 3.2.97 16.04.10	421
T 1798/08 - 3.2.02 21.08.12	55, 585, 1220	T 2052/08 - 3.3.04 03.02.09	1069, 1187, 1190
T 1799/08 - 3.3.07 18.06.13	1122	T 2056/08 - 3.2.04 15.01.09	592
T 1808/08 - 3.3.03 28.09.11	422	T 2102/08 - 3.4.02 26.07.11	934, 949, 1129, 1139, 1140
T 1818/08 - 3.5.03 04.03.11	1174	T 2110/08 - 3.5.03 18.08.11	225
T 1835/08 - 3.2.01 18.11.11	1045	T 2118/08 - 3.3.09 05.07.11	420
		T 2135/08 - 3.2.07 15.12.11	817, 821
		T 2170/08 - 3.2.07 27.01.09	367
		T 2179/08 - 3.2.04 22.12.10	180
		T 2181/08 - 3.3.04 14.11.12	348

Table of cases

T 2188/08 - 3.3.01 09.10.12	105	T 162/09 - 3.5.05 13.09.12	587, 1128, 1152, 1155
T 2202/08 - 3.4.02 06.09.11	410, 412	T 175/09 - 3.3.10 18.09.12	100
T 2215/08 - 3.3.10 22.03.12	150, 153	T 182/09 - 3.3.10 09.02.12	944
T 2230/08 - 3.3.07 19.05.11	481, 484	T 183/09 - 3.2.04 09.09.10	1134
T 2233/08 - 3.3.01 28.07.11	178	T 188/09 - 3.3.04 21.07.11	162
T 2249/08 - 3.2.04 01.07.10	1191	T 189/09 - 3.3.08 27.07.11	44
T 2250/08 - 3.2.02 30.08.12	1133	T 192/09 - 3.3.03 25.11.11	954
T 2254/08 - 3.2.07 11.02.10	770	T 195/09 - 3.3.06 08.10.10	478, 482
T 2271/08 - 3.2.04 13.03.10	246, 1220	T 219/09 - 3.2.04 27.09.10	439
T 2278/08 - 3.4.03 20.03.12	1150	T 226/09 - 3.3.07 02.02.12	1092, 1119
T 2285/08 - 3.2.05 15.04.11	1162	T 228/09 - 3.5.02 28.09.12	574
T 2287/08 - 3.3.10 22.06.10	1174	T 233/09 - 3.5.07 11.04.14	223
T 2291/08 - 3.2.03 08.11.10	725	T 234/09 - 3.3.05 01.06.12	118, 419
T 2294/08 - 3.2.07 09.05.12	567	T 240/09 - 3.2.06 11.03.10	584
T 2321/08 - 3.5.02 11.05.09	446, 715, 1193	T 264/09 - 3.5.03 26.10.10	922
T 2334/08 - 3.5.05 09.08.12	1084	T 267/09 - 3.2.07 29.03.11	1156
T 2362/08 - 3.3.07 14.03.11	733, 1037	T 278/09 - 3.3.06 25.01.11	78
<b>2009</b>		T 282/09 - 3.3.09 31.03.11	472
T 2/09 - 3.5.04 12.03.12	83, 84, 88, 90, 94, 681, 1007, 1011	T 299/09 - 3.2.01 08.06.11	293
T 15/09 - 3.2.02 19.12.13	486	T 306/09 - 3.3.10 25.04.12	174, 756
T 18/09 - 3.3.08 21.10.09	257, 1164	T 308/09 - 3.2.07 09.02.11	162, 163
T 21/09 - 3.3.08 13.11.14	538	T 309/09 - 3.5.06 09.03.12	876, 1159
T 25/09 - 3.3.04 23.12.09	244, 245, 329	T 313/09 - 3.3.03 05.03.13	439
T 41/09 - 3.2.07 14.09.10	522, 649, 1094	T 317/09 - 3.2.06 01.02.11	585
T 45/09 - 3.3.05 19.01.11	337, 364	T 349/09 - 3.3.08 26.02.10	1100
T 67/09 - 3.3.10 05.07.11	1158	T 365/09 - 3.3.03 14.04.10	1074
T 71/09 - 3.3.10 03.07.12	679, 685	T 379/09 - 3.3.08 09.06.11	1143
T 75/09 - 3.3.03 13.09.11	272, 336	T 385/09 - 3.2.04 25.11.10	57
T 98/09 - 3.3.01 27.10.11	422	T 388/09 - 3.2.06 24.06.09	1209
T 99/09 - 3.3.02 06.02.13	440, 770	T 396/09 - 3.3.02 27.02.13	141
T 107/09 - 3.3.04 12.07.12	387	T 406/09 - 3.3.10 17.11.10	942
T 108/09 - 3.3.02 14.02.13	142	T 412/09 - 3.4.02 09.05.12	76
T 114/09 - 3.2.03 12.05.09	542, 558	T 421/09 - 3.2.04 13.04.10	1152
T 132/09 - 3.3.01 24.07.12	376	T 422/09 - 3.2.04 18.01.11	228
T 137/09 - 3.3.06 26.10.10	1221	T 423/09 - 3.2.04 03.02.11	241
T 144/09 - 3.2.06 04.05.11	1129, 1140, 1141, 1144, 1147, 1149, 1230	T 443/09 - 3.3.10 16.06.11	91, 100, 956
T 160/09 - 3.5.06 20.06.12	744, 1191	T 444/09 - 3.3.05 26.06.14	673, 957
T 161/09 - 3.2.01 30.11.11	946	T 447/09 - 3.3.05 30.07.14	1133, 1157
		T 448/09 - 3.4.01 18.10.11	1068
		T 455/09 - 3.5.04 07.08.12	487
		T 459/09 - 3.4.01 13.12.12	1046, 1048
		T 468/09 - 3.2.02 28.09.11	339, 498
		T 473/09 - 3.3.07 09.10.12	1098, 1101, 1102

T 476/09 - 3.3.09 21.09.12	394, 395, 1162	T 715/09 - 3.2.03 18.10.11	228
T 477/09 - 3.3.03 10.06.11	432	T 727/09 - 3.5.04 06.11.13	1099, 1101
T 482/09 - 3.3.06 14.07.11	338, 341, 362	T 748/09 - 3.2.08 06.11.12	428
T 485/09 - 3.2.07 17.11.10	569	T 753/09 - 3.4.03 05.03.10	659, 668
T 491/09 - 3.2.07 15.09.11	1038	T 755/09 - 3.5.07 27.02.15	1077, 1090
T 494/09 - 3.3.04 28.09.11	406	T 756/09 - 3.5.07 18.03.15	826
T 501/09 - 3.3.04 25.06.13	944, 1099	T 775/09 - 3.3.08 20.03.12	947
T 529/09 - 3.5.03 10.06.10	620, 692, 790	T 783/09 - 3.3.04 25.01.11	423, 424
T 531/09 - 3.5.01 03.05.12	24	T 808/09 - 3.2.08 28.02.13	336, 338
T 532/09 - 3.2.07 03.08.10	551	T 834/09 - 3.3.05 02.02.12	90, 91
T 533/09 - 3.4.01 11.02.14	255	T 836/09 - 3.5.04 17.02.10	612, 619, 621
T 538/09 - 3.5.07 11.02.15	99, 689, 700	T 848/09 - 3.5.03 07.10.11	1147
T 540/09 - 3.2.07 20.12.11	1089	T 852/09 - 3.3.04 06.09.13	343
T 549/09 - 3.2.01 31.01.12	496	T 854/09 - 3.2.04 11.03.11	1001
T 560/09 - 3.3.10 20.01.10	262, 276	T 872/09 - 3.4.02 08.04.14	120, 1144
T 562/09 - 3.2.07 30.06.11	1135	T 879/09 - 3.4.03 14.01.10	439, 443
T 573/09 - 3.5.04 26.09.12	1097, 1105	T 881/09 - 3.2.01 22.06.12	229, 1129, 1147
T 583/09 - 3.3.08 13.12.11	406, 425	T 902/09 - 3.3.02 30.04.14	1141
T 584/09 - 3.3.01 01.03.13	728, 1244	T 903/09 - 3.3.01 07.09.11	458
T 593/09 - 3.3.09 20.12.11	336, 338, 341, 358, 359	T 908/09 - 3.3.01 17.07.12	377
T 605/09 - 3.3.09 07.02.12	147	T 916/09 - 3.3.01 03.08.12	586
T 611/09 - 3.3.02 18.10.11	59	T 926/09 - 3.5.06 04.09.13	519
T 612/09 - 3.3.04 11.04.13	415, 416	T 933/09 - 3.2.02 05.06.12	1106
T 624/09 - 3.3.06 08.04.11	1088, 1093	T 936/09 - 3.2.01 01.03.12	940, 1007, 1129, 1141, 1143, 1147
T 625/09 - 3.5.03 21.07.10	1206	T 937/09 - 3.2.04 20.07.12	580, 868, 873-875
T 630/09 - 3.2.01 11.01.12	1045	T 945/09 - 3.3.02 23.06.10	96
T 636/09 - 3.3.02 03.04.12	240	T 949/09 - 3.3.08 17.10.12	974
T 637/09 - 3.3.02 20.03.13	783, 810	T 961/09 - 3.2.04 15.12.09	420, 494
T 661/09 - 3.4.02 22.10.13	239	T 963/09 - 3.5.07 05.06.14	1171
T 662/09 - 3.2.08 04.11.14	1089	T 967/09 - 3.3.04 04.11.14	330, 363, 702
T 666/09 - 3.3.08 01.03.12	943	T 990/09 - 3.3.08 03.07.12	683
T 670/09 - 3.3.06 14.12.11	1109	T 996/09 - 3.3.08 16.06.10	533
T 677/09 - 3.5.01 15.11.13	211, 217	T 1000/09 - 3.5.01 18.11.14	220
T 679/09 - 3.3.08 13.11.12	1145	T 1011/09 - 3.4.02 09.11.12	573
T 689/09 - 3.2.04 24.11.10	1068, 1092, 1093	T 1014/09 - 3.2.07 12.05.11	1022
T 690/09 - 3.5.05 12.05.10	553, 554, 586, 880, 890, 899	T 1022/09 - 3.2.07 27.10.11	1021
T 691/09 - 3.3.06 10.06.11	1145	T 1033/09 - 3.2.04 20.09.11	985
T 701/09 - 3.3.06 03.08.11	106	T 1039/09 - 3.3.04 05.03.13	150, 152, 153
		T 1045/09 - 3.3.03 17.01.14	429

Table of cases

T 1050/09 - 3.2.08 07.04.11	542, 543, 565, 1242	T 1402/09 - 3.2.07 01.03.11	404
T 1051/09 - 3.3.03 07.02.12	335	T 1407/09 - 3.3.05 28.09.12	96
T 1057/09 - 3.3.01 25.10.11	82, 91, 667, 680, 686, 689	T 1427/09 - 3.5.05 17.11.09	1087
T 1086/09 - 3.5.04 29.04.14	516, 1190	T 1437/09 - 3.4.02 28.02.14	163
T 1097/09 - 3.3.01 03.05.11	175	T 1439/09 - 3.3.08 16.04.13	778
T 1099/09 - 3.2.08 12.01.12	138, 146	T 1442/09 - 3.2.07 03.11.10	757
T 1111/09 - 3.5.03 22.03.12	1190	T 1448/09 - 3.4.01 18.02.14	520, 550
T 1115/09 - 3.3.05 14.06.12	132	T 1457/09 - 3.3.04 17.01.14	113, 114
T 1123/09 - 3.5.05 17.12.09	447	T 1479/09 - 3.2.04 25.11.09	1188
T 1126/09 - 3.2.07 12.08.10	183	T 1487/09 - 3.2.02 24.09.13	283, 435
T 1129/09 - 3.2.07 17.03.11	329	T 1493/09 - 3.3.04 01.10.14	243
T 1130/09 - 3.3.10 05.05.11	130, 382	T 1495/09 - 3.2.01 09.09.10	767, 777
T 1140/09 - 3.4.03 18.01.12	150, 687	T 1526/09 - 3.3.01 22.01.13	359, 360
T 1156/09 - 3.3.08 21.06.12	1150	T 1527/09 - 3.5.05 27.11.09	1190
T 1168/09 - 3.2.04 15.10.10	90, 93	T 1538/09 - 3.2.04 22.11.11	1106
T 1188/09 - 3.2.04 07.04.11	1093, 1120, 1121	T 1539/09 - 3.5.06 18.07.13	222
T 1192/09 - 3.4.02 28.06.13	176, 247, 250	T 1541/09 - 3.2.04 11.07.11	980
T 1207/09 - 3.4.01 15.05.14	744	T 1547/09 - 3.2.04 08.06.10	206
T 1214/09 - 3.5.07 18.07.14	211, 214, 873	T 1570/09 - 3.3.02 16.05.14	140
T 1224/09 - 3.4.03 15.05.14	780, 783	T 1616/09 - 3.3.02 27.08.14	348, 349
T 1231/09 - 3.3.05 12.12.12	1150	T 1621/09 - 3.2.03 22.09.11	549, 578, 946-949
T 1253/09 - 3.2.01 25.04.12	934, 935	T 1634/09 - 3.2.04 30.06.11	1133, 1152
T 1259/09 - 3.2.01 10.09.10	767	T 1635/09 - 3.3.02 27.10.10	2011, 542 58, 59, 61, 62, 475
T 1265/09 - 3.5.03 24.01.12	24	T 1682/09 - 3.4.02 21.03.13	86, 1131
T 1273/09 - 3.3.04 20.02.13	344, 365	T 1698/09 - 3.2.07 10.05.11	72
T 1284/09 - 3.3.10 01.09.10	1189	T 1710/09 - 3.3.02 12.04.11	423
T 1289/09 - 3.2.07 08.02.12	162	T 1712/09 - 3.3.05 05.02.13	337, 364
T 1306/09 - 3.5.02 02.05.13	944	T 1727/09 - 3.3.07 07.03.11	450
T 1316/09 - 3.5.01 18.12.12	222, 223	T 1730/09 - 3.3.06 25.10.11	288
T 1336/09 - 3.4.02 14.12.11	778, 779	T 1736/09 - 3.4.03 30.01.14	459, 461, 476
T 1344/09 - 3.4.01 19.06.12	202, 203	T 1743/09 - 3.3.01 07.02.12	1152
T 1350/09 - 3.3.06 30.03.12	1028	T 1744/09 - 3.2.04 20.12.11	799, 809
T 1355/09 - 3.3.07 10.09.13	619, 620, 622	T 1752/09 - 3.4.01 21.11.12	1159
T 1358/09 - 3.5.07 21.11.14	6, 205, 222, 223	T 1760/09 - 3.2.05 22.07.11	568
T 1361/09 - 3.3.10 11.06.13	992	T 1764/09 - 3.4.02 08.01.14	170
T 1365/09 - 3.3.05 25.03.10	1199	T 1779/09 - 3.5.07 21.05.14	480
T 1367/09 - 3.4.01 11.12.13	551, 1124	T 1782/09 - 3.2.04 05.05.11	205, 206
T 1388/09 - 3.2.01 04.07.12	292	T 1786/09 - 3.2.04 23.11.10	120
T 1397/09 - 3.2.04 18.09.12	444	T 1797/09 - 3.3.06 08.02.12	675, 695
		T 1822/09 - 3.3.06 14.04.10	1190
		T 1824/09 - 3.2.02 21.02.13	586
		T 1841/09 - 3.3.03 15.09.11	123
		T 1843/09 - 3.3.09 06.06.12	2013, 502 432, 1118
		T 1864/09 - 3.2.07 09.02.10	1182

T 1871/09 - 3.4.01 24.11.15	290
T 1890/09 - 3.2.02 26.03.15	385, 1132, 1133
T 1908/09 - 3.2.02 15.12.10	610
T 1911/09 - 3.2.05 27.09.12	960, 1076
T 1912/09 - 3.3.02 16.01.14	1134
T 1915/09 - 3.3.01 27.06.13	1104
T 1916/09 - 3.3.02 17.07.12	570, 571
T 1920/09 - 3.3.07 14.06.12	119
T 1926/09 - 3.3.05 28.09.10	1095
T 1938/09 - 3.3.02 09.03.15	583, 729
T 1943/09 - 3.4.03 31.05.10	1095
T 1949/09 - 3.3.07 26.09.12	667, 948
T 1955/09 - 3.3.04 12.06.13	142
T 1959/09 - 3.2.01 20.06.12	1032
T 1961/09 - 3.2.06 26.06.13	970, 1089, 1226
T 1973/09 - 3.2.07 09.08.11	639, 1109
T 1975/09 - 3.2.06 24.09.12	496
T 1982/09 - 3.5.03 27.04.12	961, 1082
T 2000/09 - 3.5.02 20.01.15	1149
T 2006/09 - 3.3.01 08.07.11	270
T 2020/09 - 3.3.09 05.03.13	952
T 2023/09 - 3.4.02 02.10.12	1109
T 2043/09 - 3.3.10 28.06.12	252
T 2044/09 - 3.3.02 11.02.14	175, 226, 227, 244
T 2045/09 - 3.3.04 14.05.14	1090
T 2063/09 - 3.5.04 29.10.13	208
T 2076/09 - 3.3.10 13.06.13	458
T 2085/09 - 3.5.03 19.06.12	444
T 2106/09 - 3.2.07 22.01.14	564
T 2112/09 - 3.3.09 20.12.10	890
T 2127/09 - 3.2.04 12.05.11	206, 1158
T 2175/09 - 3.5.04 10.06.11	495, 496
T 2179/09 - 3.2.07 19.03.13	992
T 2187/09 - 3.5.02 23.10.14	282
T 2197/09 - 3.4.03 20.11.14	239
T 2220/09 - 3.5.01 13.09.12	275
T 2227/09 - 3.5.06 27.03.14	536, 1210
T 2231/09 - 3.5.04 23.04.14	285
T 2233/09 - 3.3.06 21.09.12	496, 986
T 2238/09 - 3.5.03 28.08.12	1134
T 2247/09 - 3.5.02 20.10.14	1209
T 2259/09 - 3.2.02 07.06.13	466
T 2270/09 - 3.5.03 13.11.12	412
T 2273/09 - 3.3.02 19.11.14	424
T 2284/09 - 3.3.03 23.01.13	461
T 2285/09 - 3.3.10 20.01.11	490, 695
T 2289/09 - 3.4.03 03.06.14	323
T 2298/09 - 3.2.07 16.05.13	448
T 2339/09 - 3.2.03 17.11.11	83, 85, 101, 683
T 2344/09 - 3.3.05 17.07.14	1133
T 2359/09 - 3.2.04 16.10.12	411
T 2364/09 - 3.2.02 09.12.14	757
T 2375/09 - 3.2.02 10.09.13	420
T 2377/09 - 3.2.02 01.12.10	1211
T 2415/09 - 3.3.10 15.09.11	539
T 2422/09 - 3.2.04 17.03.11	1133
T 2434/09 - 3.5.04 22.11.11	74, 543, 586, 1169
T 2453/09 - 3.2.04 05.10.11	244, 1106
T 2467/09 - 3.5.07 17.12.15	916
<b>2010</b>	
T 5/10 - 3.2.04 05.04.11	1134
T 9/10 - 3.3.06 16.11.11	469
T 23/10 - 3.3.02 18.01.11	940, 1069, 1097, 1129, 1139, 1140, 1144
T 28/10 - 3.3.01 12.12.11	1121, 1122, 1139, 1140, 1161, 1163
T 32/10 - 3.2.03 12.01.12	659
T 42/10 - 3.5.01 28.02.13	221
T 45/10 - 3.2.06 27.09.11	279
T 46/10 - 3.4.03 01.04.14	978
T 51/10 - 3.4.03 24.03.15	105, 106
T 61/10 - 3.3.07 13.11.13	1118
T 71/10 - 3.3.03 01.03.12	465
T 75/10 - 3.3.02 20.01.14	544
T 88/10 - 3.2.08 02.02.12	444
T 95/10 - 3.2.04 02.08.11	1097, 1099
T 111/10 - 3.3.02 24.06.14	1115
T 112/10 - 3.3.07 18.09.14	419
T 122/10 - 3.2.06 09.12.11	1151
T 128/10 - 3.4.01 10.12.10	772, 958, 1090
T 134/10 - 3.3.06 22.05.12	270
T 180/10 - 3.2.07 02.05.11	757
T 184/10 - 3.3.02 07.05.12	170
T 196/10 - 3.2.05 06.12.12	501
T 197/10 - 3.3.06 28.10.11	290

Table of cases

T 206/10 - 3.3.01 09.08.10	536, 882, 1206	T 495/10 - 3.3.09 03.07.12	1141, 1145
T 209/10 - 3.3.02 23.10.12	422	T 518/10 - 3.3.01 09.04.13	363, 569, 573, 697, 701, 702
T 216/10 - 3.3.05 21.01.14	946, 1102	T 520/10 - 3.3.08 11.06.13	976
T 217/10 - 3.2.02 25.03.15	1132	T 521/10 - 3.5.05 05.09.13	332, 377
T 241/10 - 3.5.04 07.05.14	944	T 535/10 - 3.2.04 23.03.13	169
T 245/10 - 3.3.10 17.10.12	667, 669, 955	T 553/10 - 3.3.05 11.02.15	335
T 252/10 - 3.3.06 26.04.12	234	T 571/10 - 3.3.07 03.06.14	395
T 253/10 - 3.3.01 16.03.12	1129, 1130, 1133, 1151, 1153, 1160	T 602/10 - 3.3.07 24.06.14	337
T 260/10 - 3.2.04 08.11.11	466	T 606/10 - 3.3.08 12.05.11	974, 1007
T 273/10 - 3.3.05 12.09.11	443, 444, 987	T 607/10 - 3.4.03 10.04.14	946, 949
T 286/10 - 3.5.06 21.05.14	84, 100, 655, 664, 681, 683, 689	T 613/10 - 3.4.03 29.11.12	1023
T 287/10 - 3.3.06 15.05.12	360	T 632/10 - 3.5.06 06.12.13	173
T 301/10 - 3.4.02 02.08.10	867, 876	T 648/10 - 3.5.04 11.05.11	410, 1092
T 306/10 - 3.5.07 04.02.15	14, 216, 222	T 657/10 - 3.3.08 19.12.13	346
T 311/10 - 3.2.08 08.05.12	954	T 663/10 - 3.5.03 23.03.12	563, 581
T 313/10 - 3.5.01 19.07.12	7, 22, 198, 200, 832	T 680/10 - 3.5.04 04.06.14	1137, 1138
T 317/10 - 3.3.07 21.01.14	954	T 683/10 - 3.2.07 25.04.12	1152
T 320/10 - 3.3.10 10.01.13	448	T 698/10 - 3.5.04 27.04.15	162, 164, 166, 167, 536, 1196
T 328/10 - 3.3.09 16.05.12	415	T 712/10 - 3.2.06 25.10.12	1221
T 333/10 - 3.5.04 17.07.14	923	T 726/10 - 3.2.02 06.09.13	1110
T 338/10 - 3.3.04 22.01.15	348, 349, 363, 701	T 747/10 - 3.4.01 13.04.11	410, 438
T 340/10 - 3.3.01 25.09.12	1145	T 759/10 - 3.3.09 22.03.12	457, 458
T 347/10 - 3.3.10 07.11.13	361	T 773/10 - 3.2.02 24.10.14	145
T 351/10 - 3.2.04 14.07.11	1133	T 790/10 - 3.2.05 18.12.12	497
T 358/10 - 3.2.03 12.07.12	1198	T 820/10 - 3.5.05 10.01.14	531, 534
T 369/10 - 3.3.01 01.10.12	403	T 835/10 - 3.5.06 03.09.14	1195
T 370/10 - 3.3.10 01.03.11	489, 490	T 846/10 - 3.4.01 05.09.14	377
T 376/10 - 3.2.04 29.09.11	1152	T 853/10 - 3.3.06 10.07.12	1195
T 379/10 - 3.3.01 21.09.15	958, 1244	T 862/10 - 3.5.06 15.05.13	221
T 382/10 - 3.5.05 13.12.11	555, 1195	T 869/10 - 3.3.06 25.05.12	469
T 407/10 - 3.3.06 26.09.12	424, 425	T 901/10 - 3.5.06 06.06.14	566, 1202
T 430/10 - 3.3.05 28.02.14	361	T 902/10 - 3.5.03 09.10.12	1150
T 432/10 - 3.3.02 19.12.12	330	T 906/10 - 3.3.04 09.04.13	349
T 447/10 - 3.3.10 14.11.13	435	T 911/10 - 3.5.06 17.01.14	559
T 456/10 - 3.2.04 09.11.11	101, 102	T 928/10 - 3.2.03 27.10.11	672
T 479/10 - 3.4.02 21.09.11	614, 622	T 933/10 - 3.3.03 25.01.11	581, 1192
		T 948/10 - 3.5.03 22.10.13	840
		T 970/10 - 3.5.03 16.05.12	1196
		T 973/10 - 3.2.03 12.07.11	670
		T 974/10 - 3.2.05 05.07.11	1117
		T 976/10 - 3.3.06 01.08.12	942
		T 983/10 - 3.5.06 29.11.13	221
		T 999/10 - 3.3.09 19.06.12	464, 469



T 1014/10 - 3.3.05 15.01.13	546	T 1469/10 - 3.5.05 28.06.13	85, 681, 689
T 1016/10 - 3.2.02 11.04.14	1218	T 1471/10 - 3.4.03 11.06.14	440
T 1032/10 - 3.2.03 17.01.13	964	T 1483/10 - 3.2.03 28.02.13	650
T 1033/10 - 3.2.06 21.03.13	1130, 1131	T 1488/10 - 3.4.03 25.09.14	109
T 1067/10 - 3.3.02 13.03.13	1156	T 1500/10 - 3.2.08 20.12.12	560, 567, 1212, 1213
T 1074/10 - 3.5.06 19.09.15	873	T 1507/10 - 3.3.10 12.11.15	341, 359
T 1084/10 - 3.2.08 10.07.12	464	T 1525/10 - 3.3.02 20.09.11	1139, 1140, 1145, 1146
T 1108/10 - 3.2.03 09.03.12	1150	T 1534/10 - 3.4.01 09.03.15	271
T 1109/10 - 3.3.08 13.03.14	258	T 1535/10 - 3.2.03 13.05.11	693, 699, 788, 789, 1188
T 1111/10 - 3.3.09 08.09.10	980	T 1538/10 - 3.5.04 22.04.15	1142
T 1118/10 - 3.5.03 30.11.12	409	T 1542/10 - 3.5.03 06.11.13	810
T 1125/10 - 3.2.06 07.02.13	1143	T 1551/10 - 3.5.03 18.10.13	1016
T 1127/10 - 3.3.07 14.05.13	679	T 1577/10 - 3.2.04 26.03.14	1049
T 1128/10 - 3.3.05 20.11.14	1153	T 1616/10 - 3.2.06 04.12.13	1141, 1142
T 1136/10 - 3.2.07 10.05.11	565	T 1634/10 - 3.2.03 11.04.11	533, 534
T 1165/10 - 3.3.06 02.10.12	1139, 1144	T 1635/10 - 3.2.07 02.04.14	589, 834
T 1188/10 - 3.3.09 22.09.11	417	T 1643/10 - 3.5.06 26.11.14	497
T 1199/10 - 3.5.07 23.10.14	536	T 1644/10 - 3.3.05 26.10.11	516, 1014
T 1225/10 - 3.2.04 11.01.11	205, 206	T 1649/10 - 3.4.01 25.09.15	1122
T 1227/10 - 3.3.06 19.10.12	456, 1135	T 1651/10 - 3.3.09 17.06.13	1197
T 1237/10 - 3.5.07 16.10.15	211	T 1685/10 - 3.3.02 06.06.11	347, 348
T 1246/10 - 3.5.04 31.03.15	571	T 1693/10 - 3.4.02 09.07.15	814, 817, 820
T 1265/10 - 3.2.04 15.04.11	793	T 1700/10 - 3.3.09 15.07.11	746, 1201
T 1278/10 - 3.2.07 06.12.11	551, 1133, 1137	T 1724/10 - 3.5.07 27.01.15	755
T 1281/10 - 3.5.01 28.02.13	221	T 1732/10 - 3.2.07 19.12.13	946, 1132, 1133, 1157
T 1289/10 - 3.5.06 13.04.11	617, 627, 1188, 1189	T 1748/10 - 3.3.07 21.10.14	79, 687
T 1306/10 - 3.5.04 17.03.15	1150	T 1755/10 - 3.5.01 06.11.14	207, 217
T 1312/10 - 3.5.05 05.11.14	536	T 1760/10 - 3.2.06 29.10.13	668
T 1340/10 - 3.3.05 22.05.13	1191, 1196	T 1761/10 - 3.3.09 11.04.13	946, 947
T 1346/10 - 3.5.06 28.03.14	978	T 1769/10 - 3.4.03 12.04.11	198, 208
T 1349/10 - 3.3.10 02.02.11	732, 746, 747, 1177, 1201	T 1829/10 - 3.2.02 01.02.11	558, 560, 561
T 1351/10 - 3.2.01 04.03.13	1164	T 1832/10 - 3.3.08 24.01.11	1151
T 1388/10 - 3.3.05 25.03.11	267, 830, 870	T 1834/10 - 3.5.01 25.02.15	203, 207, 217
T 1389/10 - 3.2.04 30.09.11	156	T 1836/10 - 3.3.08 09.04.13	432
T 1397/10 - 3.3.02 06.05.14	977	T 1846/10 - 3.3.04 12.03.15	352, 701
T 1399/10 - 3.5.06 16.04.15	896	T 1856/10 - 3.2.05 30.04.15	993
T 1402/10 - 3.2.03 14.12.12	1103	T 1869/10 - 3.3.06 17.04.13	1134
T 1404/10 - 3.2.01 24.06.13	944, 997	T 1925/10 - 3.3.05 17.12.14	1133
T 1416/10 - 3.2.06 03.04.12	86		
T 1427/10 - 3.5.05 25.07.13	581		
T 1437/10 - 3.5.02 12.02.15	374, 498		
T 1460/10 - 3.4.01 11.02.15	482		

Table of cases

T 1939/10 - 3.4.03 05.11.15	568	T 2422/10 - 3.2.07 26.02.13	648
T 1941/10 - 3.2.07 17.12.13	946	T 2425/10 - 3.5.04 30.04.14	581
T 1944/10 - 3.2.04 14.03.14	439	T 2436/10 - 3.3.01 27.08.14	124
T 1948/10 - 3.3.10 26.06.14	131	T 2449/10 - 3.2.04 23.09.11	206
T 2001/10 - 3.3.03 04.09.14	415	T 2461/10 - 3.3.08 26.03.14	508, 509, 511, 512
T 2049/10 - 3.5.06 13.02.15	284	T 2464/10 - 3.3.08 25.05.12	428
T 2068/10 - 3.3.01 21.05.12	274	T 2471/10 - 3.5.04 09.10.14	1139
T 2097/10 - 3.2.04 12.07.12	225, 936, 1136	T 2482/10 - 3.2.07 25.09.13	1157
T 2106/10 - 3.3.04 04.02.14	1210	T 2485/10 - 3.5.03 09.11.12	1137
T 2165/10 - 3.2.07 11.12.13	936	T 2497/10 - 3.2.04 30.04.14	1133
T 2166/10 - 3.5.03 01.12.11	843	T 2522/10 - 3.3.04 28.01.14	106, 769
T 2185/10 - 3.5.07 21.10.14	439	T 2534/10 - 3.2.04 23.04.12	575, 576
T 2192/10 - 3.2.06 23.11.13	191	T 2536/10 - 3.3.01 13.01.14	976
T 2201/10 - 3.4.01 21.09.15	102, 184	T 2537/10 - 3.2.05 11.11.14	412, 437, 439, 453
T 2210/10 - 3.2.02 15.09.11	1188	T 2542/10 - 3.3.09 09.10.12	944
T 2221/10 - 3.3.08 04.02.14	39, 290, 292	<b>2011</b>	
T 2245/10 - 3.3.02 31.01.13	181	T 12/11 - 3.2.02 21.04.15	957
T 2255/10 - 3.4.03 23.04.15	165	T 36/11 - 3.5.03 30.01.12	977, 978
T 2258/10 - 3.2.04 04.10.11	10	T 40/11 - 3.2.06 15.07.14	131
T 2270/10 - 3.5.06 02.07.14	222	T 49/11 - 3.3.09 25.03.14	730
T 2273/10 - 3.3.06 16.11.12	425	T 59/11 - 3.2.06 04.09.14	385
T 2299/10 - 3.5.05 31.03.14	915	T 65/11 - 3.5.03 21.11.14	639, 1130
T 2303/10 - 3.4.02 12.09.13	487	T 66/11 - 3.2.03 11.10.13	667
T 2308/10 - 3.4.03 08.10.15	798	T 74/11 - 3.3.03 13.11.14	429
T 2311/10 - 3.2.03 24.09.12	409, 440, 829, 868	T 75/11 - 3.3.01 24.04.12	935
T 2316/10 - 3.5.06 23.07.14	538	T 78/11 - 3.5.03 22.11.12	1173
T 2330/10 - 3.5.03 19.11.14	959, 1088	T 79/11 - 3.3.01 27.07.12	951
T 2336/10 - 3.2.08 28.02.13	635	T 93/11 - 3.2.07 26.08.14	1154
T 2346/10 - 3.4.01 13.07.12	1098	T 134/11 - 3.3.09 06.11.12	1147
T 2350/10 - 3.3.02 20.05.14	977	T 167/11 - 3.2.07 22.01.15	1007
T 2363/10 - 3.2.06 26.09.12	420	T 184/11 - 3.2.01 14.05.13	79, 688, 965
T 2369/10 - 3.4.01 13.11.15	146	T 188/11 - 3.2.04 03.05.13	198
T 2375/10 - 3.3.10 01.12.11	174, 756	T 223/11 - 3.3.02 22.05.12	780, 969
T 2382/10 - 3.2.08 12.03.13	960, 965	T 234/11 - 3.3.10 13.10.14	747
T 2383/10 - 3.2.07 10.10.12	11	T 236/11 - 3.5.02 22.07.15	1136
T 2385/10 - 3.5.07 20.11.15	1191	T 265/11 - 3.5.02 16.10.15	650
T 2392/10 - 3.2.02 12.11.14	440	T 270/11 - 3.3.10 06.06.13	162, 271, 435
T 2399/10 - 3.3.06 28.11.12	360	T 273/11 - 3.3.07 28.01.15	1139
T 2402/10 - 3.3.10 10.05.12	230, 508, 511	T 275/11 - 3.3.10 14.04.15	253, 678
T 2405/10 - 3.5.03 17.09.13	533, 586	T 280/11 - 3.2.01 01.07.14	1159
T 2406/10 - 3.3.01 13.01.15	395	T 285/11 - 3.3.10 21.11.14	745
T 2411/10 - 3.5.01 23.11.12	847, 1199	T 287/11 - 3.3.10 01.04.14	464, 469, 1220
T 2418/10 - 3.3.10 03.11.11	175		

T 294/11 - 3.4.01 27.06.12	1098	T 596/11 - 3.2.06 18.03.15	954
T 297/11 - 3.3.10 10.02.15	106	T 605/11 - 3.3.06 27.05.14	944
T 301/11 - 3.3.07 03.02.15	1139, 1144	T 617/11 - 3.2.07 27.03.15	15
T 307/11 - 3.3.05 19.01.15	76	T 626/11 - 3.3.10 03.03.15	446
T 353/11 - 3.3.10 16.05.12	755, 1196	T 645/11 - 3.5.01 26.01.12	536, 879
T 359/11 - 3.4.03 13.05.15	916	T 657/11 - 3.3.09 08.11.13	488, 489, 1049
T 363/11 - 3.3.10 10.01.12	467	T 664/11 - 3.3.01 25.02.15	405
T 366/11 - 3.2.04 25.10.12	935	T 698/11 - 3.5.01 14.12.11	916, 1191, 1203
T 370/11 - 3.3.02 19.08.14	1190	T 711/11 - 3.3.10 29.07.15	1210
T 375/11 - 3.3.01 06.09.13	1130	T 741/11 - 3.5.06 17.09.14	222
T 377/11 - 3.3.10 14.12.11	1188	T 742/11 - 3.4.03 29.03.12	616, 632
T 378/11 - 3.3.06 22.10.12	360	T 744/11 - 3.2.01 08.03.13	631
T 383/11 - 3.5.02 17.04.12	1183	T 749/11 - 3.2.04 01.10.13	169
T 387/11 - 3.5.05 06.07.12	607, 619, 623	T 784/11 - 3.2.02 21.07.14	1211
T 391/11 - 3.5.07 24.09.15	1134, 1137	T 786/11 - 3.5.05 12.06.14	959, 1088
T 407/11 - 3.5.05 10.04.14	193, 209, 214	T 795/11 - 3.4.03 26.09.13	1137
T 415/11 - 3.3.04 12.01.12	181, 252	T 823/11 - 3.5.07 21.12.15	1198
T 423/11 - 3.5.06 11.03.15	962	T 833/11 - 3.3.01 08.04.14	127
T 424/11 - 3.3.05 19.08.14	940	T 849/11 - 3.3.05 06.03.15	278
T 427/11 - 3.2.05 17.07.14	1179	T 862/11 - 3.3.05 17.03.15	161, 249, 330, 338, 362, 696
T 433/11 - 3.3.04 24.05.12	147, 587, 946	T 887/11 - 3.2.06 05.03.15	944
T 442/11 - 3.2.05 01.10.12	325, 923	T 892/11 - 3.5.03 30.01.14	1149, 1150
T 443/11 - 3.5.02 30.01.12	332	T 910/11 - 3.2.04 24.10.13	950
T 452/11 - 3.2.01 27.01.12	117	T 918/11 - 3.2.07 03.06.14	655, 658, 661, 684
T 480/11 - 3.3.09 11.07.13	658, 659	T 926/11 - 3.2.04 27.11.13	224, 225
T 484/11 - 3.5.05 08.11.13	1141, 1151, 1152	T 937/11 - 3.3.02 14.01.14	1145, 1146
T 493/11 - 3.2.07 03.12.13	984	T 938/11 - 3.2.06 08.12.15	403
T 500/11 - 3.3.05 04.09.13	444	T 1021/11 - 3.3.04 02.06.15	140
T 507/11 - 3.2.05 24.09.12	325	T 1028/11 - 3.2.04 05.03.14	657, 666, 670, 673
T 509/11 - 3.2.05 24.09.12	325, 923	T 1034/11 - 3.5.02 30.11.12	536, 1110
T 531/11 - 3.2.06 28.11.14	961	T 1037/11 - 3.2.04 29.06.15	517
T 553/11 - 3.3.09 19.03.13	357	T 1134/11 - 3.2.07 18.02.14	1132, 1155
T 556/11 - 3.2.02 20.02.15	276	T 1149/11 - 3.4.01 20.09.11	620, 622, 626, 633, 635, 637
T 563/11 - 3.2.03 06.11.12	1198, 1200	T 1164/11 - 3.2.02 18.02.15	328, 333, 344
T 566/11 - 3.5.01 18.12.12	203, 222	T 1190/11 - 3.2.01 28.03.12	464
T 569/11 - 3.3.07 09.10.14	573	T 1222/11 - 3.3.07 04.12.12	388, 389, 395
T 579/11 - 3.5.03 12.12.13	211, 218	T 1231/11 - 3.3.03 09.09.14	662, 665
T 592/11 - 3.4.02 25.10.12	612, 616, 617, 619, 620, 637, 643		
T 595/11 - 3.2.04 27.05.15	516, 524, 1095		

Table of cases

T 1245/11 - 3.3.01 20.06.13	1130
T 1254/11 - 3.5.02 17.11.15	746, 1178
T 1263/11 - 3.3.03 22.07.15	177
T 1269/11 - 3.2.01 17.09.14	1016
T 1273/11 - 3.2.07 11.08.15	1001, 1157, 1158
T 1283/11 - 3.2.02 15.01.15	1036
T 1285/11 - 3.3.01 15.12.11	325, 919, 920
T 1306/11 - 3.3.06 04.04.14	1137
T 1326/11 - 3.3.10 04.05.12	895, 896
T 1329/11 - 3.3.02 19.11.16	697
T 1354/11 - 3.3.02 25.06.15	1131, 1135
T 1360/11 - 3.3.07 11.11.14	469
T 1378/11 - 3.3.01 16.09.15	533, 1241
T 1381/11 - 3.5.06 22.09.14	639
T 1399/11 - 3.5.03 14.01.15	270
T 1400/11 - 3.2.07 03.07.14	1144, 1270, 1273
T 1458/11 - 3.3.05 23.10.14	818, 824
T 1459/11 - 3.3.03 21.07.15	576, 945
T 1467/11 - 3.2.06 24.07.12	1109, 1140
T 1486/11 - 3.3.05 13.04.12	608
T 1496/11 - 3.2.05 12.09.12	71, 396
T 1517/11 - 3.2.07 11.08.14	115
T 1518/11 - 3.3.01 13.08.13	1166
T 1540/11 - 3.3.10 26.07.12	895
T 1548/11 - 3.2.05 22.09.15	565, 1178
T 1562/11 - 3.5.01 03.06.15	210-212, 221
T 1569/11 - 3.2.06 21.05.15	1083
T 1574/11 - 3.2.04 19.03.14	1124
T 1577/11 - 3.3.01 03.06.15	186
T 1589/11 - 3.4.03 29.09.15	1137
T 1640/11 - 3.4.03 03.11.15	281
T 1641/11 - 3.3.05 03.05.12	75, 76, 195
T 1643/11 - 3.2.04 03.12.14	935, 937
T 1644/11 - 3.3.05 04.04.14	440
T 1648/11 - 3.3.08 08.11.12	419
T 1677/11 - 3.3.01 27.11.12	730
T 1680/11 - 3.2.08 18.10.12	1212
T 1700/11 - 3.2.01 15.11.12	811
T 1705/11 - 3.3.08 15.11.12	506
T 1713/11 - 3.2.04 12.12.12	969
T 1722/11 - 3.5.03 18.12.15	282
T 1734/11 - 3.5.01 13.01.15	211, 218

T 1756/11 - 3.2.04 14.01.15	672, 777, 778, 780-783
T 1760/11 - 3.3.01 16.11.12	163, 730, 731
T 1814/11 - 3.3.01 06.02.13	233
T 1823/11 - 3.3.07 20.05.15	349
T 1830/11 - 3.2.07 29.07.15	667, 951
T 1835/11 - 3.5.02 21.09.15	957
T 1836/11 - 3.2.04 25.07.14	225
T 1839/11 - 3.3.09 29.06.12	770
T 1841/11 - 3.4.03 03.12.15	167
T 1843/11 - 3.3.09 08.03.13	537
T 1856/11 - 3.2.07 09.08.12	1021, 1024
T 1869/11 - 3.3.02 22.03.13	141, 349
T 1880/11 - 3.5.06 19.01.12	564
T 1898/11 - 3.5.01 27.07.12	534, 536
T 1906/11 - 3.4.02 18.01.13	408, 440
T 1910/11 - 3.5.05 04.06.14	194
T 1919/11 - 3.3.02 15.05.13	415, 445
T 1979/11 - 3.3.09 28.06.13	1115, 1118
T 1985/11 - 3.3.02 06.11.12	607, 609
T 1994/11 - 3.2.01 05.10.12	1210
T 2035/11 - 3.5.07 25.07.14	222, 223
T 2054/11 - 3.2.04 09.10.15	655, 657
T 2061/11 - 3.2.04 26.06.13	977, 978
T 2068/11 - 3.3.08 17.03.15	354
T 2075/11 - 3.3.09 23.07.13	1161, 1162
T 2076/11 - 3.5.03 21.05.12	588, 745, 1200
T 2077/11 - 3.2.03 21.01.15	1102
T 2084/11 - 3.3.06 15.01.14	497
T 2086/11 - 3.3.06 30.01.13	262, 280
T 2125/11 - 3.2.02 23.09.15	570, 572
T 2130/11 - 3.3.07 02.12.14	283, 431, 435
T 2168/11 - 3.3.08 24.06.15	185
T 2172/11 - 3.2.01 31.01.14	444
T 2227/11 - 3.4.03 18.02.16	655, 681, 684, 689
T 2244/11 - 3.3.01 05.03.14	1148
T 2254/11 - 3.2.04 05.03.13	603
T 2274/11 - 3.5.06 29.08.12	616, 632, 1188
T 2305/11 - 3.3.05 07.03.13	331
T 2331/11 - 3.4.02 04.11.14	341, 359

T 2334/11 - 3.4.02 24.05.12	919, 922-926	T 324/12 - 3.2.08 04.11.14	107
T 2347/11 - 3.5.06 16.10.12	1169	T 336/12 - 3.3.01 28.08.14	428
T 2366/11 - 3.3.08 26.03.12	751, 1196	T 373/12 - 3.2.08 02.04.14	2014, A115 1047
T 2373/11 - 3.5.05 09.04.13	560, 561, 1209	T 395/12 - 3.5.06 23.11.12	1097
T 2403/11 - 3.3.09 30.04.14	338, 364	T 405/12 - 3.2.01 05.06.14	753
T 2454/11 - 3.2.05 19.07.12	603, 645, 699	T 408/12 - 3.2.07 19.12.12	243
T 2485/11 - 3.3.01 15.01.14	1147	T 409/12 - 3.5.05 23.09.14	1152
T 2509/11 - 3.2.07 11.10.13	732	T 414/12 - 3.2.04 10.04.13	198, 206
T 2513/11 - 3.2.04 02.10.14	935, 937, 1155	T 419/12 - 3.3.05 14.10.14	331, 675, 1140
T 2526/11 - 3.3.01 09.01.13	568, 572	T 428/12 - 3.3.01 26.06.14	268, 1043
T 2532/11 - 3.3.05 14.10.13	1098, 1107	T 432/12 - 3.2.07 07.10.15	949
T 2541/11 - 3.2.04 17.12.14	539	T 500/12 - 3.3.08 24.04.15	975
T 2552/11 - 3.3.01 14.04.15	817, 821	T 516/12 - 3.2.07 10.12.14	404
T 2573/11 - 3.5.04 07.02.13	748	T 524/12 - 3.2.01 16.10.14	946
T 2575/11 - 3.2.07 19.06.15	1158, 1163	T 526/12 - 3.5.05 31.08.15	78
T 2579/11 - 3.3.05 10.03.15	172, 174	T 544/12 - 3.3.09 22.11.13	343, 935, 937
T 2599/11 - 3.2.05 26.11.13	1146	T 571/12 - 3.3.01 03.04.14	76
T 2619/11 - 3.4.02 25.02.13	403, 829	T 573/12 - 3.5.01 08.05.13	873
<b>2012</b>		T 576/12 - 3.2.01 09.01.15	1112
T 7/12 - 3.2.07 26.10.12	542	T 582/12 - 3.2.03 17.07.14	1160
T 30/12 - 3.2.01 26.09.14	657, 666	T 598/12 - 3.3.02 05.11.13	406, 407
T 36/12 - 3.2.08 15.07.14	1161	T 614/12 - 3.2.08 10.12.13	455, 477
T 37/12 - 3.2.01 02.10.14	589, 834	T 616/12 - 3.2.06 23.01.14	1049
T 50/12 - 3.3.05 27.06.13	698	T 623/12 - 3.2.08 23.05.14	531, 546
T 74/12 - 3.3.05 25.02.14	1096	T 642/12 - 3.2.04 11.01.13	517, 523, 524, 796
T 79/12 - 3.2.05 26.07.12	1201	T 674/12 - 3.3.01 25.10.13	1212
T 100/12 - 3.2.08 05.08.14	130	T 691/12 - 3.2.03 21.01.14	956
T 108/12 - 3.3.05 29.09.15	481	T 703/12 - 3.2.04 08.06.15	657, 658, 662, 668, 685
T 116/12 - 3.2.06 01.03.13	537	T 719/12 - 3.3.01 29.10.15	113
T 135/12 - 3.2.07 07.12.12	745	T 720/12 - 3.2.07 13.08.15	1099
T 140/12 - 3.3.10 10.03.15	1145	T 734/12 - 3.3.04 17.05.13	141, 1068
T 154/12 - 3.5.03 25.06.13	1142	T 755/12 - 3.2.08 23.01.14	409
T 158/12 - 3.2.06 25.10.13	866	T 764/12 - 3.3.09 18.02.14	235
T 162/12 - 3.2.07 02.08.12	1133, 1135	T 783/12 - 3.2.08 20.06.13	90
T 169/12 - 3.2.07 20.08.15	949, 950	T 802/12 - 3.2.01 23.01.15	549
T 174/12 - 3.2.08 05.11.13	946	T 809/12 - 3.3.05 16.10.15	272, 284
T 198/12 - 3.2.08 14.01.14	1218	T 863/12 - 3.3.05 23.09.15	296
T 233/12 - 3.5.06 10.02.15	877	T 879/12 - 3.3.08 27.08.14	139, 140, 512
T 236/12 - 3.2.01 14.11.14	468	T 883/12 - 3.2.06 06.03.14	1146
T 248/12 - 3.2.06 05.03.13	408, 440	T 926/12 - 3.4.02 04.07.13	1145
T 250/12 - 3.2.05 27.09.13	385	T 935/12 - 3.3.03 05.12.13	1129, 1145
T 274/12 - 3.2.04 11.05.15	94, 655, 685		

Table of cases

T 942/12 - 3.3.03 17.11.15	628	T 1727/12 - 3.2.05 01.02.16	335, 345
T 967/12 - 3.3.05 25.03.15	1000	T 1775/12 - 3.4.02 15.06.15	564
T 970/12 - 3.3.02 22.07.15	619	T 1780/12 - 3.3.04 30.01.14	139, 140, 475, 508, 511, 512
T 979/12 - 3.3.06 05.05.15	1077, 1090		
T 996/12 - 3.2.07 14.03.13	553, 554, 873	T 1791/12 - 3.2.06 24.03.15	408, 440
T 1000/12 - 3.3.09 17.12.13	76	T 1799/12 - 3.2.07 26.03.14	419, 425
T 1009/12 - 3.2.07 08.01.13	227, 464	T 1802/12 - 3.3.01 07.11.14	277, 1149
T 1031/12 - 3.2.05 05.12.13	545, 1196	T 1822/12 - 3.3.09 23.10.14	150, 154
T 1032/12 - 3.3.08 30.07.15	425	T 1836/12 - 3.2.07 05.03.14	1132, 1133
T 1076/12 - 3.2.06 07.09.12	495	T 1849/12 - 3.2.05 03.12.12	887, 1127
T 1112/12 - 3.2.01 17.06.15	1049	T 1869/12 - 3.2.07 13.12.13	765
T 1131/12 - 3.5.03 08.02.13	1198	T 1882/12 - 3.3.07 26.05.15	269, 834
T 1142/12 - 3.3.03 08.04.14	581, 1072, 1192, 1218	T 1883/12 - 3.2.04 17.11.14	932, 933
T 1181/12 - 3.3.05 09.10.15	778	T 1886/12 - 3.3.06 11.03.15	697
T 1205/12 - 3.5.06 14.12.12	539, 756	T 1888/12 - 3.2.01 15.01.15	282
T 1206/12 - 3.5.06 14.12.12	536, 540, 756	T 1904/12 - 3.2.02 11.06.14	663, 678
T 1278/12 - 3.3.09 28.04.15	148	T 1929/12 - 3.5.06 14.07.15	754, 1179
T 1295/12 - 3.2.01 28.01.15	957	T 1930/12 - 3.5.05 30.04.15	581
T 1314/12 - 3.3.06 26.02.14	950, 1104	T 1932/12 - 3.2.08 15.05.14	666
T 1331/12 - 3.2.04 10.04.13	198, 206	T 1933/12 - 3.2.08 21.02.14	391
T 1343/12 - 3.3.06 10.10.14	1172	T 1941/12 - 3.3.09 16.12.14	242
T 1363/12 - 3.2.06 12.12.14	403, 829	T 1942/12 - 3.5.07 03.09.15	581
T 1364/12 - 3.2.03 12.02.15	1129	T 1952/12 - 3.5.06 11.08.15	209
T 1422/12 - 3.3.10 11.04.13	173	T 1962/12 - 3.3.07 23.07.15	253, 680
T 1436/12 - 3.5.06 21.07.15	484	T 1964/12 - 3.3.03 16.04.15	1142
T 1458/12 - 3.5.05 09.10.15	959	T 1981/12 - 3.2.03 24.09.13	325, 326, 926
T 1461/12 - 3.5.06 04.08.15	202, 207, 209	T 1995/12 - 3.2.05 06.08.15	1137
T 1466/12 - 3.3.05 10.11.15	1129	T 2001/12 - 3.4.03 29.01.15	161, 177, 273, 285, 330, 339, 362
T 1528/12 - 3.5.05 22.04.15	220	T 2017/12 - 3.5.06 24.02.14	645, 1225
T 1534/12 - 3.2.02 21.10.15	291	T 2102/12 - 3.2.02 30.04.13	55, 274
T 1540/12 - 3.5.05 06.02.15	272	T 2134/12 - 3.3.01 16.07.13	1207
T 1568/12 - 3.2.03 30.04.15	936	T 2177/12 - 3.2.02 24.07.13	979, 997
T 1646/12 - 3.2.05 26.06.15	290	T 2219/12 - 3.3.06 03.07.15	1130, 1134
T 1650/12 - 3.2.07 15.10.14	1157	T 2235/12 - 3.5.02 03.07.13	544
T 1663/12 - 3.3.05 14.01.13	624, 633	T 2281/12 - 3.2.07 14.01.14	1137
T 1674/12 - 3.2.04 10.10.13	575, 725, 727, 1067	T 2284/12 - 3.3.06 12.08.14	1137
T 1694/12 - 3.3.06 13.02.15	284, 1094	T 2294/12 - 3.3.05 12.01.16	538, 671
T 1697/12 - 3.3.09 18.09.14	338, 1145	T 2300/12 - 3.4.03 30.06.15	412
T 1702/12 - 3.3.10 08.10.15	485	T 2357/12 - 3.3.05 28.11.13	682, 960
T 1703/12 - 3.5.01 14.03.13	1207	T 2364/12 - 3.3.01 18.12.13	520, 794
T 1710/12 - 3.2.08 12.02.15	657, 682, 688, 695	T 2446/12 - 3.5.05 27.05.15	117
		T 2449/12 - 3.2.08 28.10.14	1031

T 2459/12 - 3.4.03 17.10.13	325, 326, 918, 926, 1222	T 562/13 - 3.3.06 24.06.15	1077
T 2473/12 - 3.3.09 05.11.13	325	T 614/13 - 3.3.03 02.07.15	972
T 2477/12 - 3.3.08 12.11.15	405, 1221, 1222	T 620/13 - 3.2.04 22.05.14	1092
T 2528/12 - 3.5.03 12.04.13	1110, 1207	T 649/13 - 3.2.04 15.09.14	639
T 2540/12 - 3.3.09 13.01.15	1135	T 754/13 - 3.2.07 13.05.14	262, 276
T 2542/12 - 3.3.08 23.02.16	355	T 771/13 - 3.3.01 11.03.14	784
T 2557/12 - 3.4.01 30.09.13	560, 561	T 782/13 - 3.3.06 07.02.14	937
T 2573/12 - 3.3.09 18.03.14	980	T 801/13 - 3.2.02 27.02.14	406
<b>2013</b>		T 837/13 - 3.2.08 13.05.15	373, 374, 378
T 8/13 - 3.2.06 10.12.13	660, 817, 823	T 893/13 - 3.5.06 09.11.15	1207
T 25/13 - 3.2.08 20.11.14	166, 169, 190	T 895/13 - 3.3.04 21.05.15	348, 1068
T 27/13 - 3.2.07 29.01.14	1104	T 899/13 - 3.5.04 29.01.14	1099
T 38/13 - 3.4.02 25.03.14	1142	T 943/13 - 3.3.09 25.06.15	174, 348
T 83/13 - 3.3.07 23.09.15 2014, A76	419	T 972/13 - 3.2.05 28.01.15	990
T 143/13 - 3.3.01 12.11.14	179	T 1020/13 - 3.2.06 16.10.13	281, 1108
T 146/13 - 3.3.09 30.01.15	79, 688	T 1027/13 - 3.3.06 22.04.15	543, 818, 819, 822, 1055
T 160/13 - 3.2.03 23.04.15	368, 369, 691	T 1060/13 - 3.5.05 16.12.13	834, 1110
T 163/13 - 3.2.07 06.11.13	444, 487	T 1093/13 - 3.2.01 24.11.14	757
T 184/13 - 3.5.05 27.08.15	1150	T 1125/13 - 3.3.04 28.03.14	716, 1069
T 202/13 - 3.2.03 10.07.15	655, 678, 684	T 1155/13 - 3.2.02 07.05.14	498
T 206/13 - 3.4.02 29.09.15	329, 330	T 1162/13 - 3.5.02 17.03.14	444
T 241/13 - 3.4.02 13.03.14	403, 1141	T 1170/13 - 3.2.01 01.10.15	684
T 260/13 - 3.3.09 29.09.15	1049	T 1171/13 - 3.2.08 01.10.15	619, 622, 633, 634
T 306/13 - 3.3.05 24.11.15	279	T 1269/13 - 3.5.02 04.02.15	619, 624
T 307/13 - 3.2.07 16.07.13	980	T 1354/13 - 3.5.04 30.04.14	1202
T 316/13 - 3.3.05 07.05.14	630, 631	T 1362/13 - 3.5.05 27.11.13	1110
T 327/13 - 3.2.03 17.07.15	1079	T 1402/13 - 3.3.05 25.02.16	1169
T 345/13 - 3.2.05 01.12.14	922	T 1426/13 - 3.3.09 14.04.15	1016
T 355/13 - 3.5.02 18.11.15	730, 731	T 1441/13 - 3.3.08 09.09.14	39, 429, 436
T 395/13 - 3.5.02 12.11.14	1100	T 1506/13 - 3.3.08 08.05.15	420, 421
T 405/13 - 3.4.02 09.04.14	242	T 1553/13 - 3.2.06 20.02.14 2014, A84	1188, 1225
T 450/13 - 3.3.09 24.03.15	957, 1101, 1102	T 1654/13 - 3.3.06 27.01.15	807
T 460/13 - 3.3.09 25.03.15	1101	T 1682/13 - 3.2.08 11.06.15	1078, 1079
T 467/13 - 3.3.03 18.06.15	1146, 1161	T 1697/13 - 3.2.07 28.11.14	1163
T 480/13 - 3.2.07 05.11.14	974	T 1765/13 - 3.3.05 24.04.14	511, 1208
T 557/13 - 3.3.06 17.07.15 2016, Axx	71, 396, 493	T 1766/13 - 3.3.05 17.04.14	511
T 558/13 - 3.5.04 04.11.13	449	T 1808/13 - 3.3.08 26.02.15	436
T 560/13 - 3.5.04 04.11.13	1219	T 1853/13 - 3.3.09 30.09.14	419
		T 1855/13 - 3.2.07 01.08.14	936
		T 1905/13 - 3.5.03 18.02.16	263
		T 1929/13 - 3.5.07 16.07.14	1148
		T 1958/13 - 3.5.05 12.06.15	209, 219

Table of cases

T 1961/13 - 3.5.07 16.09.14	85, 536
T 1977/13 - 3.5.02 12.11.15	263, 1049, 1230
T 2059/13 - 3.3.01 07.12.15	331, 348
T 2111/13 - 3.2.05 22.07.14	1210
T 2191/13 - 3.3.09 16.10.15	121
T 2246/13 - 3.2.05 16.09.14	520, 1193
T 2249/13 - 3.5.01 17.10.14	222, 915
T 2317/13 - 3.3.04 14.04.14	642, 644
T 2352/13 - 3.2.01 04.03.14	536, 752, 1207
T 2415/13 - 3.3.09 06.10.15	1041
T 2451/13 - 3.3.09 14.01.16	655, 683-685, 688
<b>2014</b>	
T 13/14 - 3.3.02 15.10.15	139, 512
T 15/14 - 3.3.02 06.10.15	512
T 77/14 - 3.5.05 30.06.15	209, 210
T 81/14 - 3.2.08 12.03.15	262, 299
T 107/14 - 3.2.08 22.09.15	458
T 129/14 - 3.2.02 17.09.14	306, 312, 1196
T 205/14 - 3.3.01 18.06.15	369, 682, 690, 691
T 305/14 - 3.2.08 02.04.14	534, 542
T 336/14 - 3.5.05 02.09.15	15, 204, 209, 211, 213, 216
T 378/14 - 3.5.07 22.05.15	1197
T 517/14 - 3.3.01 19.06.15	370, 659, 682, 691, 693
T 598/14 - 3.5.07 06.11.14	21
T 615/14 - 3.3.09 27.10.15	1017
T 640/14 - 3.4.01 13.03.15	464
T 685/14 - 3.5.06 21.10.14	1195
T 736/14 - 3.5.05 25.02.16	1187
T 755/14 - 3.2.03 21.05.15	326, 832
T 828/14 - 3.2.05 10.06.15	943
T 964/14 - 3.3.05 23.02.15	997
T 977/14 - 3.2.07 22.10.15	974
T 998/14 - 3.2.05 24.06.15	325, 918
T 1022/14 - 3.5.05 03.07.15	631
T 1101/14 - 3.5.06 12.12.14	627
T 1117/14 - 3.2.08 29.09.15	75
T 1245/14 - 3.2.07 24.02.15	1137
T 1410/14 - 3.2.01 14.10.15	87, 666, 687
T 1536/14 - 3.3.04 14.10.15	980
T 1537/14 - 3.3.01 07.10.15	445
T 2001/14 - 3.4.03 16.06.15	1069, 1097-1099, 1108
T 2008/14 - 3.5.07 16.03.15	1207
T 2017/14 - 3.2.07 06.03.15	1141
T 2068/14 - 3.5.06 30.07.15	543, 581, 834, 1179
T 2220/14 - 3.3.08 09.11.15	340
<b>2015</b>	
T 30/15 - 3.2.07 20.01.16	668, 697
T 109/15 - 3.5.04 01.09.15	248
T 177/15 - 3.3.08 07.04.15	755, 757
T 203/15 - 3.4.03 25.01.16	1195, 1197
T 245/15 - 3.2.01 16.10.15	1194
T 740/15 - 3.3.03 10.11.15	558, 974
T 1020/15 - 3.2.07 23.09.15	535, 832
<b>PCT Protests</b>	
W 4/85 - 3.2.01 22.04.86	1987, 63 309
W 7/85 - 3.3.02 05.06.87	1988, 211 307
W 3/87 - 3.4.01 30.09.87	305
W 4/87 - 3.2.02 02.10.87	1988, 425 606
W 2/88 - 3.5.01 10.04.89	305
W 3/88 - 3.3.01 08.11.88	1990, 126 304, 308
W 29/88 - 3.3.01 28.11.88	304
W 31/88 - 3.3.01 09.11.88	1990, 134 312
W 32/88 - 3.4.01 28.11.88	1990, 138 304
W 35/88 - 3.5.01 07.06.89	308
W 44/88 - 3.4.01 31.05.89	1990, 140 308
W 3/89 - 3.3.01 11.04.89	304
W 7/89 - 3.3.01 15.12.89	312
W 11/89 - 3.3.02 09.10.89	1993, 225 312
W 12/89 - 3.3.01 29.06.89	1990, 152 308, 313
W 13/89 - 3.3.02 12.07.90	305
W 14/89 - 3.3.01 26.01.90	312
W 16/89 - 3.4.01 29.11.89	304
W 17/89 - 3.2.02 02.03.91	314, 317
W 19/89 - 3.3.01 14.11.91	315, 326
W 21/89 - 3.4.02 13.06.91	309
W 27/89 - 3.2.02 21.08.90	314
W 30/89 - 3.3.02 07.06.90	305
W 32/89 - 3.4.02 07.08.90	305



W 6/90 - 3.2.02	19.12.90	1991, 438	308, 313, 315-317	W 34/92 - 3.2.02	23.11.93		317
W 18/90 - 3.2.01	17.08.90		314	W 38/92 - 3.3.02	22.10.93		317
W 19/90 - 3.2.01	02.10.90		314	W 40/92 - 3.5.01	01.03.93		305
W 24/90 - 3.2.01	05.10.90		313	W 45/92 - 3.2.02	15.10.93		317
W 26/90 - 3.2.02	09.11.90		305	W 52/92 - 3.3.02	02.04.93		308
W 36/90 - 3.3.01	04.12.90		326	W 3/93 - 3.3.01	21.10.93	1994, 931	606, 639
W 38/90 - 3.2.02	13.03.91		316	W 4/93 - 3.3.01	05.11.93	1994, 939	311
W 39/90 - 3.4.02	12.02.91		307	W 8/93 - 3.2.04	24.03.94		317
W 48/90 - 3.3.01	22.04.91		317	W 9/93 - 3.3.01	14.07.94		318
W 50/90 - 3.3.02	06.05.91		317	W 1/94 - 3.3.01	29.07.94		319
W 59/90 - 3.3.01	21.06.91		312	W 3/94 - 3.3.01	15.12.94	1995, 775	319
W 5/91 - 3.3.02	10.09.91		305	W 8/94 - 3.3.03	21.11.94		312
W 6/91 - 3.3.01	03.04.92		312	W 2/95 - 3.4.01	18.10.95		317, 319
W 8/91 - 3.2.02	26.02.92		305	W 6/95 - 3.3.01	16.07.96		320
W 14/91 - 3.2.04	03.06.91		312	W 1/96 - 3.3.04	22.05.96		308
W 16/91 - 3.3.02	25.11.91		314	W 4/96 - 3.3.02	20.12.96	1997, 552	321
W 17/91 - 3.3.02	08.08.91		312	W 6/96 - 3.3.01	15.04.97		321
W 21/91 - 3.3.02	19.02.92		314	W 1/97 - 3.3.04	15.11.97	1999, 33	313
W 22/91 - 3.2.02	10.02.92		317	W 6/97 - 3.3.01	18.09.97		307, 312, 317, 320
W 23/91 - 3.3.02	08.09.92		305, 313	W 6/98 - 3.4.02	17.12.98		305
W 28/91 - 3.3.02	27.02.92		305	W 11/99 - 3.3.05	20.10.99	2000, 186	318, 319
W 31/91 - 3.3.02	20.12.91		317	W 18/01 - 3.5.02	23.01.02		319
W 35/91 - 3.3.01	28.09.92		307, 319	W 9/02 - 3.2.03	23.09.02		312
W 43/91 - 3.3.03	09.04.92		313	W 9/03 - 3.5.03	22.12.03		316
W 50/91 - 3.2.03	20.07.92		308	W 17/03 - 3.5.01	20.09.04		312, 314
W 52/91 - 3.3.02	19.10.92		308	W 21/04 - 3.2.07	25.05.07		312
W 54/91 - 3.2.01	28.01.92		305	W 34/07 - 3.3.05	21.12.11		321
W 5/92 - 3.5.01	28.02.92		303	W 1/10 - 3.3.07	21.01.11		321
W 10/92 - 3.3.02	30.10.92		314	W 2/10 - 3.3.05	22.12.11		309
W 22/92 - 3.3.02	16.11.92		308				
W 29/92 - 3.2.02	19.10.93		317				
W 32/92 - 3.2.02	15.10.92	1994, 239	316, 317				
W 33/92 - 3.3.01	12.08.92		307				



## INDEX OF CITED PROVISIONS

### 1. European Patent Convention

#### EPC 2000 – articles

Art. 2(2) EPC	597
Art. 4(2) EPC	1269
Art. 4(3) EPC	1228, 1269
Art. 10 EPC	1269
Art. 10(1) EPC	1276
Art. 10(2) EPC	581, 828
Art. 10(2)(a) EPC	732, 828, 1276
Art. 10(2)(f) EPC	738-740
Art. 10(3) EPC	738-740
Art. 11(5) EPC	1217, 1245
Art. 14 EPC	646, 848
Art. 14(1) EPC	646
Art. 14(2) EPC	404, 646
Art. 14(3) EPC	647, 655, 1268
Art. 14(4) EPC	522, 646, 649, 651, 777, 1026
Art. 15 EPC	1269
Art. 16 EPC	836, 837
Art. 17 EPC	836
Art. 18 EPC	837
Art. 18(2) EPC	744
Art. 19(2) EPC	727, 744-747, 1177, 1200
Art. 20 EPC	771
Art. 21 EPC	1074, 1265, 1269
Art. 21(1) EPC	766, 1269
Art. 21(2) EPC	771
Art. 21(3) EPC	1075
Art. 21(3)(a) EPC	1075
Art. 21(3)(c) EPC	1075
Art. 21(4)(a) EPC	1228
Art. 22(2) EPC	1217
Art. 23 EPC	739, 740, 1269, 1270
Art. 23(1) EPC	1216, 1245, 1246
Art. 23(3) EPC	710, 739, 829, 1269
Art. 23(4) EPC	1273

Art. 24 EPC	723, 726, 727, 730, 735, 737-739, 1217, 1227, 1234
Art. 24(1) EPC	723, 729, 734, 735, 1234
Art. 24(2) EPC	1244
Art. 24(3) EPC	723, 725, 727-731, 734-736
Art. 24(4) EPC	723, 727, 729, 1235
Art. 33 EPC	1269
Art. 33(1)(b) EPC	714
Art. 33(4) EPC	1274
Art. 51(4) EPC	792
Art. 52 EPC	2, 12, 198, 202, 255, 262, 776, 979, 1030
Art. 52(1) EPC	2-4, 9, 10, 12, 16, 21, 22, 27, 28, 199, 202-204, 207, 212, 223, 254, 1030
Art. 52(2) EPC	2, 7-12, 14-16, 19-23, 25-27, 199, 200, 202, 204, 205, 207, 218, 222, 223, 254, 1030, 1223, 1225
Art. 52(2)(a) EPC	12
Art. 52(2)(b) EPC	15
Art. 52(2)(c) EPC	16, 27, 28, 31, 198, 217
Art. 52(2)(d) EPC	12, 15, 32-34, 204, 211, 216-220
Art. 52(3) EPC	2, 7, 9-12, 14, 16, 21-23, 26-28, 31, 200, 202, 204, 207, 222, 223
Art. 52(4) EPC	62, 144
Art. 53 EPC	36, 254
Art. 53(a) EPC	36-41, 43, 45, 432, 436

Index of cited provisions

Art. 53(b) EPC	37, 43, 44, 46-50, 708-710, 714	Art. 61 EPC	369, 791, 837
Art. 53(c) EPC	36, 37, 51-63, 65, 69, 134, 135, 137, 140, 143, 145, 147, 148, 254, 273, 274, 434	Art. 61(1) EPC	773, 837
Art. 54 EPC	69, 73, 103, 121, 140, 402, 427, 691, 857, 1030	Art. 61(1)(b) EPC	837
Art. 54(1) EPC	69, 113, 142, 1023	Art. 64 EPC	262, 504, 1007
Art. 54(2) EPC	69, 70, 74, 78, 81-83, 86, 145, 160, 161, 171, 360, 367, 389, 675, 688-690, 700, 1023, 1197	Art. 64(2) EPC	151, 152, 296, 472
Art. 54(3) EPC	69-72, 108, 142, 160, 367, 395-397, 428, 435, 493, 888, 1023	Art. 67(4) EPC	504
Art. 54(4) EPC	69, 135-138, 143, 146, 349	Art. 68 EPC	974, 979, 980, 1007
Art. 54(5) EPC	69, 137-140, 142-146, 348, 349, 475, 511, 512	Art. 69 EPC	262, 289, 290, 460, 461, 464, 704, 1045, 1046
Art. 55 EPC	73	Art. 69(1) EPC	287, 290, 291, 460, 461, 466, 483
Art. 55(1)(a) EPC	691	Art. 72 EPC	369, 772
Art. 56 EPC	21, 27, 160-162, 174, 177, 185, 198, 200, 202-204, 206, 212, 213, 223, 243, 330, 362, 407, 756, 871, 1225	Art. 74 EPC	597
Art. 57 EPC	198, 254, 255, 257, 258, 262, 776, 979, 1030	Art. 75 EPC	837
Art. 58 EPC	837, 1012	Art. 75(1) EPC	838
Art. 59 EPC	837, 1077	Art. 75(1)(b) EPC	514
Art. 60 EPC	504, 508, 510	Art. 76 EPC	492, 494
Art. 60(1) EPC	837	Art. 76(1) EPC	396, 405, 407, 428, 438, 443, 453, 459, 462, 476, 492-498, 500, 508, 837, 848
Art. 60(3) EPC	837, 840	Art. 76(2) EPC	506, 853
		Art. 78 EPC	849
		Art. 78(1) EPC	849, 850
		Art. 78(1)(c) EPC	890
		Art. 78(2) EPC	850
		Art. 79 EPC	852
		Art. 79(1) EPC	604, 851, 853
		Art. 79(2) EPC	851, 852
		Art. 79(3) EPC	851, 853
		Art. 80 EPC	836, 838, 843, 848
		Art. 81 EPC	849, 850
		Art. 82 EPC	302, 303, 306, 307, 309, 310, 314, 918, 925

Art. 83 EPC	114, 161, 177, 257, 263, 271, 273, 284, 285, 328-331, 334, 336-339, 341-343, 346-349, 351, 354, 356, 358-360, 362, 364, 537, 588, 684, 697, 701, 702, 1036, 1046, 1104	Art. 90(5) EPC	801, 849, 1067
Art. 84 EPC	161, 177, 262, 263, 268, 270-274, 277, 278, 281, 283-287, 289, 291, 294, 328-330, 336, 341, 356, 358-360, 362, 434, 435, 551, 834, 913, 979, 1019, 1045-1049, 1124, 1179, 1211, 1241	Art. 92 EPC	920-922
Art. 87 EPC	367, 369, 372, 391, 402, 427, 592	Art. 92(1) EPC	922
Art. 87(1) EPC	367, 368, 377, 378, 387, 389, 391, 605, 606	Art. 93 EPC	69, 333, 768, 859
Art. 87(2) EPC	367	Art. 93(1) EPC	768
Art. 87(3) EPC	373	Art. 93(1)(b) EPC	850, 858
Art. 87(4) EPC	377, 387, 389, 690	Art. 93(2) EPC	887
Art. 88 EPC	369, 849, 855	Art. 94 EPC	836, 876
Art. 88(2) EPC	393, 396	Art. 94(1) EPC	863
Art. 88(3) EPC	394, 395	Art. 94(2) EPC	863
Art. 88(4) EPC	373-375	Art. 94(3) EPC	505, 542, 716, 865, 867, 868, 871, 878, 1149, 1193
Art. 89 EPC	367	Art. 94(4) EPC	505, 596, 878
Art. 90 EPC	842, 843	Art. 97 EPC	876
Art. 90(1) EPC	836, 838	Art. 97(1) EPC	878, 887, 901
Art. 90(2) EPC	838, 842	Art. 97(2) EPC	879, 880, 890, 909, 910, 918, 926, 927
Art. 90(3) EPC	836, 848, 849, 851	Art. 97(3) EPC	748, 910, 912
Art. 90(4) EPC	849, 851	Art. 98 EPC	911
		Art. 99 EPC	1006, 1012, 1019
		Art. 99(1) EPC	603, 692, 781, 782, 1006, 1008, 1010-1012, 1014, 1020, 1029, 1032
		Art. 99(3) EPC	819, 1008, 1012, 1083
		Art. 100 EPC	100, 489, 498, 684, 700, 702, 980, 1007, 1010, 1018, 1019, 1028, 1030, 1038, 1040, 1045, 1046, 1048-1050, 1127
		Art. 100(a) EPC	367, 888, 1019, 1023, 1030, 1054, 1103
		Art. 100(b) EPC	257, 334, 337, 343, 364, 1030, 1033, 1104

## Index of cited provisions

Art. 100(c) EPC	403, 428, 458, 480, 487, 490, 492, 495, 496, 1022, 1030, 1032, 1033, 1083, 1097, 1146	Art. 108 EPC	524, 592, 603, 635, 638, 639, 750, 958, 972, 1069, 1070, 1086-1090, 1095-1097, 1099, 1100, 1102, 1105, 1106, 1108
Art. 101 EPC	1018, 1028, 1042, 1205	Art. 109 EPC	639, 1070, 1072, 1110, 1206, 1212
Art. 101(1) EPC	1029, 1036, 1050-1052	Art. 109(1) EPC	639, 1109, 1110, 1151, 1209, 1256
Art. 101(2) EPC	1046, 1057	Art. 109(2) EPC	1213, 1256
Art. 101(3) EPC	263, 497, 1019, 1033, 1047, 1048	Art. 110 EPC	758, 1070, 1166
Art. 101(3)(a) EPC	311, 496, 1033, 1046, 1047, 1057	Art. 111 EPC	747, 1065, 1070, 1118
Art. 101(3)(b) EPC	496	Art. 111(1) EPC	639, 862, 1170, 1171, 1173, 1177, 1184
Art. 102 EPC	1018	Art. 111(2) EPC	1182, 1183
Art. 104 EPC	562, 569, 589, 981, 982, 1003	Art. 112 EPC	737, 1216, 1217, 1221, 1222, 1224, 1225, 1229, 1239
Art. 104(1) EPC	981, 982, 1002	Art. 112(1)(a) EPC	468, 1217, 1218, 1220, 1221
Art. 104(2) EPC	981	Art. 112(1)(b) EPC	26, 1217, 1222, 1223
Art. 104(3) EPC	1002	Art. 112(2) EPC	1218
Art. 105 EPC	967, 968, 970, 971, 1006, 1083, 1276	Art. 112(3) EPC	1218, 1225
Art. 105(1) EPC	967	Art. 112a EPC	514, 531, 533, 536, 737, 738, 1074, 1109, 1185, 1216, 1218, 1226, 1228, 1230, 1233, 1234
Art. 105(1)(a) EPC	968, 1276	Art. 112a(1) EPC	1229
Art. 105(1)(b) EPC	969	Art. 112a(2) EPC	821, 1074, 1226, 1227
Art. 105(2) EPC	967, 971	Art. 112a(2)(a) EPC	702, 723, 735, 738, 1226, 1227, 1229, 1230, 1234, 1235, 1242
Art. 105a EPC	974, 979, 1010, 1038	Art. 112a(2)(b) EPC	1235
Art. 105a(2) EPC	979	Art. 112a(2)(c) EPC	531, 535, 1226-1228, 1235, 1241-1243
Art. 105b(3) EPC	979		
Art. 105c EPC	979, 1010		
Art. 106 EPC	750, 1065, 1067, 1070, 1072, 1078, 1265, 1275		
Art. 106(1) EPC	771, 916, 1066, 1070, 1074		
Art. 106(2) EPC	596, 720, 1056, 1058, 1067, 1073		
Art. 107 EPC	767, 810, 972, 1008, 1070, 1072, 1076, 1078, 1079, 1083, 1084, 1089, 1091, 1122		

Art. 112a(2)(d) EPC	531, 558, 1226-1230, 1242, 1243	Art. 114(2) EPC	539, 578, 666, 667, 670, 762, 781, 782, 930, 931, 935, 936, 938, 950, 951, 954, 957, 1035, 1036, 1051, 1104, 1126
Art. 112a(2)(e) EPC	702, 1227, 1244	Art. 115 EPC	776-778, 780-784, 810, 968, 1018, 1029, 1042
Art. 112a(3) EPC	1074, 1226	Art. 115(1) EPC	777
Art. 112a(4) EPC	592, 606, 1232, 1244	Art. 116 EPC	543, 558, 562, 583, 588, 1055, 1192, 1233, 1242
Art. 112a(5) EPC	1244	Art. 116(1) EPC	542, 558-560, 563, 564, 899, 1213, 1242
Art. 113 EPC	531, 532, 547, 548, 551, 1037, 1050, 1051, 1053, 1139, 1196, 1227, 1228, 1230, 1235	Art. 116(2) EPC	560
Art. 113(1) EPC	531-539, 541-545, 548, 549, 551, 552, 560, 567, 583, 588, 654, 669, 671, 673, 675, 752, 758, 867, 879-884, 899, 934, 948, 1035-1037, 1050, 1051, 1053-1055, 1137, 1173, 1195, 1211, 1234-1238, 1240-1243, 1260	Art. 116(3) EPC	581
Art. 113(2) EPC	165, 531, 552, 553, 555, 890, 892, 979, 1137, 1155, 1195, 1235, 1240	Art. 116(4) EPC	581, 588
Art. 114 EPC	667, 930, 935, 1018, 1025, 1042, 1045, 1107, 1124, 1139, 1227, 1228	Art. 117 EPC	369, 654, 655, 658, 661, 664, 690
Art. 114(1) EPC	532, 543, 779, 781, 782, 930, 931, 942, 1007, 1012, 1025, 1028-1030, 1033, 1036, 1124, 1167	Art. 117(1) EPC	538, 539, 654, 656, 657, 659, 661-664, 671, 675, 982
		Art. 117(1)(c) EPC	538, 654, 663, 664, 671
		Art. 117(1)(d) EPC	657, 659
		Art. 117(1)(e) EPC	659, 660, 669
		Art. 117(1)(g) EPC	657, 660, 662
		Art. 117(2) EPC	654
		Art. 118 EPC	807
		Art. 119 EPC	785
		Art. 121 EPC	595, 596, 602, 605, 852
		Art. 121(1) EPC	595
		Art. 121(4) EPC	595, 605
		Art. 122 EPC	602-604, 606, 612, 613, 626, 644
		Art. 122(1) EPC	603, 604, 606, 608, 612, 615, 626
		Art. 122(3) EPC	602, 645

## Index of cited provisions

Art. 122(4) EPC	603, 605	Art. 133(1) EPC	800
Art. 122(5) EPC	642	Art. 133(2) EPC	610, 800, 801, 1067
Art. 123 EPC	70, 402, 427, 482, 485, 488, 694, 764, 867, 1040, 1045, 1046, 1057, 1153, 1202	Art. 133(3) EPC	798, 1251
Art. 123(1) EPC	401, 862, 867, 872, 876, 895, 1148	Art. 133(4) EPC	610, 1012
Art. 123(2) EPC	292, 328, 390, 401, 404-408, 413, 414, 417, 419-429, 432, 433, 436, 438-440, 442-444, 446, 448, 449, 456-459, 462, 466, 475, 477-483, 489, 490, 492, 493, 495-497, 546, 650, 829, 842, 950, 979, 1032, 1033, 1043, 1141, 1147, 1148, 1211, 1225	Art. 134 EPC	799, 823
Art. 123(3) EPC	290, 401, 404, 449, 459-462, 464-470, 472, 475-483, 489, 490, 549, 695, 979, 1038, 1043, 1046, 1117	Art. 134(1) EPC	799, 800, 803, 804, 1247
Art. 125 EPC	508, 509, 512, 531, 616, 693, 704, 910, 1260	Art. 134(2) EPC	799, 1247
Art. 127 EPC	771, 906	Art. 134(2)(c) EPC	1248, 1249
Art. 128 EPC	768, 776	Art. 134(3) EPC	799, 801, 1249
Art. 128(1) EPC	768	Art. 134(4) EPC	804
Art. 128(2) EPC	768	Art. 134(8) EPC	799, 803-805, 822, 1247, 1250
Art. 128(3) EPC	768	Art. 134a EPC	1247
Art. 128(4) EPC	768-770, 777	Art. 134a(1)(c) EPC	1260
Art. 129(a) EPC	906	Art. 134a(2) EPC	1248
Art. 131(2) EPC	654	Art. 135(1)(a) EPC	839
Art. 133 EPC	799, 814, 823, 849	Art. 136(2) EPC	839
		Art. 138 EPC	1007
		Art. 138(1)(a) EPC	888
		Art. 138(1)(c) EPC	492
		Art. 139(3) EPC	508, 512
		Art. 150 EPC	1265
		Art. 150(2) EPC	704, 1265
		Art. 153 EPC	1265
		Art. 153(2) EPC	650, 1265, 1267
		Art. 153(3) EPC	72, 73
		Art. 153(4) EPC	72, 73
		Art. 153(5) EPC	72, 73
		Art. 164(2) EPC	704, 714
		Art. 177 EPC	704, 715
		Art. 177(1) EPC	730
		Part IV EPC	322
		<b>EPC 1973 – articles</b>	
		Art. 1 EPC 1973	712
		Art. 2(1) EPC 1973	1276
		Art. 2(2) EPC 1973	712
		Art. 9 EPC 1973	1268
		Art. 10 EPC 1973	1193
		Art. 10(1) EPC 1973	581
		Art. 10(2)(a) EPC 1973	581
		Art. 10(2)(b) EPC 1973	581
		Art. 14 EPC 1973	650, 651, 838



Art. 14(1) EPC 1973	646, 648, 651, 839, 1252	Art. 52(2) EPC 1973	3-11, 13-18, 27-30, 32-34, 193, 198-201, 205-207, 214, 255, 711, 1018
Art. 14(2) EPC 1973	404, 646, 650-652, 839	Art. 52(2)(a) EPC 1973	29
Art. 14(4) EPC 1973	649, 650, 652, 1025, 1094	Art. 52(2)(b) EPC 1973	14, 15
Art. 14(5) EPC 1973	649, 1025, 1094, 1189	Art. 52(2)(c) EPC 1973	7, 9, 14-17, 20, 22, 28-31, 205, 255, 706
Art. 15 EPC 1973	1193	Art. 52(2)(d) EPC 1973	15, 30, 32-34
Art. 16 EPC 1973	836, 847	Art. 52(3) EPC 1973	3-8, 11, 13-18, 20, 22, 27-32, 34, 198, 199, 201, 205-207, 255, 706, 711
Art. 18 EPC 1973	847	Art. 52(4) EPC 1973	36, 37, 51-53, 56, 58, 60, 62-65, 69, 135, 138, 140, 143, 147, 156, 254, 273, 274, 474, 1018
Art. 18(2) EPC 1973	887	Art. 53 EPC 1973	1018
Art. 19(2) EPC 1973	726, 734, 746, 747, 1200	Art. 53(a) EPC 1973	37, 41, 42
Art. 20(1) EPC 1973	640	Art. 53(b) EPC 1973	36, 43-45, 50, 707
Art. 21 EPC 1973	414, 559, 1074, 1207, 1271	Art. 54 EPC 1973	72, 91, 111, 126, 127, 140, 149, 164, 195, 413, 479, 1018
Art. 21(1) EPC 1973	1072	Art. 54(1) EPC 1973	4, 10, 146, 148, 155
Art. 21(3) EPC 1973	1074, 1075	Art. 54(2) EPC 1973	74, 75, 77, 81, 83, 84, 89-91, 97, 102, 105, 109, 125, 131, 148, 149, 164, 170, 172, 189, 388, 390, 392, 426, 431, 436, 686, 841, 858
Art. 21(3)(a) EPC 1973	766, 1074	Art. 54(3) EPC 1973	69, 71-73, 102, 103, 109, 379, 382, 388, 390, 426, 431, 436, 437, 841, 857
Art. 21(3)(b) EPC 1973	1074	Art. 54(4) EPC 1973	69-71, 388, 426, 436, 437
Art. 21(3)(c) EPC 1973	1074, 1075		
Art. 21(4) EPC 1973	1074		
Art. 21(4)(b) EPC 1973	1072		
Art. 23(1) EPC 1973	1271		
Art. 23(3) EPC 1973	713, 1086, 1271		
Art. 23(4) EPC 1973	577, 1274		
Art. 24 EPC 1973	724, 730, 734, 1271		
Art. 24(1) EPC 1973	726, 730, 733, 735		
Art. 24(2) EPC 1973	727		
Art. 24(3) EPC 1973	730, 736		
Art. 24(4) EPC 1973	728, 730, 731		
Art. 25 EPC 1973	1071		
Art. 33(1)(b) EPC 1973	1274		
Art. 52 EPC 1973	3, 126, 212, 426, 434, 479, 869, 1018		
Art. 52(1) EPC 1973	3-11, 18, 22, 28-31, 179, 198, 199, 201, 254, 255, 296, 903, 1018, 1030		

Index of cited provisions

Art. 54(5) EPC 1973	69, 135-137	Art. 79 EPC 1973	1276
Art. 55(1) EPC 1973	73, 74, 707	Art. 79(1) EPC 1973	604
Art. 55(1)(a) EPC 1973	73	Art. 79(2) EPC 1973	506, 852, 853
Art. 56 EPC 1973	4, 10, 160, 161, 173, 177, 181, 189, 190, 195, 199, 204, 207, 231, 347, 479, 1018, 1080, 1122	Art. 80 EPC 1973	519, 838, 839, 841, 842, 846, 850
Art. 57 EPC 1973	3, 4, 10, 58, 254-258, 426, 434, 1018	Art. 80(c) EPC 1973	840
Art. 60 EPC 1973	510	Art. 80(d) EPC 1973	646, 647, 838
Art. 60(3) EPC 1973	369, 599, 641	Art. 81 EPC 1973	836
Art. 61 EPC 1973	499, 791, 840	Art. 82 EPC 1973	177, 304-306, 310, 311, 316, 318, 320, 926
Art. 61(1) EPC 1973	774, 791	Art. 83 EPC 1973	113, 160, 195, 258, 273, 329, 332, 333, 336, 338, 341, 344, 345, 347, 348, 350, 352, 354-362, 386, 714
Art. 61(1)(b) EPC 1973	791	Art. 84 EPC 1973	55, 63, 64, 160, 161, 262, 265, 269-278, 280-282, 284-286, 289, 291, 294, 295, 300, 341, 347, 356-362, 411, 426, 433, 434, 447, 462, 1038, 1123, 1124, 1183, 1197
Art. 63(1) EPC 1973	841	Art. 86 EPC 1973	600
Art. 64 EPC 1973	116	Art. 86(2) EPC 1973	595
Art. 64(1) EPC 1973	471, 841, 911, 1084	Art. 87 EPC 1973	267, 369, 373, 386, 711
Art. 64(2) EPC 1973	44, 151, 296, 300, 471, 473	Art. 87(1) EPC 1973	368, 370-373, 380, 381, 385, 388-390, 394, 605
Art. 65 EPC 1973	1262	Art. 87(4) EPC 1973	372, 388-390
Art. 66 EPC 1973	712	Art. 88 EPC 1973	372
Art. 67(4) EPC 1973	506, 507, 852	Art. 88(1) EPC 1973	390
Art. 68 EPC 1973	980	Art. 88(2) EPC 1973	371, 380, 391, 393, 394
Art. 69 EPC 1973	116, 286, 290, 292-295, 339, 357, 460, 462, 471, 1123	Art. 88(3) EPC 1973	371, 392, 394
Art. 69(1) EPC 1973	290, 291, 293, 295, 462, 463, 465, 471	Art. 88(4) EPC 1973	374, 380, 392
Art. 70(2) EPC 1973	404	Art. 89 EPC 1973	368
Art. 72 EPC 1973	368, 369, 690	Art. 90 EPC 1973	836, 847
Art. 75 EPC 1973	652	Art. 90(1)(a) EPC 1973	841
Art. 75(1)(b) EPC 1973	838, 839		
Art. 76 EPC 1973	494, 497, 499		
Art. 76(1) EPC 1973	371, 412, 443, 450, 493-495, 500		
Art. 76(2) EPC 1973	506, 507, 852		
Art. 77(2) EPC 1973	839		
Art. 77(5) EPC 1973	603, 839		
Art. 78(1)(c) EPC 1973	831, 890		
Art. 78(2) EPC 1973	506, 592, 850		
Art. 78(3) EPC 1973	909		

Art. 90(2) EPC 1973	841, 842	Art. 100(b) EPC 1973	271, 357, 547, 1018, 1022, 1023, 1199
Art. 90(3) EPC 1973	646	Art. 100(c) EPC 1973	409, 411, 417, 476, 495, 496, 941, 967, 984, 1018, 1175, 1197
Art. 91 EPC 1973	836, 847	Art. 101 EPC 1973	781, 1028, 1042
Art. 91(2) EPC 1973	606	Art. 101(1) EPC 1973	1042
Art. 91(3) EPC 1973	836	Art. 101(2) EPC 1973	1036, 1042, 1050-1052, 1080, 1205
Art. 91(4) EPC 1973	507	Art. 102 EPC 1973	781, 1028, 1042
Art. 92 EPC 1973	310, 652	Art. 102(1) EPC 1973	753, 1042, 1046, 1057, 1181
Art. 92(1) EPC 1973	921	Art. 102(2) EPC 1973	1046
Art. 93 EPC 1973	859	Art. 102(3) EPC 1973	311, 1033, 1042, 1046, 1047, 1057
Art. 93(1) EPC 1973	413	Art. 102(3)(a) EPC 1973	1057
Art. 94 EPC 1973	863, 864	Art. 102(3)(b) EPC 1973	1057
Art. 94(1) EPC 1973	652, 837, 863	Art. 102(4) EPC 1973	607, 1056, 1072
Art. 94(2) EPC 1973	600, 651, 652, 863	Art. 102(5) EPC 1973	607, 1056, 1072
Art. 94(3) EPC 1973	863	Art. 104 EPC 1973	989
Art. 96 EPC 1973	893	Art. 104(1) EPC 1973	982, 990, 991, 994, 996, 1183
Art. 96(1) EPC 1973	847, 864	Art. 104(2) EPC 1973	1003, 1183
Art. 96(2) EPC 1973	505, 538, 541, 542, 640, 716, 719, 758, 833, 837, 867, 869-872, 874-876, 879, 881, 883-885, 900, 1071	Art. 105 EPC 1973	968-971
Art. 96(3) EPC 1973	505, 541, 596, 878, 879	Art. 105(1) EPC 1973	971
Art. 97 EPC 1973	765, 893, 909, 1101	Art. 106 EPC 1973	750, 836, 1074, 1082, 1276
Art. 97(1) EPC 1973	554, 720, 837, 879, 889, 893, 898, 909, 910, 923, 1204, 1208	Art. 106(1) EPC 1973	749, 760, 774, 870, 1067, 1081, 1091, 1103, 1188, 1189, 1203, 1275
Art. 97(2) EPC 1973	644, 837, 893, 911	Art. 106(3) EPC 1973	596, 720, 909, 1056, 1058, 1071, 1073
Art. 97(2)(a) EPC 1973	888-890, 893, 1079	Art. 106(4) EPC 1973	1003, 1004
Art. 97(4) EPC 1973	488, 773, 910-912	Art. 107 EPC 1973	819, 888, 971, 1000, 1070, 1079-1085, 1112, 1115, 1119
Art. 97(6) EPC 1973	911		
Art. 98 EPC 1973	765, 911		
Art. 99 EPC 1973	971, 972		
Art. 99(1) EPC 1973	782, 911, 1009, 1015, 1020, 1028		
Art. 99(3) EPC 1973	1007		
Art. 99(4) EPC 1973	819, 1008		
Art. 100 EPC 1973	973, 1008, 1114		
Art. 100(a) EPC 1973	547, 941, 1018		

Index of cited provisions

Art. 108 EPC 1973	521, 523, 613, 614, 626, 630, 643, 717, 748, 794, 970, 989, 1086, 1087, 1091, 1094, 1096, 1104, 1126, 1169, 1188, 1189	Art. 114(1) EPC 1973	545, 580, 594, 777, 782, 934, 938, 939, 944, 1066, 1124-1126, 1167, 1172, 1173
Art. 109 EPC 1973	503, 553, 747, 891, 1091, 1111, 1192, 1209	Art. 114(2) EPC 1973	574, 578, 583, 782, 933, 936, 938, 939, 941, 942, 952, 953, 955, 956, 983, 1051, 1122, 1124, 1165
Art. 109(1) EPC 1973	743, 1074, 1110, 1206, 1208	Art. 115 EPC 1973	779-784, 1084
Art. 109(2) EPC 1973	1109, 1111, 1208	Art. 116 EPC 1973	552, 580, 581, 815, 816, 885-887
Art. 110(1) EPC 1973	777	Art. 116(1) EPC 1973	559, 563, 564, 994
Art. 110(2) EPC 1973	517, 716, 858, 1067	Art. 116(2) EPC 1973	560
Art. 110(3) EPC 1973	858, 878, 1067	Art. 117 EPC 1973	668, 826, 827
Art. 111 EPC 1973	1070, 1182, 1203	Art. 117(1) EPC 1973	370
Art. 111(1) EPC 1973	560, 639, 767, 901, 939, 980, 990, 1003, 1170, 1176, 1178-1184, 1272	Art. 117(2) EPC 1973	654
Art. 111(2) EPC 1973	901, 1183, 1184, 1186, 1200	Art. 117(6) EPC 1973	654
Art. 112 EPC 1973	308, 1204, 1225	Art. 118 EPC 1973	712
Art. 113 EPC 1973	535, 545, 640, 1181	Art. 120 EPC 1973	593
Art. 113(1) EPC 1973	534, 538, 540, 541, 544-547, 550, 552, 559, 641, 672, 719, 818, 868, 870-872, 875, 879-885, 952, 955, 1003, 1052, 1072, 1173, 1175, 1183	Art. 121 EPC 1973	596, 1267
Art. 113(2) EPC 1973	554, 555, 716, 719, 721, 831, 876, 880, 889-893, 897, 1057, 1080, 1208	Art. 121(2) EPC 1973	505, 596, 1267
Art. 114 EPC 1973	781, 978	Art. 122 EPC 1973	501-503, 515, 604, 606, 625, 626, 638, 641, 643, 854, 1267
		Art. 122(1) EPC 1973	604, 626, 641, 643
		Art. 122(2) EPC 1973	522, 523, 527, 606, 607, 610-612, 614-616, 641, 645, 684
		Art. 122(3) EPC 1973	614-616, 684
		Art. 122(4) EPC 1973	638-640
		Art. 122(5) EPC 1973	605, 854
		Art. 122(6) EPC 1973	642, 905
		Art. 123 EPC 1973	405, 478, 578, 1168
		Art. 123(1) EPC 1973	926

Art. 123(2) EPC 1973	178, 179, 237, 267, 298, 330, 373, 379, 402-404, 406-417, 421, 426, 436, 437, 440-443, 445-452, 454, 456-458, 463, 464, 470, 475-480, 482, 486, 489, 490, 493, 845, 846, 903, 999, 1041, 1047, 1114, 1123, 1183
Art. 123(3) EPC 1973	295, 299, 300, 412, 450, 451, 459, 460, 462-465, 467, 470, 471, 473-478, 549, 1041, 1047, 1116, 1134, 1156
Art. 125 EPC 1973	510, 575, 693, 882, 1255
Art. 127 EPC 1973	771, 836
Art. 128(2) EPC 1973	575
Art. 128(4) EPC 1973	769
Art. 133 EPC 1973	812, 816, 826
Art. 133(2) EPC 1973	598, 599, 801, 803
Art. 133(3) EPC 1973	802, 820, 1076
Art. 133(4) EPC 1973	806
Art. 134 EPC 1973	598, 599, 802, 813, 820, 826, 1010
Art. 134(1) EPC 1973	629, 802, 805, 815
Art. 134(2) EPC 1973	804
Art. 134(4) EPC 1973	804
Art. 134(7) EPC 1973	802-806, 815, 1247, 1250
Art. 134(8) EPC 1973	1247
Art. 134(8)(c) EPC 1973	1260
Art. 138(1) EPC 1973	72
Art. 138(1)(a) EPC 1973	72
Art. 139 EPC 1973	72

Art. 141 EPC 1973	1262
Art. 150(3) EPC 1973	650, 1267
Art. 153 EPC 1973	1266
Art. 153(1) EPC 1973	1267
Art. 153(2) EPC 1973	1267
Art. 154(3) EPC 1973	302, 1265
Art. 155(3) EPC 1973	302, 1265
Art. 158(1) EPC 1973	73
Art. 158(2) EPC 1973	72, 73, 650
Art. 158(3) EPC 1973	73
Art. 163 EPC 1973	799, 801
Art. 163(1) EPC 1973	801
Art. 163(5) EPC 1973	801
Art. 163(6) EPC 1973	801, 802
Art. 164(2) EPC 1973	650, 713, 792, 1081, 1274
Art. 167(2) EPC 1973	899
Art. 167(2)(a) EPC 1973	1040
Art. 177(1) EPC 1973	615

## 2. Implementing Regulations to the EPC

### EPC 2000 – rules

R. 2 EPC	692, 785, 837
R. 2(1) EPC	785, 837, 1086
R. 3 EPC	646, 1012
R. 3(1) EPC	647, 650
R. 3(3) EPC	655, 777
R. 4 EPC	588, 648, 655
R. 4(1) EPC	590, 647-649, 730
R. 4(5) EPC	647, 648
R. 6(1) EPC	646
R. 6(2) EPC	649
R. 6(3) EPC	646, 651, 796
R. 6(7) EPC	646, 651
R. 7 EPC	646, 650
R. 10 EPC	836
R. 11(2) EPC	742
R. 11(3) EPC	865, 1026
R. 12(3) EPC	1273
R. 13(2) EPC	1273
R. 14 EPC	499, 774
R. 14(1) EPC	499, 772, 773, 775, 791
R. 14(3) EPC	775

Index of cited provisions

R. 16 EPC	791	R. 42(1)(b) EPC	433, 446, 447
R. 17 EPC	791	R. 42(1)(c) EPC	161, 172, 310
R. 19 EPC	850	R. 42(1)(e) EPC	334
R. 19(1) EPC	850	R. 42(1)(f) EPC	258
R. 22 EPC	772, 958, 1229	R. 43 EPC	262-265
R. 22(3) EPC	499, 641, 959, 960	R. 43(1) EPC	262-264, 433
R. 26 EPC	38	R. 43(1)(a) EPC	264
R. 26(1) EPC	43, 710	R. 43(1)(b) EPC	264
R. 26(2)(c) EPC	1015	R. 43(2) EPC	265, 266, 268, 1044, 1045
R. 26(4) EPC	44	R. 43(3) EPC	268, 269, 282, 329
R. 26(4)(a) EPC	44	R. 43(4) EPC	268, 269, 1049
R. 26(5) EPC	46, 710, 714	R. 43(5) EPC	268
R. 26(6) EPC	50	R. 43(6) EPC	269
R. 27(c) EPC	47, 48	R. 44 EPC	303, 307, 314
R. 28 EPC	37, 38, 40	R. 44(1) EPC	302, 303, 316, 318, 319, 924
R. 28(c) EPC	38-40, 432, 436, 708, 1273	R. 44(2) EPC	319
R. 28(d) EPC	39-41	R. 45 EPC	898, 914
R. 29 EPC	38	R. 45(3) EPC	903
R. 29(2) EPC	38	R. 46 EPC	851
R. 30 EPC	353, 354	R. 49 EPC	851
R. 30(1) EPC	353	R. 49(1) EPC	851
R. 30(3) EPC	353	R. 49(2) EPC	851
R. 31 EPC	354, 355	R. 49(9) EPC	851
R. 31(1) EPC	354	R. 49(12) EPC	851
R. 31(1)(a) EPC	354	R. 50(3) EPC	778, 1013, 1017, 1026, 1087
R. 32 EPC	354	R. 51(1) EPC	795
R. 33 EPC	354	R. 51(2) EPC	595
R. 34 EPC	354	R. 51(3) EPC	793, 868
R. 36 EPC	492, 499, 501, 1219	R. 51(4) EPC	893
R. 36(1) EPC	492, 501-504, 604	R. 52 EPC	369
R. 36(2) EPC	501, 646	R. 52(2) EPC	855, 858
R. 36(3) EPC	323, 508	R. 52(3) EPC	855, 858
R. 36(4) EPC	506	R. 52(4) EPC	858
R. 38 EPC	592	R. 53 EPC	369, 855
R. 39 EPC	852	R. 53(1) EPC	690
R. 39(2) EPC	506, 507, 852	R. 55(c) EPC	1022, 1032, 1033
R. 40 EPC	836, 838	R. 56 EPC	842-845, 848
R. 40(1) EPC	843	R. 56(1) EPC	842-845
R. 40(1)(b) EPC	840	R. 56(3) EPC	843
R. 40(1)(c) EPC	646	R. 57(a) EPC	646
R. 40(3) EPC	646	R. 58 EPC	596, 646
R. 41 EPC	1088	R. 58(4) EPC	759
R. 41(2)(c) EPC	1008, 1015, 1089	R. 59 EPC	596
R. 41(2)(h) EPC	1093		

R. 60(1) EPC	850, 851	R. 76(2)(c) EPC	781, 931, 934, 972, 1014, 1017-1025, 1027, 1028, 1032, 1033, 1046, 1119
R. 62a EPC	918	R. 77 EPC	967, 1016, 1018
R. 62a(2) EPC	917	R. 77(1) EPC	1008, 1010, 1013, 1017, 1019, 1026, 1027
R. 63 EPC	913-915, 918, 1124, 1158	R. 77(2) EPC	1013, 1017
R. 63(1) EPC	913, 915	R. 79(1) EPC	1007, 1027, 1041, 1051
R. 63(2) EPC	913, 915, 916	R. 79(2) EPC	1012, 1036
R. 63(3) EPC	917	R. 79(3) EPC	1050, 1051, 1053
R. 64 EPC	303, 309, 918	R. 80 EPC	489, 931, 1038, 1040, 1041, 1044, 1050, 1127, 1154, 1155
R. 64(1) EPC	321, 325, 918	R. 81(3) EPC	1045, 1051
R. 64(2) EPC	309, 310, 1075	R. 82 EPC	1033, 1042, 1046, 1047, 1057
R. 66(1) EPC	862	R. 82(1) EPC	759, 1052, 1057, 1081
R. 67(1) EPC	859	R. 82(2) EPC	720, 1057, 1058
R. 67(2) EPC	859	R. 82(3) EPC	692, 1056
R. 69(1) EPC	692	R. 84 EPC	973
R. 70 EPC	863	R. 84(1) EPC	973, 974, 976
R. 70(1) EPC	651, 863	R. 84(2) EPC	973, 976-978
R. 70(2) EPC	864, 865	R. 84a EPC	839
R. 70a EPC	862, 866	R. 85 EPC	772, 839
R. 70a(1) EPC	862	R. 86 EPC	778, 1015, 1026
R. 70a(2) EPC	862	R. 86(3) EPC	872
R. 71 EPC	887, 893, 895, 910	R. 86(4) EPC	925
R. 71(1) EPC	866, 867	R. 88 EPC	457, 845, 981
R. 71(2) EPC	716, 866-868	R. 88(1) EPC	1000, 1001
R. 71(3) EPC	558, 559, 564, 718, 751, 765, 878, 887, 888, 890, 894-896, 898, 899, 1072, 1127	R. 88(2) EPC	1001, 1002
R. 71(4) EPC	898	R. 88(3) EPC	1002
R. 71(5) EPC	888, 898	R. 89 EPC	764, 967, 971, 972, 1006
R. 71(6) EPC	894, 898	R. 89(2) EPC	967, 972
R. 71(7) EPC	890	R. 91 EPC	979
R. 71a EPC	577, 887	R. 93(1) EPC	979
R. 71a(2) EPC	898	R. 93(2) EPC	979
R. 72(1) EPC	657	R. 95(2) EPC	979
R. 73(1) EPC	911	R. 97(1) EPC	1003
R. 75 EPC	974, 1006, 1007	R. 99 EPC	1065, 1069, 1088, 1092, 1093, 1095
R. 76 EPC	967, 972, 1008, 1010-1012, 1018		
R. 76(1) EPC	1014, 1028		
R. 76(2)(a) EPC	691, 1008, 1013-1015, 1017, 1020		
R. 76(2)(b) EPC	1014, 1017, 1020		

Index of cited provisions

R. 99(1) EPC	1087, 1095
R. 99(1)(a) EPC	1077, 1087-1090
R. 99(1)(b) EPC	1087, 1091
R. 99(1)(c) EPC	1087, 1092, 1119
R. 99(2) EPC	1068, 1087, 1092, 1093, 1096, 1097, 1099, 1100, 1122, 1227
R. 99(3) EPC	1093
R. 100 EPC	858, 1012
R. 100(1) EPC	716, 974, 1008, 1013, 1029, 1033, 1065, 1127, 1148
R. 100(2) EPC	517, 566, 858
R. 100(3) EPC	566, 858
R. 101 EPC	989, 1166, 1227
R. 101(1) EPC	639, 650, 1077, 1089, 1091, 1096, 1122
R. 101(2) EPC	1077, 1088-1091, 1221
R. 103 EPC	719, 1065, 1069, 1070, 1085, 1095, 1110, 1190, 1191, 1206, 1207, 1211
R. 103(1) EPC	832, 1189
R. 103(1)(a) EPC	531, 532, 914, 1187, 1205, 1225
R. 103(1)(b) EPC	1111, 1187, 1190
R. 103(2) EPC	516, 1187, 1190
R. 103(3) EPC	1187, 1206
R. 104 EPC	702, 1074, 1227, 1242, 1243
R. 104(a) EPC	558, 1227, 1242
R. 104(b) EPC	555, 1227, 1228, 1242, 1243
R. 105 EPC	702, 1074, 1244
R. 106 EPC	584, 818, 821, 824, 1228-1232
R. 107 EPC	1232
R. 107(1)(a) EPC	1232
R. 107(2) EPC	1232
R. 108(2) EPC	1232
R. 108(3) EPC	738, 1244
R. 109 EPC	1233
R. 109(1) EPC	1233, 1234
R. 109(2)(a) EPC	1233

R. 109(2)(b) EPC	1233
R. 109(3) EPC	1233
R. 110 EPC	1234
R. 111 EPC	748, 750, 751, 759, 763
R. 111(1) EPC	748, 1052, 1199
R. 111(2) EPC	174, 536, 537, 539, 581, 662, 748, 750-753, 755-758, 833, 876, 1192, 1196, 1238, 1255
R. 112 EPC	742, 743, 849, 1071
R. 112(1) EPC	607, 692, 742, 743, 811, 852, 1056
R. 112(2) EPC	507, 560, 640, 742, 743, 1055, 1201
R. 113 EPC	750, 759
R. 113(2) EPC	759
R. 114 EPC	780
R. 114(1) EPC	776-779
R. 114(2) EPC	776
R. 115 EPC	558, 575, 576
R. 115(1) EPC	575
R. 115(2) EPC	548, 566, 567
R. 116 EPC	558, 577, 578, 656, 666, 875, 938, 1041, 1135, 1141
R. 116(1) EPC	539, 577, 580, 931, 934, 1038, 1227
R. 116(2) EPC	577, 875, 1038, 1122, 1140, 1161, 1227
R. 117 EPC	654, 656, 660
R. 118 EPC	670, 673, 982
R. 120 EPC	982
R. 121 EPC	659
R. 124 EPC	558, 583, 585, 654, 692, 700, 1195
R. 124(1) EPC	585, 586, 1231
R. 124(3) EPC	586, 587



R. 125 EPC	692, 785	R. 137(3) EPC	554, 564, 580, 716, 719, 761, 862, 872-878, 894-896, 899, 1040, 1127, 1148, 1159, 1174, 1202, 1209
R. 125(1) EPC	785	R. 137(4) EPC	918, 922-924, 1202
R. 125(2) EPC	785	R. 137(5) EPC	325, 326, 917-920, 922, 924-927
R. 125(4) EPC	699, 789	R. 138 EPC	70, 71, 1038, 1040
R. 126 EPC	692, 697, 785	R. 139 EPC	401, 452, 481-485, 487-489, 504, 507, 748, 837, 838, 840, 844-848, 853, 855, 894, 901, 903, 906-908, 1015-1017, 1049, 1050, 1090, 1091, 1221
R. 126(1) EPC	693, 787, 789, 1220	R. 140 EPC	488, 489, 761, 763-767, 848, 901, 906, 1039, 1049, 1050, 1257
R. 126(2) EPC	592, 610, 692, 698, 699, 785, 789, 790	R. 142 EPC	596, 641
R. 126(4) EPC	786	R. 142(1)(a) EPC	596-598
R. 127 EPC	692, 697, 700, 785, 786, 789	R. 142(1)(b) EPC	599, 600
R. 127(2) EPC	786	R. 142(1)(c) EPC	596-598
R. 128 EPC	787	R. 142(4) EPC	596, 600
R. 129 EPC	692, 700, 785	R. 143 EPC	771
R. 129(1) EPC	787	R. 143(2) EPC	771
R. 130 EPC	785, 799	R. 144 EPC	769, 770
R. 130(1) EPC	787	R. 144(d) EPC	769, 770
R. 130(3) EPC	610	R. 147 EPC	674
R. 131 EPC	591	R. 150 EPC	654
R. 131(2) EPC	591, 592	R. 151 EPC	802, 806, 808
R. 132 EPC	592, 593, 792, 1053	R. 151(1) EPC	610
R. 132(2) EPC	539, 592	R. 152 EPC	799, 808, 809
R. 133 EPC	692	R. 152(1) EPC	811, 814
R. 133(1) EPC	785	R. 152(2) EPC	809, 810
R. 134 EPC	593, 641, 692	R. 152(6) EPC	801, 808, 810, 811
R. 134(1) EPC	593	R. 152(8) EPC	1078
R. 134(2) EPC	501, 593		
R. 134(5) EPC	594		
R. 135(1) EPC	505, 596		
R. 135(2) EPC	595		
R. 136 EPC	602, 684		
R. 136(1) EPC	522, 606, 607, 609, 611, 615, 641		
R. 136(2) EPC	526, 614		
R. 136(3) EPC	603, 605		
R. 136(4) EPC	638		
R. 137 EPC	761, 862, 894, 931, 1038, 1202		
R. 137(2) EPC	862		

R. 152(10) EPC	810
R. 152(11) EPC	815
R. 154 EPC	800
R. 157 EPC	1265
R. 158(3) EPC	302, 1266
R. 159 EPC	73
R. 159(1)(c) EPC	72
R. 159(2) EPC	1267
R. 161 EPC	862
R. 161(1) EPC	862
R. 162 EPC	898
R. 164 EPC	300, 303, 324, 325, 1222
R. 164(1) EPC	324, 326, 919
R. 164(2) EPC	324, 325
R. 165 EPC	72, 1265

**EPC 1973 – rules**

R. 1 EPC 1973	1012
R. 1(1) EPC 1973	647, 650
R. 2(1) EPC 1973	590, 647, 648
R. 2(5) EPC 1973	590
R. 6(2) EPC 1973	649
R. 6(3) EPC 1973	651, 796
R. 7 EPC 1973	650
R. 9(2) EPC 1973	749
R. 9(3) EPC 1973	1026, 1074
R. 10(2) EPC 1973	1274
R. 11 EPC 1973	1274
R. 13 EPC 1973	499, 773, 774, 1083, 1084
R. 13(1) EPC 1973	773, 774, 1066
R. 13(3) EPC 1973	775
R. 15(2) EPC 1973	853
R. 20 EPC 1973	369, 966
R. 20(1) EPC 1973	772, 966
R. 20(3) EPC 1973	499, 599, 641, 772, 959, 965
R. 23a EPC 1973	388
R. 23b(1) EPC 1973	43
R. 23b(5) EPC 1973	46, 710, 714
R. 23c(b) EPC 1973	36
R. 23d EPC 1973	38, 40
R. 23d(c) EPC 1973	38
R. 23d(d) EPC 1973	39-41
R. 23e(2) EPC 1973	38

R. 24 EPC 1973	838
R. 24(2) EPC 1973	850
R. 25 EPC 1973	492, 499, 501-503, 1219
R. 25(1) EPC 1973	501, 503, 604, 903
R. 25(1)(b) EPC 1973	902
R. 25(2) EPC 1973	853
R. 26(2)(c) EPC 1973	1088
R. 27 EPC 1973	17, 179, 300
R. 27(1)(b) EPC 1973	74, 433, 446, 447
R. 27(1)(c) EPC 1973	172, 310
R. 27(1)(d) EPC 1973	310
R. 27(1)(e) EPC 1973	334
R. 27(1)(f) EPC 1973	258
R. 27a EPC 1973	354
R. 28 EPC 1973	354, 355, 387, 714
R. 28(1)(c) EPC 1973	355
R. 28(2)(a) EPC 1973	355
R. 28a EPC 1973	354
R. 29 EPC 1973	17, 265, 273, 300
R. 29(1) EPC 1973	34, 262, 264, 265, 283, 297, 433, 470
R. 29(1)(a) EPC 1973	264, 265
R. 29(1)(b) EPC 1973	264
R. 29(2) EPC 1973	265-268, 1044
R. 29(2)(a) EPC 1973	267
R. 29(2)(c) EPC 1973	266, 267
R. 29(3) EPC 1973	282, 329
R. 29(4) EPC 1973	267, 269, 282
R. 29(6) EPC 1973	269, 279, 295
R. 29(7) EPC 1973	269
R. 30 EPC 1973	302-304
R. 30(1) EPC 1973	318
R. 30(b) EPC 1973	320
R. 30(c) EPC 1973	304
R. 31 EPC 1973	903
R. 31(1) EPC 1973	300
R. 31(2) EPC 1973	903
R. 34(1)(c) EPC 1973	310
R. 36(3) EPC 1973	802, 806, 807, 1013, 1026
R. 36(5) EPC 1973	1086
R. 37(1) EPC 1973	595, 795
R. 38(2) EPC 1973	855

R. 38(3) EPC 1973	606, 855	R. 56(2) EPC 1973	1013, 1017
R. 41(1) EPC 1973	606	R. 57(1) EPC 1973	541, 721, 1007, 1027, 1041, 1051, 1071
R. 43 EPC 1973	842, 844, 845	R. 57(2) EPC 1973	1036
R. 43(1) EPC 1973	1205	R. 57(3) EPC 1973	1050, 1051, 1053
R. 43(2) EPC 1973	1205	R. 57a EPC 1973	462-464, 1038, 1040, 1041, 1044, 1114, 1120, 1121
R. 44(1) EPC 1973	921	R. 58(1) EPC 1973	1080
R. 45 EPC 1973	913, 914, 917, 1123, 1124	R. 58(2) EPC 1973	721, 1045
R. 46 EPC 1973	309, 310, 322, 832, 918	R. 58(3) EPC 1973	1051, 1080
R. 46(1) EPC 1973	310, 311, 321-323, 325, 832, 918, 921, 924	R. 58(4) EPC 1973	745, 1052, 1057, 1081, 1082
R. 46(2) EPC 1973	309-311	R. 58(5) EPC 1973	617, 639, 720, 910, 1057, 1058, 1222
R. 48 EPC 1973	859	R. 60 EPC 1973	975
R. 48(1) EPC 1973	859	R. 60(1) EPC 1973	974-976
R. 51 EPC 1973	630, 885, 893-895	R. 60(2) EPC 1973	960, 977, 1167
R. 51(1) EPC 1973	864	R. 61a EPC 1973	268, 1015, 1026
R. 51(2) EPC 1973	535, 541, 716, 867, 871, 879	R. 63 EPC 1973	981
R. 51(3) EPC 1973	535, 867-871, 881, 883, 884, 1071	R. 63(1) EPC 1973	1001
R. 51(4) EPC 1973	501, 554, 604, 630, 719, 751, 765, 887-889, 891, 893-901, 1079, 1101, 1201, 1202, 1208	R. 64 EPC 1973	613, 1095
R. 51(5) EPC 1973	889, 897, 1101	R. 64(a) EPC 1973	1076, 1087-1089
R. 51(6) EPC 1973	559, 889, 895, 899, 900	R. 64(b) EPC 1973	717, 1087, 1091-1093, 1096, 1104, 1169
R. 55 EPC 1973	1008, 1010-1012, 1018	R. 65 EPC 1973	989, 1095
R. 55(a) EPC 1973	691, 1008, 1013, 1020	R. 65(1) EPC 1973	650, 743
R. 55(b) EPC 1973	1017, 1020	R. 65(2) EPC 1973	1076, 1088, 1089
R. 55(c) EPC 1973	932, 1014, 1017-1025, 1027, 1028, 1032, 1033, 1046, 1066, 1119, 1125	R. 66(1) EPC 1973	716, 807, 862, 1008, 1029, 1033
R. 56 EPC 1973	1018	R. 66(2) EPC 1973	1271
R. 56(1) EPC 1973	1008, 1010, 1013, 1017, 1026, 1027	R. 67 EPC 1973	644, 719, 734, 831, 877, 1085, 1187, 1189-1192, 1194, 1196, 1197, 1201, 1202, 1204, 1206, 1211, 1213, 1225
		R. 68 EPC 1973	748, 750, 759, 763
		R. 68(1) EPC 1973	751, 1052

Index of cited provisions

R. 68(2) EPC 1973	174, 537, 581, 587, 662, 751-758, 833, 886, 892, 910, 923, 1192, 1196, 1255	R. 84 EPC 1973	592, 593, 606, 1053
R. 69 EPC 1973	526	R. 85(1) EPC 1973	595
R. 69(1) EPC 1973	519, 527, 607-609, 692, 742, 743, 1056, 1071, 1075, 1197, 1266	R. 85(2) EPC 1973	593-595, 641, 761, 839
R. 69(2) EPC 1973	507, 560, 640, 742-744, 1055, 1056, 1071, 1201	R. 85(4) EPC 1973	595
R. 70 EPC 1973	750, 759	R. 85(5) EPC 1973	594
R. 70(2) EPC 1973	759, 760	R. 85a EPC 1973	519, 595, 605, 853, 1206, 1266
R. 71 EPC 1973	1274	R. 85b EPC 1973	595, 605
R. 71(1) EPC 1973	575, 973	R. 86(1) EPC 1973	520
R. 71(2) EPC 1973	548	R. 86(3) EPC 1973	554, 559, 564, 716, 719, 761, 833, 862, 873-877, 890-892, 894-899, 901, 926, 1040, 1122, 1174, 1202, 1209
R. 71a EPC 1973	558, 577-580, 666, 822, 938, 1041, 1273	R. 86(4) EPC 1973	325, 918-924, 926, 927
R. 71a(1) EPC 1973	577, 579, 580, 822, 938, 1273, 1274	R. 87 EPC 1973	70, 71, 462, 1038, 1040
R. 71a(2) EPC 1973	577, 579, 580, 1135	R. 88 EPC 1973	298, 452, 482-488, 500, 507, 508, 838, 840, 841, 844-847, 853-856, 894, 903-905, 907, 908, 912, 1014, 1015, 1075, 1080, 1081
R. 72 EPC 1973	656, 827	R. 89 EPC 1973	488, 751, 761, 763-767, 911, 1071, 1072, 1075, 1080, 1257
R. 72(1) EPC 1973	827	R. 90 EPC 1973	596, 641
R. 72(2) EPC 1973	670	R. 90(1)(a) EPC 1973	597, 598
R. 76 EPC 1973	583, 827	R. 90(1)(b) EPC 1973	599, 600, 641
R. 76(1) EPC 1973	584, 587	R. 90(1)(c) EPC 1973	597-599
R. 76(3) EPC 1973	586	R. 90(2) EPC 1973	600
R. 77(2)(d) EPC 1973	786	R. 90(4) EPC 1973	600
R. 78(2) EPC 1973	610, 611, 692, 698, 786, 812, 1094	R. 92 EPC 1973	771
R. 78(3) EPC 1973	610	R. 93 EPC 1973	769, 770
R. 81 EPC 1973	812	R. 93(d) EPC 1973	770
R. 81(1) EPC 1973	787, 788	R. 95a EPC 1973	674
R. 82 EPC 1973	699, 788, 1094	R. 100 EPC 1973	806-808, 1077
R. 83(2) EPC 1973	591, 592	R. 100(1) EPC 1973	806, 1077
R. 83(3) EPC 1973	592		
R. 83(4) EPC 1973	592, 595		
R. 83(5) EPC 1973	592		

R. 100(2) EPC 1973	806
R. 101 EPC 1973	808
R. 101(1) EPC 1973	805
R. 101(2) EPC 1973	811
R. 101(4) EPC 1973	813
R. 101(6) EPC 1973	787, 1078
R. 101(9) EPC 1973	713, 815
R. 104b EPC 1973	528
R. 104b(1) EPC 1973	1266, 1267
R. 107(1) EPC 1973	853
R. 107(2) EPC 1973	797
R. 110 EPC 1973	300
R. 110(1) EPC 1973	301
R. 112 EPC 1973	323

### 3. Rules relating to Fees

Art. 2(1)(2) RFees	508
Art. 2(1)(3) RFees	506
Art. 2(1)(10) RFees	971
Art. 2(2)(3) RFees	506
Art. 2(3) RFees	851
Art. 2(16) RFees	1003
Art. 5 RFees	793
Art. 5(1) RFees	793
Art. 5(2) RFees	793
Art. 6(2) RFees	794
Art. 7(1) RFees	795
Art. 7(2) RFees	793
Art. 7(3) RFees	595, 795
Art. 7(4) RFees	593, 595, 795
Art. 8 RFees	795, 796
Art. 9(2) RFees	323
Art. 10(2) RFees	322
Art. 10b(b) RFees	865
Art. 11(b) RFees	797
Art. 12 RFees	1189
Art. 12(1) RFees	796
Art. 12(2) RFees	797
Art. 14(1) RFees	796

### 4. Patent Cooperation Treaty (articles and rules)

#### PCT Articles

Art. 2(xiii) PCT	1267
Art. 3(4)(iii) PCT	302, 307
Art. 6 PCT	312
Art. 8(2)(b) PCT	388
Art. 11(1) PCT	522, 1268
Art. 11(2)(b) PCT	1268
Art. 11(3) PCT	1267
Art. 14(1)(b) PCT	1267
Art. 15(5)(a) PCT	322
Art. 17 PCT	313
Art. 17(2)(a) PCT	915, 1268
Art. 17(3)(a) PCT	302, 303, 308-310, 313, 321, 324, 1265
Art. 22 PCT	502
Art. 24(1)(i) PCT	1267
Art. 24(2) PCT	1267
Art. 25 PCT	1267
Art. 26 PCT	1267
Art. 27(7) PCT	599
Art. 31(4)(a) PCT	1266
Art. 34(3) PCT	318
Art. 34(3)(a) PCT	302, 303, 309, 1265
Art. 48(2) PCT	606
Art. 48(2)(a) PCT	605, 1267
Art. 49 PCT	599
Art. 56 PCT	309
Art. 56(3)(ii) PCT	309

#### PCT Rules

R. 4.9(b)(ii) PCT	1267
R. 4.9(c) PCT	1267
R. 13 PCT	302-304, 307, 317, 321
R. 13.1 PCT	303, 305, 307, 308, 312-318, 320
R. 13.2 PCT	303, 304, 307, 312, 316, 318, 319, 321
R. 13.3 PCT	319

R. 13.4 PCT	305
R. 13bis.4 PCT	355, 606
R. 17.1(b) PCT	857
R. 26.2 PCT	1267
R. 33.1(a) PCT	309
R. 40 PCT	302, 303, 313
R. 40.2(c) PCT	307, 311, 320, 606
R. 40.2(e) PCT	307, 311
R. 40.3 PCT	606
R. 60 PCT	1267
R. 68 PCT	302, 303
R. 68.3(c) PCT	311
R. 68.3(e) PCT	311
R. 82ter PCT	1268
R. 92bis.1 PCT	772

### 5. Regulation on the European qualifying examination for professional representatives

Art. 1(6) REE	1248
Art. 1(7) REE	1248
Art. 2 REE	1248
Art. 3 REE	1248
Art. 3(7) REE	1248
Art. 6(2)(c) REE	1253, 1257
Art. 6(5) REE	1260
Art. 7(1)(b) REE	1250
Art. 7(1)(b)(i) REE	1250
Art. 7(3) REE	1258
Art. 8(1)(d) REE	1253
Art. 8(1)(e) REE	1253, 1258
Art. 8(b) REE	1253, 1254, 1258
Art. 10 REE	1251
Art. 10(1) REE	1251
Art. 10(2)(a) REE	1251
Art. 10(2)(b) REE	1251
Art. 11 REE	1248
Art. 11(1)(a) REE	1249
Art. 11(2) REE	1250
Art. 11(2)(a) REE	1250-1252
Art. 11(2)(a)(i) REE	1250
Art. 11(2)(a)(ii) REE	1251
Art. 11(2)(b) REE	1251
Art. 11(3) REE	1251, 1252
Art. 11(5) REE	1250

Art. 11(7) REE	1248, 1250
Art. 12 REE	1252
Art. 12(3) REE	1252
Art. 14 REE	1249
Art. 14(1) REE	1254
Art. 15 REE	1249, 1252
Art. 16 REE	1253, 1254, 1257
Art. 16(1) REE	1254
Art. 24 REE	1249
Art. 24(1) REE	1255, 1257
Art. 24(2) REE	1256
Art. 24(3) REE	1256
Art. 24(4) REE	1259
Art. 27 REE	1249, 1256
Art. 27(1) REE	1255, 1257
Art. 27(3) REE	1256
R. 4 IPREE	1258
R. 4(1) IPREE	1254, 1258
R. 4(2) IPREE	1258
R. 4(3) IPREE	1258
R. 5 IPREE	1252
R. 6 IPREE	1249
R. 6(1) IPREE	1254, 1255
R. 6(3) IPREE	1254
R. 6(3)(c) IPREE	1254
R. 6(4) IPREE	1254
R. 10 IPREE	1248
R. 11 IPREE	1248, 1249
R. 11(2) IPREE	1249
R. 12 IPREE	1249
R. 13 IPREE	1249
R. 14 IPREE	1250
R. 15 IPREE	1248, 1250
R. 15(2) IPREE	1251
R. 16(1) IPREE	1250
R. 16(2) IPREE	1252
R. 19(3) IPREE	1260
R. 19(4) IPREE	1260
R. 22(3) IPREE	1259

### 6. Regulation on discipline for professional representatives

Art. 1 RDR	1262
Art. 1(1) RDR	1261
Art. 1(2) RDR	1261
Art. 2 RDR	1263

Art. 4(1)(e) RDR	1261
Art. 5 RDR	1248
Art. 8 RDR	1248
Art. 8(2) RDR	1262
Art. 18 RDR	1263
Part I RDR	1263

## 7. Rules of procedure of the Enlarged Board of Appeal

Art. 1 RPEBA	1233
Art. 1(2) RPEBA	737
Art. 2(3) RPEBA	1233
Art. 2(4) RPEBA	1217
Art. 2(5) RPEBA	1245
Art. 2(6) RPEBA	1233
Art. 4(1) RPEBA	727, 729
Art. 4(2) RPEBA	729
Art. 4(3) RPEBA	723
Art. 9 RPEBA	1218, 1219
Art. 10 RPEBA	1218
Art. 12(1) RPEBA	1233
Art. 12a(4) RPEBA	1246
Art. 12a(5) RPEBA	1246
Art. 12a(8) RPEBA	1245
Art. 12a(10) RPEBA	1246
Art. 18(2) RPEBA	1221, 1222
Art. 18(3) RPEBA	1246
Art. 19 RPEBA	1217

## 8. Rules of procedure of the Boards of Appeal

Art. 3 RPBA	728
Art. 3(1) RPBA	727-729
Art. 3(2) RPBA	729
Art. 3(3) RPBA	723
Art. 7(1) RPBA	552
Art. 8(1) RPBA	552
Art. 10 RPBA	734
Art. 10a RPBA	1127
Art. 10a(4) RPBA	950
Art. 10b RPBA	985, 1127
Art. 10b(3) RPBA	940
Art. 11 RPBA	531, 532, 876, 1175, 1177-1179, 1228

Art. 11(1) RPBA	576
Art. 11(2) RPBA	576, 577
Art. 11(3) RPBA	548, 551, 552, 566
Art. 11a RPBA	589
Art. 12 RPBA	862, 931, 939, 948, 1127, 1130, 1229
Art. 12(1) RPBA	949, 981
Art. 12(1)(a) RPBA	1198
Art. 12(1)(b) RPBA	810, 811
Art. 12(2) RPBA	551, 576, 668, 939, 945, 949, 1079, 1098, 1101, 1109, 1128, 1130, 1132, 1133, 1161, 1198
Art. 12(4) RPBA	666, 667, 670, 783, 940, 943, 944, 947, 949-951, 957, 1099, 1121, 1122, 1128, 1129, 1133, 1139-1142, 1144, 1146, 1148, 1150, 1151, 1158, 1161, 1162
Art. 13 RPBA	578, 666, 669, 783, 862, 931, 939, 947, 948, 981, 985, 1122, 1127, 1130, 1138, 1161, 1228, 1240
Art. 13(1) RPBA	498, 576, 642, 667, 668, 783, 939-941, 945-947, 985, 1128, 1130, 1132, 1133, 1137, 1140, 1151, 1152, 1229
Art. 13(2) RPBA	948, 1129, 1131
Art. 13(3) RPBA	659, 660, 668, 669, 783, 940, 946, 948, 1128, 1130, 1132-1135, 1157, 1180
Art. 15 RPBA	558

## Index of cited provisions

---

Art. 15(1) RPBA	551, 552, 576, 577, 945, 1124, 1160, 1273	Art. 16 RPBA	589, 1002, 1225
Art. 15(2) RPBA	569, 571, 829	Art. 16(1) RPBA	981
Art. 15(3) RPBA	548, 549, 551, 552, 566, 948, 949, 1137	Art. 16a(1)(c) RPBA	992
Art. 15(4) RPBA	588, 1228, 1240	Art. 16a(1)(e) RPBA	992
Art. 15(5) RPBA	584, 1228, 1240, 1243	Art. 19(1) RPBA	589, 1235
Art. 15(6) RPBA	549, 588, 669, 1134, 1137, 1228	Art. 20 RPBA	1228
		Art. 20(1) RPBA	1219
		Art. 21 RPBA	1219, 1224, 1225
		Art. 23 RPBA	862



## **ANNEXES**

### **1. Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office**

Decision of the Administrative Council of 25 March 2015 approving amendments to the Rules of Procedure of the Enlarged Board of Appeal of the European Patent Office (CA/D 3/15, OJ EPO 2015, A35).

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention, and in particular Article 23, paragraph 4, thereof,

Having regard to the amendments to the Rules of Procedure of the Enlarged Board of Appeal, adopted on 19 March 2015 under Rule 13, paragraph 2, of the Implementing Regulations to the European Patent Convention,

HAS DECIDED AS FOLLOWS:

The amendments to the Rules of Procedure of the Enlarged Board of Appeal, as shown in the Annex to this decision, are hereby approved.

This decision shall enter into force on 25 March 2015.

Done at Munich, 25 March 2015

For the Administrative Council  
The Chairman

Jesper KONGSTAD

## ANNEX

### DECISION

Amendments to the Rules of Procedure of the Enlarged Board of Appeal, OJ EPO 1983, 3, as amended in OJ EPO 1989, 362, OJ EPO 1994, 443, OJ EPO 2003, 58, and OJ EPO 2007, 303

In accordance with Rule 13 of the Implementing Regulations to the Convention on the Grant of European Patents, the Enlarged Board of Appeal amends its Rules of Procedure. These amended Rules of Procedure read as follows:

#### **Article 1**

##### Field of application

These Rules of Procedure shall apply in proceedings before the Enlarged Board of Appeal under Article 23, paragraph 1, first sentence, EPC, Article 112 EPC, and Article 112a EPC.

#### **Article 2**

##### Business distribution and composition

(1) Before the beginning of each working year the members of the Enlarged Board of appeal appointed under Article 11, paragraph 3, EPC shall draw up a business distribution scheme. This scheme shall designate the regular members and their alternates in proceedings under Article 23, paragraph 1, first sentence, EPC, Article 112 EPC and Article 112a EPC initiated during the year. The scheme may be amended during the working year.

(2) The Chairman of the Enlarged Board of Appeal shall determine the composition of the Board for each particular case in accordance with the business distribution scheme. In proceedings under Article 23, paragraph 1, first sentence, EPC, in accordance with paragraph 5 the composition of the Board shall be determined by the alternate of the Chairman of the Enlarged Board of Appeal.

(3) For the examination of a petition under Article 112a EPC conducted in the composition under Rule 109, paragraph 2(b), EPC, two legally qualified members shall supplement the composition specified in Rule 109, paragraph 2(a), EPC.

(4) In proceedings before the Enlarged Board of Appeal under Article 112, paragraph 1(a), EPC at least four of the members shall not have taken part in the proceedings before the Board of Appeal referring the point of law.

(5) In proceedings under Article 23, paragraph 1, first sentence, EPC the Enlarged Board of Appeal shall be composed according to the provisions of Article 22, paragraph 2, first sentence, EPC, the Chairman being replaced by his alternate, and two of the legally qualified members being external members of the Enlarged Board of Appeal.

(6) Article 24 EPC shall apply to proceedings under Article 112a EPC. The Chairman, appointed under Article 11, paragraph 3, EPC, of the Board against whose decision the petition for review has been filed may not take part in the review proceedings.

(7) The parties shall be informed of the Board's composition as soon as it has been determined or changed.

### **Article 3**

#### Replacement of members

(1) Members shall be replaced by alternates if they are prevented from participating, particularly as a result of sickness, excessive workload, and commitments which cannot be avoided.

(2) Any member who wishes to be replaced by an alternate shall inform the Chairman of the Board of his unavailability without delay.

(3) The Chairman of the Enlarged Board of Appeal may, in accordance with the business distribution scheme, designate another regular legally qualified member of the Board to act as Chairman in his stead.

### **Article 4**

#### Exclusion and objection

(1) If the Board has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings, then the procedure of Article 24, paragraph 4, EPC shall be applied.

(2) The member concerned shall be invited to present his comments as to whether there is a reason for exclusion.

(3) Before a decision is taken on the exclusion of the member, there shall be no further proceedings in the case.

### **Article 5**

#### Rapporteurs

(1) The Chairman of the Board shall for each case designate a member of the Board, or himself, as rapporteur. The Chairman may appoint an additional rapporteur. The rapporteur of the Board as composed under Rule 109, paragraph 2(a), EPC shall generally go on to be the rapporteur for proceedings conducted in the composition under Rule 109, paragraph 2(b), EPC.

(2) If an additional rapporteur is appointed, the steps referred to in paragraphs 3 to 5 shall be taken by the rapporteur and additional rapporteur jointly unless the Chairman directs otherwise.

(3) The rapporteur shall carry out a preliminary study of the case and may prepare communications to the eligible parties subject to the direction of the Chairman of the Board. Communications shall be signed by the rapporteur on behalf of the Board.

(4) The rapporteur shall make the preparations for meetings of the Board and for oral proceedings.

(5) The rapporteur shall draft decisions or opinions.

(6) If a rapporteur or additional rapporteur considers that his knowledge of the language of the proceedings is insufficient for drafting communications or decisions or opinions, he may draft these in one of the other official languages. His drafts shall be translated by the European Patent Office into the language of the proceedings and the translations shall be checked by the rapporteur or by another member of the Board.

### **Article 6**

#### **Registry**

(1) A Registry shall be established for the Enlarged Board of Appeal. The Senior Registrar of the Boards of Appeal or the registrars assigned to him for this purpose shall be responsible for the discharge of its functions.

(2) The members of the Enlarged Board of Appeal appointed under Article 11, paragraph 3, EPC may entrust to the Registry tasks which involve no technical or legal difficulties, in particular in relation to arranging for inspection of files, issuing summonses to oral proceedings and notifications and granting requests for further processing of applications.

(3) Minutes of oral proceedings and of the taking of evidence shall be drawn up by the Senior Registrar, a registrar assigned to him for this purpose or such other employee of the Office as the Chairman may designate.

### **Article 7**

#### **Change in the composition of the Board**

(1) If the composition of the Board is changed after oral proceedings, the parties eligible to take part in the proceedings shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board in its new composition. Fresh oral proceedings shall also be held if so requested by the new member and if the other members of the Board have given their agreement.

(2) Paragraph 1 shall not apply to a change in composition under Article 2, paragraph 3. In this event, a request for oral proceedings shall continue to apply even where oral proceedings have already taken place.

(3) Each new member shall be bound to the same extent as the other members by an interim decision which has already been taken.

(4) If, when the Board has already reached a final decision, a member is unable to act, he shall not be replaced by an alternate. If the Chairman is unable to act, the legally qualified member of the Board having the longest service on the Board or, in the case where members have the same length of service, the eldest member shall sign the decision on behalf of the Chairman.

#### **Article 8**

##### Consolidation of proceedings

If two or more points of law with the same or similar subject-matter have been submitted, or two or more petitions to review the same appeal decision, the Board may consider them in consolidated proceedings.

#### **Article 9**

##### EPO President's right to comment

In proceedings under Article 112 EPC the Board may, on its own initiative or at the written, reasoned request of the President of the European Patent Office, invite him to comment in writing or orally on questions of general interest which arise in the course of proceedings pending before it. The parties shall be entitled to submit their observations on the President's comments.

#### **Article 10**

##### Statements by third parties

(1) In the course of proceedings under Article 112 EPC, any written statement concerning the points of law raised in such proceedings which is sent to the Board by a third party may be dealt with as the Board thinks fit.

(2) The Board may announce further provisions concerning such statements in the Official Journal of the European Patent Office if it seems appropriate.

#### **Article 11**

##### Special communications to parties in proceedings under Article 112a EPC

Notwithstanding notifications or communications required under other provisions,

(a) the other parties shall be informed of the receipt of a petition for review and shall receive a copy of the petition, reference being made to Rule 109, paragraph 3, EPC;

(b) the parties shall be informed that a clearly inadmissible or unallowable petition for review has been rejected in oral proceedings;

(c) the parties shall be informed that a petition for review has been forwarded to the Board as composed under Rule 109, paragraph 2(b), EPC.

### **Article 12**

#### **New submissions filed after expiry of the time limit in proceedings under Article 112a EPC**

(1) Notwithstanding Rule 109, paragraph 3, EPC the Board may consider new submissions made by the petitioner after expiry of the time limit for filing petitions for review, if this is justified for special reasons.

(2) The same shall apply in proceedings conducted in the composition under Rule 109, paragraph 2(b), EPC to new submissions from the other parties filed subsequently to their reply.

### **Article 12a**

#### **Proceedings under Article 23, paragraph 1, first sentence, EPC**

(1) A request that the Enlarged Board of Appeal make a proposal for the removal from office of a member under Article 23, paragraph 1, first sentence, EPC may be made to the Enlarged Board either by the Administrative Council of the European Patent Organisation or by the Vice-President of the European Patent Office in charge of the Boards of Appeal.

(2) In the case of such a request being made by the Administrative Council, the Administrative Council shall be represented in the proceedings. The Vice-President of the European Patent Office in charge of the Boards of Appeal shall also be entitled to be heard in such proceedings.

(3) In the case of such a request being made by the Vice-President in charge of the Boards of Appeal, he shall be a party to the proceedings.

(4) The member who is the subject of a request to make a proposal for their removal from office under Article 23, paragraph 1, first sentence, EPC shall be a party to the proceedings as respondent.

(5) The request referred to in paragraph 1 shall set out all the facts, arguments and evidence relied on. All documents referred to shall be attached.

(6) The proceedings shall be conducted in writing, where necessary or requested supplemented by oral proceedings according to Article 14, and may not be concluded without the respondent being informed of the facts, arguments and evidence underlying the request and having had the opportunity to be heard on them. The respondent may appoint a person to advise or represent him.

(7) Article 117, paragraph 1, EPC shall be applicable.

(8) The proceedings shall be conducted independently of any disciplinary or national proceedings.

(9) Unless and to the extent that the Enlarged Board decides otherwise, the proceedings shall not be public and shall be confidential.

(10) The Enlarged Board of Appeal may on request propose the reimbursement of some or all costs incurred in the proceedings by the respondent if the request to make a proposal for their removal from office has been rejected.

### **Article 13**

#### Non-binding communications from the Board

If the Board deems it expedient to communicate with the eligible parties regarding a possible appreciation of substantive or legal matters, such communication shall be made in such a way as not to imply that the Board is in any way bound by it.

### **Article 14**

#### Oral proceedings

(1) If oral proceedings are to take place, the Board shall endeavour to ensure that the eligible parties have provided all relevant information and documents before the hearing.

(2) The Board's communication under Article 13 may draw attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or may contain other observations that may help concentration on essentials during the oral proceedings.

(3) A change of date for oral proceedings may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request made as far in advance of the appointed date as possible.

(4) The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case.

(5) The Chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct.

(6) When a case is ready for decision during oral proceedings, the Chairman shall state the final requests of the eligible parties and declare the debate closed. No submissions may be made by the parties after the closure of the debate unless the Board decides to re-open the debate.

(7) The Board shall ensure that each case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary. Before the oral proceedings are closed, the Board's decision or opinion may be announced orally by the Chairman.

### **Article 15**

#### Attendance of interpreters

If required, the Chairman of the Board shall make arrangements for interpreting during oral proceedings, the taking of evidence or the deliberations of the Board.

### **Article 16**

#### Deliberation and voting

(1) Only members of the Board shall participate in deliberations; the Chairman may, however, authorise other officers to attend. Deliberations shall be secret.

(2) During the deliberations between members of the Board, the opinion of the rapporteur shall be heard first, followed by that of the additional rapporteur if one has been appointed and, if the rapporteur is not the Chairman, the Chairman's last.

(3) If voting is necessary, votes shall be taken in the same sequence; even if the Chairman is the rapporteur, he shall vote last. Abstentions shall not be permitted.

### **Article 17**

Submission of case by the Board as composed under Rule 109, paragraph 2(a), EPC to the Board as composed under Rule 109, paragraph 2(b), EPC

If, in proceedings under Article 112a EPC, the Board as composed under Rule 109, paragraph 2(a), EPC fails after deliberation to reach the unanimous conclusion that the petition for review should be rejected as clearly inadmissible or unallowable, it shall submit the petition without delay and without comment as to its merit to the Board as composed under Rule 109, paragraph 2(b), EPC for decision.

### **Article 18**

#### Reasons for the decision or opinion

(1) Subject to Rule 109, paragraph 2(a), EPC the decision or opinion of the Board shall be in accordance with the votes of the majority of its members.

(2) In proceedings under Article 23, paragraph 1, first sentence, EPC or Article 112 EPC, the reasons for such decision or opinion may also indicate the opinions held by a minority of the members if a majority of the members of the Board agrees. Neither the names of the members forming any such minority nor the size of such minority may be indicated.

(3) The final decision of the Enlarged Board of Appeal in proceedings under Article 23, paragraph 1, first sentence, EPC may be published, due regard being taken of the confidentiality of the proceedings.



**Article 19**

Binding nature of the Rules of Procedure

These Rules of Procedure shall be binding upon the Enlarged Board of Appeal, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention.

**Article 20**

Entry into force

These Rules of Procedure shall enter into force on 1 April 2015.

Done at Munich, 19 March 2015

For the Enlarged Board of Appeal  
The Chairman

Wim VAN DER EIJK



## **2. Rules of Procedure of the Boards of Appeal of the European Patent Office**

Decision of the Administrative Council of 25 October 2007 approving amendments to the Rules of Procedure of the Boards of Appeal of the European Patent Office, OJ EPO 2007, 536

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention, and in particular Article 23, paragraph 4, thereof,

Having regard to the amendments to the Rules of Procedure of the Boards of Appeal, adopted on 12 September 2007 under Rule 10, paragraph 3, of the Implementing Regulations to the European Patent Convention,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

The amendments to the Rules of Procedure of the Boards of Appeal, as shown in the Annex to this decision, are hereby approved.

Done at Munich, 25 October 2007

For the Administrative Council  
The Chairman

Roland GROSSENBACHER

## ANNEX

### DECISION

Amendments to the Rules of Procedure of the Boards of Appeal, OJ EPO 1983, 7 as amended in OJ EPO 1989, 361, OJ EPO 2000, 316, OJ EPO 2003, 61, OJ EPO 2003, 89 and OJ EPO 2004, 541

In accordance with Rule 10, paragraph 3, of the Implementing Regulations to the European Patent Convention, the Presidium amends the Rules of Procedure of the Boards of Appeal. These amended Rules of Procedure read as follows:

#### **Article 1**

##### Business distribution and composition

(1) The Presidium referred to in Rule 12, paragraph 4, EPC, shall before the beginning of each working year draw up a business distribution scheme for the distribution among the Boards of Appeal of all appeals that may be filed during the year, designating the members who may serve on each Board and their respective alternates. The scheme may be amended during the working year.

(2) The Chairman of each Board of Appeal shall determine the composition of the Board for each particular case in accordance with the business distribution scheme.

#### **Article 2**

##### Replacement of members

(1) Members shall be replaced by alternates if they are prevented from participating, particularly as a result of sickness, excessive workload, and commitments which cannot be avoided.

(2) Any member requesting to be replaced by an alternate shall inform the Chairman of the Board concerned of his unavailability without delay.

(3) The Chairman of the Board may designate another member of the Board to replace him or her as Chairman in a particular appeal in accordance with the business distribution scheme.

#### **Article 3**

##### Exclusion and objection

(1) If a Board has knowledge of a possible reason for exclusion or objection which does not originate from a member himself or from any party to the proceedings, then the procedure of Article 24, paragraph 4, EPC shall be applied.

(2) The member concerned shall be invited to present his comments as to whether there is a reason for exclusion.

(3) Before a decision is taken on the exclusion of the member, there shall be no further proceedings in the case.

#### **Article 4**

##### Procedural compliance

(1) The Chairman shall for each appeal designate a member of the Board or himself to consider the admissibility of the appeal.

(2) The Chairman or a member designated by him shall ensure that the parties comply with these Rules and with directions of the Board and shall propose action to be taken as appropriate.

#### **Article 5**

##### Rapporteurs

(1) The Chairman of each Board shall for each appeal designate a member of his Board, or himself, as rapporteur. If appropriate in the light of the subject-matter of the case, the Chairman may designate an additional rapporteur.

(2) If an additional rapporteur is appointed, the steps referred to in paragraphs 3 to 5 shall be taken by the rapporteur and additional rapporteur jointly unless the Chairman directs otherwise.

(3) The rapporteur shall carry out a preliminary study of the appeal and may prepare communications to the parties subject to the direction of the Chairman of the Board. Communications shall be signed by the rapporteur on behalf of the Board.

(4) The rapporteur shall make the preparations for meetings of the Board and for oral proceedings.

(5) The rapporteur shall draft decisions.

(6) If a rapporteur or additional rapporteur considers that his knowledge of the language of the proceedings is insufficient for drafting communications or decisions, he may draft these in one of the other official languages. His drafts shall be translated by the European Patent Office into the language of the proceedings and the translations shall be checked by the rapporteur or by another member of the Board concerned.

#### **Article 6**

##### Registries

(1) Registries shall be established for the Boards of Appeal. Registrars shall be responsible for the discharge of the functions of the Registries. One of the Registrars shall be designated Senior Registrar.

(2) The Presidium referred to in Rule 12, paragraph 1, EPC may entrust to the Registrars the execution of functions which involve no technical or legal difficulties, in particular in relation to arranging for inspection of files, issuing summonses to oral proceedings and notifications and granting requests for further processing of applications.

(3) The Registrar shall report to the Chairman of the Board concerned on the admissibility of each newly filed appeal.

(4) Minutes of oral proceedings and of the taking of evidence shall be drawn up by the Registrar or such other employee of the Office as the Chairman may designate.

#### **Article 7**

##### Attendance of interpreters

If required, the Chairman of any Board shall make arrangements for interpretation during oral proceedings, the taking of evidence or the deliberations of his Board.

#### **Article 8**

##### Change in the composition of the Board

(1) If the composition of a Board is changed after oral proceedings, the parties to the proceedings shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board in its new composition. Fresh oral proceedings shall also be held if so requested by the new member and if the other members of the Board concerned have given their agreement.

(2) Each new member shall be bound to the same extent as the other members by an interim decision which has already been taken.

(3) If, when a Board has already reached a final decision, a member is unable to act, he shall not be replaced by an alternate. If the Chairman is unable to act, the member of the Board concerned having the longer or longest service on the Boards of Appeal, or in the case where members have the same length of service, the elder or eldest member, shall sign the decision on behalf of the Chairman.

#### **Article 9**

##### Enlargement of a Board of Appeal

If a Board of Appeal consisting of two technically qualified members and one legally qualified member considers that the nature of the appeal requires that the Board should consist of three technically qualified members and two legally qualified members, the decision to enlarge the Board shall be taken at the earliest possible stage in the examination of that appeal.

### **Article 10**

#### Consolidation of appeal proceedings

(1) If several appeals are filed from a decision, these appeals shall be considered in the same proceedings.

(2) If appeals are filed from separate decisions and all the appeals are designated to be examined by one Board in a common composition, that Board may deal with those appeals in consolidated proceedings with the consent of the parties.

### **Article 11**

#### Remission to the department of first instance

A Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

### **Article 12**

#### Basis of Proceedings

(1) Appeal proceedings shall be based on

(a) the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC;

(b) in cases where there is more than one party, any written reply of the other party or parties to be filed within four months of notification of the grounds of appeal;

(c) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board.

(2) The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on. All documents referred to shall be

(a) attached as annexes insofar as they have not already been filed in the course of the grant, opposition or appeal proceedings or produced by the Office in said proceedings;

(b) filed in any event to the extent that the Board so directs in a particular case.

(3) Subject to Articles 113 and 116 EPC the Board may decide the case at any time after filing of the statement of grounds of appeal or, in cases where there is more than one party, after the expiry of the time limit in (1)(b).

(4) Without prejudice to the power of the Board to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first instance

proceedings, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2).

(5) Extension of time limits may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request.

### **Article 13**

#### Amendment to a party's case

(1) Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.

(2) Other parties shall be entitled to submit their observations on any amendment not held inadmissible by the Board ex officio.

(3) Amendments sought to be made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party or parties cannot reasonably be expected to deal with without adjournment of the oral proceedings.

### **Article 14**

#### Interventions

Articles 12 and 13 shall apply mutatis mutandis to interventions commenced while an appeal is pending.

### **Article 15**

#### Oral Proceedings

(1) If oral proceedings are to take place, the Board may send a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings.

(2) A change of date for oral proceedings may exceptionally be allowed in the Board's discretion following receipt of a written and reasoned request made as far in advance of the appointed date as possible.

(3) The Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case.

(4) The Chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct.



(5) When a case is ready for decision during oral proceedings, the Chairman shall state the final requests of the parties and declare the debate closed. No submissions may be made by the parties after the closure of the debate unless the Board decides to re-open the debate.

(6) The Board shall ensure that each case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary. Before the oral proceedings are closed, the decision may be announced orally by the Chairman.

### **Article 16**

#### Costs

(1) Subject to Article 104, paragraph 1, EPC, the Board may on request order a party to pay some or all of another party's costs which shall, without limiting the Board's discretion, include those incurred by any .

(a) amendment pursuant to Article 13 to a party's case as filed pursuant to Article 12, paragraph 1;

(b) extension of a time limit;

(c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings;

(d) failure to comply with a direction of the Board;

(e) abuse of procedure.

(2) The costs ordered to be paid may be all or part of those incurred by the receiving party and may inter alia be expressed as a percentage or as a specific sum. In the latter event, the Board's decision shall be a final decision for the purposes of Article 104, paragraph 3, EPC. The costs ordered may include costs charged to a party by its professional representative, costs incurred by a party itself whether or not acting through a professional representative, and the costs of witnesses or experts paid by a party but shall be limited to costs necessarily and reasonably incurred.

### **Article 17**

#### Communications to the parties

(1) In the written phase of proceedings, replies to requests and directions on matters of procedure shall be given by means of communications.

(2) If a Board deems it expedient to communicate with the parties regarding a possible appreciation of substantive or legal matters, such communication shall be made in such a way as not to imply that the Board is in any way bound by it.

### **Article 18**

#### EPO President's right to comment

The Board may, on its own initiative or at the written, reasoned request of the President of the European Patent Office, invite him to comment in writing or orally on questions of general interest which arise in the course of proceedings pending before it. The parties shall be entitled to submit their observations on the President's comments.

### **Article 19**

#### Deliberation and voting

(1) If the members of a Board are not all of the same opinion, the Board shall meet to deliberate regarding the decision to be taken. Only members of the Board shall participate in the deliberations; the Chairman may, however, authorise other officers to attend. Deliberations shall be secret.

(2) During the deliberations between members of the Board, the opinion of the rapporteur shall be heard first, followed by that of the additional rapporteur if one has been appointed and, if the rapporteur is not the Chairman, the Chairman's last.

(3) If voting is necessary, votes shall be taken in the same sequence; even if the Chairman is the rapporteur, he shall vote last. Abstentions shall not be permitted.

### **Article 20**

#### Deviations from an earlier decision of any Board or from the Guidelines

(1) Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention given in an earlier decision of any Board, the grounds for this deviation shall be given, unless such grounds are in accordance with an earlier opinion or decision of the Enlarged Board of Appeal. The President of the European Patent Office shall be informed of the Board's decision.

(2) If, in its decision, a Board gives a different interpretation of the Convention to that provided for in the Guidelines, it shall state the grounds for its action if it considers that this decision will be more readily understood in the light of such grounds.

### **Article 21**

#### Deviation from an earlier decision or opinion of the Enlarged Board of Appeal I

Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier opinion or decision of the Enlarged Board of Appeal, the question shall be referred to the Enlarged Board of Appeal.

**Article 22**

Referral of a question to the Enlarged Board of Appeal

(1) If a point is to be referred to the Enlarged Board of Appeal, a decision to this effect shall be taken by the Board concerned.

(2) The decision shall contain the items specified in Rule 102, sub-paragraphs (a), (b), (c), (d) and (f), EPC and the point which the Board refers to the Enlarged Board of Appeal. The context in which the point originated shall also be stated.

(3) The decision shall be communicated to the parties.

**Article 23**

Binding nature of the Rules of Procedure

These Rules of Procedure shall be binding upon the Boards of Appeal, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the Convention.

**Article 24**

Entry into force

These Rules of Procedure shall enter into force upon entry into force of the revised text of the European Patent Convention in accordance with Article 8 of the Revision Act.

Done at Munich on 12 September 2007

For the Presidium

The Chairman

Peter MESSERLI



### 3. Transitional provisions

Article 7 of the Act revising the EPC of 29 November 2000

#### **Article 7**

##### Transitional provisions

(1) The revised version of the Convention shall apply to all European patent applications filed after its entry into force, as well as to all patents granted in respect of such applications. It shall not apply to European patents already granted at the time of its entry into force, or to European patent applications pending at that time, unless otherwise decided by the Administrative Council of the European Patent Organisation.

(2) The Administrative Council of the European Patent Organisation shall take a decision under paragraph 1 no later than 30 June 2001, by a majority of three quarters of the Contracting States represented and voting. Such decision shall become an integral part of this Revision Act.

#### **Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000**

The Administrative Council of the European Patent Organisation, having regard to Article 7, paragraph 2, of the Act revising the European Patent Convention of 29 November 2000 ("Revision Act"), on a proposal from the President of the European Patent Office, having regard to the opinion of the Committee on Patent Law, has decided as follows:

#### **Article 1**

In accordance with Article 7, paragraph 1, second sentence, of the Revision Act, the following transitional provisions shall apply to the amended and new provisions of the European Patent Convention specified below:

1. Articles 14(3) to (6), 51, 52, 53, 54(3) and (4), 61, 67, 68 and 69, the Protocol on the Interpretation of Article 69, and Articles 70, 86, 88, 90, 92, 93, 94, 97, 98, 106, 108, 110, 115, 117, 119, 120, 123, 124, 127, 128, 129, 133, 135, 137 and 141 shall apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time. However, Article 54(4) of the version of the Convention in force before that time shall continue to apply to these applications and patents.

2. Articles 65, 99, 101, 103, 104, 105, 105a-c and 138 shall apply to European patents already granted at the time of their entry into force and to European patents granted in respect of European patent applications pending at that time.

3. Article 54(5) shall apply to European patent applications pending at the time of its entry into force, in so far as a decision on the grant of the patent has not yet been taken.

4. Article 112a shall apply to decisions of the Boards of Appeal taken as from the date of its entry into force.

5. Articles 121 and 122 shall apply to European patent applications pending at the time of their entry into force and to European patents already granted at that time, in so far as the time limits for requesting further processing or reestablishment of rights have not yet expired at that time.

6. Articles 150 to 153 shall apply to international applications pending at the time of their entry into force. However, Articles 154(3) and 155(3) of the version of the Convention in force before that time shall continue to apply to these applications.

## **Article 2**

This decision shall enter into force upon the entry into force of the revised text of the Convention in accordance with Article 8 of the Revision Act.

## 4. Cross-reference list EPC 1973 - EPC 2000

The concordance list compares the thematically corresponding provisions of the current Convention and Implementing Regulations with the Articles and Rules of the EPC 2000.

### Article EPC 1973:

Convention on the Grant of European Patents of 5.10.1973, text as amended by the Act revising Article 63 EPC and by decisions of the Administrative Council of 21.12.1978, 13.12.1994, 20.12.1995, 5.12.1995, 10.12.1998 and 27.10.2005

### Article EPC 2000:

European Patent Convention 2000 as adopted by decision of the Administrative Council of 28.6.2001

### Rule EPC 1973:

Implementing Regulations to the EPC 1973, as last amended by decision of the Administrative Council of 9.12.2004

### Rule EPC 2000:

Implementing Regulations to the EPC 2000 as adopted by decision of the Administrative Council of 7.12.2006

### elmts:

Only certain elements of the provisions correspond

## Article EPC 1973 → Article / Rule EPC 2000

-	Art. 4a
Art. 16 (elmts)	R. 10
Art. 18(1) (elmts)	R. 10
Art. 52(4)	Art. 53(c)
Art. 54(4)	-
Art. 54(5)	Art. 54(4)
-	Art. 54(5)
Art. 61(1) (elmts)	R. 16
Art. 77(elmts)	R. 37
Art. 78(2)	R. 38
Art. 79(2), (3)	R. 39
Art. 80	R. 40
Art. 88(1) (elmts)	R. 53
Art. 91(1) - (3)	Art. 90(3) - (5); R. 57
Art. 91(5)	Art. 90(5); R. 60
Art. 92(2)	R. 65
Art. 93(2)	R. 68
Art. 94(2), (3)	R. 70
Art. 95	-
Art. 96(1)	R. 70
Art. 96(2), (3)	Art. 94(3), (4)
Art. 99(3)	R. 75
Art. 99(4), (5)	Art. 99(3), (4)
Art. 102(1), (2)	Art. 101(2)
Art. 102(3)	Art. 101(3)(a)
Art. 105 (elmts)	R. 89
-	Art. 105a - c
Art. 106(2)	R. 98
Art. 106(4), (5)	R. 97
Art. 110(2), (3)	R. 100(2), (3)
-	Art. 112a
Art. 115 (elmts)	R. 114
Art. 117(2)	R. 119
Art. 117(4) - (6)	R. 120
Art. 121(2), (3)	R. 135
Art. 122(2) - (5)	R. 136
Art. 126	-
Art. 134(8)	Art. 134a
Art. 135(2)	R. 155
Art. 136(1), (2) (elmts)	R. 155
Art. 136(2)	Art. 135(2), (4)
-	Art. 149a
Art. 151(1)	R. 157
Art. 152	R. 157

Art. 153(2)	R. 159
Art. 154	Art. 152
Art. 155	Art. 152
Art. 156	Art. 153(1)
Art. 157(1) - (3)	Art. 153(6), (7)
Art. 158	Art. 153(3) - (5)
Art. 159	-
Art. 160	-
Art. 160(2)	Art. 11(5)
Art. 161	-
Art. 162	-
Art. 163(1) - (4), (6)	Art. 134(3), (4), (7)
Art. 163(5), (7)	-
Art. 167	-

**Rule EPC 1973 →****Rule EPC 2000**

-	R. 1
-	R. 2
R. 1	R. 3
R. 2	R. 4
R. 4 (elmts)	R. 36(2)
R. 5	R. 5
R. 6	R. 6
R. 7	R. 7
R. 8	R. 8
-	R. 10
R. 9	R. 11
R. 10	R. 12
R. 11	R. 13
R. 12	R. 9
R. 13(1) - (3), (5)	R. 14
R. 13(4)	R. 78
R. 14	R. 15
-	R. 16
R. 15(1), (2)	R. 17
R. 15(3)	-
R. 16(1), (2)	R. 18
R. 16(3)	R. 78
R. 17	R. 19
R. 18	R. 20
R. 19	R. 21
R. 20	R. 22
R. 21	R. 23
R. 22	R. 24
R. 23	R. 25

R. 23a	-
R. 23b	R. 26
R. 23c	R. 27
R. 23d	R. 28
R. 23e	R. 29
R. 24	R. 35
R. 25	R. 36
R. 26	R. 41
R. 27	R. 42
R. 27a(1), (4)	R. 30
R. 27a(2), (3)	-
R. 28(1), (2)	R. 31
R. 28(4), (5)	R. 32
R. 28(3), (6) - (9)	R. 33
R. 28a	R. 34
R. 29	R. 43
R. 30	R. 44
R. 31	R. 45
R. 32	R. 46
R. 33	R. 47
R. 34	R. 48
R. 35	R. 49
R. 36	R. 50
R. 37	R. 51
R. 38(1), (2), (6)	R. 52
R. 38(3) - (5)	R. 53
R. 38a	R. 54
R. 39	R. 55
R. 40	R. 57
R. 41	R. 57; R. 58
-	R. 59
R. 42	R. 60
R. 43	R. 56
R. 44	R. 61
R. 44a	R. 62
R. 45	R. 63
R. 46	R. 64
-	R. 65
R. 47	R. 66
R. 48	R. 67
R. 49	R. 68
R. 50	R. 69
R. 51(1)	R. 70(2)
R. 51(2) - (11)	R. 71
R. 52	R. 72
R. 53	R. 73
R. 54	R. 74



-	R. 75
R. 55	R. 76
R. 56	R. 77
-	R. 78
R. 57	R. 79
R. 57a	R. 80
R. 58(1) - (3)	R. 81
R. 58(4) - (8)	R. 82
R. 59	R. 83
R. 60	R. 84
R. 61	R. 85
R. 61a	R. 86
R. 62	R. 87
R. 62a	R. 87
R. 63	R. 88
-	R. 89 - 98
R. 64	R. 99
R. 65	R. 101
R. 66(1)	R. 100(1)
R. 66(2)	R. 102
R. 67	R. 103
-	R. 104 - 110
R. 68	R. 111
R. 69	R. 112
R. 70	R. 113
-	R. 114
R. 71	R. 115
R. 71a	R. 116
R. 72(1)	R. 117
R. 72(2)	R. 118
R. 72(3), (4)	R. 119
-	R. 120
R. 73	R. 121
R. 74	R. 122
R. 75	R. 123
R. 76	R. 124
R. 77	R. 125
R. 78	R. 126
-	R. 127
R. 79	R. 128
R. 80	R. 129
R. 81	R. 130
R. 82	R. 125(4)
R. 83	R. 131
R. 84	R. 132
R. 84a	R. 133
R. 85	R. 134

R. 85a	-
R. 85b	-
-	R. 135
-	R. 136
R. 86	R. 137
R. 87	R. 138
R. 88	R. 139
R. 89	R. 140
R. 90	R. 142
R. 91	-
R. 92	R. 143
R. 93	R. 144
R. 94	R. 145
R. 95	R. 146
R. 95a	R. 147
R. 96	-
R. 97	R. 148
R. 98	R. 149
R. 99	R. 150
R. 100	R. 151
R. 101	R. 152
-	R. 153
R. 102	R. 154
-	R. 155
R. 103	R. 156
R. 104	R. 157
R. 105	R. 158
R. 106	-
R. 107	R. 159
R. 108	R. 160
R. 109	R. 161
R. 110	R. 162
R. 111	R. 163
R. 112	R. 164
-	R. 165

**Rule EPC 2000 →  
Article or Rule EPC 1973**

R. 1	-
R. 2	-
R. 3	R. 1
R. 4	R. 2
R. 5	R. 5
R. 6	R. 6
R. 7	R. 7
R. 8	R. 8

R. 9	R. 12	R. 56	R. 43
R. 10	Art. 16; Art. 18(1)	R. 57	Art. 91(1); R. 40, 41
R. 11	R. 9	R. 58	Art. 91(1); R. 40, 41
R. 12	R. 10	R. 59	-
R. 13	R. 11	R. 60	R. 42
R. 14	R. 13(1) - (3), (5)	R. 61	R. 44
R. 15	R. 14	R. 62	R. 44a
R. 16	Art. 61(1)	R. 63	R. 45
R. 17	R. 15(1), (2)	R. 64	R. 46
R. 18	R. 16(1), (2)	R. 65	Art. 92(2)
R. 19	R. 17	R. 66	R. 47
R. 20	R. 18	R. 67	R. 48
R. 21	R. 19	R. 68	Art. 93(2); R. 49
R. 22	R. 20	R. 69	R. 50
R. 23	R. 21	R. 70	Art. 94(2), (3); Art. 96(1); R. 51(1)
R. 24	R. 22	R. 71	R. 51(2) - (11)
R. 25	R. 23	R. 72	R. 52
R. 26	R. 23b	R. 73	R. 53
R. 27	R. 23c	R. 74	R. 54
R. 28	R. 23d	R. 75	Art. 99(3)
R. 29	R. 23e	R. 76	R. 55
R. 30	R. 27a(1), (4)	R. 77	R. 56
R. 31	R. 28(1), (2)	R. 78	R. 13(4); R. 16(3)
R. 32	R. 28(4), (5)	R. 79	R. 57
R. 33	R. 28(3),(6) - (9)	R. 80	R. 57a
R. 34	R. 28a	R. 81	R. 58(1) - (3)
R. 35	R. 24	R. 82	R. 58(4) - (8)
R. 36	R. 4; R. 25	R. 83	R. 59
R. 37	Art. 77	R. 84	R. 60
R. 38	Art. 78(2)	R. 85	R. 61
R. 39	Art. 79(2), (3)	R. 86	R. 61a
R. 40	Art. 80	R. 87	R. 62; R. 62a
R. 41	R. 26	R. 88	R. 63
R. 42	R. 27	R. 89	Art. 105
R. 43	R. 29	R. 90	-
R. 44	R. 30	R. 91	-
R. 45	R. 31	R. 92	-
R. 46	R. 32	R. 93	-
R. 47	R. 33	R. 94	-
R. 48	R. 34	R. 95	-
R. 49	R. 35	R. 96	-
R. 50	R. 36	R. 97	Art. 106(4), (5)
R. 51	R. 37	R. 98	Art. 106(2)
R. 52	R. 38(1), (2), (6)	R. 99	R. 64
R. 53	R. 38(3) - (5)	R. 100	Art. 110(2), (3); R. 66(1)
R. 54	R. 38a		
R. 55	R. 39		

## 4. Cross-reference list EPC 1973 - EPC 2000

R. 101	R. 65	R. 134	R. 85
R. 102	R. 66(2)	R. 135	Art. 121(2), (3)
R. 103	R. 67	R. 136	Art. 122(2) - (5)
R. 104	-	R. 137	R. 86
R. 105	-	R. 138	R. 87
R. 106	-	R. 139	R. 88
R. 107	-	R. 140	R. 89
R. 108	-	R. 141	Art. 124(1)
R. 109	-	R. 142	R. 90
R. 110	-	R. 143	R. 92
R. 111	R. 68	R. 144	R. 93
R. 112	R. 69	R. 145	R. 94
R. 113	R. 70	R. 146	R. 95
R. 114	Art. 115	R. 147	R. 95a
R. 115	R. 71	R. 148	R. 97
R. 116	R. 71a	R. 149	R. 98
R. 117	R. 72(1)	R. 150	R. 99
R. 118	R. 72(2)	R. 151	R. 100
R. 119	Art. 117(2); R. 72(3), (4)	R. 152	R. 101
R. 120	Art. 117(4) - (6)	R. 153	-
R. 121	R. 73	R. 154	R. 102
R. 122	R. 74	R. 155	Art. 135(2); Art. 136(1), (2)
R. 123	R. 75	R. 156	R. 103
R. 124	R. 76	R. 157	Art. 151(1); Art. 152; R. 104
R. 125	R. 77; R. 82	R. 158	R. 105
R. 126	R. 78	R. 159	Art. 153(2); R. 107
R. 127	-	R. 160	R. 108
R. 128	R. 79	R. 161	R. 109
R. 129	R. 80	R. 162	R. 110
R. 130	R. 81	R. 163	R. 111
R. 131	R. 83	R. 164	R. 112
R. 132	R. 84	R. 165	-
R. 133	R. 84a		



## 5. General Index

### A

#### **Abandonment of subject-matter in examination procedure, 902**

Claims fees, non-payment, 903

#### **Absence from oral proceedings, 948**

**Abusive conduct, evidence, 691**

#### **Accelerated processing before boards of appeal, 1068**

#### **Acceleration of opposition proceedings, infringement proceedings, 1055**

#### **Accidental anticipation, 429**

#### **Accidental disclosure, 112**

#### **Added subject-matter, amendments, 401**

Addition of prior art citations to description, 446

Addition of advantages and effects, 446

Addition of new claim category, 446

Broadening of claim by deleting a feature, 449

Cross-references to other documents, 404

Description, 453

Different sets of claims for different contracting states, 405

Disclaimers, 425

Drawings, 453

Errors in disclosure, amendments, 452

Generalisations, 437

Gold standard: directly and unambiguously derivable, 405

Implicit disclosure, 405

Insertion of ambiguous feature in claim, 447

Intermediate generalisation, 439

Interpretation of content of application as filed, 402

Languages, 404

Lists and singling out combination of features, 419

Non-technical subject-matter, 414

Novelty test, 412

Original disclosure, 407

Priority documents, 402

Ranges of parameters, setting upper and lower limits, 414

Reformulating the technical problem, 458

Replacement or removal of features from claim, 448

Skilled person, reflection and imagination, 402

The essentiality and the three-point test, 409

#### **Addition of advantages and effects, 446**

#### **Addition of new claim category, 446**

#### **Addition of prior art citations to description, 446**

#### **Additional period for renewal fees, 595**

#### **Additional search, 1157**

#### **Adjournment of oral proceedings, late submissions, 948**

#### **Administrative agreements under**

##### **Article 10(2)(a) EPC, 1276**

#### **Administrative notice with no legal consequences, legitimate expectations, 517**

#### **Administrative Council, 713**

#### **Admissibility of**

~ appeal, 1069

~ to be checked in every phase of appeal proceedings, 1108

Appealable decisions, 1070

Board competent to hear a case, 1074

Entitlement to appeal, 1076

Form of appeal, 1086

Interlocutory revision, 1109

Partial ~, 1108

Statement of grounds of appeal, 1095

Time limit for appeal, 1086

~ evidence, 656

Affidavits and statutory declarations, 660

Documentary evidence, 663

Expert opinions as means of evidence, 657

Statements in writing as means of evidence, 660

Witness testimony as means of evidence, 657

~ intervention, 967

Fees for intervention, 971

Intervention in appeal proceedings, 970

Intervention in opposition proceedings, 970

- National infringement proceedings, intervention, 968
- Time limit for intervention, 971
- ~ opposition, 1008, 1026, 1118
  - Entitlement to file opposition, 1008
  - Formal requirements for opposition, 1014
  - Formalities officer in opposition proceedings, 1026
  - Opposition inadmissible, 1027
  - Opposition period, 1014
  - Opposition procedure, 1008
  - Subject-matter under examination in appeal procedure, 1118
- ~ request for re-establishment of rights, 606
  - Inability to observe time limits and re-establishment of rights, 612
  - Omitted act and re-establishment of rights, 614
  - Request for re-establishment of rights, 614, 615
  - Time limits for filing request for re-establishment of rights, 606
- Advertising brochures and availability to the public, 79**
- Advertising, Code of Professional Conduct, 1263**
- Aesthetic creations, 14**
- Affidavits and statutory declarations, 660**
- Age of documents, 246**
- Aim to be achieved in formulation of technical problem, 207**
- Alleged advantages, 175**
- Allowability of appeal, reimbursement of appeal fee, 1190**
- Alternative solution to a known problem, 181**
- Ambiguous communication, 1204**
- Amended claims**
  - ~ filed during oral proceedings, 1134
    - Non-appearance at oral proceedings, 1137
  - ~ in appeal proceedings, 1127
    - Additional search, 1157
    - Amended claims after arrangement of oral proceedings, 1133
    - Amended claims clearly allowable, 1152
  - Converging or diverging versions of claims, 1154
  - Dependent claims, 1158
  - Divisional applications, amended claims not admitted, 1160
  - Number of auxiliary requests, 1159
  - Parties' right to submit observations on amendments, 1131
  - Procedural economy, 1130
  - Reinstating broader claims in appeal proceedings, 1160
  - Response to objections, amended claims, 1153
  - Rules of Procedure of the Boards of Appeal, amended claims in appeal proceedings, 1127
  - Search, amended claims, 1157
  - Unsubstantiated requests, 1132
  - ~ not examined at first instance, 1139
    - Amended claims admitted as a normal procedural development, 1147
    - Interlocutory revision, amended claims, 1151
    - Reintroduction of feature on appeal, 1151
- Amendments, 398**
  - Added subject-matter, ~, 401
  - Amendment after approval of text for grant, 898
  - ~ after decision to grant, 901
  - ~ in examination procedure, 894
    - Withdrawal of ~, 902
  - ~ in opposition proceedings, 1037
    - Amendments occasioned by national prior rights, 1040
    - Removal of error (in claim) in opposition proceedings, 1049
    - Scope of examination of amendments in opposition proceedings, 1046
  - ~ or corrections in examination procedure, 894
  - ~, priority, 373
  - ~ relating to unsearched subject-matter, 918
    - Amendments under Rule 137(5) EPC, 924
    - Non-compliance with Rule 137(5) EPC, 926
    - Search report, 920
  - ~ to Article 53 EPC, 36
  - ~ to divisional applications, 495
  - ~ under Rule 137(2) EPC, 862

- ~ under Rule 137(3) EPC, 872
  - Discretion of examining division, 872
- Change of claim category, ~, 470
- Correction of errors – Rule 139 EPC, 481
- Disclosure in drawings, ~, 453
- Errors in disclosure, ~, 452
- Extension of conferred protection, 459
- Handwritten ~, oral proceedings, 589
- Languages, ~, 404
- Novelty test, ~, 412
- Parties' right to submit observations on ~, 1131
- Patent application and ~, 261
- Protection, extension of, 459
- Relationship between Article 123(2) and Article 123(3) EPC, 475
- Standard of proof for allowing ~ and corrections, 489
- Amorphous forms as compared to crystalline forms in chemical inventions, 233**
- Analogy process, 238**
- Animal testing, 243**
- Animals and animal varieties, 45**
- Anonymously filed third-party observations, 778**
- Antibodies, sufficiency of disclosure, 349**
- Anticipation of certain compounds, 123**
- Apparatus claim, 55**
- Apparatus constituting a physical entity, 9**
- Appeal**
  - ~ against decisions of boards of appeal, 1073
  - ~ by patentee against revocation, 1120
  - ~ fee, 1095
    - Allowability of appeal, reimbursement of ~, 1190
    - Appeal inadmissible, reimbursement of ~, 1188
    - Competence to decide on reimbursement of ~, 1206
    - Error of judgment, reimbursement of ~, 1196
    - Inadequate reasons in decision at first instance, reimbursement of ~, 1196
    - Intervention in opposition appeal proceedings, reimbursement of ~, 1190
    - Legitimate expectations and reimbursement of ~, 1213
    - Oral proceedings, reimbursement of ~-s, 556, 1193
    - Partiality, reimbursement of ~, 1202
    - Reimbursement of ~, 1111, 1167, 1187
    - Reimbursement of ~ if equitable, 1209
    - Reimbursement of ~ in case of interlocutory revision, 1206
    - Reimbursement of ~ in case of request for re-establishment, 1189
    - Right to be heard, reimbursement of ~, 1195
    - Several appellants, reimbursement of ~-s, 1190
    - Suspensive effect of appeal, reimbursement of ~, 1203
    - Withdrawal of appeal, reimbursement of ~, 1189
  - ~ filed by wrong company, 1076
  - ~ filed in name of representative, 1076
  - ~ procedure, 1059
    - Admissibility of appeal, 1069
    - Amended claims in appeal proceedings, 1127
    - ~, requests, 721
    - Arguments under examination in ~, 1126
    - Ex officio examination of facts in appeal proceedings, 1124
    - Ex parte proceedings, 1123
    - Legal character of appeal procedure, 1065
    - Parallel proceedings, 1164
    - Reformatio in peius in ~, 1111
    - Reimbursement of appeal fee, 1187
    - Remittal to department of first instance, 1170
    - Review of first-instance discretionary decisions, appeal procedure, 1126
    - Subject-matter under examination in ~, 1118
    - Termination of appeal proceedings, 1164
- Appealable decisions, 1070**
  - Appeal against decisions of boards of appeal, 1073
  - Interlocutory decisions, 1073

**Appeals against decisions of Examination Board and Examination Secretariat, 1255**

- Complaints about conduct of examination, European qualifying examination, 1260
- Legitimate interest, European qualifying examination, 1259
- Marks awarded, European qualifying examination, 1256
- Time limit for appeal, European qualifying examination, 1256

**Appeals against decisions of the Disciplinary Board of Appeal, 1263****Applications**

- ~ by non-entitled persons, 791
- ~ giving rise to a right of priority, 368
  - Applications filed in or for a state party to the Paris Convention, priority, 368
  - Exercise of priority right for one contracting state, 371
  - Exhibition priority, 370
  - National deposit of industrial design, priority, 370
  - Postdating of previous application, 371
  - Priority right of applicant or successor-in-title, 368
- ~ with same filing or priority date, 70

**Apportionable costs, 1001**

Apportionment of costs, 1002

**Apportionment of costs, 589****Apportionment of costs, 981, 1002**

Apportionable costs, 1001, 1002

- ~ for reasons of equity where abuse of procedure, 952
- ~ not appealable alone, 1003
- Equity of different ~, 982
- Equity of different ~, late submissions, 983
- Proceedings before the EPO, 981
- Request for ~, 1000

**Approval of text by applicant, 888**

Decisions in absence of text submitted or agreed by the applicant, 890

**Arguments, reinforcement, 945****Arguments under examination in appeal procedure, 1126****Ascertaining differences, 115**

Distinguishing features, 116

**Assistants, presence at deliberations of the board, 589****Automation, inventive step, 240****Auxiliary request for oral proceedings, 565****Auxiliary requests, 716**

- Appeal procedure, requests, 721
- Examination procedure, requests, 719
- Filing of ~, 716
- Interlocutory decision on auxiliary request, 719
- Main and ~, 716
- Number of ~, 1159
- Opposition procedure, requests, 720
- Requests, admissibility, 717
- Requests, order of, 716
- Requests, refusal of and duty to give reasons, 718

**Availability to the public, 78**

- Advertising brochures and ~, 79
- Biological material and ~, 89
- Books and ~, 80
- Company papers and ~, 78
- Conferences and ~, 97
- Definition of the public, 90
- Instruction manuals and ~, 80
- Internet and ~, 83
- Lectures and oral disclosures and ~, 81
- Obligation to maintain secrecy, 92
- Patents and ~, 80
- Products and ~, 94, 95
- Proof, novelty, 99
- Public and ~, 90
- Public libraries and ~, 91
- Publications and ~, 78
- Reports in specialist field and ~, 80
- Samples/products for test purposes and ~, 96
- Utility models and ~, 80
- Ways of making information available to the public, 78

---

**B**

---

**Balance of probabilities, 683****Binding effect of decision, remittal, 1182**

- Department of first instance bound by decision of board of appeal, 1183
- Divisional applications, 1185



Remittal for continuation of proceedings, 1186  
 Remittal only for adaptation of description,  
 1185

**Biological inventions, 43**

Animals and animal varieties, 45  
 Essentially biological processes, 45  
 Microbiological processes, exceptions to  
 patentability, 50  
 Plants and plant varieties, 43

**Biological material and availability to the public, 89**

**Board competent to hear a case, 1074**

Legal Board of Appeal competent, 1075  
 Technical board of appeal competent, 1075

**Boards of appeal as judicial authorities, 1270**

Courts according to national case law, 1272  
 Courts of law under the EPC, 1270  
 Judicial or quasi-judicial authorities under  
 TRIPS Agreement, 1271  
 Tribunals under Article 6 European Convention  
 on Human Rights, 1270

**Bonus effect, 250**

**Booked holidays, postponement of oral proceedings, 571**

**Books and availability to the public, 80**

**Breach of Article 24 EPC, 1234**

**Breaches of ordre public or morality, 37**

Objection under Article 53(a) EPC, 41  
 Rule 28 EPC, 38

**Broad claims, 110, 274, 346**

~, inventive step, 231  
 Claims, clarity, 274  
 Clarity of disclosure, 346  
 Content of relevant prior art, 110

**Broadening of claim by deleting a feature, 449**

**Budapest Treaty, sufficiency of disclosure, 355**

**Burden of proof, 99, 267, 693, 1234**

Claim, independent per category, 267  
 Evidence, 693  
 Petition for review, 1234  
 Proof, novelty, 99  
 Shifting of ~, 700

**Business engagements, postponement of oral proceedings, 572**

---

**C**

---

**Calculation errors, 452**

**Calculation of time limits, 591**

Extension of time limits due to public holidays  
 or dislocation in delivery of mail, 593  
 Periods of grace and fee payments, 595  
 Rules relating to Fees, 593

**Carrying out invention, indication of one way, 333**

**Case law, legitimate expectations, 527**

**Categories of claims, 282**

**Change of claim category, amendments, 470**

Method claim, 473  
 Product claim, 470, 472, 473  
 Product-by-process claim, 472  
 Purpose-related product claim, 475  
 Swiss-type claim, 475  
 Use claim, 474, 475

**Change of representative and late submission, 957**

**Characterisation of a product by a parameter, 278**

**Chemical compounds, 122, 342**

Anticipation of certain compounds, 123  
 Enantiomers, 127  
 Novelty of ~, 122  
 Novelty of enantiomers, 127  
 Novelty of groups of substances, 125  
 Substances, 125

**Chemical inventions, 121, 229**

Amorphous forms as compared to crystalline  
 forms in ~, 233  
 Broad claims, inventive step, 231  
 Chemical compounds, 122  
 Intermediate products, 232  
 Novelty of chemical compounds, 122  
 Parameter ranges, 129  
 Problem and solution approach in ~, 229  
 Selection of parameter ranges, 129  
 Structural similarity in ~, 230  
 Substances, 122  
 Synergistic effects, 233

**Chosen type of starting point, 168**

**Claims, 261**

- Amended ~ admitted as a normal procedural development, 1147
- Amended ~ after arrangement of oral proceedings, 1133
- Amended ~ clearly allowable, 1152
- Amended ~ filed during oral proceedings, 1134
- Amended ~ in appeal proceedings, 1127
- Amended ~ not examined at first instance, 1139
- Broad ~, inventive step, 231
- Claim, independent per category, 265
  - Burden of proof, 267
- Claim interpretation, 464
- ~ and reading additional features into them, 292
- ~ and their purpose, 262
- ~, clarity, 270
  - Broad claims, 274
  - Categories of claims, 282
  - Characterisation of a product by a parameter, 278
  - Essential features, claims, 272
  - Functional features, claims, 275
  - Unspecified features, claims, 280
- ~ fees, 300
  - ~, non-payment, 903
  - ~, refund of, 301
  - Claims, number of, 300
- ~, forbidden area, 341
- ~, one-part or two-part form, 264
- ~ supported by the description, 284
  - Description, adaptation to claims, 286
- ~ to computer programs, 25
  - Computer programs recorded on the medium, 25
  - Exclusion of computer programs, 26
- ~, totality of, 459
- ~, two-part: preamble and characterising portion, 265
- Clarity in opposition proceedings, ~, 263
- Clarity of ~ and Article 83 EPC, 263
- Conciseness of ~, 263
- Content of ~, 263
- Converging or diverging versions of ~, 1154
- Dependent ~, 305, 1158
- Description and drawings to interpret ~, 289
- Different sets of ~ for different contracting states, 405
- Disclaimers, 283
- Divisional applications, amended ~ not admitted, 1160
- Form of ~, 263
- Independent ~, 303
- Interlocutory revision, amended ~, 1151
- Interpretation of ~, 287
- Markush ~, 319
- Meaning of terms in ~, 288
- Number of ~, 268
- Process ~, 150, 152
- Process ~ containing a purpose feature, 148
- Product ~ for plants, 48
- Product ~ with purpose characteristics, 156
- Product-by-process ~, 296
- Product-by-process ~ and their scope of protection, 299
- Product-by-process ~ and use claims, 299
- Reach-through ~, 339
- Reinstating broader ~ in appeal proceedings, 1160
- Remittal following substantial amendment to ~, 1174
- Response to objections, amended ~, 1153
- Rules of Procedure of the Boards of Appeal, amended ~ in appeal proceedings, 1127
- Scope of protection of product-by-process ~, 299
- Search, amended ~, 1157
- Statement of purpose in non-medical use ~, 156
- Sufficiency of disclosure and clarity of ~, 358
- Technical features, ~, 263
- Transposition of features within ~, 470
- Unity in context of different types of ~, 303
- Use ~ and process claims, 150

**Clarity, 333**

- Carrying out invention, indication of one way, 333
- Claims, ~, 270
- ~ in opposition proceedings, claims, 263
- ~ in relation to diagnostic methods, 64
- ~ of claims and Article 83 EPC, 263
- ~ of disclosure, 344
- Disclaimers, ~, 433

- Invention to be performed over whole range claimed, 335
- Parameters, sufficiency of disclosure, 335
- Sufficiency of disclosure and ~ of claims, 358
- Clarity of disclosure, 344**
- Broad claims, 346
- Implementing invention over whole scope of claim, showing one way, 345
- Repeatability, sufficiency of disclosure, 346
- Closest prior art, 163**
- Improvement of a production process for a known product, 170
- Old prior art documents as ~, 171
- Same purpose or effect, 164
- Selection of most promising starting point, 167
- Similarity of technical problem, 165
- Speculative character of ~, 170
- Closure of substantive debate in appeal proceedings, 1165**
- Decision taken as the file stands, 1165
- Code of Professional Conduct, 1262**
- Advertising, ~, 1263
- Professional obligations, ~, 1262
- Professional secrecy, ~, 1262
- Combination**
- ~ inventions, 223
- Partial problems, 224
- ~ of documents, 228
- ~ of features pertaining to separate embodiments, 419
- ~ of teachings, 226
- ~s within a prior art document, 104
- Commercial success, 247**
- Common general knowledge, 75**
- ~, priority, 374
- Databases as ~, 76
- Definition of ~, 75
- Patent specifications as ~, 76
- Proof of ~, 77
- Specialist journals as ~, 76
- Common representative, 806**
- Communication**
- ~ from examining division, failure to reply, 878
- Waiver by applicant of right to present comments, 879
- ~ of a board of appeal, 945
- ~ under Article 15(1) RPBA, 576
- ~ under Rule 111(2) EPC, 750
- ~ under Rule 71(3) EPC, 887
- ~s in examination procedure, 879
- Form of communication under Article 113(1) EPC, 884
- Informal ~, 885
- IPEER, examining procedure, 882
- ~s under Rule 71(1) and (2) EPC, 866
- Company in receivership, 1078**
- Company papers and availability to the public, 78**
- Comparative tests, 251**
- Competence**
- ~ of EPO as designated Office, 1266
- ~ of EPO as elected Office, 1266
- ~ of the board in its original composition, partiality, 730
- ~ to decide on reimbursement of appeal fee, 1206
- Complaints about conduct of examination, European qualifying examination, 1260**
- Complete case, 945**
- Complete disclosure, 333**
- Carrying out invention, indication of one way, 333
- Invention to be performed over whole range claimed, 335
- Parameters, sufficiency of disclosure, 335
- Completion of internal decision-making process, 747**
- Complexity of new subject-matter, late submissions, 941**
- Composition of**
- ~ competent departments of first instance, 744
- Examining division, composition, 744
- Opposition division, composition, 744
- ~ Enlarged Board in review procedure, 1233
- ~ Enlarged Board of Appeal, 1217
- ~ opposition division, 1177, 1200
- Remittal following substantial procedural violation, 1177
- Substantial procedural violation, 1200
- ~ product and public prior use, 88
- Computer programs, 17, 18**
- Claims to ~, 25
- ~ recorded on the medium, 25
- Computer-implemented inventions, 17, 18

- Exclusion of ~, 26
- Methods performed by a computer, 22
- Programming a computer, 19
- Simulation methods, 23
- Technical effect on a physical entity, 19
- Computer-generated communications, 759**
- Computer-generated presentations, oral proceedings, 582**
- Computer-implemented inventions, 16**
- Claims to computer programs, 25
- Computer programs, 17, 18
- Skilled person in field of ~, 192
- Comvik approach, 201**
- Conciseness of claims, 263, 268**
- Claim, independent per category, 265
- Claims, one-part or two-part form, 264
- Claims, two-part: preamble and characterising portion, 265
- Number of claims, 268
- Reference to description or drawings, 269
- Conference, postponement of oral proceedings, 572**
- Conferences and availability to the public, 97**
- Confidential prior art, 170**
- Consolidation of proceedings in examination procedure, 866**
- Content of**
  - ~ claims, 263
    - Claim, independent per category, 265
    - Claims, one-part or two-part form, 264
    - Claims, two-part: preamble and characterising portion, 265
    - Conciseness of claims, 268
    - Number of claims, 268
    - Reference to description or drawings, 269
  - ~ earlier application, divisional applications, 493
    - Languages and divisional applications, 495
    - Sequence of divisional applications, 494
  - ~ relevant prior art, 101
    - Accidental disclosure, 112
    - Broad claims, 110
    - Combinations within a prior art document, 104
    - Deficiencies in a disclosure, 111
    - Drawings and novelty, 109
    - Equivalents, 108
    - Examples and novelty, 110
    - Implicit features, 105
    - Intrinsic features, 108
    - Reproducibility of content of disclosure, 113
- Continuation of opposition proceedings by EPO, 973**
- Death of an opponent, 976
- Lapse of patent, 973
- Surrender of patent, 973
- Withdrawal of opposition, 976
- Continuation of oral proceedings on next day, 575**
- Contradictory acts and legitimate expectations, 519**
- Contribution approach, technical inventions, 5**
- Converging or diverging versions of claims, 1154**
- Correction**
  - ~ of decision already issued, 520
  - ~ of designation of applicant, 840
  - ~ of designation of states, 853
  - ~ of errors – Rule 139 EPC, 481
    - Correction of errors after grant and in opposition proceedings, 488
    - Obviousness of error and of correction, 483
    - Relationship of Rule 139 EPC to Article 123(2) EPC, 482
  - ~ of errors in decisions, 763
    - Errors in printed version of European patent specification, 765
    - Procedural status of third parties, 767
  - ~ of errors in divisional applications, 507
  - ~ of priority documents, 855
    - Request for correction, time limit for, 856
  - ~ of withdrawal of application, 906
  - ~s, 845
    - Amendments or ~ in examination procedure, 894
    - Receiving Section, ~, 847
    - Standard of proof for allowing amendments and ~, 489
- Cosmetic and beauty salons, 257**

**Costs, oral proceedings, 589**

Apportionment of costs, 589

**Could-would approach, 183****Courtesy service and legitimate expectations, 518****Courts according to national case law, 1272****Courts of law under the EPC, 1270****Cross-references to other documents, 404****Cut-off point, 462**

---

**D**

---

**Databases as common general knowledge, 76****Date**

~ of decision, 747

Completion of internal decision-making process, 747

Date on which European patent takes effect, 748

Entry into force of decisions, 747

~ of filing, 838, 847

Corrections, 845

~ attributed to divisional applications, 500

Identity of applicant, 840

Subsequent filing of missing parts of description or missing drawings, 842

~ of payment, 795

**Death of an opponent, 976****Debit orders, fees, 793****Decision**

~, inconsistency between oral and written decisions, 751

~, more than one issued, 750

~ taken as the file stands, 1165

~ to grant, date on which takes effect, 910

~ under Rule 112(2) EPC, 743

~s according to the state of the file, 757

~s in absence of text submitted or agreed by the applicant, 890

~s in written proceedings, 760

~s of EPO departments, 741

Composition of competent departments of first instance, 744

Date of decision, 747

Exercise of discretion, 761

Form of decisions, 748

Right to a decision after notification of loss of rights, 742

~s of opposition division, 1056

Interlocutory decisions, 1056

Revocation of European patent by way of decision, 1056

**Deemed withdrawal**

~, designation of states, 852

~ of application, 858

~ of patent application, 1169

**Defective disclosure, 169****Deficiencies in a disclosure, 111****Deficiencies in computerised systems, re-establishment of rights, 624****Definition of**

~ common general knowledge, 75

~ "plant varieties", 43

~ skilled person, 188

Group of people as skilled person, 190

Skilled person in biotechnology, 191

Skilled person in field of computer-implemented inventions, 192

~ the public, 90

Limited circle of people and availability to the public, 91

Person not skilled in the art, availability to, 90

Public libraries and availability to the public, 91

~ "time limit" in re-establishment of rights, 604

Designation of states and re-establishment of rights, 604

Divisional applications, re-establishment of rights, 604

**Deletion of**

~ disclaimer, 466

~ drawings, 466

~ examples for a general feature, 465

~ feature from claim, 464

~ important feature from description, 465

**Department of first instance bound by decision of board of appeal, 1183****Dependent claims, 305, 1158**

Amended claims in appeal proceedings, 1158

Unity in context of different types of claims, 305

**Deposit number, late submission, 355**

**Deposit of living material, 353**

Budapest Treaty, sufficiency of disclosure, 355

Deposit number, late submission, 355

**Description, 453**

Addition of prior art citations to ~, 446

Claims supported by the ~, 284

Deletion of important feature from ~, 465

~, adaptation to claims, 286

~ and drawings to interpret claims, 289

Disclosure in drawings, amendments, 453

Reference to ~ or drawings, 269

Remittal only for adaptation of ~, 1185

Replacement of complete ~ and drawings, 457

Subsequent filing of missing parts of ~ or missing drawings, 842

Sufficiency of disclosure and support from ~, 356

**Description and drawings to interpret claims, 289**

Claims and reading additional features into them, 292

Interpretation of ambiguous terms, 291

Relevance of Article 69 EPC, 290

Scope of protection and infringement, 295

**Designation**

~ fee, non-payment, 852

Deemed withdrawal, designation of states, 852

Designation of states in divisional applications, 852

~ of contracting states in divisional application, 506

~ of inventor, 850

~ of states, 851

Correction of ~, 853

Deemed withdrawal, ~, 852

~ and re-establishment of rights, 604

~ in divisional applications, 852

**Devolutive effect of appeal, 1067****Diagnostic methods, 51, 62**

Clarity in relation to ~, 64

Medical practitioner, 52, 63

**Different**

~ decisions, 1223

~ sets of claims for different contracting states, 405

~ values, 117

**Disadvantageous modifications, inventive step, 239****Disciplinary matters, 1260**

Disciplinary measures, 1260

**Disclaimers, 56, 237, 283, 425**

Accidental anticipation, 429

Added subject-matter, amendments, 425

Claims, 283

~, clarity, 433

~, disclosed, 429

~, drafting of, 431

~, priority, 373

~, restoration of novelty, 433

~, undisclosed, 428

Inventive step, 237

Notion of disclaimer, 425

Surgical methods, 56

**Disclosure**

~ in drawings, amendments, 453

~ in previous application as a whole, 373

~ in priority document enabling, 385

~ of essential features, 377

~ of essential features in priority document, 375

Non-disclosure of essential features, 375

~, see Sufficiency of disclosure, 327

Clarity, 333

Complete disclosure, 333

Evidence, sufficiency of disclosure, 362

Relationship between Article 83 and Article 84 EPC, 356

Relevant date, sufficiency of disclosure, 328

Relevant parts of application, sufficiency of disclosure, 329

Reproducibility, sufficiency of disclosure, 338

Skilled person, relevant knowledge, 330

Sufficiency of disclosure in biotechnology field, 344

**Discoveries, 12**

Mathematical methods, 12

Scientific theories, 12

**Discretion of examining division, 872****Discretion of President, 1223****Dislocation in delivery of mail, 593**

Extension of time limits due to public holidays or ~, 593

**Distinguishing features, 116**

Different values, 117  
 Functional features, 119  
 Generic disclosure, 120  
 Non-technical ~, 121  
 Parameters, 119  
 Product claim with process features, 120

**Divisional applications, 491, 1185**  
 Amendments to ~, 495  
 Binding effect of decision, remittal, 1185  
 Content of earlier application, ~, 493  
 Correction of errors in ~, 507  
 Date of filing attributed to ~, 500  
 Designation of contracting states in divisional application, 506  
 Designation of states in ~, 852  
 ~, amended claims not admitted, 1160  
 ~ applicability of Article 54(3) EPC, 71  
 ~, re-establishment of rights, 604  
 ~, subject-matter, 493  
 Double patenting, 508  
 Filing ~, 499  
 Independence of ~, 505  
 Languages and ~, 495  
 Patent application and amendments, 491  
 Pendency of earlier application, ~, 501  
 Res judicata and ~, 497  
 Search fees for divisional application, 508  
 Sequence of ~, 494

**Divisional applications, subject-matter, 493**  
 Amendments to divisional applications, 495  
 Content of earlier application, divisional applications, 493  
 Res judicata and divisional applications, 497  
 Subject-matter of patent granted on divisional application, 496

**Documentary evidence, 663**

**Documents and evidence withheld, 949**

**Double patenting, 508**

**Draft decisions, 760**

**Drawings, 453**  
 Deletion of ~, 466  
 Description and ~ to interpret claims, 289  
 Disclosure in ~, amendments, 453  
 ~ and novelty, 109  
 Reference to description or ~, 269

Replacement of complete description and ~, 457

Replacement of ~, 468

Subsequent filing of missing parts of description or missing ~, 842

**Due care**

~ and re-establishment of rights, 617, 624  
 Due care in using mail delivery services, 638  
 Due care on part of applicant, 625  
 Due care on part of non-European representative, 632  
 Due care on part of professional representative, 626  
 ~ in dealing with assistants, 632  
 Responsibility of representative, re-establishment of rights, 636

---

**E**

---

**Electronic filing of appeal, 1086****Electronic filing of documents, legitimate expectations, 524****Employee, re-establishment of rights, 623, 624**

Isolated mistake within a satisfactory system, re-establishment of rights, 623, 624

**Enantiomers, 127**

Novelty of ~, 127

**Enhanced effect, inventive step, 240****Enlarged Board of Appeal, 1215**

Petition for review, 1226

Referral under Article 112 EPC, 1217

Removal from office of a board member, 1245

**Enlargement and reduction of opposition division, 746****Entitlement to appeal, 1076**

Appeal filed by wrong company, 1076

Appeal filed in name of representative, 1076

Company in receivership, 1078

Parties to appeal proceedings, procedural status, 1083

Party adversely affected, 1078

**Entitlement to file opposition, 1008**

Joint opposition, 1012

Multiple oppositions by different persons, 1012

Opposition by patent proprietor, 1009  
Straw man, opposition procedure, 1010

**Entry into force of decisions, 747**

**Envisageable product, 238**

**EPO as PCT authority, Euro-**

**PCT applications, 1265**

Competence of EPO as designated Office,  
1266

Competence of EPO as elected Office, 1266

Jurisdiction of boards of appeal, 1265

Language of proceedings, EPO as designated  
or elected Office, 1268

**Equity of different apportionment of costs,  
982**

~, late submissions, 983

Non-appearance at oral proceedings, 990

Postponement of oral proceedings, 994

Withdrawal of appeal, 998

Withdrawal of opposition, 998

**Equity of different apportionment of costs,  
late submissions, 983**

**Equivalents, 108**

~, inventive step, 233

**Errors**

Error margins and definitions of limits, priority,  
379

Error of judgment, reimbursement of appeal  
fee, 1196

~ in disclosure, amendments, 452

Calculation errors, 452

Structural formula incorrect, 452

~ in Patent Bulletin, 912

~ in printed version of European patent  
specification, 765

**Essential features, claims, 272**

**Essentially biological processes, 45**

~ for the production of animals, 46

~ for the production of plants, 46

Patentable technical processes, 47

Product claims for plants, 48

**Euro-PCT applications, 324**

EPO as PCT authority, ~, 1265

Non-unity under former R. 164 EPC, 324

**European**

~ Convention on Human Rights, 711, 724  
Interpretation of the EPC, 711

Partiality, 724

Tribunals under Article 6 ECHR, 1270

~ patent application and language privilege,  
651

~ Patent Register, 768, 771

Inspection of files, 768

Registration of licences in Patent  
Register, 771

Stay of proceedings, 773

Transfers and Patent Register, 772

~ qualifying examination, 1249

Appeals against decisions of Examination  
Board and Examination Secretariat,  
1255

Complaints about conduct of examination,  
~, 1260

Examination conditions, ~, 1252

Examination grades, ~, 1254

Legitimate interest, ~, 1259

Marking answer papers, ~, 1253

Marks awarded, ~, 1256

Registration and enrolment conditions, ~,  
1249

Substantiation of EQE decisions, 1255

Time limit for appeal, ~, 1256

**Evaluation of evidence, 100, 674**

Evidence, 674

Evidence, other written, 681

Internet and proof of date of availability, 100

Internet archives, 680

Internet publications, 680

Principle of free ~, 674

Proof, novelty, 100

Public prior use, 100

Standard of proof, 683

Test and experimental evidence, 678

Witness testimony, 676

Written statements, 676

**Everyday items from a different technical  
field, 196**

**Evidence, 653**

Abusive conduct, ~, 691

Admissibility of ~, 656

Burden of proof, 693

Documentary ~, 663

Documents and ~ withheld, 949

Evaluation of ~, 674



- ~ of transfer of party status, 964
- ~, other written, 681
- ~, sufficiency of disclosure, 362
- Expert opinions as means of ~, 657
- Fresh facts and ~, opposition proceedings, 1035
- Late-submitted new facts and ~, oral proceedings, 577
- Minutes as ~ that objection was raised, 1231
- New ~ of requests, postponement of oral proceedings, 574
- New facts or ~, 1172
- Principle of free evaluation of ~, 674
- Return of filed ~, 674
- Statements in writing as means of ~, 660
- Surprising grounds or ~ and right to be heard, 533
- Taking of ~, 664
- Test and experimental ~, 678
- Witness testimony as means of ~, 657
- Evidence of transfer of party status, 964**
- Heir, 966
- Ex officio examination of facts in appeal proceedings, 1124**
- Ex parte proceedings, 1123**
- Ex post facto analysis, 184**
- Examination**
  - ~ after remittal for further prosecution, 900
  - ~ as to relevance, 933
  - ~ conditions, European qualifying examination, 1252
  - ~ fee, partial refund, 797
  - ~ fee, reduction, 797
  - ~ grades, European qualifying examination, 1254
  - ~ procedure, 860
    - Abandonment of subject-matter in ~, 902
    - Amendments in ~, 894
    - Amendments or corrections in ~, 894
    - Amendments relating to unsearched subject-matter, 918
    - Amendments under Rule 137(2) EPC, 862
    - Communications in ~, 879
    - Consolidation of proceedings in ~, 866
    - Grant of patent, 887
    - Informal communications in ~, 885
    - Interviews in ~, 886
    - Refusal after a single communication in ~, 869
    - Request for examination, 863
    - Search during examination, 913
    - Substantive examination, 865
    - Telephone conversations in ~, 885
    - Withdrawal of amendments in ~, 902
- ~ proceedings, unity of invention, 309
  - Refund of further search fees, 310
  - Search fees, refund of, 310
- Examination procedure, requests, 719**
- Examining division, composition, 744**
- Examples and novelty, 110**
- Exceptional circumstances, re-establishment of rights, 617**
- Illness, re-establishment of rights, 618
- Exceptions to patentability, 35**
- Amendments to Article 53 EPC, 36
- Biological inventions, 43
- Breaches of ordre public or morality, 37
- Medical methods, 51
- Microbiological processes, ~, 50
- Morality, 37
- Ordre public, 37
- Excluded time limits, re-establishment of rights, 605**
- Exclusion of computer programs, 26**
- Exclusion of public from oral proceedings, 588**
- Exercise of**
  - ~ discretion, 761
    - ~ of the boards of appeal and late submissions, 940
    - Opposition divisions' ~ and late submissions, 935
  - ~ discretion to remit, 1180
    - Expiry of patent, 1181
    - Procedural economy, 1181
  - ~ priority right for one contracting state, 371
- Exhibition priority, 370**
- Expectation of success, 185**
- Reasonable ~, 185
- Try and see situation, 187
- Experimental data, late submission of, 954**
- Experiments, sufficiency of disclosure, 341**
- Expert opinions, 659**
  - ~ as means of evidence, 657

**Expert opinions as means of evidence, 657**

Expert opinions, 659

Hearing of witnesses, 657

**Expiry of patent, 1181****Extension**

~ agreements and ordinances, 1274

~ of conferred protection, 459

Change of claim category, amendments,  
470

Claims, totality of, 459

Deletion of disclaimer, 466

Deletion of drawings, 466

Deletion of examples for a general  
feature, 465

Deletion of feature from claim, 464

Deletion of important feature from  
description, 465

Extent of protection, 460

Purpose of Article 123(3) EPC, 459

Replacement by "aliud", 468

Replacement of drawings, 468

Replacement of restrictive term by less  
restrictive term, 467Replacement of substance by device  
containing substance, 468Transposition of features within claims,  
470~ of time limits due to public holidays or  
dislocation in delivery of mail, 593

Dislocation in delivery of mail, 593

Public holidays, 593

**Extent of opposition, 1017, 1028****Extent of protection, 460**

Claim interpretation, 464

Cut-off point, 462

**External persons, representation  
requirement, 800**

---

**F**

---

**Failure to arrange oral proceedings, 1242****Features**~ missing with respect to earlier application,  
priority, 384

Features, non-essential, 384

Features, omission of indispensable, 384

~ not contributing to solution of problem, 227

**Fee**

~ for re-establishment, 644

~ payments, legitimate expectations, 523

~s for intervention, 971

**Fiction of fee payment in due time, 595****Filing**

~ divisional applications, 499

Date of filing attributed to divisional  
applications, 500Filing of divisional application during stay  
of proceedings, 499Pendency of earlier application, divisional  
applications, 501

~ of appeal, 1094

Electronic -, 1086

~ of applications, 837

~, entitled persons, 837

**Financial difficulties and re-establishment  
of rights, 613****First**

~ and second medical use, 134

Second (or further) medical use, 137

~ application, priority, 387

Identity of applicant, priority, 390

Identity of invention, priority, 388

~ medical use, 134

Product claim, 135

Purpose-related product claim, 135

**Form of**

~ appeal, 1086

Appeal fee, 1095

Electronic filing of appeal, 1086

Filing of appeal, 1094

~ claims, 263

Claim, independent per category, 265

Claims, one-part or two-part form, 264

Claims, two-part: preamble and  
characterising portion, 265

Conciseness of claims, 268

Number of claims, 268

Reference to description or drawings, 269

~ communication under Article 113(1) EPC,  
884

~ decisions, 748

Communication under Rule 111(2) EPC,  
750

Decision, inconsistency between oral and written decisions, 751  
 Decision, more than one issued, 750  
 Decisions according to the state of the file, 757  
 Notification of decision, 748  
 Reasons for decision, 751  
 Signature, 759  
 Signatures on decisions, 759

**Formal requirements for opposition, 1014**  
 Extent of opposition, 1017  
 Grounds for opposition, 1018, 1022  
 Identity of opponent, 1015  
 Notice of opposition, 1025  
 Opposition fee, 1014  
 Opposition period, start of, 1014  
 Public prior use in opposition proceedings, 1023  
 Title of invention, opposition proceedings, 1017

**Formal requirements of patent application, 848**  
 Designation of inventor, 850

**Formalities officer in opposition proceedings, 1026**

**Formalities officers, 742**

**Former board members, 740**

**Formulation of partial problems, 177**

**Formulation of technical problem, 175**  
 Aim to be achieved in ~, 207  
 Formulation of partial problems, 177

**Fresh**  
 ~ ground for opposition in appeal proceedings, observations by third parties, 782  
 ~ ground for opposition in opposition proceedings, observations by third parties, 781  
 ~ grounds for opposition, 1030  
     Fresh facts and evidence, opposition proceedings, 1035  
     Objections of lack of novelty and lack of inventive step, 1031  
     Opportunity to comment on new grounds for opposition, 1035  
     Scope of examination of new grounds for opposition by opposition division, 1033

**Functional features, 119**  
 ~, claims, 275

**Fundamental procedural defect, 1242**  
 Failure to arrange oral proceedings, 1242

**Fundamental violation of Article 113 EPC, 1235**

**Further**  
 ~ oral proceedings before same department, 563  
 ~ processing, 591, 595  
     Calculation of time limits, 591  
     Interruption of proceedings, 596  
 ~ search fees, non-payment of, 322

---

## G

---

**Games, 27**  
 Mental acts, 29  
 Methods for doing business, 28  
 Word-processing, 30

**General authorisations, representatives, 811**

**Generalisation and claim category, 438**

**Generalisations, 437**  
 Generalisation and claim category, 438

**Generic disclosure, 120**  
 ~, priority, 380

**Gold standard: directly and unambiguously derivable, 405**

**Grant of patent, 887**  
 Abandonment of subject-matter in examination procedure, 902  
 Amendment after approval of text for grant, 898  
 Amendments after decision to grant, 901  
 Amendments or corrections in examination procedure, 894  
 Approval of text by applicant, 888  
 Communication under Rule 71(3) EPC, 887  
 Decision to grant, date on which takes effect, 910  
 Errors in Patent Bulletin, 912  
 Examination after remittal for further prosecution, 900  
 Refusal of application, 909  
 Withdrawal of amendments in examination procedure, 902  
 Withdrawal of patent application, 903

**Grounds**  
 Ground for opposition under Article 100(c) EPC, 496

~ for exclusion under Article 24(1) EPC, 735  
Participation in decision under appeal,  
partiality, 735  
~ for objection under Article 24(3) EPC, 736  
~ for opposition, 1018, 1022  
Fresh ~, 1030  
~, scope of examination, 1028  
Opportunity to comment on new ~, 1035  
Scope of examination of new ~ by  
opposition division, 1033  
~ for review, 1227  
Review of substantive law excluded, 1228  
**Group of people as skilled person, 190**  
**Guidelines for Examination, 521, 828**

---

**H**

---

**Handwritten amendments, oral  
proceedings, 589**  
**Hearing of witnesses, 657**  
~ and right to be heard, 547  
**Heir, 966**

---

**I**

---

**Identity of**

~ applicant, 840  
Correction of designation of applicant, 840  
~, priority, 390  
~ invention, 372  
Amendments, priority, 373  
Common general knowledge, priority, 374  
Disclaimers, priority, 373  
Disclosure in previous application as a  
whole, 373  
Disclosure in priority document enabling,  
385  
Disclosure of essential features in priority  
document, 375  
Error margins and definitions of limits,  
priority, 379  
Features missing with respect to earlier  
application, priority, 384  
Generic disclosure, priority, 380  
~, priority, 388  
Implicit features, priority, 383  
Interpretation of "the same invention", 372

Nucleotide and amino acid sequences,  
priority, 382  
Solution of same problem, priority, 377  
Teaching in priority document, 378  
~ opponent, 1015  
**Illness, postponement of oral proceedings,  
570**  
**Illness, re-establishment of rights, 618**  
**Immediate refusal after communication, 541**  
**Implementing invention over whole scope  
of claim, showing one way, 345**  
**Implementing Regulations, interpretation,  
713**  
**Implicit disclosure, 405**  
**Implicit features, 105**  
~, priority, 383  
**Improvement of a production process for a  
known product, 170**  
**Improvement of properties, 236**  
**Inability to observe time limits and re-  
establishment of rights, 612**  
Financial difficulties and re-establishment of  
rights, 613  
**Inadequate reasons in decision at first  
instance, reimbursement of appeal fee,  
1196**  
**Independence of divisional applications,  
505**  
**Independent claims, 303**  
**Industrial application, 254**  
Industry, any kind of, 256  
Invention and ~, 254  
Profitable use of the invention in industry, 258  
Reproducibility, 257  
Sufficiency of disclosure, 257  
Cosmetic and beauty salons, 257  
**Inescapable trap, 475**  
**Informal communications in examination  
procedure, 885**  
Interviews in examination procedure, 886  
Telephone conversations in examination  
procedure, 885  
**Information provided by telephone and  
legitimate expectations, 520**  
**In-house knowledge not published before  
priority date, 74**  
**Insertion of ambiguous feature in claim, 447**

**Inspection of files, 768**

European Patent Register, 771

Inspection of files, 768

Stay of proceedings, 773

**Institutional matters, 1269**

Administrative agreements under

Article 10(2)(a) EPC, 1276

Extension agreements and ordinances, 1274

Legal status of boards of appeal, 1269

**Instruction manuals and availability to the public, 80****Interlocutory**

~ decision on auxiliary request, 719

~ decisions, 1056, 1073

Appealable decisions, 1073

Decisions of opposition division, 1056

~ of boards of appeal, 1166

Maintenance of European patent as amended, 1057

~ revision, amended claims, 1151

**Interlocutory revision, 1109**

Reimbursement of appeal fee, 1111

**Intermediate generalisation, 439****Intermediate products, 232**

~, unity of invention, 306

**Internal structure of product and public prior use, 88****International Searching Authority, unity of invention, 308****Internet**

~ and availability to the public, 83

Publication date, 84

~ and proof of date of availability, 100

~ archives, 680

~ publications, 680

**Interpretation of**

~ ambiguous terms, 291

~ claims, 287

Description and drawings to interpret claims, 289

Meaning of terms in claims, 288

~ content of application as filed, 402

~ "substance or composition", 144

~ the EPC, 704

Administrative Council, 713

European Convention on Human Rights, 711

Implementing Regulations, interpretation, 713

~ affected by TRIPS Agreement, 710

Interpretation of various language texts of the EPC, 715

National decisions, 711

Vienna Convention on the Law of Treaties, 705

~ "the same invention", 372

**Interpreting, oral proceedings, 588****Interruption of proceedings, 591, 596**

Calculation of time limits, 591

Further processing, 595

~ and re-establishment of rights, 641

~ because of insolvency, 599

Legal capacity, 596

Legal capacity, representative, 598

Legal incapacity, 596

**Interruption of proceedings because of insolvency, 599****Intervention, 967**

Admissibility of ~, 967

Fees for ~, 971

~ in appeal proceedings, 970

~ in opposition appeal proceedings, reimbursement of appeal fee, 1190

~ in opposition proceedings, 970

Legal status of intervener, 972

National infringement proceedings, ~, 968

Surgical ~, 57

Third party, ~, 967

Time limit for ~, 971

Withdrawal of appeal after filing of ~, 1168

**Interviews in examination procedure, 886****Intrinsic features, 108****Invention and industrial application, 254****Invention to be performed over whole range claimed, 335****Inventive step, 158**

Analogy process, 238

Animal testing, 243

Automation, ~, 240

Broad claims, ~, 231

Chemical inventions, 229

Closest prior art, 163

Combination inventions, 223

Combination of documents, 228

Combination of teachings, 226  
Could-would approach, 183  
Disadvantageous modifications, ~, 239  
Disclaimers, 237  
Enhanced effect, ~, 240  
Envisageable product, 238  
Equivalents, ~, 233  
Ex post facto analysis, 184  
Expectation of success, 185  
Features not contributing to solution of problem, 227  
Improvement of properties, 236  
New use of a known measure, 235  
Obvious alternatives, ~, 242  
Obvious new use, 236  
Obvious steps, ~, 242  
Optimisation of parameters, 237  
Post-published documents, ~, 181  
Problem and solution approach, 161  
Problem inventions, 234  
Purposive selection, 240  
Reversal of procedural steps, ~, 240  
Secondary indicia, ~, 243  
Simplification of complicated technology, ~, 241  
Skilled person, 188  
Substitution of materials, analogous use, 227  
Technical and non-technical features, 197  
Technical disclosure in prior art document, 226  
Technical problem, 172  
**Invitation to file observations in opposition proceedings, 1050**  
**Invitation to oral proceedings, 542**  
**IPER, examining procedure, 882**  
**"Isolated mistake" by representative, re-establishment of rights, 619**  
**Isolated mistake within a satisfactory system, re-establishment of rights, 619**  
Deficiencies in computerised systems, re-establishment of rights, 624  
Employee, re-establishment of rights, 623, 624  
"Isolated mistake" by representative, re-establishment of rights, 619  
Requirement for a cross-check, re-establishment of rights, 620

---

**J**

---

**Joint opposition, 1012**

Opposition fee, 1012

**Joint venture and commercial agreements, 98****Judicial**

~ branch of European Patent Organisation, 1269

~ independence, 1245

~ or quasi-judicial authorities under TRIPS Agreement, 1271

**Jurisdiction of boards of appeal, 1265**

---

**L**

---

**Language**

~ of proceedings, 647

~ , EPO as designated or elected Office, 1268

~ of third party observations, 777

~ privilege, 649

European patent application and ~, 651

Request for examination and ~, 651

Translations and ~, 649

**Language-related fee reductions, 651**

European patent application and language privilege, 651

Request for examination and language privilege, 651

**Languages, 646**

Language-related fee reductions, 651

~, amendments, 404

~ and divisional applications, 495

Translations and language privilege, 649

**Lapse of patent, 973**

Surrender of patent, 973

**Late submission of new arguments, 938**

New arguments – definition, 938

**Late submissions, 930**

Adjournment of oral proceedings, ~, 948

Complexity of new subject-matter, ~, 941

Equity of different apportionment of costs, ~, 983

Examination as to relevance, 933

Exercise of discretion of the boards of appeal and ~, 940

**Late-filed submissions in appeal proceedings, 939**

- Absence from oral proceedings, 948
- Adjournment of oral proceedings, late submissions, 948
- Apportionment of costs for reasons of equity where abuse of procedure, 952
- Arguments, reinforcement, 945
- Change of representative and late submission, 957
- Communication of a board of appeal, 945
- Complete case, 945
- Complexity of new subject-matter, late submissions, 941
- Documents and evidence withheld, 949
- Exercise of discretion of the boards of appeal and late submissions, 940
- Experimental data, late submission of, 954
- Legitimate reaction to first-instance decision, 942
- New arguments on appeal, 945
- Procedural economy, 941
- Public prior use, late submission of, 955
- Relevance, 944
- Resumption of proceedings before the boards, 958
- Rules of Procedure of the Boards of Appeal, 939

**Late-filed submissions in opposition proceedings, 934**

- Late submission of new arguments, 938
- Opposition divisions' exercise of discretion and late submissions, 935

**Late-submitted new facts and evidence, oral proceedings, 577****Lectures and oral disclosures and availability to the public, 81****Legal**

- ~ capacity, 596
  - ~, representative, 598
- ~ character of appeal procedure, 1065
  - Accelerated processing before boards of appeal, 1068
  - Devolutive effect of appeal, 1067
  - Suspensive effect of appeal, 1066
- ~ character of opposition proceedings, 1006
- ~ incapacity, 596

- ~ practitioners, 803
  - Register of ~, 804
- ~ status of boards of appeal, 1269
  - Boards of appeal as judicial authorities, 1270
  - Judicial branch of European Patent Organisation, 1269
- ~ status of intervener, 972
- Legal Board of Appeal competent, 1075**
- Legitimate interest, European qualifying examination, 1259**
- Legitimate reaction to first-instance decision, 942**
- Legitimate expectations and reimbursement of appeal fee, 1213**
- Legitimate expectations relating to information provided by EPO, 518**
- Contradictory acts and legitimate expectations, 519
- Correction of decision already issued, 520
- Courtesy service and legitimate expectations, 518
- Guidelines for Examination, 521
- Information provided by telephone and legitimate expectations, 520
- Limitation of patent, 979**
- Limited circle of people and availability to the public, 91**
- List of professional representatives, 799**
- Lists and singling out combination of features, 419**
- Combination of features pertaining to separate embodiments, 419
- Selection from two lists, 420
- Location of oral proceedings, 580**
- Loss of rights under Rule 112 EPC, 743**

---

**M**

---

**Main and auxiliary requests, 716**

- Appeal procedure, requests, 721
- Auxiliary requests, filing of, 716
- Examination procedure, requests, 719
- Interlocutory decision on auxiliary request, 719
- Opposition procedure, requests, 720
- Requests, admissibility, 717

Requests, order of, 716  
Requests, refusal of and duty to give reasons, 718

**Maintenance of European patent as amended, 1057**

**Market competitors, 248**

**Marking answer papers, European qualifying examination, 1253**

**Marks awarded, European qualifying examination, 1256**

**Markush claims, 319**

**Mathematical algorithms, 222**

**Mathematical methods, 12**

Discoveries, 12

Scientific theories, 12

**Meaning of terms in claims, 288**

**Measuring methods, 342**

**Medical**

~ methods, 51

    Diagnostic methods, 51, 62

    Surgical methods, 51, 52

    Therapeutic methods, 51, 57

~ practitioner, 52, 63

~ use, sufficiency of disclosure, 347

**Mental acts, 27, 29, 211**

Methods for doing business, 28

Word-processing, 30

**Meta methods for software production, 221**

**Methods**

Method claim, 473

~ concerning operation of a device, 56

~ for doing business, 27, 28

    Mental acts, 29

    Word-processing, 30

~ involving technical means, 7

~ of payment of fees, 793

~ performed by a computer, 22

**Microbiological processes, exceptions to patentability, 50**

**Minutes, 1194**

~ as evidence that objection was raised, 1231

~, correction, 586

~ of oral proceedings, 583

~, signing of, 587

Signature on decision and ~, 1200

Signing of ~, 587

**Minutes of oral proceedings, 583**

Minutes, correction, 586

Minutes, signing of, 587

**Morality, 37, 41**

Breaches of ordre public or ~, 37

Objection under Article 53(a) EPC, 41

Rule 28 EPC, 38

**Most promising springboard, 168**

**Multiple oppositions by different persons, 1012**

**Multiple priorities for one claim, priority, 393**

---

## N

---

**National**

~ court, 774

    Proceedings before a ~, postponement of oral proceedings, 574

~ decisions, 711

    ~, binding effect, 712

~ deposit of industrial design, priority, 370

~ holiday, postponement of oral proceedings, 572

~ infringement proceedings, intervention, 968

~ prior rights, 72

    Amendments occasioned by ~, 1040

**Neighbouring field, 193**

**New**

~ arguments – definition, 938

~ arguments in oral proceedings, 546

~ arguments on appeal, 945

~ case raised by opponent in statement of grounds of appeal, 1103

~ case raised by patent proprietor in statement of grounds of appeal, 1103

~ documents in oral proceedings and right to be heard, 543

~ dosage regimen, 143

~ evidence of requests, postponement of oral proceedings, 574

~ facts or evidence, 1172

~ technical effect, 142

~ therapy with different mode of administration, 144

~ use of a known measure, 235

**New ground for opposition by opposition division, 547**



**Non-appearance at oral proceedings, 990, 1137**

Amended claims filed during oral proceedings, 1137

Equity of different apportionment of costs, 990

**Non-attendance at oral proceedings, 566**

~, obligation to give notice, 567

Right to present comments and ~, 567

**Non-attendance at oral proceedings, obligation to give notice, 567****Non-compliance with Rule 137(5) EPC, 926****Non-disclosure of essential features, 375****Non-inventions under Article 52(2) and (3) EPC, 10**

Aesthetic creations, 14

Computer-implemented inventions, 16

Discoveries, 12

Games, 27

Mathematical methods, 12

Mental acts, 27

Methods for doing business, 27

Presentations of information, 32

Scientific theories, 12

**Non-observance of time limit directly causing loss of a right, 604**

Definition of "time limit" in re-establishment of rights, 604

Excluded time limits, re-establishment of rights, 605

Time limits concerning PCT and re-establishment of rights, 605

**Non-prejudicial disclosures under Article 55 EPC, 73****Non-technical**

~ distinguishing features, 121

~ features and interaction with technical subject-matter, 205

~ features and technical contribution, 203

~ subject-matter, 414

**Non-unity under former R. 164 EPC, 324****Notary, 99****Notice of appeal, 1119**

~ not timely filed, 1188

**Notice of opposition, 1025****Notification, 785**

~ by delivery by hand and delivery by public notice, 787

~ by means of electronic communication, 786

~ by postal services, 785

~ of decision, 748

~ of loss of rights, 742

Right to a decision after ~, 742

~ to representatives, 787

~ to third parties, 788

**Notion of disclaimer, 425****Notoriously well-known technical features, 916****Novelty, 66**

Ascertaining differences, 115

Availability to the public, 78

Chemical inventions, 121

Content of relevant prior art, 101

Disclaimers, restoration of ~, 433

Drawings and ~, 109

Examples and ~, 110

First and second medical use, 134

~ of chemical compounds, 122

Anticipation of certain compounds, 123

Enantiomers, 127

Novelty of enantiomers, 127

Novelty of groups of substances, 125

Substances, 125

~ of therapeutic application, 141

Discovery of previously unknown property of compound, 146

Interpretation of "substance or composition", 144

New dosage regimen, 143

New technical effect, 142

New therapy with different mode of administration, 144

Statement of purpose of surgical use for a known instrument, 146

Therapeutic method, 147

~ test, amendments, 412

Objections of lack of ~ and lack of inventive step, 1031

Proof, ~, 99

Second (or further) non-medical use, 148

Selection inventions, 121

State of the art, 69

**Nucleotide and amino acid sequences, 353**

~, priority, 382

**Number of auxiliary requests, 1159****Number of claims, 268**

---

**O**

---

**Objection**

- ~ by a party, 728
- ~ by a third party, 729
- ~ by members of the board, 728
- ~ under Article 53(a) EPC, 41
  - Morality, 41
  - Ordre public, 41
- ~s of lack of novelty and lack of inventive step, 1031

**Obligation to**

- ~ draw attention to easily remediable deficiencies, 521, 525
  - Electronic filing of documents, legitimate expectations, 524
  - Fee payments, legitimate expectations, 523
- ~ give reasons why representative not replaced, oral proceedings, 573
- ~ maintain secrecy, 92
  - Conferences and availability to the public, 97
  - Joint venture and commercial agreements, 98
  - Notary, 99
  - Products and availability to the public, 94, 95
  - Samples/products for test purposes and availability to the public, 96
  - Scientific papers submitted to obtain an academic degree, 99
- ~ raise objections, 1229
  - Minutes as evidence that objection was raised, 1231

**Observations by third parties, 776**

- Anonymously filed third-party observations, 778
- Language of third party observations, 777
- Observations by third parties, legal status, 779

**Observations by third parties in opposition proceedings, 781**

- Fresh ground for opposition in appeal proceedings, observations by third parties, 782

**Obvious**

- ~ alternatives, inventive step, 242
- ~ new use, 236
- ~ steps, inventive step, 242

**Obviousness of error and of correction, 483****Old prior art documents as closest prior art, 171****Omitted act and re-establishment of rights, 614****One-year time limit and re-establishment of rights, 611****Opponent as sole appellant and reformatio in peius, 1114****Opportunity to comment on new grounds for opposition, 1035****Opportunity to present comments in opposition proceedings, 1054****Opposition**

- ~ by patent proprietor, 1009
  - ~ division, composition, 744
    - Enlargement and reduction of opposition division, 746
  - ~ divisions' exercise of discretion and late submissions, 935
  - ~ inadmissible, 1027
  - ~ period, 1014
    - Extent of opposition, 1017
    - Grounds for opposition, 1018, 1022
    - Identity of opponent, 1015
    - Notice of opposition, 1025
    - Opposition fee, 1014
    - ~, start of, 1014
    - Public prior use in opposition proceedings, 1023
    - Title of invention, opposition proceedings, 1017
  - ~ procedure, requests, 720
  - ~ proceedings, unity of invention, 311
- Opposition procedure, 1005**
- Acceleration of opposition proceedings, infringement proceedings, 1055
  - Admissibility of opposition, 1008
  - Amendments in opposition proceedings, 1037
  - Decisions of opposition division, 1056
  - Extent of opposition, 1028
  - Fresh grounds for opposition, 1030

Grounds for opposition, scope of examination, 1028

Legal character of opposition proceedings, 1006

Right to be heard in opposition proceedings, 1050

Straw man, ~, 1010

### **Optimisation of parameters, 237**

#### **Oral**

~ proceedings, attendance at, 560

~ proceedings before the Receiving Section, 560

~ proceedings by video conference, 581

~ proceedings, reimbursement of appeal fees, 556, 1193

Costs, oral proceedings, 589

Minutes, 1194

Non-attendance at oral proceedings, 566

Preparation and conduct of oral proceedings, 568

Request for oral proceedings, 560, 1193

Right to oral proceedings, 558

~ submissions of accompanying person, 548, 588, 815

Oral submissions by former members of boards of appeal, 824

Oral submissions by qualified patent lawyers of non-contracting states, 826

Preparation and conduct of oral proceedings, 588

Representation, 815

Right to be heard in oral proceedings, 548

#### **Ordre public, 37, 41**

Breaches of ~ or morality, 37

Objection under Article 53(a) EPC, 41

Rule 28 EPC, 38

#### **Original disclosure, 407**

#### **Overlapping ranges, 131**

---

## **P**

---

#### **Parallel proceedings, 1164**

#### **Parameter ranges, 129**

Overlapping ranges, 131

Selection from a broad range, 129

Selection of ~, 129

#### **Parameters, 119**

Optimisation of ~, 237

~, sufficiency of disclosure, 335

Ranges of ~, setting upper and lower limits, 414

#### **Partial**

~ admissibility of appeal, 1108

~ and multiple priorities, 391

Multiple priorities for one claim, priority, 393

Priorities for different parts of a European patent application, 392

Publications during priority interval, 392

~ problems, 224

Formulation of ~, 177

#### **Partiality, 722**

Competence of the board in its original composition, ~, 730

European Convention on Human Rights, 724

Former board members, 740

Objection by a party, 728

Objection by a third party, 729

Objection by members of the board, 728

~ of Chairman of the Enlarged Board of Appeal, 738

~ of members of boards of appeal, 734

Grounds for exclusion under Article 24(1) EPC, 735

Grounds for objection under Article 24(3) EPC, 736

~ of members of departments of first instance, 732

Partiality, personal interest, 733

~ of members of the Enlarged Board of Appeal, 737

Petition for review proceedings, 737

~, reimbursement of appeal fee, 1202

Participation in decision under appeal, ~, 735

Reasoned objection, ~, 731, 732

Self-recusation, 727

#### **Participation in decision under appeal, partiality, 735**

#### **Party**

Parties' right to submit observations on amendments, 1131

Parties to appeal proceedings, procedural status, 1083

- ~ adversely affected, 1078
- ~ status, 963
  - Evidence of transfer of ~, 964
  - ~ as patent proprietor, 958
- ~ status as opponent, 959
  - Evidence of transfer of party status, 964
  - Transfer together with related business assets, 961
  - Universal succession, 960
- ~ status, transfer, 958
  - Party status as patent proprietor, 958
- Patent**
- ~ application and amendments, 261
  - Amendments, 398
  - Claims, 261
  - Disclosure, see Sufficiency of disclosure, 327
  - Divisional applications, 491
  - Priority, 366
  - Sufficiency of disclosure, 327
  - Unity of invention, 302
- ~ application, prior art acknowledged, 74
- ~ specifications as common general knowledge, 76
- Patentability, 1**
- Exceptions to ~, 35
- Industrial application, 254
- Inventive step, 158
- Microbiological processes, exceptions to ~, 50
- Novelty, 66
- ~ requirements, 4
- Patentable inventions, 1
- Patentability requirements, 4**
- Technical inventions, 4
- Patentable inventions, 1**
- Non-inventions under Article 52(2) and (3) EPC, 10
- Technical inventions, 2
- Patentable technical processes, 47**
- Patentee as sole appellant and reformatio in peius, 1114**
- Patents and availability to the public, 80**
- Payment of fees, 793**
- Debit orders, fees, 793
- Methods of ~, 793
- Payments, small amounts lacking, 795**
- PCT applications as state of the art, 72**

- Pendency of earlier application, divisional applications, 501**
- Period of notice for summons to oral proceedings, 575**
- Periods of grace and fee payments, 595**
- Additional period for renewal fees, 595
- Fiction of fee payment in due time, 595
- Person not skilled in the art, availability to, 90**
- Petition for review, 1226**
- Breach of Article 24 EPC, 1234
- Burden of proof, 1234
- Composition of Enlarged Board in review procedure, 1233
- Fundamental procedural defect, 1242
- Fundamental violation of Article 113 EPC, 1235
- Grounds for review, 1227
- Obligation to raise objections, 1229
- ~ proceedings, 737
- Scope of review by the Enlarged Board of Appeal, 1227
- Petition for review proceedings, 737**
- Partiality of Chairman of the Enlarged Board of Appeal, 738
- Plants and plant varieties, 43**
- Definition of "plant varieties", 43
- Point of law of fundamental importance – Enlarged Board of Appeal, 1222**
- Postdating of previous application, 371**
- Postponement of oral proceedings, 568, 994**
- Booked holidays, ~, 571
- Business engagements, ~, 572
- Conference, ~, 572
- Continuation of oral proceedings on next day, 575
- Equity of different apportionment of costs, 994
- Illness, ~, 570
- National holiday, ~, 572
- New evidence of requests, ~, 574
- Obligation to give reasons why representative not replaced, oral proceedings, 573
- Preparation and conduct of oral proceedings, 568
- Proceedings before a national court, ~, 574
- Post-published documents, 344**
- ~, inventive step, 181

**Preliminary and formalities examination, 835**

Date of filing, 838  
 Deemed withdrawal of application, 858  
 Designation of states, 851  
 Filing of applications, entitled persons, 837  
 Formal requirements of patent application, 848  
 Priority, 855  
 Publication of application, 859

**Preparation and conduct of oral proceedings, 568**

Assistants, presence at deliberations of the board, 589  
 Communication under Article 15(1) RPBA, 576  
 Computer-generated presentations, oral proceedings, 582  
 Exclusion of public from oral proceedings, 588  
 Handwritten amendments, oral proceedings, 589  
 Interpreting, oral proceedings, 588  
 Late-submitted new facts and evidence, oral proceedings, 577  
 Location of oral proceedings, 580  
 Minutes of oral proceedings, 583  
 Oral proceedings by video conference, 581  
 Oral submissions by accompanying person, 588  
 Period of notice for summons to oral proceedings, 575  
 Postponement of oral proceedings, 568  
 Sound recordings, 583  
 Speaking time, oral proceedings, 588  
 Video conference, 581

**Presence of an invention under Article 52(1) EPC, 4**

Apparatus constituting a physical entity, 9  
 Contribution approach, technical inventions, 5  
 Methods involving technical means, 7

**Presentations of information, 32, 210**

Mental acts, 211  
 Non-inventions under Article 52(2) and (3) EPC, 32  
 Technical and non-technical features, 210

**Principle of**

~ free evaluation of evidence, 674  
 ~ proportionality, 642

~ protection of legitimate expectations, 513  
 Administrative notice with no legal consequences, legitimate expectations, 517  
 Case law, legitimate expectations, 527  
 Legitimate expectations relating to information provided by EPO, 518  
 Obligation to draw attention to easily remediable deficiencies, 521  
 Unclear requests, 526

**Principle of equal treatment in opposition proceedings, 1050****Prior art documents, availability to the public, 687****Prior rights, 70**

Amendments occasioned by national ~, 1040  
 Divisional applications, applicability of Article 54(3) EPC, 71  
 National ~, 72  
 PCT applications as state of the art, 72

**Priority, 366, 855**

Amendments, ~, 373  
 Applications filed in or for a state party to the Paris Convention, ~, 368  
 Applications giving rise to a right of ~, 368  
 Applications with same filing or ~ date, 70  
 Common general knowledge, ~, 374  
 Disclaimers, ~, 373  
 Disclosure in ~ document enabling, 385  
 Disclosure of essential features in ~ document, 375  
 Error margins and definitions of limits, ~, 379  
 Exercise of ~ right for one contracting state, 371  
 Exhibition ~, 370  
 Features missing with respect to earlier application, ~, 384  
 First application, ~, 387  
 Generic disclosure, ~, 380  
 Identity of applicant, ~, 390  
 Identity of invention, ~, 372, 388  
 Implicit features, ~, 383  
 In-house knowledge not published before ~ date, 74  
 Multiple priorities for one claim, ~, 393  
 National deposit of industrial design, ~, 370  
 Nucleotide and amino acid sequences, ~, 382

- Partial and multiple priorities, 391
- Patent application and amendments, 366
- Preliminary and formalities examination, 855
- Priorities for different parts of a European patent application, 392
- ~ documents, 402, 855
  - Added subject-matter, amendments, 402
  - Correction of ~, 855
  - Priority, 855
- ~ right of applicant or successor-in-title, 368
- Publications during ~ interval, 392
- Solution of same problem, ~, 377
- Teaching in ~ document, 378
- Problem**
- ~ and solution approach, 161
  - ~ in chemical inventions, 229
- ~ and solution approach and "mixed" inventions, 201
  - Comvik approach, 201
  - Non-technical features and interaction with technical subject-matter, 205
  - Non-technical features and technical contribution, 203
  - Technical implementation of excluded subject-matter, 205
- ~ inventions, 234
- Procedural economy, 941, 1130, 1181**
- Amended claims in appeal proceedings, 1130
- Exercise of discretion to remit, 1181
- Late-filed submissions in appeal proceedings, 941
- Procedural status of third parties, 767**
- Proceedings before**
- ~ a national court, postponement of oral proceedings, 574
- ~ the Disciplinary Board of Appeal, 1247
  - Appeals against decisions of the Disciplinary Board of Appeal, 1263
  - Code of Professional Conduct, 1262
  - Disciplinary matters, 1260
  - European qualifying examination, 1249
- ~ the EPO, 835
  - Appeal procedure, 1059
  - Apportionment of costs, 981
  - Continuation of opposition proceedings by the EPO, 973
  - Enlarged Board of Appeal, 1215
  - Examination procedure, 860
  - Intervention, 967
  - Late submissions, 930
  - Limitation of patent, 979
  - Opposition procedure, 1005
  - Party status, transfer, 958
  - Preliminary and formalities examination, 835
  - Revocation of patent, 979
- Process claims, 150, 152**
- ~ containing a purpose feature, 148
- Use claims and ~, 150
- Use of known process for particular purpose, 152
- Process claims containing a purpose feature, 148**
- Process claims, 150
- Product claims with purpose characteristics, 156
- Statement of purpose in non-medical use claims, 156
- Therapeutic treatment of animals, 149
- Product claims, 135, 470, 472, 473**
- ~ with process features, 120
- ~s for plants, 48
- ~s with purpose characteristics, 156
- Purpose-related ~, 135, 139, 475
- Product-by-process claims, 296, 472**
- ~ and their scope of protection, 299
- ~ and use claims, 299
- Scope of protection of ~, 299
- Products and availability to the public, 94, 95**
- Obligation to maintain secrecy, 94, 95
- Professional**
- ~ experience, 1250
- ~ obligations, Code of Professional Conduct, 1262
- ~ secrecy, Code of Professional Conduct, 1262
- Profitable use of the invention in industry, 258**
- Programming a computer, 19**
- Proof, novelty, 99**
- Burden of proof, 99
- Evaluation of evidence, 100
- Proof of common general knowledge, 77**

**Protection, extension of, 459**

- Change of claim category, amendments, 470
- Claims, totality of, 459
- Deletion of disclaimer, 466
- Deletion of drawings, 466
- Deletion of examples for a general feature, 465
- Deletion of feature from claim, 464
- Deletion of important feature from description, 465
- Extent of protection, 460
- Purpose of Article 123(3) EPC, 459
- Replacement by "aliud", 468
- Replacement of drawings, 468
- Replacement of restrictive term by less restrictive term, 467
- Replacement of substance by device containing substance, 468
- Transposition of features within claims, 470
- Protection of legitimate expectations, 513**
- Administrative notice with no legal consequences, legitimate expectations, 517
- Case law, legitimate expectations, 527
- Legitimate expectations relating to information provided by EPO, 518
- Obligation to draw attention to easily remediable deficiencies, 521
- Principle of ~, 513
- Unclear requests, 526

**Public**

- ~ and availability to the public, 90
  - Limited circle of people and availability to the public, 91
  - Person not skilled in the art, availability to, 90
  - Public libraries and availability to the public, 91
- ~ holidays, 593
  - Extension of time limits due to ~ or dislocation in delivery of mail, 593
- ~ prior use, 86, 100, 684
  - Composition of product and ~, 88
  - Evaluation of evidence, 100
  - Internal structure of product and ~, 88
  - ~ in opposition proceedings, 1023
  - ~, late submission of, 955

Standard of proof, 684

Ways of making information available to the public, 86

**Publication**

- ~ date, 84
- ~ of application, 859
- ~ of decision, 1246
- ~s and availability to the public, 78
  - Advertising brochures and availability to the public, 79
  - Books and availability to the public, 80
  - Company papers and availability to the public, 78
  - Instruction manuals and availability to the public, 80
  - Patents and availability to the public, 80
  - Reports in specialist field and availability to the public, 80
  - Utility models and availability to the public, 80
- ~s during priority interval, 392
- Purpose of Article 123(3) EPC, 459**
- Purpose-related product claims, 135, 139, 475**
- Purposive selection, 240**

---

**R**

---

**Ranges of parameters, setting upper and lower limits, 414****Reach-through claims, 339****Reasonable expectation of success, 185****Reasoned objection, partiality, 731, 732****Reasons for decision, 751**

~, incomplete and deficient reasoning, 752, 753

**Reasons for decision, incomplete and deficient reasoning, 752, 753****Receiving Section, corrections, 847****Re-establishment, request for, 640****Re-establishment of rights, 601**

Admissibility of request for ~, 606

Deficiencies in computerised systems, ~, 624

Definition of "time limit" in ~, 604

Designation of states and ~, 604

Divisional applications, ~, 604

Due care and ~, 617, 624

Employee, ~, 623, 624

- Exceptional circumstances, ~, 617
- Excluded time limits, ~, 605
- Fee for re-establishment, 644
- Financial difficulties and ~, 613
- Illness, ~, 618
- Inability to observe time limits and ~, 612
- Interruption of proceedings and ~, 641
- "Isolated mistake" by representative, ~, 619
- Isolated mistake within a satisfactory system, ~, 619
- Non-observance of time limit directly causing loss of a right, 604
- Omitted act and ~, 614
- One-year time limit and ~, 611
- Principle of proportionality, 642
- Re-establishment, request for, 640
- ~, opponent, 603
- ~, right to file request, 603
- Refund, 644
- Removal of cause of non-compliance and ~, 606
- Request for ~, 614, 615
- Responsibility of representative, ~, 636
- Rights of use, 642
- Time limits concerning PCT and ~, 605
- Time limits for filing request for ~, 606
- Re-establishment of rights, right to file request, 603**
- Re-establishment of rights, opponent, 603
- Reference to description or drawings, 269**
- Referral**
- ~ by a board of appeal, 1217
  - Point of law of fundamental importance – Enlarged Board of Appeal, 1222
  - Uniform application of law, Enlarged Board of Appeal, 1221
- ~ by President of the EPO, 1222
  - Different decisions, 1223
  - Discretion of President, 1223
- ~ under Article 112 EPC, 1217
  - Composition of Enlarged Board of Appeal, 1217
  - Stay of appeal proceedings following a referral, 1225
  - Stay of first instance proceedings following a referral, 1225
- Reformatio in peius in appeal procedure, 1111**
- Opponent as sole appellant and reformatio in peius, 1114
- Patentee as sole appellant and reformatio in peius, 1114
- Reformatio in peius and lack of cross-appeal in the EPC, 1118
- Reformulating the technical problem, 458**
- Reformulation of technical problem, 177**
- Technical effect invoked subsequently, 179
- Refund, 644**
- Claims fees, ~ of, 301
- Examination fee, partial ~, 797
- ~ of further search fees, 310
- Search fees, ~ of, 310
- Refusal after a single communication in examination procedure, 869**
- Refusal of application, 909**
- Register of legal practitioners, 804**
- Registration and enrolment conditions, European qualifying examination, 1249**
- Professional experience, 1250
- Required qualification, 1249
- Registration of licences in Patent Register, 771**
- Reimbursement of**
- ~ appeal fee, 1111, 1167, 1187
  - Allowability of appeal, ~, 1190
  - Appeal inadmissible, ~, 1188
  - Appeal procedure, 1187
  - Competence to decide on ~, 1206
  - Error of judgment, ~, 1196
  - Inadequate reasons in decision at first instance, ~, 1196
  - Interlocutory revision, 1111
  - Intervention in opposition appeal proceedings, ~, 1190
  - Legitimate expectations and ~, 1213
  - Notice of appeal not timely filed, 1188
  - Oral proceedings, ~s, 556, 1193
  - Partiality, ~, 1202
  - ~ in case of request for re-establishment, 1189
  - Right to be heard, ~, 1195
  - Several appellants, ~s, 1190
  - Substantial procedural violation, 1191



- Suspensive effect of appeal, ~, 1203
- Withdrawal of appeal, ~, 1189
- Withdrawal of appeal after filing of intervention, 1168
- ~ appeal fee if equitable, 1209
  - Legitimate expectations and reimbursement of appeal fee, 1213
- ~ appeal fee in case of interlocutory revision, 1206
  - Competence to decide on reimbursement of appeal fee, 1206
- ~ costs, 1246
- Reinstating broader claims in appeal proceedings, 1160**
- Revocation of patent, 1162
- Reintroduction of feature on appeal, 1151**
- Relationship**
  - ~ between Article 123(2) and Article 123(3) EPC, 475
    - Inescapable trap, 475
  - ~ between Article 83 and Article 84 EPC, 356
    - Sufficiency of disclosure and clarity of claims, 358
    - Sufficiency of disclosure and support from description, 356
  - ~ of Rule 139 EPC to Article 123(2) EPC, 482
- Relevance, 944**
  - Examination as to ~, 933
  - ~ of Article 69 EPC, 290
- Relevant**
  - ~ date of documents, 70
  - ~ date, sufficiency of disclosure, 328
  - ~ parts of application, sufficiency of disclosure, 329
- Remittal**
  - ~ following filing of relevant new document, 1170
    - New facts or evidence, 1172
  - ~ following substantial procedural violation, 1175
    - Composition of opposition division, 1177
    - Right to be heard, 1176
  - ~ for continuation of proceedings, 1186
  - ~ only for adaptation of description, 1185
  - ~ to department of first instance, 1170
    - Binding effect of decision, remittal, 1182
  - Exercise of discretion to remit, 1180
  - Remittal following substantial amendment to claims, 1174
- Removal**
  - ~ from office of a board member, 1245
    - Judicial independence, 1245
    - Publication of decision, 1246
    - Reimbursement of costs, 1246
  - ~ of cause of non-compliance and re-establishment of rights, 606
  - ~ of error (in claim) in opposition proceedings, 1049
- Repeatability, sufficiency of disclosure, 338, 346**
  - Clarity of disclosure, 346
  - Reproducibility, sufficiency of disclosure, 338
- Replacement**
  - ~ by "aliud", 468
  - ~ of complete description and drawings, 457
  - ~ of drawings, 468
  - ~ of restrictive term by less restrictive term, 467
  - ~ of substance by device containing substance, 468
  - ~ or removal of features from claim, 448
- Reply in opposition proceedings, 1052**
- Reports in specialist field and availability to the public, 80**
- Representation, 798**
  - Common representative, 806
  - External persons, ~ requirement, 800
  - General authorisations, representatives, 811
  - Legal practitioners, 803
  - List of professional representatives, 799
  - Notification to representatives, 787
  - Oral submissions by accompanying person, 815
  - Representative, authorisation, 808
  - Representatives, association, 814
  - Representatives during the transitional period, 801
- Reproducibility, 257**
  - ~ of content of disclosure, 113
  - ~, sufficiency of disclosure, 338
    - Post-published documents, 344
    - Reach-through claims, 339
    - Repeatability, sufficiency of disclosure, 338

- Trial and error, sufficiency of disclosure, 343
- Variants, 339
- ~ without undue burden, 340
  - Chemical compounds, 342
  - Claims, forbidden area, 341
  - Experiments, sufficiency of disclosure, 341
  - Measuring methods, 342
  - Trial and error, sufficiency of disclosure, 340
- Request for oral proceedings, 1193**
- Request for**
  - ~ apportionment of costs, 1000
  - ~ correction, time limit for, 856
  - ~ examination, 863
  - ~ oral proceedings, 560
    - Auxiliary ~, 565
    - Further oral proceedings before same department, 563
    - Withdrawal of ~, 562
  - ~ re-establishment of rights, 614, 615
    - Admissibility of ~, 614, 615
    - Time limits for filing ~, 606
- Request for examination and language privilege, 651**
- Requests**
  - ~, admissibility, 717
    - ~ of late-filed, 718
    - Requests of equal rank, 718
  - ~, order of, 716
  - ~, refusal of and duty to give reasons, 718
- Required qualification, 1249**
- Requirement for a cross-check, re-establishment of rights, 620**
- Res judicata and divisional applications, 497**
- Response to objections, amended claims, 1153**
- Responsibility of representative, re-establishment of rights, 636**
- Resumption of proceedings before the boards, 958**
- Return of filed evidence, 674**
- Reversal of procedural steps, inventive step, 240**
- Review of first-instance discretionary decisions, appeal procedure, 1126**
- Review of substantive law excluded, 1228**
- Revocation of European patent by way of decision, 1056**
- Revocation of patent, 979, 1108, 1162**
- Reinstating broader claims in appeal proceedings, 1162
- Statement of grounds of appeal, 1108
- Right**
  - ~ to a decision after notification of loss of rights, 742
    - Decision under Rule 112(2) EPC, 743
    - Formalities officers, 742
    - Loss of rights under Rule 112 EPC, 743
    - Notification of loss of rights, 742
  - ~ to be heard, 530, 671, 1176
    - Hearing of witnesses and ~, 547
    - New documents in oral proceedings and ~, 543
    - Remittal following substantial procedural violation, 1176
    - ~ in case of non-attendance of oral proceedings, 548
    - ~, reimbursement of appeal fee, 1195
    - Statement of grounds of appeal not received by respondent and ~, 535
    - Surprising grounds or evidence and ~, 533
    - Taking of evidence, 671
    - Timing of decisions and ~, 540
    - Violation of ~, examination ex officio, 532
  - ~ to be heard in opposition proceedings, 1050
    - Invitation to file observations in opposition proceedings, 1050
    - Opportunity to present comments in opposition proceedings, 1054
    - Principle of equal treatment in opposition proceedings, 1050
    - Reply in opposition proceedings, 1052
  - ~ to be heard in oral proceedings, 542
    - Hearing of witnesses and right to be heard, 547
    - New arguments in oral proceedings, 546
    - New documents in oral proceedings and right to be heard, 543

- New ground for opposition by opposition division, 547
- Oral submissions of accompanying person, 548
- ~ to oral proceedings, 558
  - Oral proceedings, attendance at, 560
  - Oral proceedings before the Receiving Section, 560
  - ~ after Rule 71(3) EPC communication, 558
  - Telephone conversation, right to, 559
- ~ to present comments and non-attendance at oral proceedings, 567
- ~s of use, 642
- Rules**
- Rule 28 EPC, 38
  - Scope of exception under Rule 28(c) EPC, 38
  - Scope of exception under Rule 28(d) EPC, 39
- ~ of Procedure of the Boards of Appeal, 939
  - ~, amended claims in appeal proceedings, 1127
- ~ relating to Fees, 593, 792
  - Date of payment, 795
  - Examination fee, partial refund, 797
  - Examination fee, reduction, 797
  - Payment of fees, 793
  - Payments, small amounts lacking, 795

---

## S

---

- Same purpose or effect, 164**
- Samples/products for test purposes and availability to the public, 96**
- Satisfaction of a long-felt need, 247**
- Scientific papers submitted to obtain an academic degree, 99**
- Scientific theories, 12**
- Discoveries, 12
- Mathematical methods, 12
- Scope of**
  - ~ examination of amendments in opposition proceedings, 1046
  - ~ examination of new grounds for opposition by opposition division, 1033
  - ~ exception under Rule 28(c) EPC, 38

- ~ exception under Rule 28(d) EPC, 39
- ~ protection, 139
  - Product-by-process claims and their ~, 299
  - ~ and infringement, 295
  - ~ of product-by-process claims, 299
- ~ review by the Enlarged Board of Appeal, 1227
  - Review of substantive law excluded, 1228

**Search**

- ~, amended claims, 1157
- ~ during examination, 913
- ~ fees, 326
  - Further ~, non-payment of, 322
  - Refund of further ~, 310
  - ~ for divisional application, 508
  - ~, refund of, 310
- ~ fees, non-payment, 918
  - Further ~ of, 322
- ~ fees where plurality of inventions, 321
- Euro-PCT applications, 324
- Further search fees, non-payment of, 322
- Unsearched subject-matter, 325
- ~, incomplete, 913
  - Notoriously well-known technical features, 916
  - Search, additional necessary, 914
- ~ report, 920

**Second (or further) medical use, 137**

- Novelty of therapeutic application, 141
- Purpose-related product claim, 139
- Scope of protection, 139
- Swiss-type claim, 139
- Therapeutic application, 141
- Second (or further) non-medical use, 148**
- Process claims containing a purpose feature, 148

**Secondary indicia, inventive step, 243**

- Age of documents, 246
- Bonus effect, 250
- Commercial success, 247
- Comparative tests, 251
- Market competitors, 248
- Satisfaction of a long-felt need, 247
- Simple solution, 249
- Surprising effect, 250

Technical prejudice, 244

Time factor, 246

**Selection**

~ from two lists, 420

~ inventions, 121

Chemical compounds, 122

Novelty of chemical compounds, 122

Parameter ranges, 129

Substances, 122

~ of most promising starting point, 167

Chosen type of starting point, 168

Confidential prior art, 170

Defective disclosure, 169

Most promising springboard, 168

Speculative character of closest prior art,  
170

~ of parameter ranges, 129

Overlapping ranges, 131

Selection from a broad range, 129

**Self-recusation, 727**

**Sequence of divisional applications, 494**

**Several appellants, reimbursement of  
appeal fees, 1190**

**Shifting of burden of proof, 700**

**Signature, 759**

Computer-generated communications, 759

Decisions in written proceedings, 760

~ on decision and minutes, 1200

**Signatures on decisions, 759**

Computer-generated communications, 759

Decisions in written proceedings, 760

Draft decisions, 760

**Signing of minutes, 587**

**Similarity of technical problem, 165**

**Simple solution, 249**

**Simplification of complicated technology,  
inventive step, 241**

**Simulation methods, 23**

**Single general inventive concept, unity of  
invention, 314**

Markush claims, 319

**Skilled person, 188**

Definition of ~, 188

Everyday items from a different technical field,  
196

Group of people as ~, 190

Neighbouring field, 193

~ and level of knowledge, 195

~ in biotechnology, 191

~ in field of computer-implemented inventions,  
192

~, reflection and imagination, 402

~, relevant knowledge, 330

**Skilled person and level of knowledge, 195**

**Solution of same problem, priority, 377**

**Sound recordings, 583**

**Speaking time, oral proceedings, 588**

**Specialist journals as common general  
knowledge, 76**

**Speculative character of closest prior art,  
170**

**Standard of proof, 683**

Abusive conduct, evidence, 691

Balance of probabilities, 683

Prior art documents, availability to the public,  
687

Public prior use, 684

~ for allowing amendments and corrections,  
489

**State of the art, 69**

Applications with same filing or priority date, 70

Common general knowledge, 75

In-house knowledge not published before  
priority date, 74

Non-prejudicial disclosures under Article  
55 EPC, 73

Patent application, prior art acknowledged, 74

PCT applications as ~, 72

Prior rights, 70

Relevant date of documents, 70

**Statement**

~ of grounds of appeal, 1095

New case raised by opponent in ~, 1103

New case raised by patent proprietor in ~,  
1103

Partial admissibility of appeal, 1108

Revocation of patent, 1108

~ not received by respondent and right to  
be heard, 535

Substantial procedural violation, 1108

~ of purpose in non-medical use claims, 156

~ of purpose of surgical use for a known  
instrument, 146

~s in writing as means of evidence, 660

**Stay of**

- ~ appeal proceedings following a referral, 1225
- ~ first instance proceedings following a referral, 1225
- ~ proceedings, 768, 773
  - European Patent Register, 771
  - Filing of divisional application during ~, 499
  - Inspection of files, 768
  - National court, 774

**Straw man, opposition procedure, 1010****Structural formula incorrect, 452****Structural similarity in chemical inventions, 230****Subject-matter of patent granted on divisional application, 496**

- Ground for opposition under Article 100(c) EPC, 496

**Subject-matter under examination in appeal procedure, 1118**

- Admissibility of opposition, 1118
- Appeal by patentee against revocation, 1120
- Notice of appeal, 1119

**Subsequent filing of missing parts of description or missing drawings, 842****Substances, 122, 125**

- Anticipation of certain compounds, 123
- Enantiomers, 127
- Novelty of enantiomers, 127
- Novelty of groups of ~, 125

**Substantial procedural violation, 1108, 1191**

- Ambiguous communication, 1204
- Composition of opposition division, 1200
- Error of judgment, reimbursement of appeal fee, 1196
- Inadequate reasons in decision at first instance, reimbursement of appeal fee, 1196
- Oral proceedings, reimbursement of appeal fee, 1193
- Partiality, reimbursement of appeal fee, 1202
- Reimbursement of appeal fee, 1191
- Remittal following ~, 1175
- Right to be heard, reimbursement of appeal fee, 1195
- Signature on decision and minutes, 1200
- Statement of grounds of appeal, 1108

- Suspensive effect of appeal, reimbursement of appeal fee, 1203
- Wrong form, 1204

**Substantive examination, 865**

- Amendments under Rule 137(3) EPC, 872
- Communication from examining division, failure to reply, 878

- Communications in examination procedure, 879

- Communications under Rule 71(1) and (2) EPC, 866

- Consolidation of proceedings in examination procedure, 866

- Informal communications in examination procedure, 885

- Refusal after a single communication in examination procedure, 869

**Substitution of materials, analogous use, 227****Sufficiency of disclosure, 257, 327**

- Antibodies, ~, 349
- Budapest Treaty, ~, 355
- Clarity, 333
- Complete disclosure, 333
- Disclosure, see ~, 327
- Evidence, ~, 362
- Experiments, ~, 341
- Medical use, ~, 347
- Parameters, ~, 335
- Relationship between Article 83 and Article 84 EPC, 356
- Relevant date, ~, 328
- Relevant parts of application, ~, 329
- Repeatability, ~, 338, 346
- Reproducibility, ~, 338
- Skilled person, relevant knowledge, 330
- ~ and clarity of claims, 358
- ~ and support from description, 356
- ~ in biotechnology field, 344
- Trial and error, ~, 340, 343
- Sufficiency of disclosure in biotechnology field, 344**
- Antibodies, sufficiency of disclosure, 349
- Clarity of disclosure, 344
- Deposit of living material, 353
- Medical use, sufficiency of disclosure, 347

Nucleotide and amino acid sequences, 353  
Undue burden, sufficiency of disclosure, 351

**Surgical intervention, 57**

**Surgical methods, 51, 52, 53**

Apparatus claim, 55

Disclaimers, 56

Medical practitioner, 52

Methods concerning operation of a device, 56

Surgical intervention, 57

**Surprising effect, 250**

**Surprising grounds or evidence and right to be heard, 533**

Statement of grounds of appeal not received by respondent and right to be heard, 535

**Surrender of patent, 973**

**Suspensive effect of appeal, 1066**

~, reimbursement of appeal fee, 1203

**Swiss-type claim, 139, 475**

**Synergistic effects, 233**

---

**T**

---

**Taking of evidence, 664**

Return of filed evidence, 674

Right to be heard, 671

**Teaching in priority document, 378**

**Technical**

~ and non-technical features, 197, 199

Aim to be achieved in formulation of technical problem, 207

Mathematical algorithms, 222

Meta methods for software production, 221

Presentations of information, 210

Problem and solution approach and "mixed" inventions, 201

~ board of appeal competent, 1075

~ character of an invention, 3, 198

~ disclosure in prior art document, 226

~ effect invoked subsequently, 179

~ effect on a physical entity, 19

~ features, claims, 263

~ implementation of excluded subject-matter, 205

~ inventions, 2

Contribution approach, ~, 5

Patentability requirements, 4

Presence of an invention under Article 52(1) EPC, 4

~ prejudice, 244

~ problem, 172

Aim to be achieved in formulation of ~, 207

Alleged advantages, 175

Alternative solution to a known problem, 181

Formulation of ~, 175

Post-published documents, inventive step, 181

Reformulation of ~, 177, 458

Similarity of ~, 165

~, unity of invention, 312

**Telephone conversation, right to, 559**

**Telephone conversations in examination procedure, 885**

**Termination of appeal proceedings, 1164**

Closure of substantive debate in appeal proceedings, 1165

Deemed withdrawal of patent application, 1169

Interlocutory decisions of boards of appeal, 1166

Reimbursement of appeal fee, 1167

Withdrawal of appeal, 1167

**Test and experimental evidence, 678**

**Therapeutic**

~ application, 141, 150

Discovery of previously unknown property of compound, 146

Interpretation of "substance or composition", 144

New dosage regimen, 143

New technical effect, 142

New therapy with different mode of administration, 144

Novelty of ~, 141

Statement of purpose of surgical use for a known instrument, 146

~ methods, 51, 57, 147

Medical practitioner, 52

Therapeutic and non-therapeutic indications, 59

~ treatment of animals, 149

**Third party, intervention, 967**

**Third party's legal status, 779****Time**

- ~ factor, 246
- ~ limit for appeal, 1086
  - Appeal fee, 1095
  - Electronic filing of appeal, 1086
  - Filing of appeal, 1094
  - ~, European qualifying examination, 1256
- ~ limit for intervention, 971
- ~ limits, 591
  - Calculation of ~, 591
  - Excluded ~, re-establishment of rights, 605
  - Extension of ~ due to public holidays or dislocation in delivery of mail, 593
  - Further processing, 595
  - Inability to observe ~ and re-establishment of rights, 612
  - Interruption of proceedings, 596
    - ~ concerning PCT and re-establishment of rights, 605
- ~ limits for filing request for re-establishment of rights, 606
  - One-year time limit and re-establishment of rights, 611
  - Removal of cause of non-compliance and re-establishment of rights, 606

**Timing of decisions and right to be heard, 540**

- Immediate refusal after communication, 541
- Invitation to oral proceedings, 542

**Title of invention, opposition proceedings, 1017****Transfer together with related business assets, 961****Transfers and Patent Register, 772****Translations and language privilege, 649****Transposition of features within claims, 470****Trial and error, sufficiency of disclosure, 340, 343**

- Reproducibility, sufficiency of disclosure, 343
- Reproducibility without undue burden, 340

**Tribunals under Article 6 European****Convention on Human Rights, 1270****Try and see situation, 187****U****Unclear requests, 526****Undue burden, sufficiency of disclosure, 351****Uniform application of law, Enlarged Board of Appeal, 1221****Unity**

- ~ in context of different types of claims, 303
  - Dependent claims, 305
  - Independent claims, 303
  - Intermediate products, unity of invention, 306
- ~ of invention, 302
  - Examination proceedings, ~, 309
  - Intermediate products, ~, 306
  - International Searching Authority, ~, 308
  - Opposition proceedings, ~, 311
  - Search fees where plurality of inventions, 321
  - Single general inventive concept, ~, 314
  - Technical problem, ~, 312
- ~ of invention, lack of, 312
  - Technical problem, unity of invention, 312

**Universal succession, 960****Unsearched subject-matter, 325**

- Amendments relating to ~, 918

**Unspecified features, claims, 280****Unsubstantiated requests, 1132****Use claim, 474, 475**

- Product-by-process claims and ~s, 299
- Statement of purpose in non-medical ~s, 156
- ~s and process claims, 150

**Use of known process for particular purpose, 152****Utility models and availability to the public, 80****V****Variants, 339****Video conference, 581**

- Oral proceedings by ~, 581

**Vienna Convention on the Law of Treaties, 705****Violation of right to be heard, examination ex officio, 532**

---

**W**

---

**Waiver by applicant of right to present comments, 879**

**Ways of making information available to the public, 78**

Biological material and availability to the public, 89

Internet and availability to the public, 83

Lectures and oral disclosures and availability to the public, 81

Public prior use, 86

Publications and availability to the public, 78

**Withdrawal of**

~ amendments in examination procedure, 902  
Claims fees, non-payment, 903

~ appeal, 998, 1167

~ after filing of intervention, 1168

~, reimbursement of appeal fee, 1189

~ opposition, 976, 998

~ patent application, 903

Correction of withdrawal of application, 906

Deemed ~, 1169

~ request for oral proceedings, 562

**Witness testimony, 676**

~ as means of evidence, 657

Expert opinions, 659

Hearing of witnesses, 657

**Word-processing, 30**

**Written statements, 676**